

**IN THE MATTER OF AN OPPOSITION
by Canadian Council of Professional Engineers
to application no. 851,453 for the trade-mark
ROTHENBUHLER ENGINEERING filed
by Rothenbuhler Engineering Company**

On July 21, 1997, the applicant Rothenbuhler Engineering Company filed an application to register the trade-mark ROTHENBUHLER ENGINEERING based on (1) use in Canada in association with "engineering services," and with the following wares, since at least as early as

1958:

radio transmitters; radio receivers; radio transceivers; radio remote control systems including transmitters and receivers; timers; well pump controllers;

security equipment, namely, remote terminals, master controllers, alarm bells, line modules, interrogators, responders, programmable clocks, keypad controls, switch controls, communications line security modules, tone encoders, voltage and current boosters, annunciator/loop expansion modules, alarm signal processors, polarity reversal monitors, interface boards, sound sensors, entry sensors, heat sensors, status controls, keyswitches, bill traps and door switches.

The subject Canadian application is also based on (2) use and registration of the applicant's mark ROTHENBUHLER ENGINEERING in the United States. The aforementioned United States mark was applied for on April 7, 1997 as application no. 75-271,232 and issued to registration no. 2,202,596 on November 10, 1998, for use in association with "engineering services" and with the following wares:

radio transmitters; radio receivers; radio transceivers; radio remote control systems, namely, transmitters, receivers, antennas, external speakers, battery chargers and mounting panels; timers; well pump

controllers;

security equipment, namely, remote terminals, master controllers, alarm bells, line modules, interrogators, responders, programmable clocks, keypad controls, switch controls, communications line security modules, tone encoders, voltage and current boosters, annunciator/loop expansion modules, alarm signal processors, polarity reversal monitors, interface boards, sound sensors, entry sensors, heat sensors, status controls, keyswitches, bill traps, namely, cash removal sensors and door switches.

The subject Canadian application claims a priority filing date of April 7, 1997, pursuant to section 34(1) of the *Trade-marks Act*, in respect of the above-mentioned parallel trade-mark application filed in the United States. In response to an objection by the Examination Section of the Trade-marks Office, the applicant disclaimed the right to the exclusive use of the word ENGINEERING apart from the trade-mark as a whole.

I note that, during the Examination process, the applicant submitted a certified copy of its United States trade-mark registration in support of the second basis of registration, pursuant to section 31(1) of the *Trade-marks Act*. United States registration no. 2,202,596 indicates first use of the mark in the United States in 1946 and first use in commerce in 1956. I also note that the applicant's mark ROTHENBUHLER ENGINEERING issued to registration in the United States on November 10, 1998, that is, subsequent to the filing of the subject Canadian trade-mark application.

The subject Canadian application was advertised for opposition purposes in the *Trade-marks Journal* issue dated October 20, 1999 and was opposed by Canadian Council of

Professional Engineers on March 20, 2000. The Registrar forwarded a copy of the statement of opposition to the applicant on May 23, 2000. The applicant responded by filing and serving a counter statement.

The statement of opposition pleads that (1) the applicant is a federation of provincial and territorial associations of engineers, (2) provincial and territorial statutes regulate the practice of engineering and use of the terms "engineer" and "engineering," (3) no person is entitled to practice engineering unless he is licensed to do so, (4) the applicant is not registered to practice engineering anywhere in Canada, (5) the opponent is the owner of several official marks including the marks ENGINEER, PROFESSIONAL ENGINEER, CONSULTING ENGINEER, and ENGINEERING.

The grounds of opposition allege that:

- (i) The application does not comply with section 30(b) of the *Trade-marks Act* because the applicant has not used its mark since 1958, or that use of the mark has not been continuous.
- (ii) The application does not comply with section 30(i) of the *Act* because (a) the term ROTHENBUHLER ENGINEERING cannot function as a trade-mark, and (b) the applicant is not registered to practice engineering in Canada and therefore use of the applied for mark in Canada is unlawful use.
- (iii) The applied for mark is not registrable, pursuant to section 12(1)(b) of the *Act*, because it is clearly descriptive or deceptively misdescriptive of the character or quality of the wares and services in association with which it is proposed to be used or of the persons employed in their

production.

(iv) The applied for mark is not registrable, pursuant to sections 12(1)(e) and 9(1)(n)(iii), because it so nearly resembles the opponent's official marks as to be likely to be mistaken for them.

(v) The applied for mark is not registrable, pursuant to sections 12(1)(1)(e) and 10, because the word "engineering" has become recognised in Canada as designating the kind, quality, or value of wares or services provided by a particular class of persons, that is, by duly registered engineers.

(vi) The applied for mark is not distinctive in view of the above, and also because the mark is not adapted to distinguish nor does it distinguish the applicant's wares and services from other engineers with the surname "ROTHENBUHLER." Further, the use of the applied for mark by the applicant is likely to lead to the inference that its wares and services are associated with or manufactured, sold, leased or licensed by the applicant.

The applicant's counter statement generally denies all of the grounds of opposition and also pleads that (i) the opponent has acquiesced to the applicant's use of its mark ROTHENBUHLER ENGINEERING since 1958, (ii) the opponent's reliance on official marks is without legal effect because the opponent is not a public authority and because the opponent has never adopted nor used its marks as official marks, (iii) the opponent does not manufacture, sell, lease or license any wares or services.

The opponent's evidence consists of the affidavits of Wendy Ryan-Bacon, Barry E. Hutsel, Lisa J. Reynolds, and D. Jill Roberts. The applicant's evidence consists of the affidavits

of Kelly L Miranda, Timothy R. Kirkconnell, Robert A Patone Jr., Carl Gauthier and Neal Rothenbuhler.

The affiants Roberts, Ryan-Bacon, Rothenbuhler and Miranda were cross-examined on their affidavits. The transcripts thereof, exhibits thereto and replies to undertakings form part of the evidence of record. The opponent's evidence in reply consists of the affidavit of John Kizas and a second affidavit of Jill Roberts. The affiants Roberts and Kizas and were cross-examined on their reply evidence.

The applicant objected that the opponent's evidence filed in reply, apart from paragraphs 1- 4 of the Roberts affidavit, is inadmissible because it is not in reply to the applicant's evidence. I agree. It is evidence that should have been submitted as part of the opponent's case in chief. I have therefore had no regard to the inadmissible reply evidence or the cross-examination on such evidence.

On February 5, 2004, during the written argument stage of the proceedings, the applicant advised the Board that it would claim the benefit of Section 14 of the *Trade-marks Act* in relation to the ground of opposition based on section 12(1)(b) of the *Act*. The opponent objected to the introduction of a new issue at a late date in the proceedings. The Board responded to the parties on April 20, 2004, stating, in part,

In any event, the applicant in its letter of February 5 has not made any request of the Board and it is therefore unnecessary for the Board to make any ruling at this time.

On April 27, 2004, after both parties had filed their written arguments, the applicant formally requested leave to amend its counter statement to add a claim to the benefit of section 14 in connection to ground (iii) of the statement of opposition. In a ruling dated July 6, 2004, the Board refused to grant leave for the following reasons:

With respect to the potential prejudice that will be suffered by the opponent, the applicant submits that distinctiveness has been an issue since the opposition was instituted and the opponent has fully cross-examined on that issue. I agree with the opponent that it is not for the applicant to decide whether the opponent has fully cross-examined on the distinctiveness issue, especially since s.14(1) was not in issue at the time of cross-examination and differences do exist between s.38(2)(d) and s.14(1). The potential prejudice that would be suffered by the opponent if this amendment were allowed would therefore be quite substantial as it could require the opponent to amend its statement of opposition, cross-examine the applicant's affiants again, file additional evidence in reply and file amended written submissions.

In view of the above, and in particular the late stage of the proceeding, the failure of the applicant to sufficiently explain why the amendment was not made earlier and the potential prejudice that could be suffered by the opponent, I am not satisfied that it is in the interests of justice in this case to grant leave to the applicant to amend its counter statement. . . . the combination of these factors to outweigh the potential importance of the amendment sought.

The legal burden is on the applicant to show that its application complies with the provisions of the *Trade-marks Act* pleaded against the applicant in the statement of opposition. However, there is an initial evidential onus on the opponent in respect of each ground of opposition: see, for example, *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pages 329-330. To meet the evidential onus in relation to a particular ground, that is, to put a ground of opposition into issue, the opponent must adduce sufficient

admissible evidence, or otherwise rely on any evidence of record, from which it could reasonably be concluded that the facts alleged to support that issue exist.

With respect to the first ground of opposition, Mr. Rothenbuhler's affidavit evidence is that the applicant is engaged in manufacturing engineered products and providing engineering services in the United States since 1946 and in Canada since the early 1950's. The exhibit material, it appears that the applicant is headquartered in Sedro Woolley, in the State of Washington. The opponent specializes in electronic products and has employed at least one professional engineer since 1948.

The opponent, for its part, also relies on Mr. Rothenbuhler's written evidence as well as oral testimony evidenced in his transcript of cross-examination. In his affidavit and at cross-examination Mr. Rothenbuhler admitted that the opponent did not enter into electronic security products until the late 1960's or early 1970's. Further, the enumeration of wares in the subject application beginning with "security equipment" and ending with "door switches" falls into the category of security equipment: see Mr. Rothenbuhler's transcript of cross-examination, Q 126, page 26 to Q 135, page 27. Accordingly, I find that the opponent cannot support the instant trade-mark application for such wares based on use in Canada since 1958. Further, based on Mr. Rothenbuhler's oral testimony, I find that Mr. Rothenbuhler was unable to substantiate that the applicant provided engineering services in Canada: see Q 47, page 11 to Q 56, page 12 of the transcript of his cross-examination. The opponent therefore partially succeeds on the first ground of opposition in respect of the first basis for registration based on past use in Canada.

With respect to the second ground of opposition, the relevant date for assessing the registrability of a trade-mark pursuant to section 12(1)(b) of the *Trade-marks Act* is the filing date of the application: see *Shell Canada Ltd. v. P.T. Sari Incofood Corp.* (2005) 41 C.P.R. (4th) 250 (F.C.T.D.). In the instant case, the material date is the priority filing date April 7, 1997. As always, there is an evidential burden on the opponent to adduce sufficient evidence that would support the truth of its allegations. The issue as to whether the applicant's mark ROTHENBUHLER ENGINEERING is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the applicant's wares and services. Further, the mark must not be dissected into its component elements and carefully analysed but must be considered in its entirety as a matter of immediate impression: see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at pp. 27-8; *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.) at p. 186.

This Board, and the Federal Court, have had occasion to consider whether a trade-mark comprised of a surname, followed by the term "engineers" or "engineering," offends the provisions of section 12(1)(b) of the *Trade-marks Act*. In *Canadian Council of Professional Engineers v. Krebs Engineers* (1996) 69 C.P.R.(3d) 267, this Board considered whether the trade-mark KREBS ENGINEERS & Design, for use in association with industrial processing equipment namely, liquid cyclones, clearly describes or deceptively misdescribes the persons employed in the production of those wares. The Board found as follows, at p.271:

. . . I consider that the everyday user of the applicant's wares would, upon seeing or hearing the applicant's mark, assume that the applicant employs engineers who are involved in the design, production and sale of the applied for wares. The component "KREBS" is a surname and, as noted, the trade-mark as a whole would be viewed as the name of an engineering firm. This underscores the immediate reaction of the everyday user of the applicant's wares that the applicant's employees are engineers. Thus, the mark is either clearly descriptive or deceptively misdescriptive of the persons employed in the production of the applied for wares. The second ground is therefore successful.

I note that in *Krebs*, above, there was no discussion of whether engineers were actually employed to manufacture the applicant's wares.

In Canadian Council of Professional Engineers v. John Brooks Co. (2003) 35

C.P.R.(4th) 507, the Federal Court, Trial Division, considered whether the trade-mark BROOKS BROOKS SPRAY ENGINEERING, for use in association with the service shown below, was prohibited by section 12(1)(b):

operation of a business, namely distributing spray nozzles and manifolds for high and low pressure cooling, cleaning, conditioning 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 reasoned as follows, at p. 513:

. . . The proposed trade-mark "BROOKS BROOKS SPRAY ENGINEERING" is deceptively misdescriptive of JBCL's services and the persons providing them. However, the evidence does not show that the proposed trade-mark is clearly descriptive since JBCL employs relatively few engineers.

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. . . While "spray engineering" may not be a recognized field of specialty 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.

I note that in *Brooks*, above, the Court found as a fact that the applicant was not an engineering firm although the applicant employed some persons with engineering backgrounds or professional qualifications.

The present applicant, in its written argument, submits that the case at hand may be distinguished from *Krebs*, above, in that (i) the component ROTHENBUHLER is neither primarily nor merely a surname, and that (ii) the component ENGINEERING is different from the term ENGINEERS in having "a much broader significance than merely skills of a professional engineers."

The applicant argues that the present case is comparable to the *Molson Companies Ltd. v. John Labatt Ltd.* (1981) 58 C.P.R.(2d) 157 (F.C.T.D.) case in which the Court considered whether the mark LABATT EXTRA was clearly descriptive of the wares "brewed alcoholic beverages." In *Labatt*, above, the Court found that the mark did not offend section 12(1)(b), based on the following reasoning:

. . . I am indebted to and accept the reasoning of a former Registrar of Trade Marks who, in an opposition by an association of clothing manufacturers located in Hawick, Scotland, to an application for the registration of the trade

mark HOWICK CONTOURS for clothing one ground of opposition being that "Howick" was a surname of an individual, said in *Hawick Knitwear Manufacturers Ass'n v. W. Howick Ltd.* (1972), 9 C.P.R. (2d) 93 at p. 95:

The applicant's trade mark when considered as a whole is not a surname, notwithstanding that one of the elements of which the trade mark is made up is a surname and the subject of a disclaimer clause, in the application.

Neither, in my opinion, is the trade mark LABATT EXTRA, clearly descriptive of the character or quality of brewed alcoholic beverages generally. While the word "extra" alone is descriptive when that word is prefaced with the word "Labatt" to form the trade mark LABATT EXTRA, the resultant trade mark is not. At its highest it is only indicative of the superior attributes of a brew brewed by a particular brewer bearing the surname "Labatt".

Counsel for the applicant distinguishes the *Brooks* case, above, by noting that the Court found that the word "Brooks" is a common name. I agree with the applicant that the evidence before me does not show that "ROTHENBUHLER" is a common surname in Canada. However, the evidence before me does show that it is common for engineering firms to use a surname as a component of their business names. As in *Krebs*, above, ROTHENBUHLER is a surname and the trade-mark ROTHENBUHLER ENGINEERING as a whole would be viewed as the name of an engineering firm. In context, ROTHENBUHLER would be perceived as a surname. In the factual circumstances of the instant case, when a purchaser acquires the applicant's sophisticated electronic wares or services under the trade-mark ROTHENBUHLER ENGINEERING, the perception is, in my view, clear that the wares or services emanate from an engineering firm employing qualified engineers. The mark as a whole sends the clear, if elliptical, message that qualified engineers are employed in the production of the applicant's wares and services. Of course, in the *Labatt* case, above, the Court was concerned with whether the mark in issue was clearly descriptive of wares, not whether the mark was clearly descriptive of persons employed

in the production of wares. I also note that in *Labatt*, above, the Court ultimately ruled against the applicant in finding that the mark LABATT EXTRA was not distinctive of the applicant's wares.

Further, I accept the submissions of counsel for the opponent that the term ENGINEERING forms a significant part of the applied for mark ROTHENBUHLER ENGINEERING. As noted in *Brooks*, above, at pg. 514, paragraph 21:

If part of a proposed trade-mark is objectionable, the question arises whether the whole can still be registered. Here, given that JBCL cannot register SPRAY ENGINEERING, can it register BROOKS BROOKS SPRAY ENGINEERING? The answer depends on whether the objectionable part of the proposed trade-mark forms a significant part of the whole and, therefore, causes it to remain deceptively misdescriptive. The parties differed on the question whether the offensive part of the trade-mark must be the dominant element of it or merely a dominant feature. As I read the case law, the proper test is whether the deceptively misdescriptive words "so dominate the applied for trade mark as a whole such that . . . the trade mark would thereby be precluded from registration" [p. 255]: *Chocosuisse Union des Fabricants -- Suisses de Chocolate v. Hiram Walker & Sons Ltd.* (1983), 77 C.P.R. (2d) 246 (T.M.O.B.), citing *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103 (F.C.T.D.).
(emphasis added)

In view of the above, I find that the applied for mark ROTHENBUHLER ENGINEERING is not registrable because it is clearly descriptive or deceptively misdescriptive of the persons employed in the production of the applicant's wares and services.

The applicant argues that even if its mark ROTHENBUHLER ENGINEERING is not registrable under 12(1)(b), it is nevertheless registrable pursuant to section 14(1) of the *Trade-*

marks Act, shown below. In this regard, the applicant relies on its corresponding United States registration no. 2,202,596 referred to earlier.

14(1) Notwithstanding section 12, a trade-mark that the applicant or the applicant's predecessor in title has caused to be duly registered in or for the country of origin of the applicant is registrable if, in Canada,

- (a) it is not confusing with a registered trade-mark;
- (b) it is not without distinctive character, having regard to all the circumstances of the case including the length of time during which it has been used in any country;
- (c) it is not contrary to morality or public order or of such a nature as to deceive the public; or
- (d) it is not a trade-mark of which the adoption is prohibited by section 9 or 10.

The Board recently considered the operation of section 14 in *Zorti Investments Inc. v.*

Party City Corp. (2004) 36 C.P.R.(4th) 90, at pages 95-96:

Section 14 provides a mechanism analogous to that of s. 12(2) to allow the registration of a trade-mark otherwise unregistrable pursuant to s. 12(1)(b) where the applicant owns a corresponding foreign registration. Section 14(1) provides an exception to s. 12(1)(b) in the same way that s. 12(2) does: see *Molson Breweries*, supra. It would therefore seem to follow that the material time for considering the circumstances respecting s. 14(1) of the Act should be the same as that for s. 12(1)(b) and 12(2) -- i.e. -- the filing date of the applicant's application as discussed above. In fact, prior to the Lubrication Engineers decision, that was the position taken by the Opposition Board (see, for example, *Holiday Juice Ltd. v. Sundor Brand Inc.* (1990), 33 C.P.R. (3d) 509 (T.M.O.B.) at 512-513). To use a later material date for s. 14(1) would be not only logically inconsistent but would also appear to unfairly advantage a foreign applicant over a domestic applicant who must evidence that his clearly descriptive mark has become distinctive as of the filing date of the application.

It is therefore necessary for the applicant to evidence the existence of its corresponding foreign registration and to show that the applied for mark was not without distinctive character in Canada pursuant to s. 14(1)(b) of the Act as of the filing date of the application. Although the evidential burden on the applicant regarding the latter requirement is less than that respecting s. 12(2) of

the Act, it nevertheless remains a heavy one: see *Supershuttle International, Inc. v. Canada (Registrar of Trade-marks)* (2002), 19 C.P.R. (4th) 34 (F.C.T.D.) at 42.

In the present case, the applicant's s. 14 claim fails on two counts. First, the applicant's corresponding U.S. registration did not issue until after the filing date of the present application. Second, the Zepf affidavit evidences use and advertising of the applicant's mark well after the material time.

As discussed earlier, in the instant case it was very late in the proceedings that the applicant signalled its intention to rely on section 14 in answer to the opponent's third ground of opposition. Because the issue of section 14 was raised so late in the day, and because its introduction into the proceedings would prejudice a timely determination of the issues already addressed by evidence and cross-examination, with the Board did not permit the applicant to introduce section 14 as a defence in its counter statement. The Board, through its interlocutory ruling dated July 6, 2004 discussed earlier, has precluded the applicant from relying on Section 14 at the decision stage of the proceedings. However, even if the applicant were permitted to rely on section 14, its claim to the benefit of section 14 would fail on two counts. First, the applicant's corresponding United States registration did not issue until November 10, 1998, that is, well after the material date April 7, 1997 (the priority filing date): see *Zorti*, above. Second, the applicant's evidence is far from sufficient to establish that its mark ROTHENBUHLER ENGINEERING was "not without distinctive character" at the material date April 7, 1997, or, for that matter, at any later time.

In view of the above, the opponent succeeds on the third ground of opposition alleging non-registrability. The subject application is therefore refused. Accordingly, it is not necessary for me to consider the remaining grounds of opposition.

DATED AT GATINEAU, QUEBEC, THIS 28th DAY OF NOVEMBER, 2005.

Myer Herzig,
Member,
Trade-marks Opposition Board