

**IN THE MATTER OF AN OPPOSITION  
by the Association of Professional  
Engineers, Geologists and Geophysicists of  
Alberta to application No. 1157042 for  
the certification mark PE filed by the  
Alberta Institute of Power Engineers**

On October 15, 2002, the Alberta Institute of Power Engineers (the “Applicant” or “AIPE”) filed an application to register the certification mark PE (the “Mark”) based upon use of the Mark in Canada in association with Professional Power Engineering Services since July, 2001. The specific standards for use of the Mark are as follows: A class of persons who a) hold a valid Power Engineer’s Certificate of Competency in any jurisdiction in Canada or equivalent certification issued by the appropriate government regulatory authority; and b) are members in good standing of the Institute of Power Engineers (Canada).

The application was subsequently amended December 13, 2004, to include the following statement: The applicant 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.

On February 10, 2006, the statement of services was amended and now reads as follows:

Professional Power Engineering Services, namely the operation and maintenance of industrial equipment (such as boilers, steam and gas turbines, generators, gas and diesel internal combustion engines, motors, pumps, condensers, compressors, heat exchangers, heat engines, pressure vessels, water treatment systems and related controls), the operation and maintenance of heating, air-conditioning, ventilation and refrigeration systems, the operation and maintenance of fire systems, the operation and maintenance of building control systems; but specifically excluding all professional engineering services (such as electrical engineering).

The application was advertised for opposition purposes in the Trade-marks Journal of March 3, 2004.

On August 3, 2004, the Association of Professional Engineers, Geologists and Geophysicists of

Alberta (the “Opponent” or “APEGGA”), filed a statement of opposition against the application. The Applicant filed and served a counter statement, in which it denied the Opponent’s allegations.

The Opponent’s evidence consists of the affidavit of Albert J. Schuld, Deputy Registrar of the Opponent. The Applicant’s evidence consists of the affidavit of Ray Shupac, and two affidavits of Matt Park (one sworn August 26, 2005, and one sworn February 2, 2006). As its evidence in reply, the Opponent filed a second affidavit of Mr. Schuld. Neither affiant was cross-examined.

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

The statement of opposition alleges the following:

1. PE is a term which is commonly used throughout North America to indicate a Professional Engineer.
2. In the province of Alberta, where the AIPE operates, only APEGGA can license Professional Engineers.
3. A person certified by AIPE is not a Professional Engineer.

The only ground of opposition pleaded is as follows: “...the trade-mark is not registrable, because, contrary to s. 12(1)(b) it is deceptively misdescriptive of the character or quality of the services in association with which it is used or proposed to be used.”

The material time for considering s. 12(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) is the filing date of the application (see *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4<sup>th</sup>) 541 (T.M.O.B.); *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4<sup>th</sup>) 60 (F.C.T.D.)). The issue is to be determined from the point of view of an everyday user of the wares or services. Further, 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 (F.C.T.D.) at 27-28, and *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)).

Although there is a legal burden upon the Applicant to show that its mark is registrable, the Opponent must first adduce sufficient evidence to support its claim that the mark is deceptively misdescriptive (see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)).

In his affidavit, Mr. Schuld states that the term PE is the designated abbreviation for Professional Engineer in the United States and, the term PE has increasingly come into “common usage” in Canada as designating a Professional Engineer as a result of cross-border business subsequent to the North American Free Trade Agreement (NAFTA). Attached as Exhibit A to his affidavit is an excerpt from the Texas Engineering Practice Act which refers to the use of “PE” by Professional Engineers licensed in the State of Texas. Mr. Schuld states that this “Professional Identification” is representative of that found in other states within the U.S.

Mr. Schuld goes on to state that in order to become licensed to practise in the U.S., Professional Engineers in Canada must write the National Council of Examiners for Engineering and Surveying (“NCEES”) Fundamentals of Engineering Examination. Attached as Exhibit B to his affidavit is an excerpt taken from the NCEES website relating to licensure in the U.S. According to Mr. Schuld, approximately 70 members of the Opponent take this examination each year. He estimates that the number of members of the Opponent who have reciprocal qualifications and are entitled to use the “PE” designation in the U.S. to be in the order of 1000 members. He further explains that the Opponent monitors U.S. Professional Engineers who are working on projects within Alberta, and the records indicate that there are 207 U.S. Professional Engineers registered with the Opponent.

Attached as Exhibit C to his affidavit is a copy of s.3 of the Engineering, Geological and Geophysical Professions Act (“the EGGP Act”) relating to terms that licensed Professional Engineers may use in Alberta. He explains that any Professional Engineer who has dual

qualifications is entitled to use the PE designation. He attaches as Exhibit D to his affidavit an excerpt from a website “www.answers.com” which provides background on Professional Engineer and the “post nominal letters” used to designate a Professional Engineer in various jurisdictions. Exhibit E is an excerpt from the website “www.nspe.org” that discusses issues relating to mobility of Professional Engineers working in both the United States and Canada.

Mr. Schuld goes on to state that most of the members of the Applicant do not meet the standards necessary for admission into the Opponent’s organization. He also states that some of the Opponent’s Professional Engineers are also qualified as Power Engineers.

The Applicant raised various objections to Mr. Schuld’s evidence, including objections to the Internet evidence presented by him. The reliability of Internet evidence was discussed by Madame Justice Lamer-Tremblay in *ITV Technologies Inc. v. WIC Television Ltd.* (2003), 29 C.P.R. (4<sup>th</sup>) 182 (F.C.T.D.) as follows:

“With regard to the reliability of the Internet, I accept that in general, official web sites, which are developed and maintained by the organization itself, will provide more reliable information than unofficial web sites, which contain information about the organization but which are maintained by private persons or businesses.

In my opinion, official web sites of well-known organizations can provide reliable information that would be admissible as evidence, the same way the Court can rely on Carswell or C.C.C. for the publication of Court decisions without asking for a certified copy of what is published by the editor. For example, it is evident that the official web site of the Supreme Court of Canada will provide an accurate version of the decisions of the Court.”

The Court did not provide much further guidance about what constitutes an “official website”.

In the present case, the “Answers.com” website’s disclaimer states that the entry is from Wikipedia, the leading “user contributed encyclopedia” and may not have been reviewed by professional editors. This disclaimer raises doubt about the website’s reliability. On the other hand, I note that the Trade-mark Trial and Appeal Board (“TTAB”) accepts evidence from Wikipedia provided that there is an opportunity to reply to it. In this regard, the TTAB acknowledges that while the online encyclopedia Wikipedia carries with it a certain degree of

risk of unreliability, it is not so much that it is completely inadmissible as long as the other side can reply to the evidence (see *In Re IP Carrier Consulting Group*, TTAB, Serial No. 78542726, 6/18/07). I also note that evidence from the Wikipedia was accepted at face value in the decisions *Build-A-Vest Structures Inv. v. Red Deer (City)*, (2006), 29 M.P.L.R. (4<sup>th</sup>) 210 and *Gauvin c. Vallée* 2006 QCCS 3363. As a result, I have given some weight to this evidence, although I note that it is not clear from this evidence whether the information on this website has been brought to the attention of consumers in the marketplace in Canada.

With respect to the excerpts taken from the NCEES and NSPE websites, while I am satisfied that the websites existed at the time the searches were performed, the evidence is not admissible for the truth of its contents since very little information was provided to establish that these may be “official websites” or that the information from them is reliable. In any case, there is no evidence that the information from these websites has been brought to the attention of any consumers in the marketplace in Canada.

The Opponent’s agent submits that even if I were not to give much weight to the exhibits attached to Mr. Schuld’s affidavit, in view that Mr. Schuld is Deputy Registrar of the Opponent (i.e. the Association of Professional Engineers, Geologists, and Geophysicists of Alberta), he has personal knowledge of the facts deposed in his affidavit. I agree. I also note that Mr. Schuld was not cross-examined on his affidavit.

While I am satisfied from the evidence that the term “PE” is the designated abbreviation for Professional Engineer in the United States, I am not satisfied from the evidence that the everyday user of the Applicant’s services in Canada understood that to be the meaning of the Mark in Canada as of the filing date of the Applicant’s application. In this regard, while there may be 1000 members of the Opponent who have reciprocal qualifications and are entitled to use the “PE” designation in the U.S., there is no evidence of actual use or reputation of this designation by any of those members, or anyone else, in Canada as of the filing date of the application. There is also no evidence that any of the 207 U.S. Professional Engineers who are registered with the Opponent use PE in Canada.

Further, while the EGGP Act precludes use of the title “Professional Engineer”, the abbreviation “P. Eng.” or any other abbreviation of that title by any individual, corporation, partnership or other entity who is not a Professional Engineer, this legislation does not identify PE as a recognized abbreviation of Professional Engineer in Canada.

In view that the Opponent has not shown that PE was a term commonly used in Canada as of the filing date of the application to indicate a Professional Engineer, the fact that the Opponent is the only association in Alberta that can license Professional Engineers does not by itself support an allegation that the applied for mark is deceptively misdescriptive of the character or quality of the applied for services. In this regard, the Applicant’s application as amended states that the services which will be provided by the Applicant specifically exclude all professional engineering services. As the Opponent has not met its burden under this ground, this ground is unsuccessful.

Even if I were satisfied that the Opponent had met its burden under this ground, the Applicant introduced various dictionary definitions to demonstrate the common meaning of the abbreviation PE. I note that the definitions for the abbreviation PE as found in the Canadian Oxford Dictionary are: Peru (international vehicle registration), physical education and Prince Edward Island (in official postal use). Although these meanings may not relate to “professional power engineering services”, they appear to be common enough meanings as likely to be recognized by members of the Canadian public. Bearing in mind that “clearly” means “easy to understand, evident or plain” in the context of s.12(1)(b) (see *Thorold Concrete Products Ltd. v. Registrar of Trade-marks* (1961), 37 C.P.R. 166), I do not consider that the Mark’s meaning is evident since there are multiple meanings attributable to it. There would therefore have been no basis from which I could have concluded that PE, when considered in its entirety and as a matter of immediate impression, deceptively misdescribed the character or quality of the services of the Applicant as being those of such a character that they are provided by professional engineers at the relevant date.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the Opponent's opposition in view of the provisions of s. 38(8) of the Act.

DATED AT Gatineau, Quebec, THIS 26th DAY OF November, 2008.

Cindy R. Folz  
Member  
Trade-marks Opposition Board