



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

Citation: 2014 TMOB 174
Date of Decision: 2014-08-26

**IN THE MATTER OF AN OPPOSITION
by Engineers Canada/ Ingénieurs Canada
to application No. 1,481,039 for the trade-
mark V12 Engineering in the name of
Albert A. Burtoni**

[1] On May 13, 2010, Albert A. Burtoni (the Applicant) filed an application to register the trade-mark V12 Engineering (the Mark). The application is based upon use of the Mark in Canada since at least as early as February 1, 2003 and covers the following wares:

Automobile, motorcycle and marine engines and engine components; automobile body parts; engines namely engines for automobiles, motorcycles and watercraft; wheels; brakes; pistons; cams; clutches; flywheels; fuel delivery system namely intake manifolds, fuel pumps, air-fuel ration meter, fuel hanger/sender, fuel level sensor, fuel injectors, central port injectors, performance injectors, fuel pressure regulators, feed pumps, fuel filters, filter assemblies; manifolds; exhaust.

[2] The application for the Mark was advertised in the *Trade-marks Journal* for opposition purposes on May 25, 2011 and on October 24, 2011, Engineers Canada/Ingénieurs Canada (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition.

[3] The grounds of opposition, which will be set out in more detail below, are based upon sections 30(b), 30(i), 12(1)(b), 12(1)(e) and 2 of the Act.

[4] In support of its opposition, the Opponent filed the affidavit of John Kizas, affirmed May 1, 2012 (the first Kizas affidavit), the affidavit of D. Jill Roberts, sworn May 1, 2012 (the Roberts affidavit) and a certified copy of application No. 903,677 for the official mark ENGINEERING.

[5] In support of its application, the Applicant filed the affidavit of Alan Booth, sworn August 22, 2012 (the Booth affidavit) and the affidavit of Oliver Hunt, sworn August, 30, 2012 (the Hunt affidavit).

[6] As evidence in reply, the Opponent filed the affidavit of John Kizas, affirmed January 24, 2013 (the second Kizas affidavit).

[7] No cross-examinations were held.

[8] Both parties filed a written argument.

[9] A hearing was held and attended by the Opponent.

Onus

[10] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Analysis

Section 12(1)(b)

[11] The Opponent has pleaded that the Mark is not registrable under section 12(1)(b) of the Act because it is “clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used or of the conditions of the persons employed in the production of the wares”.

[12] The Opponent's section 12(1)(b) ground of opposition has been pleaded in a two-pronged manner:

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

[13] The material date for assessing a section 12(1)(b) ground of opposition is the filing date of the application, which in this case is May 13, 2010 [*Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th) 250 (FC); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)].

[14] When conducting an analysis under section 12(1)(b) of the Act, a trade-mark must be considered as a matter of first impression, in its entirety and not dissected into its constituent parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186].

[15] The word "character" in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product and the word "clearly" has been held to mean "easy to understand, self-evident or plain" [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[16] The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has been summarized by the Federal Court of Appeal in *Ontario Teachers' Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) at para 29:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by

the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[17] Bearing in mind the relevant case law, I will now go on to consider the two prongs of the Opponent's section 12(1)(b) ground.

i) *Is the Mark clearly descriptive of the character and quality of the wares and of the persons employed in their production?*

[18] This first prong of the Opponent's section 12(1)(b) ground of opposition has been dealt with in a number of other decisions involving the Opponent in the past [see, for example, *Canadian Council of Professional Engineers v Comsol AB* 2011 TMOB 3 and *Canadian Council of Professional Engineers v REM Chemicals, Inc* 2013 TMOB 144].

[19] In each of these cases, evidence was put forward to establish that the applicant was not registered to provide engineering services and there was no evidence to suggest that any engineers were employed in the production of the wares associated with the trade-marks in question. In view of this, the Registrar held that it was not necessary to give any further consideration to the opponent's allegation that the applicant's trade-mark was clearly descriptive of the persons employed in the production of the wares.

[20] At the oral hearing, the Opponent submitted that the same approach should be taken in the present case. I agree. Based upon the evidence which has been filed in this case, I see no reason to address this issue any differently.

[21] In the first Kizas affidavit, Mr. Kizas explains that the Opponent is a national organization of twelve provincial and territorial associations of engineers of Canada and that these twelve associations which make up the Opponent are responsible for regulating the profession of engineering and licensing its members in Canada [first Kizas affidavit, paras 6 and 7].

[22] Mr. Kizas has provided copies of various statutes which regulate the engineering profession in Canada and the use of engineering designations [first Kizas affidavit, paras 10, 16 and 17 and Exhibits "2"- "14"]. In paragraphs 12 to 15 of his affidavit, Mr. Kizas outlines the

registration and licensing process for engineers in Canada. He has also provided confirmation from all of the constituent associations that the Applicant is not registered to engage in the practice of engineering in Canada [First Kizas affidavit, paras 38 and 39 and Exhibit “27”]. There is no evidence before me to establish that the Applicant is registered to engage in the practice of engineering in any other jurisdiction, nor is there any evidence to establish that registered engineers from any other jurisdiction are employed in the production of the Applicant’s wares.

[23] Accordingly, I see no need to pursue the Opponent’s allegation that the Mark is clearly descriptive of the persons employed in the production of the wares. I also find it unnecessary to further pursue the Opponent’s allegation that the Mark is clearly descriptive of the character or quality of the wares, since this aspect of the Opponent’s pleading also hinges on a member of the profession of engineering being involved in the production of the Applicant’s wares and there is no evidence to suggest that this is the case.

[24] I will therefore now go on to consider the second prong of the Opponent’s section 12(1)(b) ground of opposition.

ii) Is the Mark deceptively misdescriptive of the character or quality of the wares and of the persons employed in their production?

[25] The Opponent submits that the average consumer when faced with V12 ENGINEERING (the Mark) in association with the Applicant’s wares will, as a matter of first impression, interpret the Mark to mean that the Applicant’s wares are designed by engineers (i.e. individuals who are licensed to practice engineering). Since the evidence suggests that the Applicant is not an engineer and does not employ any engineers, the Opponent submits that the Mark is deceptively misdescriptive of the character and quality of the wares and of the persons employed in their production.

[26] By contrast, the Applicant submits that the mere fact that the Mark has the word “engineering” in it would not lead to it being perceived by the average Canadian consumer as meaning that the wares which are associated with it have been produced by a member of the engineering profession.

[27] In this regard, the Applicant points out that the term “engineering” is primarily defined as “the application of science for directly useful purposes...” and is secondarily defined as “the work done by or the occupation of an engineer” [first Kizas affidavit, Exhibit “18”]. The Applicant also points out that the term “engineer” has multiple meanings, including “a person who designs or makes engines”, “a technician, mechanic or other person who is in charge of or maintains an engine or other machine” and “a person who drives an engine, esp. a railway locomotive” [first Kizas affidavit, Exhibit “18”]. I note that the primary definition of an “engineer” in the *Canadian Oxford Dictionary* is “a person qualified in any branch of engineering” [Kizas affidavit, Exhibit “18”]. In the online dictionary located at *dictionary.com*, the primary definition of “engineer” is “a person trained and skilled in the design, construction, and use of engines or machines or in any of various branches of engineering” [Hunt affidavit, Exhibit “A”].

[28] The Applicant submits that “engineer” and variants thereof are commonly used in ways other than to identify a professional who is a registered member of the engineering profession. In this regard, the Applicant relies on Exhibits “B” and “C” to the Hunt affidavit and Exhibits “A” and “B” to the Booth affidavit.

[29] Exhibit “C” to the Hunt affidavit consists of print-outs from a number of websites which the Applicant submits show use of “engineering” and “engineer” in a manner which is not descriptive of a professional occupation or designation. The Opponent has pointed out that they do not appear to be Canadian based websites.

[30] Exhibit “B” to the Hunt affidavit and Exhibits “A” and “B” to the Booth affidavit consist of copies of the particulars for various trade-mark applications and registrations for trade-marks which contain the words “engineered”, “engineer”, “engineers” or “engineering”. In his affidavit, Mr. Hunt states that he compared the identities of many of the owners of the trade-marks identified in Exhibits “A” and “B” to the Booth affidavit with the membership lists of those licensed to practice engineering which were provided in Exhibits “23” to “26” of the first Kizas affidavit. Mr. Hunt also visited the websites for some of the various provincial engineering associations and conducted his own comparisons. The results of his comparisons are set out in paragraphs 2 to 6 of his affidavit. In a nutshell, it seems that many of the owners of the trade-

marks which were identified in Exhibits “A” and “B” to the Booth affidavit are not listed as being licensed engineers.

[31] With respect to Exhibit “B” to the Hunt affidavit, the Opponent notes that none of the trade-marks located by Mr. Hunt include the word “engineering”. Rather, they all include the word “engineered”, which the Opponent submits differs in connotation from the word “engineering” which is present in the Mark. In view of this, the Opponent submits that these search results are irrelevant. With respect to Exhibits “A” and “B” to the Booth affidavit, I note that some of these search results do relate to trade-marks which incorporate the term “engineering”.

[32] In response to the Hunt and Booth affidavits, the Opponent filed the second Kizas affidavit, in which Mr. Kizas attempts to explain the reason behind the existence of some of the trade-marks which were located by Mr. Hunt and Mr. Booth on the register. Mr. Kizas explains that the Opponent has a practice of opposing trade-marks that consist of or include the term “engineering” in order to protect the integrity of the title of members of the engineering profession in Canada and to protect the public [second Kizas affidavit, para 7]. However, this practice does not extend to trade-marks that include the term “engineered” [second Kizas affidavit, para 18]. Thus, trade-marks containing “engineered” may not have been opposed.

[33] Mr. Kizas also explains that some of the trade-marks which were located by Mr. Booth were registered by publishers of magazines or journals directed to members of the engineering profession, some contained the word “engineering” in small font and were missed by the Opponent, some are trade-marks for which the Opponent provided consent to registration and some were registered prior to the Opponent’s establishment of its practice to oppose [second Kizas affidavit, para 18].

[34] Evidence similar to the second Kizas affidavit has been filed by the Opponent in the past in other cases and dealt with by this Board [see *Canadian Council of Professional Engineers v Comsol AB supra* and *Canadian Council of Engineers v Continental Teves AG & CO. OHG* 2012 TMOB 18 (affirmed at 2013 FC 801)]. In those cases, the Board found that there was no evidence to suggest that members of the Canadian public would be aware of the Opponent’s logic concerning what it considers to be an acceptable or unacceptable use of the word

“engineering” by parties who are not licensed to practice engineering in Canada. There is no such evidence in the present case either.

[35] That being said, each case must be decided on its own merits. Other trade-marks including the word “engineering” or variants thereof may appear on the register and the word “engineering” may well have multiple meanings and be used in the marketplace for purposes other than to describe a professional designation or occupation. However, I must consider what the word “engineering” would mean to the average consumer, as a matter of first impression upon seeing the Mark as a whole within the context of the specific wares with which it is associated.

[36] In this particular case, the Mark is V12 ENGINEERING. A V12 is a type of engine having twelve cylinders mounted on a crankcase in two banks of six cylinders [first Kizas affidavit, para 31, Exhibit “22”; Roberts Affidavit, paras 4 and 6, Exhibits “2” and “4”]. The Applicant’s wares include various types of engines, including automobile, marine and motorcycle engines and related automotive components, such as fuel delivery systems, manifolds, brakes, etc.

[37] The Applicant submits that although the wares may be characterized as “automotive” and consumers may view the Mark as implying that the wares relate to a certain type of engine, there is nothing in the Mark which suggests that the wares are produced by professional engineers. I disagree.

[38] The Opponent has filed evidence to establish that “automotive engineering” is a recognized field of engineering. Attached as Exhibit “21” to the first Kizas affidavit is a copy of a document entitled “The National Skills Classification”, which has been prepared by Human Resources and Skills Development Canada (HRSDC) and which lists a number of engineering specialties and sub-specialties [first Kizas affidavit, para 24, Exhibit “21”]. The document shows that Mechanical Engineers is a recognized specialty in Canada and includes the title “automotive engineer”. Thirty-five universities across Canada offer mechanical engineering as an accredited program and of these, 17 have been accredited since 1965 [first Kizas affidavit, para 32]. In paragraph 33 of his affidavit, Mr. Kizas states that the Ontario Institute of Technology has offered an accredited program in automotive engineering since 2009 [first Kizas affidavit,

para 33]. The Roberts affidavit provides some further details regarding the program [Roberts affidavit, Exhibit 15].

[39] The Roberts affidavit also introduces further evidence to establish that engineering involves the design of automobiles, including automotive engines and parts, as well as motorcycle and marine engines and engine components [Roberts affidavit, Exhibits “1”, “2” and “13” to “23”]. An internet search for the term “automotive engineering” turned up 56 million results [Roberts affidavit, Exhibit “13”]. Some of these include: a Wikipedia entry [Roberts affidavit, para 16, Exhibit 14]; a webpage from the University of Windsor providing information about Mechanical, Automotive & Materials Engineering program options [Roberts affidavit, para 19, Exhibit “17”]; job postings for Automotive Engineer jobs in Canada on the website located at *Workopolis.com* [Roberts affidavit, para 21, Exhibit “19”]; a print-out from the website of the Government of Canada’s “Working in Canada” page describing job titles in the Mechanical engineering field which includes a listing for “automotive engineer” [Roberts affidavit, para 25, Exhibit “23”]; an article from the website located at *Wheels.ca* dated February 9, 2008 entitled “Boost for Automotive Engineering” [Roberts affidavit, para 20, Exhibit “18”]; and an article from *The Globe and Mail* dated November 24, 2008 entitled “Whither automotive engineering?” [Roberts affidavit, para 22, Exhibit “20”].

[40] While some of Ms. Roberts’ evidence does post-date the material date, I am satisfied by the evidence overall that “automotive engineering” was a recognized component of engineering at the material date and that engineering plays a role in the design of automotive engines and other automotive parts.

[41] The evidence also establishes that the term V12 is recognized as relating to a type of engine [Roberts affidavit, paras 4-14, Exhibits “2”-12”]. Again, while some of this evidence post-dates the material date, overall I am satisfied that the term V12 was used to describe a type of engine at the material date, just as it is today and this has not been disputed by the Applicant.

[42] The Opponent submits that the use of the word “engineering” in the Mark has a clear meaning relating to work performed by professional engineers. The Opponent submits that the use of the word “engineering” within a trade-mark, when used in association with wares that overlap with those designed, developed or offered by engineers, will serve to indicate that the

person or entity providing those wares is a member of the engineering profession or employs members of the engineering profession to produce those goods. The Opponent relies upon several cases in support of these submissions [*Canadian Council of Professional Engineers v Tekla Oyj* (2008), 68 CPR (4th) 228 at 236 (TMOB); *Canadian Council of Professional Engineers v John Brooks Co* (2004), 35 CPR (4th) 507 at 513 (FC); *Lubrication Engineers, Inc v Canadian Council of Professional Engineers* (1992), 41 CPR (3d) 243 (FCA); *Canadian Council of Professional Engineers v Continental Teves AG & Co. OHG supra*].

[43] In *Brooks*, the Court found that the trade-mark BROOKS BROOKS SPRAY ENGINEERING contravened section 12(1)(b) of the Act in association with services relating to “the operation of a business, namely, distributing spray nozzles and manifolds for high and low pressure cooling, cleaning, condition 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 made the following findings at page 513:

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

[44] In the present case, the Opponent has provided evidence that the Applicant’s wares fall within a category of products which are designed and developed by engineers practicing in the area of automotive engineering.

[45] The use of the term “engineering” in a trade-mark in association with automotive products in particular was considered in *Continental Teves AG & Co*, where Member Robitaille found the trade-mark ENGINEERING EXCELLENCE IS OUR HERITAGE for use in association with “brake pads for land vehicles; brake rotors for land vehicles” to be deceptively misdescriptive. Member Robitaille found that in view of the very nature of the wares and their importance to safety, it would be fair to say that the trade-mark relates to wares which the public

would expect to be designed and developed by engineers. In view of this, Member Robitaille found the principles set out by the Court in the *Brooks* decision concerning the term “engineering” to be applicable.

[46] On appeal, Justice Hughes arrived at the same result as Member Robitaille, but for opposite reasons. Additional evidence was put forward on appeal to establish that the applicant did, in fact, employ engineers in the production of its wares. In view of this, Justice Hughes found the trade-mark in question to be “clearly descriptive” rather than “deceptively misdescriptive”.

[47] I also find the principles set out in the *Brooks* decision to be applicable in the present case. Since the wares in the present case are also of an automotive nature and there is evidence to establish that automotive engineering is recognized as a sub-speciality within the field of engineering, I also find that it is fair to say that the Mark relates to wares which the public would expect to be designed and developed by engineers. Having made this determination, I must now go on to consider whether the Mark as a whole is deceptively misdescriptive so as to contravene the provisions of section 12(1)(b) of the Act.

[48] In order to determine whether a trade-mark is deceptively misdescriptive, the proper test to be applied is to ask whether the deceptively misdescriptive word(s) “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 supra* at 507, para 21; citing *Chocosuisse Union des Fabricants – Suisses de Chocolate v Hiram Walker & Sons Ltd* (1983), 77 CPR (2d) 246 (TMOB); citing *Lake Ontario Cement Ltd v Registrar of Trade-marks* (1976), 31 CPR (2d) 103 (FCTD)].

[49] The Mark consists solely of the terms V12 and ENGINEERING. The term V12 itself is descriptive of a particular type of engine and therefore connotes a connection with the kinds of products which are covered by the application for the Mark and which are of a nature of which one would expect to be designed, developed or produced by professional engineers. Accordingly, I am of the view that the addition of V12 to ENGINEERING does not change the overall impact and significance of the word ENGINEERING in the Mark. If anything, it serves to place greater emphasis on it, as it suggests the nature of the wares to which the engineering relates. I therefore

find that the word “engineering” does so dominate the Mark as a whole so as to render it unregistrable under section 12(1)(b) of the Act.

[50] Having reviewed all of the evidence of record, as well as the parties’ submissions, I am not satisfied that the Applicant has met its burden of establishing that the Mark is not deceptively misdescriptive of the character or quality of its wares or of the persons employed in their production.

[51] Accordingly, the section 12(1)(b) ground of opposition is successful.

Section 2

[52] The material date to assess a non-distinctiveness ground of opposition is the filing date of the statement of opposition, which in this case is October 24, 2011 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[53] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act in that it does not distinguish nor is it adapted to distinguish nor is it capable of distinguishing the wares of the Applicant from those of others, including other professional engineers in general and other entities which are licensed to practise engineering in Canada. In addition, the Opponent has pleaded that any use of the Mark by the Applicant would be misleading in that such use would suggest that the wares of the Applicant are provided, sold, leased, authorized 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.

[54] A trade-mark that is clearly descriptive or deceptively misdescriptive is necessarily not distinctive [*Canadian Council of Professional Engineers v APA - The Engineered Wood* (2000), 7 CPR (4th) 239 (FCTD) at 253].

[55] As I have already found the Mark to be deceptively misdescriptive as of May 13, 2010 and there is no reason for me to conclude otherwise as of October 24, 2011, the non-distinctiveness ground of opposition is also successful.

Remaining Grounds of Opposition

[56] As I have already found in favour of the Opponent on two grounds, I do not consider it necessary to address the remaining grounds of opposition.

Disposition

[57] In view of the foregoing and 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.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office