IN THE MATTER OF AN OPPOSITION by the Canadian Council of Professional Engineers to application No. 1157042 for the certification mark PE filed by the Alberta Institute of Power Engineers

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

The application was subsequently amended December 13, 2004, to include the following statement: The applicant is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

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

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

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

On August 3, 2004, the Canadian Council of Professional Engineers (the "Opponent" or "CCPE") filed a statement of opposition against the application. The Applicant filed and served a

counter statement, in which it denied the Opponent's allegations.

The Opponent's evidence in chief consists of the affidavits of John Kizas and Deborah A. Eatherley. The Applicant's evidence includes two affidavits from Matt Park and Wil Amundson, and the affidavits of Ray Shupac and Lorne Shewfelt. The Opponent's reply evidence comprises the affidavits of Dermot Mulrooney, Albert J. Schuld, Roger Barker and Claude Lizotte. No affiant was cross-examined.

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

Before setting out its grounds of opposition, the Opponent alleged the following in its statement of opposition:

> The title "Power Engineer" and "PE", the initials representing this title, are the name of, and are descriptive of the profession of power engineer.
>
> CCPE is a federation of the provincial and territorial associations of engineers of Canada…
>
> Engineering is a regulated profession in Canada. The regulation of the engineering profession is a provincial and territorial responsibility. This responsibility has been delegated to the twelve associations…that make up CCPE, by provincial and territorial statutes. Only candidates meeting the requirements of said statutes within the jurisdictions in which engineering services are offered, are permitted to practice within that jurisdiction, and to use the professional designations, including P.Eng. within that jurisdiction.
>
> No person or entity is permitted to represent, expressly or by implication, that they are entitled to engage in the practice of engineering, in any jurisdiction in Canada unless they are licensed to practice engineering within that jurisdiction.
>
> The Applicant is not registered to practice engineering in any jurisdiction in Canada.

The grounds of opposition are as follows:

1. …The application fails to comply with s.30(b) in that the applicant did not commence

using PE as a certification mark or at all in Canada at least as early as July, 2001 on services. Moreover, neither the designation of the qualifications of an individual, or the name of a profession can function as a certification mark.

2. The application does not conform to s.30(f) in that it does not include particulars of the defined standard that the use of the mark is intended to indicate, nor does it include the required statement that the Applicant is not engaged in the performance of the services such as those in association with which the certification mark is used.
3. The application does not conform to s.30(i) in that, in view of the facts set out above, and the fact that the name of a profession cannot be used as a certification mark, the Applicant could not have been satisfied that it was entitled to use the mark in Canada in association with the services described in the application.
4. The trade-mark is not registrable, in light of the facts set out above and because, contrary to s.12(1)(b), it is clearly descriptive or deceptively misdescriptive of the character or quality of the services in association with which it is used or proposed to be used, or of the persons employed in their production.
5. The trade-mark is not registrable because, contrary to s.12(1)(c), it is the name in the English language of the services in connection with which it is used.
6. The trade-mark is not registrable because it is prohibited under s.10. … The term PE has become recognized as designating the kind, quality, and value of wares and services provided by power engineers and hence is precluded from registration as a trade-mark.
7. The Opponent's final ground is based on s.38(2)(d), pleading that the trade-mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the Applicant's services from the services of others, including other power engineers, and other entities which are licensed to practice engineering in Canada.

The s. 30(f) ground of opposition was withdrawn at the oral hearing.

Onus and Material Dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act,* R.S.C. 1985, c. T-13 (the

"Act"). There is however an initial 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.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)).

The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application (see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475);
- s. 12(1)(b) – the filing date of the application (see *Havana Club Holdings S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th) 541 (T.M.O.B.); *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.));
- s.12(1)(c) and (e) - the date of my decision (see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)); and
- non-distinctiveness - the date of filing of the opposition (see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)).

Summary of Opponent's Evidence

Mr. Kizas identifies himself as the Manager, Strategic Development of the Opponent. He explains that the Opponent is the national organization of the twelve provincial or territorial associations which regulate the profession of engineering in Canada and license the country's more than 160,000 engineers.

He testified that in Canada, power engineering is a well-established sub-discipline of electrical engineering. Generally speaking, professional power engineering deals with power systems, specifically, electric power transmission and distribution, power conversion and electro-mechanical devices.

He further stated that, while "P.Eng." denotes a person licensed to engage in the practice of engineering in Canada, other countries, most notably the United Stated and Japan have adopted the acronym "PE to denote a person licensed to engage in the practice of engineering." At paragraph 30 of his affidavit, he states the following: "I would assume, upon seeing the initials "PE" after a person's name, that s/he was licensed to offer professional engineering services in the United States of America, especially in circumstances where the services were described as professional power engineering services."

Ms. Eatherley identifies herself as a law clerk with the solicitors for the Opponent. She testifies that she attended at the Canadian Institute for Scientific and Technical Information located at the National Research Council Building, in Ottawa, Ontario, on June 29, 2005, and made photocopies of various materials she located related to PE/Power Engineering. She also conducted searches on the Internet relating to PE/Power Engineering. The exhibits attached to her affidavit are submitted to show various meanings for "PE", including as a recognized acronym for "power engineer", and "professional engineer".

Summary of Applicant's Evidence

Shewfelt Affidavit

Mr. Shewfelt deposes that he is the Area Director for the Applicant. He explains that the Applicant is a registered society under the laws of Alberta and that it is affiliated with the Institute of Power Engineers (IPE). Attached as Exhibit 1 to his affidavit is a true copy of the Applicant's by-laws. Clause 6.1 of these By-laws provides as follows: "Members who hold a valid Power Engineer's Certificate of Competency issued by the Alberta Boiler Safety Association, and who have met the required membership standards of the AIPE, shall be entitled to use the professional designation of PE."

On or about July 23, 2001, Mr. Shewfelt sent out a message to the 150+ members of AIPE indicating that members of AIPE who held a valid Alberta Certificate of Competency were at

that point certified to use the certification mark PE. He further states that before the end of July 2001, he personally began using PE in association with professional power engineering services. Attached as Exhibit 4 to his affidavit is a copy of his business card used in association with professional power engineering services. He has also used the PE certification mark at the end of his correspondence as follows: Lorne Shewfelt, PE.

Amundson Affidavits, No. 1 (sworn July 30, 2005) and No. 2 (sworn February 8, 2006)

Mr. Amundson deposes that he is the first Vice President of the Applicant. Much of the evidence in his first affidavit is similar to that of Mr. Shewfelt. He also states that he has used the Mark since at least as early as July 31, 2001. Attached as exhibits to his affidavits are copies of his business cards and correspondence upon which the Mark appears after his name. He also attaches copies of his resume upon which the Mark PE also appears.

In his second affidavit, Mr. Amundson deposes that the Applicant is an Alberta Incorporated Society and that since its incorporation, it represents both the Calgary and Edmonton branches of IPE. He explains that the Applicant has licensed the use of and/or the ability to certify others with the certification mark PE, to the British Columbia Institute of Power Engineers and the Nova Scotia Institute of Power Engineers. Attached to his affidavit as Exhibit 2 is a copy of a letter of permission sent by the Applicant to the British Columbia Institute of Power Engineers.

Park Affidavit, No.1 (sworn August 26, 2005)

Mr. Park identifies himself as a student-at-law with the solicitors for the Applicant. Attached as Exhibit 1 to his affidavit is an article from the Association of Professional Engineers, Geologists and Geophysicists of Alberta ("APEGGA") entitled "The How and Why of Protecting Professional Titles" which he downloaded from APEGGA's website on the Internet. In this article, the following is stated:

> "Some occupations have traditionally used the word "engineer" (i.e. Power Engineer, Stationary Engineer and Train Engineer). The use of these terms normally does not lead others to believe that the user is a member of APEGGA. That's particularly emphasized

> because these titles historically and continue to be referred to in the Safety Codes Act and Regulations relating to the design, construction and installation of boilers and pressure vessels."

Attached as Exhibit 2 to his affidavit is another article downloaded from the same website where the following is stated: "Members of the Alberta Institute of Power Engineers have the legal right to use the term power engineer and the professional designation PE. It's a designation exempted from right-to-title provisions in the Engineering, Geological and Geophysical Professions ("EGGP") Act."

Park Affidavit No. 2 (sworn February 8, 2006)

In his second affidavit, Mr. Park states that he searched the Canadian Trade-marks Database for evidence of certification marks comprised primarily of acronyms of either the services claimed or of the title of the persons entitled to use the certification mark. Attached to his affidavit are the results of his search, including over thirty registered Canadian certification marks which are comprised primarily of acronyms of either the services claimed or the title of the persons entitled to use the certification mark. He also provides the result of Internet searches for evidence of use in Canada of the certification marks C.M.A., F.C.A.D., R.E.T. and C.E.T.

Shupac Affidavit

Mr. Shupac, who only identifies himself as being of the City of Calgary, deposes that on or about December 6, 2004, he contacted one of the Opponent's constituent members (namely APEGGA) by e-mail, concerning a question about his proposed use of the corporate name "Power Engineering Educational Consulting". Attached as exhibit B to his affidavit is APEGGA's reply to his question, wherein the following is stated: "Power Engineers/Steam Engineers are governed by their own legislation and are entitled to use the term "Engineer" or "Engineering" when coupled with the words "Power" or "Steam" to ensure that there is no public misconception that they are registered Professional Engineers under the EGGP Act."

Summary of Opponent's Reply Evidence

The Opponent's Reply evidence consists of similar affidavits from Mr. Mulrooney, Mr. Lizotte, Mr. Schuld and Mr. Barker. Mr. Mulrooney is Director of Professional Practice, of the Association of Professional Engineers of the Province of Nova Scotia ("APENS"), and Mr. Lizotte is the "Directeur des Affaires professionnelles" at the Ordre des ingenieurs du Québec. Mr. Schuld deposes that he is the Deputy Registrar of APEGGA and Mr. Barker is the Deputy Registrar, Regulatory Compliance at the Association of Professional Engineers of Ontario.

None of these affiants support use of the abbreviated designation PE by any person who is not registered with their association. In this regard, they each depose the following:

- PE is used to designate an individual who is qualified to be an engineer in the U.S.; (they refer to: 1. the excerpt from the website Answers.com attached as Exhibit A that provides background on the title "professional engineer" and the letters used to designate a professional engineer in various jurisdictions; 2. undated excerpts taken from the National Council of Examiners for Engineering and Surveying (NCEES) website that discusses Licensure in the U.S. and the mobility of Professional Engineers working in both Canada and the U.S. and 3. an excerpt printed from the website of the National Society of Professional Engineers ("NSPE") that discusses issues relating to the mobility of Professional Engineers working in both the U.S. and Canada);
- with freer trade for engineering services under NAFTA, and each association's own efforts to improve professional mobility, an increasing number of qualified U.S. professional engineers are offering their services in their respective provinces;
- many members belonging to their associations who are resident in Canada (about 5000 total among the four provinces for which evidence was provided) have reciprocal qualifications and are entitled to use PE in the United States;
- members with reciprocal qualifications may lawfully use PE in business correspondence and reports, designs, proposals and drawings to represent that

they are Professional Engineers;

- they would initiate enforcement proceedings under their respective provincial legislation against any person using the designation PE who is not registered or licensed by their association; and
- given the use of PE in the U.S. and Canada, most members of the public would believe that the use of the designation PE meant that the individual was a licensed engineer.

Mr. Schuld and Mr. Mulrooney further explained that while their associations may not oppose the granting of the title Power Engineer under appropriate legislation to people who are qualified in accordance with the standards set out in their provincial legislation, they do not support the use of the abbreviated designation PE by members of AIPE (i.e. the Applicant).

Mr. Barker and Mr. Lizotte deposed, however, that members of IPE have no legal right to use the designation Power Engineer or the abbreviation PE in Ontario or Quebec. They each explained that in their provinces, a Power Engineer is someone who is qualified to practise engineering in the area of electrical power generation and transmission. It is therefore their opinions that the general public and potential users of engineering services would be confused regarding the use of the designation PE in association with "professional power engineering services".

Objections to Evidence

Both parties have raised various objections to the other party's evidence. First, the Applicant has objected to the fact that the affidavit of Ms. Eatherley was introduced by an employee of the Opponent's firm and the Opponent has objected to the fact that the affidavit of Mr. Park was introduced by a member of the Applicant's firm. The general argument is that employees are not independent witnesses giving unbiased evidence when they give opinion evidence on contested issues (see *Cross-Canada Auto Body Supply (Windsor) Ltd*. v. *Hyundai Auto Canada* (2006), 53 C.P.R. (4th) 286 (F.C.A.) ("*Cross-Canada*")). Each party argues that as a result, little if any weight should be accorded to these affidavits.

In view that neither the Eatherley nor the Park affidavits comprise contentious opinion evidence of the type adduced in the *Cross-Canada* case, I have given full consideration to those affidavits.

The Applicant also raised many objections to the evidence of Ms. Eatherly. In view that the Board has taken judicial notice in the past of dictionary definitions and encyclopedias, I am satisfied that at least some of the results of Ms. Eatherley's Internet searches show that PE can be an abbreviation for, *inter alia*, power engineer and professional engineer. While it is not clear from her evidence whether these particular meanings for this abbreviation have been brought to the attention of consumers in the marketplace in Canada, I note that some of her searches were limited to pages from Canada.

The Opponent has raised hearsay objections to the publications from IPE and the publications from APEGGA attached as exhibits to the Shewfelt and Park affidavits. I agree that such documents are hearsay and they have therefore been disregarded. I have also disregarded the testimony of Mr. Shupac regarding the e-mail reply from Jo-Ann Marshall on behalf of APEGGA, and the print out of such reply attached as Exhibit B to his affidavit.

The Applicant has also raised an objection to the Internet evidence presented by the Mulrooney, Schuld, Barker and Lizotte affidavits. The reliability of Internet evidence was discussed by Madame Justice Lamer-Tremblay in *ITV Technologies Inc.* v. *WIC Television Ltd*. (2003), 29 C.P.R. (4th) 182 (F.C.T.D.) as follows:

> "With regard to the reliability of the Internet, I accept that in general, official web sites, which are developed and maintained by the organization itself, will provide more reliable information than unofficial web sites, which contain information about the organization but which are maintained by private persons or businesses.
>
> In my opinion, official web sites of well-known organizations can provide reliable information that would be admissible as evidence, the same way the Court can rely on Carswell or C.C.C. for the publication of Court decisions without asking for a certificed copy of what is published by the editor. For example, it is evident that the official web site of the Supreme Court of Canada will provide an accurate version of the decisions of the Court."

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

In the present case, the "Answers.com" website's disclaimer states that the entry is from Wikipedia, the leading "user contributed encyclopedia" and may not have been reviewed by professional editors. I agree with the Applicant that this disclaimer raises doubt about the website's reliability. On the other hand, I note that the Trade-mark Trial and Appeal Board ("TTAB") accepts evidence from Wikipedia provided that there is an opportunity to reply to it. In this regard, the TTAB acknowledges that while the online encyclopedia Wikipedia carries with it a certain degree of risk of unreliability, it is not so much that it is completely inadmissible as long as the other side can reply to the evidence (see *In Re IP Carrier Consulting Group*, TTAB, Serial No. 78542726, 6/18/07). I also note that evidence from the Wikipedia was accepted at face value in the decisions *Build-A-Vest Structures Inv*. v. *Red Deer (City)*, (2006), 29 M.P.L.R. (4th) 210 and *Gauvin* c. *Vallée* 2006 QCCS 3363. As a result, I have given some weight to this evidence, although I note that it is not clear from this evidence whether the information on this website has been brought to the attention of consumers in the marketplace in Canada.

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

Grounds of Opposition

Section 30(b)

The initial burden on the Opponent is light respecting the issue of non-conformance with s. 30(b), because the facts regarding the Applicant's first use are particularly within the knowledge of the Applicant (*Tune Masters* v. *Mr. P's Mastertune Ignition Services Ltd*. (1986), 10 C.P.R.

6(3d) 84 (T.M.H.O.) at 89). This burden may be met by reference not only to the Opponent's evidence but also to the Applicant's evidence (*Labatt Brewing Co.* v. *Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 at 230 (F.C.T.D). While the Opponent may rely upon an Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is "clearly" inconsistent with the Applicant's claims as set forth in its application.

Before determining whether the Applicant is using the mark PE as a certification mark in association with services as contemplated by the Act, it is helpful to reproduce those sections of the Act that regard the use of certification marks.

Section 2 of the Act defines a certification mark as follows:

"certification mark" means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to:

a) the character or quality of the wares or services,
b) the working conditions under which the wares have been produced or the services performed,
c) the class of persons by whom the wares have been produced or the services performed, or
d) the area within which the wares have been produced or the services performed.

Further, s. 23 of the Act provides as follows:

(1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of ware or the performance of services such as those in association with which the certification mark is used.

(2) The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark

accordingly shall be deemed to be use thereof by the owner.

Finally, s. 4(2) provides that a trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

The Applicant's evidence suggests that PE is being applied as a professional designation as opposed to being used as a certification mark as contemplated by the Act. In this regard, one of the objects of the Applicant as set out in the Objects and By-laws attached to the Shewfelt affidavit is "to certify and give professional designations to members who meet the membership requirements of the Act." Under the heading "Certification Requirements", the following is stated: "Members, who hold a valid Power Engineer's Certificate of Competency issued by the Alberta Boiler Safety Association, and who have met the required membership standards of the AIPE, shall be entitled to use the professional designation PE."

In my view, the above evidence indicates that the Mark PE is an acronym for Power Engineer, which is a title accorded by the Applicant to those individuals who have achieved a certain skill level and competency in association with power engineering services and who have met the required membership standards. The Opponent has submitted that a professional designation cannot function as a certification mark. In this regard, it relies on the decision in *Life Underwriters Assn. Of Canada* v. *Provincial Assn. Of Quebec Life Underwriters* (1988), 22 C.P.R. (3d) 1 (F.C.T.D.). At p.9 of the reported decision, Mr. Justice Dubé stated the following:

> On the other hand, the Provincial argues, first, that the titles at issue were professional designations, not certification marks, and may not be registered. In fact, the documentary evidence submitted by the National shows in many instances that it considers chartered life underwriters as professionals and the designations in question to be professional titles. As they are professional titles, they are used in association with a person, not in association with wares or services….
>
> [p. 16] Just as the words "lawyer", "notary", "physician", "engineer" and so on cannot be registered as certification marks, so the title "chartered life underwriter" cannot be regarded as a certification mark. In my view, the name of a profession itself cannot be used as a standard, a definite norm, a distinguishing mark that can be placed on wares or services."

The Opponent also referred me to the decision in *Groupe Conseil Parisella, Vincelli Associés Inc.* v. *CPSA Sales Institute* (2003), 31 C.P.R. (4th) 308 (T.M.O.B.), wherein Member Carrière considered, *inter alia*, whether the applicant had used the certification mark PVA in association with services of a professional salesperson and operating as a sales manager on behalf of others. In that decision, Member Carrière decided as follows:

> "Based on the evidence in this matter, I agree with the Opponent that, as stated in its written pleadings, the acronym PVA is not used in association with "services of a professional sales person, and sales manager, on behalf of others", since it is not used in association with services, but is instead used as a professional title that appears after the name of an individual on business cards, letterheads or certificates of accreditation."

I agree with the Opponent that the evidence shows that the mark PE is an abbreviation for the professional title "Power Engineer". As such, it cannot be used as a certification mark. I would like to add that the Applicant's evidence that certification marks have been granted for other professional titles in the past is not sufficient, by itself, to establish that the acronym for the professional title in the present case should also be allowed. In this regard, I do not consider that the Opposition Board is in a position to explain why certain marks identified by an applicant in its evidence were permitted by the examination division of the Trade Marks Office to proceed to registration (*Thomas J. Lipton Inc*. v. *Boyd Coffee Co*. (1991), 40 C.P.R. (3d) 272 at 277).

Even if a professional designation can function as a certification mark, I agree with the Opponent that the Applicant has not shown use of its mark in association with services pursuant to s. 4(2). In this regard, the evidence of Mr. Shewfelt and Mr. Amundson is that the Mark appears on their business cards, and at the end of correspondence after their names. Mr. Amundson also uses the mark on his resume. In my view, this is not evidence of use of the Mark in association with the performance or advertising of services as is required by s. 4(2) of the Act. As this evidence is therefore clearly inconsistent with the Applicant's claim that it has used its mark since July, 2001, I am satisfied that the Opponent has met its burden under this ground.

It was therefore up to the Applicant to submit evidence of use of the Mark with services which it has not done. This ground is therefore successful.

Distinctiveness Ground of Opposition

The Opponent has pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's services from those of others, including other power engineers and other entities which are licensed to practice engineering in Canada. According to Mr. Justice Noël in the recent decision in *Bojangles' International, LLC v. Bojangles Café Ltd. (2006), 48 C.P.R. 4th 427*, the initial onus on the Opponent with respect to its distinctiveness ground of opposition requires it to show that the mark PE had a reputation in Canada that was either substantial, significant or sufficient as of the filing date of the statement of opposition (i.e. August 3, 2004). I must therefore assess if the Opponent's evidence shows that PE mark had a reputation in Canada that was either substantial, significant or sufficient as of that date.

While I consider the evidence (including the uncontradicted and unchallenged testimonies of Mr. Kizas, Mr. Mulrooney, Mr. Lizotte, Mr. Schuld and Mr. Barker) sufficient to show that PE is the abbreviation for "professional engineer" in the U.S., and that "professional engineer" and "power engineer" are two of several definitions generally found for PE, in my view the Opponent has not shown that this abbreviation and either of these meanings had a substantial, significant or sufficient reputation in Canada as of the filing date of the opposition (i.e. August 3, 2004).

While it may be reasonable to infer that some of the about 5000 professional engineers who had reciprocal qualifications to practice engineering in the U.S. and Canada as of June or July, 2006 (i.e. the dates of the Opponent's reply evidence), may have had such qualifications (and therefore may have been lawfully entitled to use PE as part of their professional designation in Canada on business cards, letter head, etc.) prior to the relevant date, it was up to the Opponent to evidence this in order to meet its burden under this ground. As I am not satisfied that the Opponent has met its initial burden with respect to the distinctiveness ground of opposition, this ground is dismissed.

Section 12(1)(b)

The Opponent further pleads that the mark is not registrable because, contrary to s. 12(1)(b), it is clearly descriptive or deceptively misdescriptive of the character or quality of the services in association with which it is used or of the persons employed in their production. The issue is to be determined from the point of view of an everyday user of the wares or services. Further, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression (see *Wool Bureau of Canada Ltd*. v. *Registrar of Trade-marks* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.) at 27-28, and *Atlantic Promotions Inc*. v. *Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.).

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

While I am satisfied from the evidence that the term "PE" is the designated abbreviation for Professional Engineer in the United States, and that professional engineer and power engineer are two of several definitions generally found for PE, I am not sure whether the prospective consumer, when faced with the Mark, would immediately and as a matter of first impression assume that the services were produced by a professional engineer or power engineer. In this regard, the definitions for the abbreviation PE in the Canadian Oxford Dictionary, as pointed out by the Applicant, include Peru, Physical Education and Prince Edward Island. Bearing in mind that "clearly" means "easy to understand, evident or plain" in the context of s. 12(1)(b) (see *Thorold Concrete Products Ltd*. v. *Registrar of Trade-marks* (1961), 37 C.P.R. 166), I do not consider that the Mark's meaning is evident in Canada since there are multiple meanings attributable to it. There is therefore no basis from which I can conclude that either of the meanings put forward by the Opponent would dominate in the mind of the average consumer. The s. 12(1)(b) ground is therefore unsuccessful.

Section 12(1)(c) and Section 12(1)(e)

As in the case of the s. 12(1)(b) ground, the Opponent has failed to meet the evidential burden upon it with respect to these grounds, even as of the later material date. These grounds are therefore dismissed.

Section 30(i) Ground

Where the Applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the Applicant (see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155). As this is not such a case, I am also dismissing this ground of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8).

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

Cindy R. Folz
Member
Trade-marks Opposition Board