



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

Citation: 2013 TMOB 47
Date of Decision: 2013-03-25

**IN THE MATTER OF AN OPPOSITION
by Canadian Council of Professional
Engineers, c.o.b. Engineers Canada to
application No. 1,392,077 for the trade-
mark GENDER ENGINEERING in the
name of Mizuno Corporation**

[1] On April 18, 2008, Mizuno Corporation (the Applicant), filed an application for the trade-mark GENDER ENGINEERING (the Mark) based upon proposed use of the Mark in Canada in association with the following wares: “footwear, namely athletic footwear, sports shoes, casual shoes”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of February 4, 2009.

[3] On April 3, 2009, Canadian Council of Professional Engineers, c.o.b. Engineers Canada, (the Opponent) filed a statement of opposition against the application. The grounds of opposition may be summarized as follows: the Applicant’s application does not conform to the requirements of section 30(a), section 30(e) and section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark is not registrable pursuant to section 12(1)(b) and section 12(1)(e), and the Mark is not distinctive.

[4] The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations. On April 16, 2010, the Applicant was granted leave to file an amended counter

statement wherein the Applicant asserted that the Opponent does not constitute a public authority for the purposes of the Act and in particular for the purposes of section 9(1)(n)(iii).

[5] The Opponent's evidence consists of the affidavits of John Kizas, Manager, Intellectual Property and Committee Liaison with the Opponent, sworn November 6, 2009, and D. Jill Roberts, Assistant Bailiff with Regional Bailiff Services Ltd. and a certified copy of application No. 903,677 for the official mark ENGINEERING of which the Opponent is the owner. Both Mr. Kizas and Ms. Roberts were cross-examined on their affidavits and their transcripts, exhibits and replies to undertakings form part of the record.

[6] The Applicant filed the affidavit of Beki Ylipelkola, a law clerk employed by the agents for the Applicant, as well as the affidavit of John Stacey, President of Mizuno Canada Ltd. As evidence in reply, the Opponent filed a second affidavit of Mr. Kizas, sworn February 14, 2011, and the affidavit of Jennifer Allen, employee of the Opponent's agent.

[7] Both the Applicant and the Opponent filed a written argument. An oral hearing was conducted at which both parties were represented.

[8] On February 12, 2013, subsequent to the oral hearing, the Opponent requested leave to file an amended statement of opposition. The amended statement of opposition removes the grounds of opposition that relate to section 12(1)(e), section 10, section 30(i) and the Opponent's official mark. Despite the extreme tardiness in making this request, in view that the statement of opposition as amended simplified and reduced the issues in the proceeding, and did not cause any prejudice to the Applicant, I considered it to be in the interests of justice to grant leave to the Opponent to amend its statement of opposition. Leave to amend the statement of opposition was granted on March 25, 2013 and the statement of opposition, as amended, forms part of the record of this proceeding.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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 Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, S.A.* (2002), 20 CPR (4th) 155 (FCA)].

[10] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(b) - the filing date of the application [see *Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th) 250 (FCTD); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FCTD)];
- Section 38(2)(d)/non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

Section 12(1)(b) Ground of Opposition

[11] The Opponent has put forth the following two arguments under this ground of opposition:

- i. if members of the profession of engineering in Canada are involved in the production of the wares, the Mark is clearly descriptive of the character or quality of the wares and/or of the persons employed in the production of the wares;
- 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 the character or quality of the wares and/or of the persons employed in the production of the wares.

[12] The determination of whether a mark is clearly descriptive of the character or quality of the wares or of the persons employed in their production is one of first impression in the mind of a normal or reasonable person in the everyday use of the associated wares or services [see *Ontario Teachers Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60 at para. 29; *College of Traditional Chinese Medicine Practitioners and Acupuncturists of British Columbia v*

Council of Natural Medicine College of Canada, 2009 FC 1110 at para. 212]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34]. Further, the trade-mark in question must not be analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression, and in conjunction with the associated wares or services [see *Ontario Teachers, supra*, at para. 29; *Wool Bureau of Canada Ltd v Registrar of Trade-marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-28].

[13] As for the first argument under this ground, a similar issue was dealt with in *Canadian Council of Professional Engineers v Comsol AB*, 2011 TMOB 3, wherein Member Bradbury dealt with the question of whether or not the mark COMSOL REACTION ENGINEERING LAB was clearly descriptive or deceptively misdescriptive of the persons employed in the production of 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. In that decision, Member Bradbury held as follows:

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.

[14] In the present case, Mr. Kizas has introduced copies of the statutes regulating the engineering profession in Canada and highlighted the provisions regulating the use of engineering designations (Kizas, para. 14; Exh. 2-14). He has also provided certified confirmation from all the constituent associations that the Applicant is not registered to engage in the practice of engineering in Canada.

[15] Applying Member Bradbury’s reasoning to the present case, in view that that 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 character or quality of the wares and/or of the persons employed in the production of the wares.

[16] In view that members of the profession of engineers in Canada are not involved in the production of the wares, the next issue of the Opponent under this ground to be decided is whether the Mark is deceptively misdescriptive of the character or quality of the wares and/or of the persons employed in the production of the Wares. The proper test that needs to be applied 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 [see *Canadian Council of Professional Engineers v John Brooks Co* (2004) FC 586; *Chocosuisse Union des Fabricants – Suisses de Chocolate v Hiram Walker & Sons Ltd* (1983), 77 CPR (2d) 246 (TMOB); *Lake Ontario Cement Ltd v Registrar of Trade-marks* (1976), 31 CPR (2d) 103 (FCTD)].

[17] In the present case, the component ENGINEERING is arguably the dominant component of the Mark. It has previously been held that most people would assume that businesses using the word “engineer” or “engineering” in their name offer engineering services and employ professional engineers [see, for example, *Canadian Council of Professional Engineers v John Brooks Co* (2004) FC 586].

[18] The present case is distinguishable from many of the previous cases on this issue, however, because the Mark in the present case is used with a product not normally considered to require the expertise of engineers. In this regard, the Applicant’s evidence shows that the GENDER ENGINEERING mark is used in association with shoes which have been specifically designed to address the different running styles and anatomy of male and female runners [Stacey, para. 14; Exhibit E]. Further, while the Opponent’s evidence suggests that both “sports engineering” and “biomechanical engineering” may be recognized engineering disciplines involved in the design of footwear [Kizas, paras. 37-40], the evidence does not show that “gender engineering” exists as a sub-discipline of engineering or would likely be viewed as such [Kizas affidavit, paras. 22, 37-40 and 47]. Finally, although much of the case law concerns engineering firms whose names have consisted of a surname followed by the word “engineering”, unlike the word “Brooks” in the *John Brooks* case or “Krebs” in the *Canadian Council of Professional Engineers v Krebs Engineers* (1996), 69 CPR (3d) 267 (TMOB) decision, the evidence in the present case does not show that the word GENDER is a common surname in Canada, or that it would be perceived as a surname [Roberts affidavit, para. 4-5; Exh. 6-13].

[19] What the Applicant's evidence in the present case does also show, however, is that Japanese engineers are involved in the research and design of the Applicant's shoes [Stacey affidavit, para. 17]. Since these engineers are not members of the profession of engineering in Canada, I find that the Mark is not registrable because it is deceptively misdescriptive of the character or quality of the wares and/or of the persons employed in the production of the wares. This ground is therefore successful.

Section 30(a) Ground of Opposition

[20] In its written argument, the Opponent submits that the Applicant's evidence shows that it is not selling shoes in association with the mark GENDER ENGINEERING but is rather advertising footwear technology that is incorporated into its shoe. As such, the Opponent submits that the Applicant has failed to describe the wares used or proposed to be used in association with the trade-mark in ordinary commercial terms. The Opponent submits that if it is not the Applicant's intention to use the Mark in association with shoes, then it has not complied with this section of the Act. The Opponent's agent confirmed at the oral hearing that this argument is based on common sense and is not supported by the jurisprudence.

[21] However, as the Applicant argued, the Mark in the present case is based on proposed use, and there is no obligation on the Applicant to show use of the Mark with the applied for wares until the Mark has been allowed [see *Molson Canada v Anheuser-Busch Inc* (2003), 29 CPR (4th) 315 (FCTD)]. Further, the test to be applied under section 30(a) is that the description of wares in a trade-mark application "must clearly set forth wares or services as they are customarily referred to in the trade (emphasis added)." [See *Dubiner and National Yo-Yo and Bo-Lo Ltd v Heede Int'l Ltd* (1975), 23 CPR (2d) 128 (TMOB) and *Pro Image Sportswear, Inc v Pro Image, Inc* (1992), 42 CPR (3d) 566 at 573.] The test is not based on what the Applicant's intention is. As the Applicant in the present case has set forth wares as they are customarily referred to in the trade, I conclude that the Applicant has satisfied the test under section 30(a) in the present case and this ground fails.

Section 30(e) Ground of Opposition

[22] With respect to the section 30(e) ground of opposition, since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the trade-mark in Canada, it formally complies with section 30(e). The issue therefore becomes whether or not the Applicant substantially complied with section 30(e), i.e. was the Applicant's statement that it intended to use the Mark true? [See *Home Quarters Warehouse, Inc v Home Depot, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB).]

[23] Since the facts regarding the Applicant's intentions are particularly within the knowledge of the Applicant, the initial burden on the Opponent is lighter than usual regarding section 30(e) [see *Molson Canada v Anheuser-Busch, supra*]. However, if the Opponent relies upon the Applicant's evidence to meet its initial burden, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd v ICON Health & Fitness Inc* (2001), 13 CPR (4th) 156 (TMOB)].

[24] In the present case, I am not satisfied that the Opponent has met its initial onus under section 30(e) for the following reasons. First, as noted above, there is no requirement on the Applicant to show use of its Mark until it has been approved [see *Molson Canada v Anheuser Busch, supra*]. Therefore, the fact that the evidence may not show the Mark in association with footwear to date pursuant to section 4(1) of the Act is not relevant. Second, the fact the Applicant may have shown use of the Mark in association with footwear technology incorporated into its shoes, is not, in my view, clearly inconsistent with the Applicant's claim that it intends to use the Mark in association with footwear.

[25] The section 30(e) ground of opposition is accordingly dismissed.

Section 38(2)(d) Ground of Opposition

[26] The Opponent also pleads that the Mark is not distinctive in that it is not capable of distinguishing the Applicant's wares from the wares of others, including other entities which are licensed to practice engineering in Canada. The Opponent further submits that any use by the

Applicant of the 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.

[27] In its written argument, the Opponent presents the following three arguments under this ground:

1. In view that the Applicant does not use or intend to use the Mark with shoes, the Mark cannot and does not distinguish the Applicant's shoes from the shoes of others.
2. Where a trade-mark consists primarily of unregistrable components, such as descriptive words or phrases, it cannot actually distinguish nor can it be adapted to distinguish the Applicant's wares from those of others.
3. The applicant's mark fails to distinguish the Applicant's wares from those of others, including other engineers in general and other engineers with the surname GENDER in particular and other entities which are licensed to practice engineering in Canada.

[28] I will begin by addressing the first and third arguments raised.

[29] As noted above, there is no evidence that the Applicant does not use or does not intend to use the Mark with shoes. Further, while the Opponent has evidenced that GENDER is a surname, the evidence does not show that GENDER has become known either by itself as a common surname or as a surname in association with entities who are licensed to practice engineering in Canada such that it would negate the distinctiveness of the applied for mark.

[30] However, with respect to the Opponent's second argument under this ground, it is apparent that one of the other bases on which the Opponent is submitting that the Mark is not distinctive is that it is clearly descriptive or deceptively misdescriptive. A trade-mark that is clearly descriptive or deceptively misdescriptive of either the character or quality of the wares and/or of the persons employed in the production of the wares is *prima facie* not distinctive. Hence, based on my finding under the section 12(1)(b) ground of opposition, the distinctiveness ground of opposition also succeeds.

Disposition

[31] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office