



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

**Citation: 2012 TMOB 18**  
**Date of Decision: 2012-01-23**

**IN THE MATTER OF AN OPPOSITION by  
Canadian Council of Professional Engineers  
to Application No. 1,361,599 for the trade-  
mark ENGINEERING EXCELLENCE IS  
OUR HERITAGE filed by Continental Teves  
AG & Co. oHG**

[1] On August 29, 2007, Continental Teves, Inc. (the Original Applicant) filed an application to register the trade-mark ENGINEERING EXCELLENCE IS OUR HERITAGE (the Mark) based upon use of the Mark in Canada since at least as early as January 31, 2007 in association with the following wares: “brake pads for land vehicles; brake rotors for land vehicles” (the Wares).

[2] The application claims a priority filing date of March 1, 2007 based upon American trade-mark application No. 77119624.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 2, 2008.

[4] On May 30, 2008, Canadian Council of Professional Engineers (the Opponent) filed a statement of opposition claiming that the application does not conform to the requirements of s. 30(b) and (i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of

opposition also claims that the Mark is not registrable pursuant to s. 12(1)(b) and (e) of the Act, and that it is non-distinctive pursuant to s. 2 and 38(2)(d) of the Act.

[5] The Original Applicant filed and served a counter statement denying the Opponent's allegations.

[6] In support of its opposition, the Opponent filed as evidence in chief, the affidavits of John Kizas, Manager, Strategic Development of the Opponent, sworn March 13, 2009, and D. Jill Roberts, assistant bailiff with Regional Bailiff Services Ltd., also sworn March 13, 2009, as well as a certified copy of official mark No. 903,677 for the word ENGINEERING. In support of its application, the Original Applicant filed the affidavit of Joanne P. Gort, an associate with the trade-mark agent firm representing the Applicant (as defined below) in this proceeding, sworn July 16, 2009. The Opponent filed as reply evidence, a second affidavit of Mr. Kizas, sworn August 7, 2009. Following the recordation on August 26, 2009 of an assignment of the subject application from the Original Applicant to Continental Teves AG & Co. oGH (I shall use the term Applicant to refer to either the Original Applicant or Continental Teves AG & Co. oGH), effective as of March 1, 2007, the Opponent obtained leave to file a supplementary affidavit of Mr. Kizas, sworn October 8, 2009 as additional evidence pursuant to r. 44(1) of the *Trade-marks Regulations* (SOR/96-195) (the Regulations).

[7] Both parties filed written arguments and were represented at an oral hearing.

### Onus

[8] 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 [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]. The presence of an onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in,

then the issue must be decided against the Applicant [see *John Labatt, supra*].

### Summary of the parties' evidence

#### The Opponent's evidence

##### The Kizas affidavits

[9] As indicated above, there are three affidavits of Mr. Kizas. These will be summarized in turn.

##### Affidavit sworn March 13, 2009

[10] Mr. Kizas first briefly goes over his personal background and experience as an engineer. He then provides a general overview of the Opponent. More particularly, the Opponent was established in 1936 and is the national organization of the twelve provincial and territorial associations (hereinafter referred to collectively as the Opponent's "constituent associations") which regulate the profession of engineering in Canada and license the country's more than 160,000 engineers [paragraphs 1 to 12 of his affidavit; Exhibit 1].

[11] Mr. Kizas explains that the engineering profession is provincially and territorially regulated and its members must be licensed to practice, as per copy of the various provincial and territorial Engineering Acts attached to his affidavit as Exhibits 2 through 14. He states in this regard that one of the most important purposes of the regulation of the profession is the protection of the public [paragraphs 13 to 20 of his affidavit; also Exhibits 15 to 17].

[12] Mr. Kizas explains that the Engineering Acts include provisions regarding the use and misuse of the designations "professional engineer"; "P. Eng."; "engineer"; and "engineering", as further particularized in Table 2 forming part of his affidavit. Other statutes also restrict use of the term "engineering" such as provincial and territorial Business Names Registration Acts, and Business Corporations Acts and Regulations, as per copy of examples of some of these

provisions attached to his affidavit as Exhibit 19(A-J) [paragraphs 21 to 23 and 26 of his affidavit; also Exhibit 18].

[13] More particularly, Mr. Kizas states that under the Engineering Acts, the use of an engineering designation that would be contrary to the public interest and public order is prohibited. This means that it is prohibited for persons to use the terms “engineer” or “engineering” to imply that they are qualified to practice engineering in Canada, unless they are licensed by one of the Opponent’s constituent associations. He states that persons or entities not qualified to engage in the practice of engineering within a given province or territory, but implying, through the use of an engineering designation in their name, title or trade-mark, that they are so qualified, pose a threat to public safety and welfare and are contrary to public order [paragraphs 24 and 25 of his affidavit].

[14] Transposing the comments of Board Member Bradbury in *Canadian Council of Professional Engineers v. Comsol AB* 2011 TMOB 3 (CanLII) at para. 18 to the present case, I do not believe that I am in a position to properly assess the impact of the various non-Federal statutes and regulations that the Opponent relies upon. To the extent that Mr. Kizas attempts to do so, I note that he is an engineer, not a lawyer. Furthermore, I am of the opinion that Mr. Kizas cannot properly be qualified as an expert in this proceeding. While I do not question Mr. Kizas’ professional experience and integrity, it seems to me that an expert qualification necessarily includes independence from the parties on the outcome of the case [see *Black Entertainment Television, Inc. v. CTV Limited* (2008), 66 C.P.R. (4th) 212 (T.M.O.B.)]. That said, transposing the comments of Board Member Sprung in *Canadian Council of Professional Engineers v. Kelly Properties, Inc.* (2010), 89 C.P.R. (4th) 401 at para. 18 to the present case, I note that generally the relevant sections of the Engineering Acts provide that no person shall engage in the practice of professional engineering or use a term which would lead (either expressly or by implication) the public to believe that the services being offered are within the practice of professional engineering, unless the person or business using the term is authorized to do so as provided by law. I note that none of these provisions appear to prohibit the use of the word “engineering” in a trade-mark where the trade-mark does not lead a consumer to believe that professional engineers are employed in the production of the wares or services. With respect to the legislation governing

corporate and business names, I note that the relevant provisions do not govern use of terms as trade-marks.

[15] Mr. Kizas states that the “practice of professional engineering” generally means any act of planning, designing, composing, evaluating, advising, reporting, directing or supervising, or managing any of the foregoing, that requires the application of engineering principles, and that concerns the safeguarding of life, health, property, economic interests, the public welfare or the environment, as per copy of the *Guideline on the Definition of the Practice of Professional Engineering* published by the Opponent, attached as Exhibit 20. He further states that as noted by the authors of the text *The Canadian Law of Architecture and Engineering* [Exhibit 17], engineering developed from a trade to a profession. He states that in his opinion, the primary and most familiar meaning of the terms “engineering” and “engineer” today are those relating to the profession of engineering. He adds that his opinion “is bolstered by the *Canadian Oxford Dictionary*, which lists, as the primary definition of ‘engineer’ and ‘engineering’, references to the profession of engineering” [paragraphs 27 and 28 of his affidavit; also Exhibit 21]. Upon review of these definitions, I note that the definition of the term “engineering” refers to:

*n.* **1** the application of science for directly useful purposes, as construction, propulsion, communication, or manufacture. **2** the work done by or the occupation of an engineer. **3** the action of working artfully to bring something about. **4** a field of study or activity concerned with deliberate alteration or modification in some particular area (*genetic engineering*).

That said, I am not prepared to afford weight to this personal opinion of Mr. Kizas, which involves questions of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding.

[16] Mr. Kizas states that engineering is the application of science for useful and practical purposes, and accordingly, the areas of specialty within engineering increase along with the growth of science. These specialties include “automotive engineer”. Mr. Kizas explains that automotive engineering, broadly speaking, is a subset of *inter alia*, mechanical and manufacturing engineering, and deals with the engineering problems and needs of the automotive sector and related industries. The discipline focuses on the design and manufacture of

automobiles and their component parts, as well as on the integration of components into an automotive system. A number of Canadian universities offer or have offered accredited programs in mechanical and manufacturing engineering with optional specialization available in automotive engineering [paragraphs 29 to 47 of his affidavit; Exhibits 22 to 34].

[17] Mr. Kizas states that in Canada, engineering excellence is not just the heritage of one company and, in particular, is not just the heritage of the Applicant. He states that all Canadians benefit from the heritage of the engineering profession which was founded on and remains based upon a high standard of education and experience coupled with a strong self-regulated profession. He further states that the phrase “engineering excellence is our heritage” should be open to all to use freely when speaking of the profession or practice of engineering as well as the education and training of engineers in Canada in all fields, including the field of automotive engineering. He goes on to state that if an entity uses title or descriptor such as engineer/engineering, barrister or solicitors/law practice, architects/architecture, or accountants/accounting and actually employed personnel qualified to offer services or produce products related to such professions, the title or descriptor would obviously describe the persons providing those services or producing those products. Conversely, if said entity did not have qualified personnel offering those services or producing those products, the title or descriptor would be deceptive. It is the professional title that conveys the dominant message regarding the qualifications of the persons providing those services or producing those products [paragraphs 28 to 30 of his affidavit]. Again, I am not prepared to afford weight to these statements of Mr. Kizas, which constitute opinions on issues that go to the merit of the opposition.

[18] Mr. Kizas states that the Original Applicant, namely Continental Teves, Inc., is not licensed or registered to provide engineering services in any of the provinces or territories in Canada, nor are any members of the engineering profession in Canada employed by the Original Applicant. Accordingly, he states that the use of the Mark by the Original Applicant is deceptive and misleading as to the character and quality of the wares provided by the Original Applicant and as to the qualifications of the persons employed in the production of those wares [paragraphs 51 and 52 of his affidavit; Exhibit 35]. For the reasons explained above, I am not prepared to afford weight to this latter statement of opinion of Mr. Kizas.

Affidavit sworn August 7, 2009

[19] As indicated above, this second affidavit of Mr. Kizas was filed as reply evidence. According to r. 43 of the Regulations, such evidence must be strictly confined to matters in reply. I am satisfied that it does.

[20] More particularly, Mr. Kizas states that he makes this affidavit in reply to the affidavit of Joanne P. Gort, and in particular to paragraph 15 and Exhibit N of the Gort affidavit [paragraph 3 of his affidavit].

[21] Mr. Kizas states that he has reviewed the 53 trade-mark registrations attached as Exhibit N to the Gort affidavit, and noted that for some time the Opponent has had a policy of opposing trade-marks which consist of or include the term “engineering” in order to both protect the integrity of the title of members of the profession of engineering in Canada and to protect the public [paragraphs 4 to 7 of his affidavit].

[22] More particularly, Mr. Kizas states that of the 53 trade-mark registrations located by Ms. Gort, ten were registered with the consent of the Opponent; two were registered by publishers of magazines or journals directed towards members of the engineering profession; four were registered before the Opponent began opposing problematic applications; two include the term “engineering” in such exceptionally small font size that the fact that the word “engineering” was included in the trade-mark was not noted at the time to oppose the applications; and the remaining 35 registrations include the word “engineered” not “engineering” or “engineer” [paragraphs 8 to 14 of his affidavit]. However, transposing the comments of Board Member Bradbury in *Comsol, supra*, at para 21, to the present case, there is no evidence that members of the Canadian public are 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.

Affidavit sworn October 8, 2009

[23] As indicated above, this third affidavit of Mr. Kizas was filed as additional evidence pursuant to r. 44(1) of the Regulations.

[24] More particularly, Mr. Kizas states that the Applicant, Continental Teves AG & Co. oHG, is not licensed or registered to provide engineering services in any of the provinces or territories in Canada, nor are any members of the engineering profession in Canada employed by the Applicant [paragraph 2 of his affidavit].

The Roberts affidavit

[25] Ms. Roberts states that she was requested by the Opponent to assist in various opposition proceedings it had instituted against trade-marks incorporating the term “engineering” [paragraphs 1 and 2 of her affidavit].

[26] More particularly, Ms. Roberts explains that she made copies of documents available from public sources, including libraries and the Internet. She attended at the Canadian Institute for Scientific and Technical Information to look for books which generally define or relate to mechanical engineering and automotive engineering. She also conducted various Internet searches, including the terms “ENGINEERING EXCELLENCE IS OUR HERITAGE” and “ENGINEERING EXCELLENCE CANADA” [paragraphs 3 to 9 of her affidavit; Exhibits A to Y].

[27] Ms. Roberts also accessed the Applicant’s website and noted that as of March 13, 2009, such website listed 16 locations “in the Americas”. However, no locations in Canada were listed [paragraph 10; Exhibits Z and AA to CC].



## The Applicant's evidence

### The Gort affidavit

[28] Ms. Gort states that she conducted various Internet searches for the terms “ENGINEER” and “ENGINEERING” and includes as Exhibits A through M and Exhibits O through W to her affidavit copies of the pages she accessed and printed.

[29] Ms. Gort further states that she conducted a state of the register search for trade-mark registrations for trade-marks that include the word ENGINEER, ENGINEERS, ENGINEERED or ENGINEERING owned by non-Canadian entities. She attaches as Exhibit N to her affidavit the results of her search, which consist of copies of the particulars of 53 trade-mark registrations for trade-marks that include the word ENGINEER, ENGINEERS, ENGINEERED or ENGINEERING.

### Analysis of the grounds of opposition

[30] I will now assess the grounds of opposition without necessarily respecting the order in which they were raised in the statement of opposition.

#### Section 12(1)(b) ground of opposition

[31] The statement of opposition sets out that:

[...] In particular, the [Mark] is not registrable because, as set out in s. 12(1)(b), 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 persons employed in the production of the wares. Without limiting the generality of the foregoing, in view of the fact that the [Mark] includes the term “engineering”, which is regulated in Canada, it follows that:

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

- 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.

[32] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares or services. Furthermore, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.); and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.)]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand, self evident or plain” [see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29].

[33] The material date to assess a s. 12(1)(b) ground of opposition is the filing date of the application, in this case August 29, 2007 [see *Fiesta Barbecues Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)].

[34] The Opponent submits that the descriptiveness of the expression “ENGINEERING EXCELLENCE IS OUR HERITAGE” is demonstrated by both the fact that the Applicant has used this slogan descriptively on its website, and the fact that third parties have used this or a similar expression descriptively. Moreover, given that it is the professional title that conveys the dominant message regarding the qualifications of the persons providing services, or producing products, the Opponent submits that, as a matter of first impression, a prospective customer of the Wares offered for sale and promoted under the Mark would immediately assume that such wares were produced or designed by a member of the engineering profession.

[35] Concerning the descriptive use made of the expression “ENGINEERING EXCELLENCE IS OUR HERITAGE” on the Applicant’s website, the Opponent relies on Exhibits BB and CC attached to the Roberts affidavit. More particularly, the Opponent relies on

the following quote retrieved by Ms. Roberts on the Applicant's website at *www.conti-online.com*:

“Engineering excellence is our heritage. We understand the entire brake system and how each component affects a vehicle's safety and performance,” said Donald James, Marketing Manager – Aftermarket, Continental Automotive Systems – North America.

[36] However, as pointed out by the Applicant, the printouts filed as Exhibit CC also include a rectangular color logo that includes the expression “Engineering Excellence is our Heritage” followed by the trade-mark symbol, designated by <sup>TM</sup>, appearing right after it. As such, I find that the alleged descriptive use made of the expression “ENGINEERING EXCELLENCE IS OUR HERITAGE” reproduced above is somewhat foiled by the trade-mark symbol displayed in the logo. Moreover, Exhibits BB and CC postdate the material date (considering both the date on which these pages have been printed by Ms. Roberts (that is March 13, 2009) and the 2009 copyright date appearing on the pages themselves).

[37] Concerning the use made by third parties of this or a similar expression, the Opponent relies on Exhibits V to Y attached to the Roberts affidavit. More particularly, Ms. Roberts explains in her affidavit that she employed the search engine GOOGLE, located at *www.google.com*, to search websites for the terms “ENGINEERING EXCELLENCE IS OUR HERITAGE” and “ENGINEERING EXCELLENCE CANADA” respectively. She attaches as Exhibits V and X respectively, the summary results pages listing the first 50 results which she printed. She also attaches as Exhibits W and Y respectively, copies of the pages accessed from a variety of the links resulted from these searches.

[38] Upon review of the printouts attached as Exhibits V and W, I note that most of the search results for the term “ENGINEERING EXCELLENCE IS OUR HERITAGE” pertain to an entity named *Biomet*, which is described as a “*company managed by bio-engineers*” and a “*worldwide leader in the design and manufacture of products for the orthopedic, sports medicine, biologic, craniomaxillofacial and dental markets*”. The printouts include the following descriptive use of the phrase “ENGINEERING EXCELLENCE IS OUR HERITAGE”: “*At Biomet, engineering excellence is our heritage and our passion. For over 30 years, [...]*”. The other web pages pertain to an entity named *Biolink*, which is described as a “*worldwide leader in the design and*

*manufacture of dental Implant Products*". The printouts include the following descriptive use of the phrase "ENGINEERING EXCELLENCE IS OUR HERITAGE": "*At Biolink, engineering excellence is our heritage and our passion and motivation. For over 30 years, [...]*". It is unclear whether that latter entity is related somehow to *Biomet*. In any event, as these exhibits postdate the material date (considering both the date on which these pages have been printed by Ms. Roberts (that is March 1, 2009) and the copyright dates appearing on the pages themselves (that is 2008 or 2009 depending of the pages)), the mere existence of these two examples of use of the phrase "ENGINEERING EXCELLENCE IS OUR HERITAGE" does not assist the Opponent's case.

[39] Turning to the search results for the term "ENGINEERING EXCELLENCE" attached as Exhibits X and Y, the date on which these exhibits have been printed by Ms. Roberts (that is March 13, 2009) again postdates the material date. However, according to the copyright dates appearing on some of the pages themselves or the information disclosed on such printouts, the phrase "ENGINEERING EXCELLENCE" would appear to have been used by others quite extensively since well before the material date of August 29, 2007. More particularly, the phrase "ENGINEERING EXCELLENCE" would appear to be commonly used in a wide variety of sources found in Canada, such as within websites, print advertising, magazine articles, journals and reports, that emanate internationally as well as from Canada. By way of example:

- many of the printouts attached under Exhibit Y pertain to various awards or scholarships such as the *Urs Meier Scholarship for Engineering Excellence* awarded annually by *ISIS* [Intelligent Sensing for Innovative Structures] *Canada* to an undergraduate student of a Canadian Engineering or Applied Sciences degree program who is planning to pursue post-graduate studies under the tutelage of an *ISIS* Canada research Project Leader – the printouts pertain more particularly to the winner of the 2008 scholarship and indicate that the deadline for such scholarship was November 1, 2007; the *Awards for Engineering Excellence* awarded annually by the *Consulting Engineers of British Columbia* – the printouts pertain among others to the 14<sup>th</sup> and 17<sup>th</sup> annual *Awards for Engineering Excellence* awarded in 2003 and 2006 respectively; the *Canadian Consulting Engineers' Awards of Excellence* awarded in 1981, 1987, 1991, 2003, 2006, and 2008; the *South*

*African Association of Consulting Engineer's Engineering Excellence Awards* - the printouts pertain more particularly to the 2007 awards; the *American Council of Engineering Companies Engineering Excellence Awards* awarded in 1999 and 2009; the *New Zealand Engineering Excellence Awards* that are hosted by a consortium of five partners and 10 contributing organizations, including *Centre for Advanced Engineering, Association of Local Government Engineering New Zealand Incorporated, Electricity Engineers Association of New Zealand*, etc. – the printouts pertain more particularly to the 2008 awards; the *Engineering Excellence Awards* awarded annually by the *American Council of Engineering Companies of Colorado* – the printouts pertain more particularly to the 2007 awards; the *Engineering Excellence Achievement Award*, sponsored by *Microsoft's Enterprise Engineering Center*, that is designed to recognize three outstanding teams from Software Development category that have created solutions that demonstrate the potential to be developed to scale with focused guidance from a *Microsoft* engineer – the printouts pertain more particularly to the 2008 winners; the *AVEVA "Engineering Excellence to the Extreme" Awards* that recognize AVEVA customers and the engineering excellence and problem-solving that goes into realizing process plant and marine projects – the printouts pertain more particularly to the 2007 winners; the *Engineering Excellence Award* generally reserved for *DuPont* engineers and scientists for outstanding technical contributions – the printouts pertain more particularly to the 2006 award; etc.;

- the printouts from the websites of the Faculty of Engineering of the University of Alberta (which bear a 2002-2009 copyright notice) and of the University of New Brunswick (UNBF) (which indicate a release date of January 28, 2004) include the headings “*Celebrating a Century of Engineering Excellence*” and “*UNBF to Celebrate 150 Years of Engineering Excellence*” respectively. The website of the Carleton University also includes under the heading “*Engineering Excellence*”, a Spring 2003 article reporting that two Carleton engineering students won a prestigious *Women in Engineering and Science* award;
- the printouts pertaining to *DPH Engineering Inc.* include among others an article published on March 1, 2003 under the heading “*DPH Engineering celebrating 30 years*

*of engineering excellence*” that indicates that this Calgary-headquartered company offers all engineering disciplines: process, mechanical, piping, civil, structural, electrical, etc.;

- the printouts pertaining to *MCW Group of Companies* include among others an undated promotional feature entitled “ENGINEERING EXCELLENCE FROM WHISTLER TO DUBAI, ENGINEERS AT THE MCW GROUP OF COMPANIES ARE BRINGING BUILDINGS TO LIFE” prepared by *BCBusiness magazine’s Special Advertising Features Dept.* for *MCW Group of Companies*, which indicates that *MCW* began as a mechanical engineering company in Winnipeg in 1964. Today, *MCW Group* is a national company of 300 professionals comprised of two main corporate entities: *MCW Consultants*, which specializes in mechanical and electrical engineering, and *MCW Custom Energy Solutions*, an energy services company founded to take part in the enormous drive to retrofit the nation’s buildings with green technology;
- the printouts pertaining to *HGC Engineering* (which bear a 2005 copyright notice) indicate that this company has grown steadily to become the largest Canadian consulting engineering firm specializing in noise, vibration and acoustics. Their “*mission is to provide engineering excellence in noise, vibration & acoustics*”;
- the printouts pertaining to *EMS-Tech Inc.* (which bear a 2004-2007 copyright notice) indicate that this engineering firm has grown to a team of sixty and is now positioning itself for an exciting further growth phase from its head office in Canada. “*With a mind for engineering excellence and an eye for talent, business owners [...], have consistently demonstrated strong commitments to engineering innovations, productivity and customer dedication*”; etc.

[40] The Applicant does not appear to dispute the fact that third parties have used the phrase “ENGINEERING EXCELLENCE” descriptively. To the contrary, the Applicant submits in its written argument that :

10. By means of the Roberts affidavit, the Opponent has clearly acknowledged:

- (a) That “engineering excellence” is a generic, unregulated and commonly used term, in a wide variety of sources found in Canada, such as within websites, print advertising, magazine articles, journals and reports, that emanate internationally as well as from

Canada (see, for example Exhibits V-Y). The Roberts affidavit therefore establishes that “engineering excellence” is a widely used and commonly understood term.

(b) That there is no indication within these materials that the word “engineering” is a regulated term or prohibited mark.[...]

(c) That “engineering excellence” is generic, unregulated and commonly used term, in association with competitors, awards, internships and scholarship programs provided to university students (see, for example, Exhibits X and Y).

[...]

59. [...] as established above by the Roberts affidavit, “engineering excellence” is a well recognized and clearly understood term that exist separate and apart from the Opponent’s alleged rights. Clearly, this term is unregulated, descriptive and generic. Furthermore, as established by the Gort affidavit, “engineering” is a generic word of the English language that is commonly understood to mean “the application of science to the design, building, and use of machines, constructions, etc.” Consequently, use of the term “engineering excellence” within the [Mark] ENGINEERING EXCELLENCE IS OUR HERITAGE is an accurate reference. Thus, these words – and therefore the [Mark] – cannot be “misdescriptive”, never mind “deceptively misdescriptive”.

The Opponent submits for its part that:

17(b). The phrases “engineering excellence is our heritage” and “engineering excellence in Canada” are in significant use by third parties (para. 6-9 [of the Roberts affidavit], Exhibits V-Y).

[...]

37. As noted by Mr. Kizas, [...], the [Mark] is a slogan or expression which “should be open to all to use freely when speaking of the engineering profession or practice of engineering as well as the education and training of engineers in Canada in all fields, including the field of automotive engineering”.

[41] This brings me to consider the third part of the Opponent’s pleading to the effect that, as a matter of first impression, a prospective customer of the Wares offered for sale and promoted under the Mark would immediately assume that such wares were produced or designed by a member of the engineering profession. In so doing, I wish to reproduce below a passage from the *Kelly Engineering* decision, *supra*, (pertaining to an opposition by the same Opponent to the registration of the trade-mark KELLY ENGINEERING RESOURCES used in association with

personnel employment services), whose reproduction, though lengthy, is necessary to fully appreciate the principles that have guided me in the present case:

[75] The Federal Court and the Registrar have had other occasions 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 Act. In *Canadian Council of Professional Engineers v. Krebs Engineers* (1996), 69 C.P.R. (3d) 267 (T.M.O.B.) [*Krebs*], the Registrar found that KREBS ENGINEERS & Design, for use in association with “industrial processing equipment namely, liquid cyclones”, was clearly descriptive or deceptively misdescriptive of the persons employed in the production of the wares. It was held that the everyday user of the applicant’s wares would assume, upon seeing or hearing the applicant’s mark, that the applicant employs engineers who are involved in the design, production and sale of the applied for wares. The portion KREBS is a surname and, as noted, the trade-mark as a whole would be viewed as the name of an engineering firm. On this basis it was found that the mark was either clearly descriptive or deceptively misdescriptive of the persons employed in the production of the applied for wares.

[76] The present case can be distinguished from *Krebs supra* in that the subject Mark relates to services and not wares, and further in that the subject services are not considered specific to engineers. The objected to portion of the Mark does not describe the persons producing or providing the services. Just because engineers may be engaged in human resource management from a production efficiency perspective, does not convince me that personnel employment services *per se* are a specialized field of engineering.

[77] I also consider this case distinguishable from the decision of the Registrar in *Management supra* [*Canadian Council of Professional Engineers v. Management Engineers GmbH* (2004), 37 C.P.R. (4th) 277 (T.M.O.B.)] as the offending trade-mark in that case, ME MANAGEMENT ENGINEERS & Design, contained the word ENGINEERS, rather than “engineering”. Therefore it was more likely in that case that a consumer of business consultation and related services would assume that said services were provided by engineers.

[78] In *Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 25 C.P.R. (4th) 507 (F.C.T.D.) [*Brooks*], the Court considered that the trade-mark BROOKS BROOKS SPRAY ENGINEERING, offended the provisions of s.12(1)(b) in association with the services of “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 reasoned 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 employees [sic] relatively few engineers”.



... 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*”(emphasis mine).

[79] In my view, based on the evidence at hand in this case, it seems self-evident that the context of personnel employment services would be one of the exceptions alluded to in the Brooks decision since personnel employment services are not the type of technical services that one would expect engineers to provide. On the contrary, as noted above, I find it reasonable to conclude that most people would immediately understand that the services assist people to find employment in the engineering field or assist engineering firms in locating qualified employees, such persons may or may not be engineers.

[80] In a subsequent decision involving the same Opponent, *Canadian Council of Professional Engineers v. Rothenbuhler Engineering Company* (2005) 50 C.P.R. (4th) 115 (T.M.O.B.) [*Rothenbuhler*] it was argued by the applicant, with respect to the trade-mark ROTHENBUHLER ENGINEERING, that the situation was distinguishable from *Krebs*, in that the component ROTHENBUHLER was neither primarily nor merely a surname, and further that “engineering” was different from the term “engineers” in that it had “a much broader significance than merely skills of professional engineers”. The Registrar found that the trade-mark offended s. 12(1)(b) on the basis that, in context, ROTHENBUHLER would be perceived as a name, such that a purchaser when purchasing the sophisticated electronic wares or services sold under that trade-mark would assume that the wares and services emanate from an engineering firm where qualified engineers are employed in the production of the wares and services. Consideration was also given to the fact that “engineering” was a significant part of that trade-mark.

[81] In my view, this principle does not apply in this case. The subject Mark relates to services (not wares) that the public would not expect to be provided by engineers. Further, I do not find that ENGINEERING is the significant part of the Mark; in the context of KELLY ENGINEERING RESOURCES, RESOURCES is equally as significant as the word ENGINEERING. Consequently, given that the nature of the services does not relate to the kind of technical endeavor that one would expect of engineers or an engineering firm, and having regard to the principles referred to in *CCPE v Kelly supra* relying on the reasoning set out in the *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 [*LABATT EXTRA*], (where the surname LABATT in conjunction with the descriptive term EXTRA was found not to offend s. 12(1)(b)), I find that on balance the Mark does not offend the provisions of s. 12(1)(b). [...]

[42] As evidenced by the Opponent, the Wares covered by the present application fall within products designed, developed and tested by engineers practicing in the area of automotive

engineering [paragraphs 38 to 47 of the first Kizas affidavit]. Considering the very nature of the Wares and their importance to safety, it is fair to say that the Mark relates to wares that the public would expect to be designed, developed and tested by engineers. That being so, I find that the principles set out by the Court in the *Brooks* decision, *supra*, concerning the fact that the term “engineering” is closely regulated are applicable here.

[43] As stressed by the Opponent at the oral hearing, the Mark is more in the nature of a slogan. Relying on the dictionary definitions of the term “ENGINEERING” provided by both the Applicant (through the Gort affidavit) and the Opponent (through the first Kizas affidavit), I find it reasonable to conclude that when considered in the context of the phrase “ENGINEERING EXCELLENCE IS OUR HERITAGE”, the term “engineering” may function as:

1. a noun referring to either “the application of science to the design, building, and use of machines, constructions, etc.” or “the work done by an engineer” and is being used together with the noun “EXCELLENCE” to convey a unitary idea, equivalent to saying “EXCELLENCE IN ENGINEERING”; or
2. a verb in a fanciful way to convey the idea of “DESIGNING/or CREATING EXCELLENCE”.

[44] As evidenced by the Opponent, the Applicant is not licensed or registered to provide engineering services in any of the provinces or territories of Canada, nor are any members of the engineering profession in Canada employed by the Applicant [paragraphs 51 and 2 of his first and third affidavits respectively]. As such, the Mark cannot be found to be clearly descriptive of the persons employed in the production of the Wares. Thus, the question becomes whether the Mark is deceptively misdescriptive, that is, whether it misleads the public? In other words, as a matter of first impression, would the public be deceived into thinking that the Wares have been designed, developed and tested by engineers practicing in the area of automotive engineering?

[45] In order for a trade-mark to be deceptively misdescriptive, the 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’”[*Brooks, supra*, at p. 514].

[46] I find the word “ENGINEERING” so dominates the Mark. The word “EXCELLENCE” has a laudatory connotation and is primarily a descriptive term. The words “IS OUR HERITAGE” are secondary and directly refer to the first portion of the Mark. The dominant message remains that of “ENGINEERING” or “ENGINEERING EXCELLENCE”.

[47] While the term ENGINEERING may have a broader significance than merely skills of professional engineers, I am of the view that, given the very nature of the Wares, the average Canadian is as likely, if not more likely, to react to the Mark by thinking that professional engineers are involved in the production of the Wares.

[48] My finding is reinforced by the fact that Exhibits X and Y to the Roberts affidavit discussed above show that the phrase “ENGINEERING EXCELLENCE” is used by various entities (which fact, as indicated above, is not contested by the Applicant), the contexts of use of which all appear to relate to either the engineering profession or practice of engineering or to the education and training of engineers in Canada or abroad.

[49] In view of the foregoing, I find that the Applicant has not discharged its burden to establish, on a balance of probabilities, that the Mark was not deceptively misdescriptive, as of the filing date of the application, of the persons employed in the production of the Wares.

[50] Accordingly, the s. 12(1)(b) ground of opposition succeeds.

#### Non-distinctiveness ground of opposition

[51] The Opponent has pleaded that the Mark is not distinctive within the meaning of s. 2 of the Act in that:

[...] it fails to distinguish the Applicant’s [W]ares from the wares of others including other engineers in general which are licensed to practice engineering in Canada. In addition, any use by the Applicant of the [Mark] would be misleading, in that such use would suggest that the [W]ares of the Applicant are provided, sold, leased, 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 listed [...] above.

[52] The material date to assess a non-distinctiveness ground of opposition is the filing date of the statement of opposition, in this case, May 30, 2008 [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)]. In deciding this issue, I am guided by the comments of Mr. Justice O’Keefe in *Canadian Council of Professional Engineers v. APA-The Engineered Wood Assn.* (2002), 7 C.P.R. (4th) 239 (F.C.T.D.) at para. 49 that “a purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive”.

[53] Having regard to my earlier finding that the Mark is deceptively misdescriptive, the difference in material date having no effect on this issue, I conclude that at the material date the Mark was not adapted to distinguish nor did it actually distinguish the Wares of the Applicant from those of others within the meaning of s. 2 of the Act. That being so, it is unnecessary to address the first part of the Opponent’s pleading that the words in the Mark are in common use by others.

[54] Accordingly, the non-distinctiveness ground of opposition succeeds.

#### Remaining grounds of opposition

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

Disposition

[56] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office