

**IN THE MATTER OF AN OPPOSITION BY  
the Canadian Council of Professional Engineers  
to application No. 1223495 for the trade-mark  
GROUPEGÉNIE EXPERTS-CONSEILS and  
design, property of Groupeg nie Inc.**

**I Proceedings**

- [1] Groupeg nie Inc. (the “Applicant”) submitted an application on July 7, 2004, to register the trade-mark GROUPEG NIE EXPERTS-CONSEILS and design, as illustrated below:



**GROUPEG NIE**  
**EXPERTS-CONSEILS**

(the “Mark”)

based on its proposed use in association with consulting engineering services, materials testing and quality assurance laboratory services, stewardship services, management services, supervision services, co-ordination services and estimation services, professional expertise services, the aforementioned services being in the fields of civil and metallurgical engineering (“Services”). The Applicant disclaimed the right to exclusive use of the words “EXPERTS-CONSEILS” apart from the Mark.

- [2] This application was published for opposition purposes in the Trade-marks Journal of December 7, 2005.

[3] On May 8, 2006, the Canadian Council of Professional Engineers (“the Opponent”) filed a statement of opposition, which was forwarded by the Registrar to the Applicant on May 18, 2006.

[4] On June 13, 2006, the Applicant filed a detailed counter statement that contains certain admissions regarding the regulation of the engineering profession in Canada and specifically in each of the provinces and territories in Canada. The Applicant denies the grounds of opposition and proposes to amend the description of Services to remove the word génie. This proposal was never decided upon and I do not intend to rule on it. If the Applicant wanted to amend its application for registration, it simply had to file an amendment. I shall therefore look at the application as it currently stands on record and as described above.

[5] The Opponent submitted the affidavits of John Kizas and Jérôme P. Bastien and an authentic copy of official mark No. 904209 for the GÉNIE Mark, property of the Opponent. The Applicant did not submit any evidence. The Opponent failed to file a written argument, but I consider the Applicant’s letter dated January 31, 2008, to be a written argument. Only the Opponent was represented at the hearing.

## **II Grounds of opposition**

[6] The grounds of opposition may be summarized as follows:

1. The application for registration does not comply with the requirements of section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the “Act”), in that paragraph 30(i) of the Act requires that the Applicant be satisfied that it can use the Mark. Since the Mark includes the word “génie” for which use is regulated in Canada and the Applicant is not licensed to practise engineering in Canada, it cannot be satisfied that it is entitled to use the Mark;
2. The Mark is not registrable as it is contrary to paragraph 12(1)(b) of the Act in that it is clearly descriptive or deceptively misdescriptive of the quality or the character of the Services or the persons that provide them;

3. The Mark is not registrable under paragraph 12(1)(e) of the Act because it is prohibited by subparagraph 9(1)(n)(iii) of the Act since it is a trade-mark adopted by a public authority in Canada;
4. The Mark is not registrable under paragraph 12(1)(e) as it is prohibited by section 10 of the Act since, by ordinary and bona fide commercial usage, the Mark has become known in Canada as designating the kind, value and quality of the Services;
5. The Mark is not distinctive within the meaning of section 2 of the Act because it does not distinguish the Applicant's Services from the services of third parties, including other engineers in general and other entities that are licensed to practise engineering in Canada. Further, use of the Mark could be misleading as its use may suggest that the Services are delivered, sold, leased or licensed by the Opponent or one of its members or that the Applicant is associated with, or authorized by, the Opponent or one of its constituent members.

### **III General principles**

[7] In proceedings to oppose the registration of a trade-mark, the Opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent meets this requirement, the burden of proof shifts to the Applicant, who must satisfy the Registrar that, on the balance of probabilities, the grounds of opposition should not prevent its Mark from being registered [refer to *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325, and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

### **IV Opponent's evidence**

[8] The Opponent submitted a certificate of authenticity for its official mark GÉNIE, No. 904209.

[9] Mr. Bastien worked as a lawyer at the Opponent's agents' firm. He did a number of searches at Library and Archives Canada in Ottawa. Following his searches, he submitted excerpts from the Quebec City, Montreal Island and Ottawa-Hull Yellow Pages for the period of 2001 to 2004.

[10] He also submitted the results of a number of searches he had performed on the Industry Canada Web site to find corporations with corporate names that include the word "group" or "groupe" and offering "expert-conseil" or "ingénieur-conseil" Services. Then he submitted the results of Internet searches on other sites and some excerpts from sites he had consulted. At most, this evidence supports the existence of these sites but is not proof of the contents of the documents submitted in support of his affidavit. I find that this part of the evidence is inadmissible as hearsay.

[11] Mr. Kizas is the Director, Strategic Development, of the Opponent. He is an engineer by training and has held this position since 2001. The Opponent was founded in 1936 and is a national organization made up of twelve provincial or territorial associations. He named each of these twelve associations. Each association has been created under a provincial or territorial law and issues licences to engineers who practise their profession under its jurisdiction.

[12] He alleged that the members of these associations require a licence to practise their profession. He submitted a copy of the provincial and territorial laws that regulate the engineering profession. One of the main purposes of this regulation is to protect the public. Engineers must meet certain requirements in performing their duties, and if these are not met, they can be held personally responsible and, in certain circumstances, so can the corporation providing the Services. All provincial laws provide for disciplinary procedures, the suspension or revocation of licences and the prosecution of offenders.

[13] He then described the required profile for obtaining a licence to practise professional engineering. He submitted a guide on the Admission to the Practice of Engineering in Canada prepared by the Opponent in 2001. There is also a Code of Ethics.

[14] He explained that the various provincial and territorial laws have provisions relating to the use and prohibited use of the following designations: “ingénieur professionnel”, “P.Eng”, “ingénierie”, “génie”, “engineering” and “ing”.

[15] Further, section 26 of the *Engineers Act*, R.S.Q. c. I-9, states that, in Quebec, it is prohibited to carry on or advertise services under a firm name that includes any of the words “ingénieur”, “génie”, “ingénierie”, “engineer” or “engineering” [refer to exhibit 6 in Mr. Kizas’ affidavit].

[16] He alleged that persons or entities that are not qualified to practise engineering, but who, in using a designation in their name, title or trade-mark, imply that they are qualified, are a threat to public safety. He added that this practice would be contrary to public order. There are also other provincial laws that restrict the use of the terms “ingénieurs”, “génie”, “ingénierie”, “engineer” or “engineering” and he named them.

[17] He submitted the definition of the word “genie”, which he found on the Office de la langue française Web site. He explained that engineering is no longer limited to building bridges and dams and has become diversified over time. Thus, the use of the words “ingénieurs”, “génie”, “ingénierie”, “engineer” or “engineering” in Canada, in association with services that overlap those offered by engineers, will be perceived by the public as an indication that these Services are provided by a person who practises the engineering profession or who employs members of this profession to provide these Services. He alleged that the Services are of the same character as those provided by professional engineers.

[18] The National Occupational Classification 2006 refers to a number of professional engineering specializations. Thus, the term “génie” is used generally to introduce various engineering specializations.

[19] The expressions “génie-conseil” and “ingénieurs-conseils” are frequently used in Canada to mean consultation in the field of engineering. For that reason, Quebec has the association des ingénieurs-conseils du Québec (AICQ).

[20] He submitted an excerpt from the *Petit Robert* dictionary, where the following definition of “expert conseil” can be found: [TRANSLATION] “Specialist responsible for solving a technical problem a client is faced with.” He alleged that the use of this expression, combined with the term “génie”, indicates that the Services will be provided by a consulting engineering.

[21] He knows that some engineering firms use a corporate name that includes the expression “experts-conseils” or the word “groupe” or “group” and combine these words with one of the engineering designations. He gave examples of designations taken from annual reports of the Association of Consulting Engineers of Canada such as Groupe HBA, Experts-Conseils senc, Groupe GLD Inc., Experts-Conseils, Le Groupe LMB Experts-Conseils Inc., Le Groupe Séguin Experts-Conseils Inc. [refer to paragraph 40 of Mr. Kizas’ affidavit for an exhaustive list of all corporate names containing the words “experts”, “conseils”, “groupe” or “group”].

[22] He asked each organization that constitutes the Opponent to verify whether the Applicant was or is properly registered with one of them to practise engineering. He stated that in most jurisdictions a certificate signed by the Registrar confirming that a designated entity was or was not authorized to practise engineering constitutes prima facie evidence of the facts described in the certificate. He submitted the replies received. The Applicant was not one of them. This evidence was not contradicted by the Applicant. Therefore, according to the Opponent, the Mark is deceptively misdescriptive of the qualifications of the Applicant’s staff that provides the Services. Even if the Applicant used licensed engineers to provide the Services, the Mark would then be clearly descriptive of the character of the Services and the professional qualifications of the people who provide them.

**III Is the Mark prohibited by paragraph 12(1)(e) and subparagraph 9(1)(n)(iii) of the Act?**

[23] The Opponent has met its initial burden by submitting a certified copy of its official mark. In the circumstances, the Applicant is required to show that the Mark does not consist of, or that it so nearly resembles as to be mistaken for, the official mark.

[24] The material date with respect to the analysis of this ground of opposition is the date of my decision [refer to *Canadian Olympic Assn. v. Allied Corp.* (1989), 28 C.P.R. (3d) 161].

[25] In *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.), Mr. Justice O’Keefe defined in these terms the test of resemblance applicable under a ground of opposition based on subparagraph 9(1)(n)(iii):

[69] Having outlined the protection official marks enjoy, based on the provisions of the Act, it must be determined what the scope of prohibited marks is: the meaning of “consists of” most specifically. As a result of the foregoing, which clearly shows the privileged position official marks enjoy, I reject the interpretation of subparagraph 9(1)(n)(iii) proffered by the appellant and declare that the interpretation advanced by the Registrar is correct. In order to offend subparagraph 9(1)(n)(iii) so as to be unregistrable under paragraph 12(1)(e), the proposed mark must either be identical to the official mark or so nearly resemble it so as to be likely to be mistaken for it. The words “consists of” in the subsection of the Act are to be interpreted to mean “identical to” as was apparently held by the Registrar.

[70] This interpretation maintains the great ambit of protection afforded to official marks, but stops short of conferring an absurdly great ambit of protection for official marks which Parliament cannot reasonably be taken to have contemplated. It is inconceivable that Parliament intended to give such wide ambit of protection to official marks through the enactment of section 9 of the Act. Were the proposition of the appellant correct and any mark that contained, in some form, the official mark could not subsequently be adopted and would be unregistrable, it would be the case that the use of “ING” would be prohibited. Consider that no one could use the term “shopping.com”, or any other mark ending in “ING”, followed by “.com”. It is not reasonable to state that such marks are prohibited. Such is a logical extension of the appellant’s argument and results in an unreasonably vast monopoly and scope of protection. Such is not the intent of the protection for official marks.

[71] The interpretation I have adopted allows the wide ambit of protection to official marks which I believe is consistent with the scheme of the Act as a whole, related sections of the Act, as well as the intention of Parliament. No one may register or use a trade-mark “ENGINEER” (or another of the official marks) in association with any ware or service, notwithstanding the fact that such a possible trade-mark may not be confusing with the appellant’s marks. And no one may register or use a trade-mark

which is similar to the appellant's official marks so that it is likely to be mistaken for them, again notwithstanding that the mark may be sought to be used in association with such wares or services that it may well not be held to be "confusing" with the official marks as that term is used in section 6 of the Act. "Mistaken therefor" and "confusing with" are not synonymous.

[26] The courts have consistently held that the traditional test for confusion between two trade-marks, which we find in subsection 6(5) of the Act, is not applicable when comparing a trade-mark with an official mark. In the latter case, it must be determined whether there is a resemblance, within the meaning of subsection 9(1) of the Act, between the marks at issue by applying the test stated in *Canadian Council of Professional Engineers*, reproduced above.

[27] The marks at issue are not identical. The Mark is visually distinctive from the official mark GÉNIE by the addition of the words GROUPE, EXPERTS and CONSEILS. A graphic element is also present, which visually distinguishes the Mark from the official mark GÉNIE. I therefore find that, on a balance of probabilities, the Mark cannot be confused with the Opponent's official mark GÉNIE, within the meaning of subsection 9(1) of the Act [refer to *Techniquip Ltd. v. Canadian Olympic Association* (1999), 3 C.P.R. (4th) 298]. I therefore dismiss the third ground of opposition.

#### **IV Is the Mark prohibited by paragraph 12(1)(e) and section 10 of the Act?**

[28] The material date to examine this ground of opposition is the date of my decision [refer to *Canadian Olympic Assn. / Assoc. Olympique Canadienne v. Olympus Optical Co.* (1991), 38 C.P.R. (3d) 1 (Fed. C.A.)].

[29] The Opponent has the burden of proving that the Mark has, by ordinary and bona fide commercial usage, become recognized in Canada as designating the kind, value and quality of Services.



[30] In *Anheuser-Busch Inc. v. John Labatt Ltd.* (2001), 14 C.P.R. (4th) 548, the Registrar found that it is not sufficient to show ample use in Canada of each component of the Mark at issue. The Opponent must show that the Mark in its entirety is recognized in Canada as designating the kind and quality of the Services. The evidence on record shows the use of the expressions “expert-conseil”, “groupe”, “group” and the combination of “groupe” or “group” with a designation of a type of engineering. However, there is no evidence in Canada of the use by a single entity of the combination of the words “GROUPE”, “GÉNIE”, “EXPERTS” and “CONSEILS”. In the circumstances, the Opponent has not discharged its initial burden of proof. The fourth ground of opposition is also dismissed.

#### **V Ground of opposition based on subsection 30(i) of the Act**

[31] The Opponent alleged that the Applicant could not state that it was satisfied that it was entitled to use the Mark in Canada since it includes the word “genie” for which the use is regulated in Canada and the Applicant does not hold a licence to practise the engineering profession in Canada.

[32] The Opponent’s evidence shows that the practice of engineering in Canada is governed in each province and territory by provincial legislation. A prohibition under provincial legislation cannot form the basis of a ground of opposition [refer to *Lubrication Engineers Inc. v. Canadian Council of Professional Engineers* (1992), 41 C.P.R. (3d) 243 (F.C.A.)]. Thus, the mere fact that the Applicant is not authorized to use the word “génie” in its corporate name under the *Engineers Act* in force in Quebec cannot be a valid ground of opposition. I therefore reject the first ground of opposition.

#### **VI Is the Mark contrary to paragraph 12(1)(b) of the Act?**

[33] The prohibition set out in paragraph 12(1)(b) of the Act is to prevent one party from monopolizing one or more descriptive words so that competitors may no longer use them in the operation of their businesses [refer to *General Motors v. Bellows*, [1949] S.C.R. 678 and *Emall.ca Inc. v. Cheap Tickets and Travel Inc.* (2007), 56 C.P.R. (4th) 81].

[34] In *Shell Canada Limited v. P.T. Sari Incofood Corporation* 2008, F.C.A. 279, Mr. Justice Noël stated:

In this respect, paragraph 12(1)(b) of the Act provides that a trade-mark is not registrable if it is descriptive “whether ... written or sounded”. I agree with Shell’s submission that although the trade-mark in issue is not two separate words, “java” and “café”, but is instead a single coined word JAVACAFE, this distinction is lost when the trade-mark is sounded in the French language. As such, for the purposes of considering descriptiveness pursuant to paragraph 12(1)(b), the trade-mark is effectively two words, namely “JAVA” and “CAFE”. Again no survey is required to establish this point as the proposed mark in the French language cannot be sounded otherwise.

[35] Thus, even though the first word portion of the Mark is written in one word, it is pronounced by a Francophone as though it were two words: “GROUPE” and “GÉNIE”. It is clear from the description that the Services include engineering services because it refers to consulting engineer services in the fields of civil and metallurgical engineering. Although the combination of the words “GROUPE”, “GÉNIE”, “EXPERTS” and “CONSEILS” seems not to be used in business, these are nevertheless words currently used in the French language. Thus, for the Francophone or bilingual consumer [refer to *Smithkline Beecham Corporation v. Pierre Fabre Médicament* (2001), 11 C.P.R. (4th). 1], the word portion of the Mark clearly describes the quality of the persons who will provide the Services, in other words, a group of consulting engineers. However, the Mark is not limited to its word portion. There is a graphic element. Is this element sufficient to circumvent the prohibition set out in paragraph 12(1)(b) of the Act?

[36] When the trade-mark is composed of a word and graphic components, it must be determined which of these portions is the dominant part. The consumer with an imperfect memory will identify the trade-mark by this dominant part. The size of the characters used in relation to the size of the graphic can be an important factor without being conclusive. The originality of the graphic can also have an impact.

[37] In the case of the Mark, I do not believe that the graphic is its dominant part despite its size in relation to the word part. In fact, the graphic depicts a plan and is not particularly distinctive when associated with the Services. In this case, I am of the opinion that the consumer with an imperfect memory will be more inclined to remember the word portion and associate it with the Services.

[38] The Opponent's evidence shows that the Applicant would not be authorized to provide engineering services as it does not hold a licence from one of the provincial organizations that govern the practice of engineering in Canada [refer to paragraph 41 of Mr. Kizas' affidavit and Exhibit 28]. Therefore, not only would the Mark be clearly descriptive of the quality of the people who provide the Services if they were carried out by properly licensed engineers, but also, in this case, it is deceptively misdescriptive of the Services because they would not be provided by engineers.

[39] The Applicant, in its written argument, alleges that Quebec's legislation (the *Engineers Act* of Quebec) does not prohibit the use of the words "ingénieur", "génie", "ingénierie", "engineer" or "engineering" in a company's corporate name. The Registrar has no jurisdiction to determine whether the Applicant is contravening the provisions of this provincial law. The Registrar's jurisdiction is limited to decisions on grounds of opposition as cited above, as long as they are related to the Act. Having found that the Mark is clearly descriptive of the quality of the people who provide the Services if they are performed by engineers and that, on the contrary, the Mark is deceptively misdescriptive of the qualities of the people who provide the Services, I must allow the second ground of opposition.

## **XI Distinctiveness of the Mark**

[40] In *Canadian Council of Professional Engineers v. APA - The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.), Mr. Justice O'Keefe stated:

A purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive. Therefore, based on my earlier finding that the Mark is clearly

descriptive, I conclude that the Mark is also not inherently adapted to distinguish the Wares of the Applicant from similar wares of others.

[41] I have already held that the Mark is descriptive or deceptively misdescriptive of the quality of people who provide the Services in association with the Mark. Consequently, the Mark cannot be distinctive, and I therefore also maintain the fifth ground of opposition based on the non-distinctiveness of the Mark. Being clearly descriptive or deceptively misdescriptive of the quality of the people who provide the Services, the Mark cannot be used to distinguish the Applicant's Services from services of the same character provided by third parties.

### **VIII Conclusion**

[42] By reason of the powers delegated to me by the Registrar of Trade-marks pursuant to subsection 63(3) of the Act, I refuse the Applicant's application to register the Mark, pursuant to subsection 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 28TH DAY OF MAY 2009.

Jean Carrière  
Member, Trade-marks Opposition Board