



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

Citation: 2013 TMOB 14
Date of Decision: 2013-01-23

**IN THE MATTER OF AN
OPPOSITION by Canadian Institute of
Bookkeeping Incorporated to
application No. 1,323,105 for the trade-
mark CERTIFIED BOOKKEEPER in
the name of Canadian Institute of
Professional Bookkeepers**

FILE RECORD

[1] On December 6, 2006, Gordon Skillen doing business as Canadian Institute of Professional Bookkeepers filed an application to register the trade-mark CERTIFIED BOOKKEEPER, based on proposed use in Canada, in association with the following wares and services:

wares

- (1) Printed publications, namely, books, booklets, . . . all in the fields of bookkeeping.
- (2) Course and education materials namely computer software and CD ROMS used for educational purposes, data bases, . . . all in the fields of bookkeeping.
- (3) Electronic publications namely books, booklets, . . . all in the fields of bookkeeping.
- (4) Promotional clothing namely hats, caps, pants, jackets, . . .
- (5) Promotional merchandise namely jewellery, watches, clocks, . . .

services

- (1) Promotion of the interchange of knowledge through website creation, development and hosting all in the fields of bookkeeping.
- (2) Education and continuing educational services namely lectures, courses, programs, presentations, . . . all in the fields of bookkeeping.
- (3) Advancement of the profession of certified bookkeeper namely providing professional bookkeeping services, . . .
- (4) Dissemination of research about certified bookkeeper, . . .
- (5) Development and maintenance of a program of professional studies and examinations leading to a certification as a certified bookkeepers.

[2] The Examination Section of the Canadian Intellectual Property Office (the Office under whose aegis this Board operates), which administers the initial stage of trade-mark applications, objected to the applied-for mark in the following terms in its letter to the applicant dated April 11, 2007:

The mark which is the subject of this application is considered to be either clearly descriptive or deceptively misdescriptive of the wares (1), (2) and (3) and of the services in association with which it is proposed to be used since it clearly indicates that the content of the educational materials and electronic publications relate to and are of interest to certified bookkeepers, and that the services relate to and are of interest to certified bookkeepers.

In view of the provisions of paragraph 12(1)(b) of the Trade-marks Act, this mark does not appear registrable in respect of the above wares and services.

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A revised application is required.

Your attention is directed to co-pending and confusing application no(s) 1,324,775 particular(s) attached, over which you appear to be entitled.

[3] The applicant responded to the Examination Section by filing a revised application which deleted the wares (1), (2) and (3) and all the services. Thus, the application of record covers various items of clothing and merchandise as specified in paragraphs (4) and (5), above. The initial applicant also advised that the application had been assigned from Gordon Skillen to the Canadian Institute of Professional Bookkeepers, the present applicant of record.

[4] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated February 24, 2010 and was opposed by Canadian Institute of Bookkeeping Incorporated (“CIB”), the owner of application No. 1,324,775 cited by the

Examination Section, on August 31, 2010. The Registrar forwarded a copy of the statement of opposition to the applicant on September 28, 2010, as required by s.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.

[5] The opponent's evidence consists of the affidavits of Walter Krystia and Karen Lau Cardinell. The applicant elected not to file any evidence in support of its application. Both parties submitted a written argument, however, neither party requested an oral hearing. During the course

STATEMENT OF OPPOSITION

[6] The grounds of opposition as pleaded are shown in full below:

(a) Pursuant to Section 38(2)(a) of the Act, the application does not comply with Section 30(i) of the Act, in that the Applicant could not have been and cannot be satisfied of its entitlement to use the Trade-mark in Canada in association with the wares set out in the application because, at the time of filing its application, the trade-mark was and is descriptive of promotional items aimed at the target market of consumers of the products namely, certified bookkeepers and should be open to all companies that certify bookkeepers to use with promotional items.

(b) Pursuant to Section 38(2)(b) of the Act, the Trade-mark is not registrable pursuant to Section 12(1)(b) in that the Trade-mark was and is clearly descriptive of the target market of consumers of these promotional products namely, certified bookkeepers. A monopoly in the mark should not be granted to the Applicant because it would prevent other companies that certify bookkeepers from using this description with respect to promotional items such companies may sell.

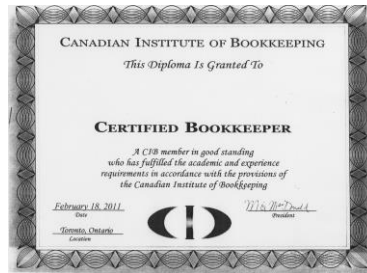
(c) Pursuant to Section 38(2)(d) of the Act, the Applicant's Trade-mark is not distinctive within the meaning of Section 2, in that it does not distinguish nor is it adapted to distinguish, nor is it capable of distinguishing the wares of the Applicant as described in Application No. 1,323,105, from the wares of others and more particularly, from the promotional wares of other companies that certify bookkeepers.

OPPONENT'S EVIDENCE

Walter Krystia

[7] Mr. Krystia identifies himself as the program director of the opponent company. The opponent CIB is a national non-profit organization which is concerned with educational, professional and ethical standards in the bookkeeping profession. CIB

members must obtain a certain level of education and agree to abide by the CIB's Code of Professional Conduct. Seventy-eight community colleges across Canada partner with CIB to offer bookkeeping courses that meet CIB requirements. When a CIB member has obtained the academic and practical experience set by CIB, the member receives a diploma bearing the designation Certified Bookkeeper. In the period 1996-2011, 432 individuals were granted the diploma, an example of which is shown below:



The Certified Bookkeeper designation indicates that the recipient has obtained educational and training courses in the field of bookkeeping as approved by CIB.

[8] The opponent CIB is the owner of the registered design certification mark, shown below, for bookkeeping services.



The opponent is also the owner of the pending application for the certification mark CERTIFIED BOOKKEEPER & Design (application No. 1,324,775), shown below, for bookkeeping services.



[9] It may be helpful at this time to include the definition of a certification mark and the terms of its use as set out in s.2, s.23(1) and s.23(2) of the *Trade-marks Act*:

- s.2 “certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to
 - (a) the character or quality of the wares or services,

- (b) the working conditions under which the wares have been produced or the services performed,
- (c) the class of persons by whom the wares have been produced or the service performed, or
- (d) the area within which the wares have been produced or the services performed, from wares or services that are not of that defined standard;

23. (1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

(2) The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

[10] The opponent has been promoting its business in Canada using the mark CERTIFIED BOOKKEEPER since 1993. In 1994 the opponent began advertising and offering its bookkeeping courses in calendars distributed by community colleges across Canada. Since 1999 the opponent has been advertising its bookkeeping services to the public and to the accounting profession in various local and national publications. From 2005 – 2010 the opponent spent over \$57,000 on advertising. Since 2000 the opponent has been advertising its services on its website using the CERTIFIED BOOKKEEPER mark.

Karen Lau Cardinell

[11] Ms. Cardinell identifies herself as a legal assistant employed by the firm representing the opponent. In April 2011 Ms. Cardinell conducted a computer search of the trade-marks register for trade-marks comprised of the words “certified” and “bookkeeper.” The search revealed five marks all in the name of the opponent. She also conducted searches on the Internet, using the search engine www.google.ca, for the terms “certified bookkeeper” and “certified bookkeeping” the (partial) results of which are attached as Exhibits C and D to her affidavit. Ms. Cardinell also conducted a search on the online telephone directory website www.canada411.ca for the terms “certified bookkeeper” and “certified bookkeeping” for businesses in Canada. Two business names were located: see Exhibit E of her affidavit. A search of “bookkeeping” in business names for all of Canada turned up 25 pages of results with about 40 businesses per page.

FIRST GROUND OF OPPOSITION

[12] The opponent's submission in its written argument with respect to the first ground of opposition may be summarized as follows. The application as initially filed shows that the applicant intends to provide services in the area of bookkeeping. The wares denoted by (4) and (5) (see para. 1, above) are "inextricably and inherently linked to the services offered by the Applicant . . . the Applicant proposes to use the mark in association with those wares for the purpose of promoting itself in general and its services in particular." The wording of the application implies that the applicant is seeking a trade-mark registration with wares intended solely to promote its services. The applicant is seeking a trade-mark registration for wares because s.12(1)(d) prevents the applicant from securing a trade-mark registration for its bookkeeping services. However, distributing marked wares for promotional purposes and to generate goodwill is not use of a mark in association with wares within the meaning of s.4(1) of the *Trade-marks Act*: see *Renaud Cointreau & Cie v. Cordon Blue International Ltd*, 188 FTR 29, aff'g (1993), 52 CPR(3d) 284 (TMOB). The opponent submits that:

. . . the impugned application is nothing more than a thinly veiled effort to secure a monopoly in the *wares* with which it may "use" the mark in association with its *services*, by using or displaying the mark in the advertising and promotion of those services by distributing those wares.

[13] The opponent therefore concludes that the applicant has acted in bad faith in applying for the subject mark to be used in association with wares. In the absence of evidence from the applicant on this point, I agree with the opponent.

[14] Ordinarily such a finding of bad faith is sufficient to support a s.30(i) ground of opposition resulting in a refused application. However, the pleading in the statement of opposition does not allege bad faith on the part of the applicant. As noted in *Massif Inc. v. Station Touristique Massif du Sud (1993) Inc.* (2011) 95 CPR(4th) 249 (FCTD):

[27] It is settled law that the Board is not authorized to allow an opposition on the basis of a ground that has not been raised by the opposing party. In *Imperial Developments Ltd. v. Imperial Oil Ltd.*, 26 A.C.W.S. (2d) 155, 79 C.P.R. (2d) 12 (Justice Muldoon), the Court stated that an organization such as the Registrar of Trade-Marks is a creature of statute and that it has no inherent or extrinsic jurisdiction in its constituting legislation. The Court also stated that [95 C.P.R. (4th) p. 261] the Registrar called on to dispose of an opposition could not base its decision on a ground that had not been stated in the statement of opposition.

[28] More recently, in *Procter & Gamble Inc. v. Colgate-Palmolive Canada Inc.*, 2010 FC 231, 364 F.T.R. 288, at paragraph 26, 81 C.P.R. (4th) 343 , Justice Boivin also adopted this jurisprudential principle:

... The Respondent submits it is settled law that there is no jurisdiction to deal with an issue not found in a Statement of Opposition and this Court does not have jurisdiction to entertain issues that were not raised before the Board (*McDonald's Corp. v. Coffee Hut Stores Ltd.* , (1994), 76 F.T.R. 281, 55 C.P.R. (3d) 463 , aff'd (1996) 199 N.R. 106, 68 C.P.R. (3d) 168 (F.C.A.)). I agree with the Respondent....

[29] I agree with these principles.

(emphasis added)

[15] In the instant case the pleading framed in the first ground of opposition is based on a descriptiveness issue which does not support an allegation of non-compliance with s.30(i). In accordance with *Massif*, above, I find that I do not have jurisdiction to consider a ground of opposition argued on the basis of bad faith when bad faith has not been pleaded. The first ground of opposition is therefore rejected.

SECOND GROUND OF OPPOSITION

[16] The opponent submits in its written argument that the term “CERTIFIED BOOKKEEPER” clearly describes a recognized profession and is therefore not registrable under s.12(1)(b). In this regard, the opponent relies on *Canadian Council of Professional Engineers v. Lubrication Engineers Inc.* (1992), 41 CPR(3d) 243 at para 2 (FCA), shown below:

First, we are of the view that the appellant's trade mark LUBRICATION ENGINEERS for use in association with greases, oils and lubricants, was not registrable under s. 12 of the *Act*. The words "Lubrication Engineers" describe a recognized occupation or profession (see Canadian Classifications and Dictionary of Occupations; see also American Society of Lubrication Engineers, Constitution). Their use as a trade mark in association with wares which are themselves intimately associated with the practice of that occupation or profession fails to distinguish those wares in any way. In the words of s. 12(1)(b), the trade mark is "either clearly descriptive or deceptively misdescriptive ... of the character or quality of the wares ... or the persons employed in their production". In the same way as such marks as PIPEFITTERS wrenches, DOCTORS thermometers, or SURVEYORS theodolites, the trade mark LUBRICATION ENGINEERS grease is prima facie unregistrable (the matter being one of first impression it matters little that the possessive apostrophe may be omitted, as it is in the case at bar). This is the basis of the decision of the Exchequer Court in the *Finishing Engineers'*

case: see *Association of Professional Engineers of Ontario v. Registrar of Trade Marks* (1959), 31 C.P.R. 79 , [1959] Ex. C.R. 354, 19 Fox Pat.C. 69.
(emphasis added)

[17] In my view, the *Lubrication Engineers* case, above, does not support the opponent's argument because clothing and general merchandise as specified in the subject application are not intimately associated with the practice or profession of bookkeeping. There is no reason to believe that the consumer would conclude that such wares were produced by a certified bookkeeper since there is no connection between bookkeepers and such wares.

[18] In any event, the second ground of opposition as framed in the pleading is based on the applied-for mark being "clearly descriptive of the target market of consumers of these promotional products namely, certified bookkeepers." The issue raised by the opponent in the statement of opposition has not been addressed by the opponent in its evidence or by argument. Accordingly, the second ground is rejected.

THIRD GROUND OF OPPOSITION

[19] With respect to the third ground of opposition, the applicant's defense, as I understand it, is that the evidence filed by the opponent is inconsistent and insubstantial in relation to its marks CERTIFIED BOOKKEEPER & Design (application No. 1,324,775) and CERTIFIED BOOKKEEPER. I agree with the applicant to the extent that Mr. Krystia in his affidavit on occasion appears to be claiming use (in the legal sense) of the mark CERTIFIED BOOKKEEPER for bookkeeping services offered by the opponent. However, in such instances Mr. Krystia is referencing exhibit material showing (i) the term being used in a descriptive sense to designate an occupation or (ii) the opponent is using the term "bookkeeping services" to indicate the training services that it offers to others, not that it is offering the services offered by its members. In the absence of evidence from the applicant or cross-examination of Mr. Krystia, I have no reason to doubt that the opponent is using its certification marks in compliance with s.23 of the *Trade-marks Act*.

[20] I also agree with the applicant that the opponent might have provided fuller and more quantitative evidence concerning the use of the certification marks CERTIFIED

BOOKKEEPER & Design and CERTIFIED BOOKKEEPER. However, as noted by Addy J. in *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 CPR(2d) 44 at 58 (FCTD):

On the issue of lack of distinctiveness of a mark, although it must be shown that the rival or opposing mark must be known to some extent at least, it is not necessary to show that it is well known . . . It is sufficient to establish that the other mark [the opposing mark] has become known sufficiently to negate the distinctiveness of the mark under attack [the applied-for mark].

[21] In the instant case, I find that the opponent has established that the mark CERTIFIED BOOKKEEPER has become known sufficiently to negate the distinctiveness of the applied-for mark. The opponent therefore succeeds on the third ground of opposition.

[22] I would add that the opponent might have framed the third ground of opposition in more specific terms. However, I have followed the guidance in *Novopharm Ltd. v. AstraZeneca AB* (2002), 21 C.P.R. (4th) 289 at para. 8, rev'g 13 CPR (4th) 61, aff'g 1 CPR (4th) 403, aff'g 1 CPR (4th) 397 and I have determined that the evidence filed by the opponent has cured any deficiencies in the third pleading:

. . . Once evidence is filed, the Registrar must take the evidence into consideration when deciding whether the parties know the case they have to meet and whether they are able to respond. The filed evidence may cure whatever inadequacy may be in the pleadings.

DISPOSITION

[23] In view of the foregoing, the application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

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