

**IN THE MATTER OF AN OPPOSITION
by Canadian Council of Professional Engineers to
to application No. 732,837 for the trade-mark SPRAY
ENGINEERING filed by John Brooks Company Limited**

On July 13, 1993, the applicant, John Brooks Company Limited, filed an application to register the trade-mark SPRAY ENGINEERING based on proposed use in Canada. The application was advertised for opposition purposes on May 24, 1995. The application as advertised included a disclaimer to the word SPRAY and covered the following wares:

spray nozzles and manifolds for high and low pressure cooling, cleaning, conditioning and processing; gauges, hoses, connectors and couplings, filters and strainers, lubricators, flow regulators; and fluid handling systems composed of spray nozzles, manifolds, gauges, hoses, connectors, couplings, filters, strainers, lubricators and flow regulators

and the following services:

operation of a business, namely distributing spray nozzles and manifolds for high and low pressure cooling, cleaning, conditioning and processing; gauges, hoses, connectors and couplings, filters and strainers, lubricators, flow regulators; and fluid handling systems comprising the aforementioned components.

On November 8, 2001, the applicant filed an amended application deleting the above-noted services. At the outset of the oral hearing held on November 9, 2001, I accepted the amended application.

The opponent, Canadian Council of Professional Engineers, filed a statement of opposition on June 2, 1995, a copy of which was forwarded to the applicant on September 25, 1995. In its statement of opposition, the opponent stated that it was the owner of nine official

marks, namely ENGINEER, PROFESSIONAL ENGINEER, P.ENG., CONSULTING ENGINEER, ENGINEERING, INGENIEUR, ING., INGENIEUR CONSEIL and INGENIERIE.

The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30 of the Trade-marks Act because (1) the applicant could not have been satisfied that it was entitled to use the applied for trade-mark in view of the existence of the opponent's official marks and (2) the "...alleged trade-mark of the applicant cannot function as a trade-mark." The second ground is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of "...the persons employed in the wares [sic] or of the contents of the wares."

The third ground of opposition is that the applied for trade-mark is not distinctive because it is not registrable since the combination of the word SPRAY and the word ENGINEERING cannot function to distinguish the applicant's wares from those of others manufacturing or selling similar wares in Canada. The fourth ground is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(n)(iii) and 12(1)(e) of the Act because it consists of or so nearly resembles as to be likely to be mistaken for one or more of the opponent's official marks.

The fifth ground of opposition is that the applied for trade-mark is not registrable pursuant to Sections 9(1)(d) and 12(1)(e) of the Act because the use of the word ENGINEERING indicates to the public that the applicant “...has government approval or authority, which it does not have.” The sixth ground is that the applied for trade-mark is not registrable pursuant to Sections 10 and 12(1)(e) of the Act because the word ENGINEERING has become recognized in Canada as designating the kind, quality and place of origin of the applied for wares and services as being those provided by a particular class of person registered and operating pursuant to relevant provincial statutes as engineers.

The seventh ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is deceptively misdescriptive of “...the conditions of or the persons employed in their production or of their place of origin.”

The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavit of Sandra M. Ward. As its evidence, the applicant submitted the affidavits of Linda Victoria Thibeault, Tai Nahm, Laura Chapman, C. Anik Morrow and James Houston. Messrs. Houston and Nahm and Mss. Chapman and Morrow were cross-examined on their affidavits and the transcripts of those cross-examinations form part of the record of this proceeding. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As a preliminary matter, it should be noted that the original affidavits submitted by the applicant were apparently misplaced by the Trade-marks Office. The applicant's agent kindly submitted replacement copies.

The Evidence

The Ward affidavit serves simply to evidence the opponent's nine official marks including the marks ENGINEER and ENGINEERING. The Thibeault affidavit evidences five third party registrations for trade-marks which include the word ENGINEERING where that word is not disclaimed. At the oral hearing, the opponent's agent submitted that three of those registrations have been expunged. However, the opponent did not file evidence on point and I am not prepared to exercise my discretion to check the trade-marks register: see the opposition decision in Quaker Oats Co. of Canada Ltd. v. Menu Foods Ltd. (1986), 11 C.P.R.(3d) 410 at 411.

The Nahm affidavit evidences dictionary definitions for the words "engineer" and "engineering" and the results of Mr. Nahm's attempts to locate references to companies or occupations which use the words "spray engineering." Exhibits C and D to the Nahm affidavit list a large number of branches and sub-branches of the engineering profession.

The Chapman affidavit evidences the results of a search of the CD-NameSearch data base respecting trade-marks that incorporate the word "engineering." The opponent's agent

submitted that the results of that search are inadmissible in line with the decision in Sta-Rite Industries Inc. v. GSW Inc. (1999), 87 C.P.R.(3d) 300 at 305 (F.C.T.D.). However, unlike in the GSW case, Ms. Chapman indicated that the data base in question was compiled directly from the records of the Canadian Trade-marks Office. She was not questioned or challenged on this point during cross-examination. Thus, I consider the results of Ms. Chapman's search to be reliable and admissible. A similar situation arose in the unreported opposition decision in Amway Corporation v. Nutravite Pharmaceutical Inc. (S.N. 790,667; February 16, 2001).

The Morrow affidavit deals with Ms. Morrow's attempts to obtain materials from the offices of the opponent. Ms. Morrow, a student-at-law with the firm representing the applicant, attended at the offices of the opponent and obtained various publicly available material produced by the opponent. Ms. Morrow subsequently spoke to an employee of the opponent by phone and requested that evidence of use by the opponent of its official marks ENGINEERING and ENGINEER be provided within five days, failing which she would assume that none existed. No such evidence was provided.

The Morrow affidavit was submitted to show that the opponent had not adopted and used its official marks ENGINEERING and ENGINEER. However, the materials appended to Ms. Morrow's affidavit are dated some seven years after the publication of the opponent's official marks in the Trade-marks Journal. Furthermore, the results of her telephone conversation with an employee of the opponent are hearsay and unreliable.

The opponent submitted that the Morrow affidavit is also inadmissible because Ms. Morrow was in breach of the Rules of Professional Conduct of the Law Society of Upper Canada. However, the Opposition Board has no jurisdiction to rule on such matters. If the opponent has concerns about a potential breach of rules of professional conduct, they should be raised in the appropriate forum. In any event, given that Ms. Morrow fully disclosed her connection to this case during her telephone conversation with the opponent's employee, it seems unlikely that there was any such breach.

In his affidavit, Mr. Houston identifies himself as the Division Manager with Spray Engineering, a division of the applicant, John Brooks Company Limited. Spray Engineering is engaged in the business of manufacturing and selling fluid handling systems and the components for such systems. The employees of Spray Engineering evaluate customers' needs and then design systems with spray nozzles, pumps, drivers, etc. to meet those needs. Although neither the applicant nor Spray Engineering has a certificate to engage in professional engineering, some of their employees are professional engineers.

According to Mr. Houston, the applicant is the exclusive Canadian distributor of Spraying Systems Co., a United States-based manufacturer of spraying equipment. In conducting its business, Spray Engineering uses wares provided by Spraying Systems Co. and other third party manufacturers.

After Spray Engineering incorporates one of their systems into a customer's overall

system, it is usually inspected by a professional engineer, either one of Spray Engineering's employees or one of the customer's employees (see page 27 of the Houston transcript). In many cases, Spray Engineering does not have sufficient expertise respecting certain spray nozzles. In those situations, it calls on Spraying Systems Co. to assist. That company has professional engineers on staff. Those engineers would provide advice or even visit Spray Engineering's customers. Thus, customers dealing with Spray Engineering often come into contact with professional engineers during those dealings, some of whom are professional engineers with expertise in spray nozzles, fluid handling systems and the like.

Mr. Houston differentiates between his company's Spray Engineering division and a "pure engineering" department such as would be found at Spraying Systems Co. (see page 56 of the Houston transcript). Exhibit D to the Houston affidavit is a letter from his division which states that Spray Engineering has ".....the engineering capabilities to provide you with the best possible solution to your application problem." Such statements would tend to give potential customers the impression that Spray Engineering is an engineering firm or division along the lines of the "pure engineering" department which exists at the U.S. company, Spraying Systems Co.

The Grounds of Opposition

The first ground is not a proper ground of opposition. The mere publication of the opponent's official marks does not preclude the applicant from stating that it is satisfied that

it is entitled to use its applied for mark. Furthermore, Section 30 of the Act does not appear to provide a basis for a ground based on the allegation that the applicant's trade-mark cannot function as a trade-mark. In any event, the opponent did not provide any supporting allegations of fact. Thus, the first ground is unsuccessful.

The second and seventh grounds of opposition are both based on Section 12(1)(b) of the Act and thus I will consider them together. The material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). The issue is to be determined from the point of view of an everyday user of the wares. Furthermore, 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 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d).

The issue in the second and seventh grounds is twofold, namely (1) is the applied for trade-mark clearly descriptive or deceptively misdescriptive of the character or quality of the applied for wares and (2) is it clearly descriptive or deceptively misdescriptive of the persons employed in the production of those wares or of their place of origin?

As for the first aspect of the second and seventh grounds, the applicant has conceded

that the word **SPRAY** is not distinctive in relation to its applied for wares. This is not surprising given that its wares comprise the components of what could be described as “spray systems.” As evidenced by the dictionary definitions introduced by the Nahm affidavit, the word **ENGINEERING** is defined as the application of science to the design, building and use of machines, constructions, etc. It can also be defined as the application of scientific principles to practical ends as the design, construction and operation of efficient and economical structures, equipment and systems. It can also refer to a profession or the work performed by an engineer.

The evidence of record shows that the wares sold by the applicant are fairly sophisticated items and that a certain expertise is required to incorporate them into spraying systems or fluid handling systems and to incorporate such systems into larger, existing systems owned by prospective customers. The evidence also shows that the everyday user of such wares would, when dealing with the applicant, often be dealing with professional engineers and would rely on their expertise in manufacturing, selecting and/or using the applicant’s wares. Spray Engineering’s own correspondence touts its “engineering capabilities” to provide customers with the best solution to their application problems.

The evidence in this case strongly suggests that the everyday user of the applicant’s wares would assume that professional engineers are involved in the design, manufacture, selection and/or installation of those wares. As a matter of first impression, those users would view the mark **SPRAY ENGINEERING** used in association with the applicant’s wares as

clearly describing that professional engineers are involved in ensuring the character and quality of those wares. If they are not, then the mark would be deceptively misdescriptive. Thus, the first aspect of the second and seventh grounds is successful in relation to the applicant's wares.

As for the second aspect of the second and seventh grounds, a similar issue was dealt with in Canadian Council of Professional Engineers v. APA - The Engineered Wood Association (2000), 7 C.P.R.(4th) 239 (F.C.T.D.) wherein Mr. Justice O'Keefe dealt with the question of whether or not the trade-mark THE ENGINEERED WOOD ASSOCIATION was clearly descriptive or deceptively misdescriptive of the persons employed in the production of certain structural wood products and services. At page 255 of the reported decision, Mr. Justice O'Keefe states as follows:

I note that in the case at bar, the impugned term ENGINEERED functions as a verb (past participle) and refers to a process that has been performed on an article (wood). It does not represent the noun "engineer" - it is a verb and a past participle of the verb no less. I therefore, am of the view that the claim by the appellant that the proposed mark is deceptively misdescriptive of the persons engaged in the production of the goods and services is without merit. The proposed trade-mark is not THE WOOD ENGINEER'S ASSOCIATION.

It is also my view that none of the arguments raised by the appellant concerning the public's perception of the word "ENGINEER" or prohibitions against the use of the term or title "ENGINEER", unless one is in fact a registered professional engineer, have any merit given these above circumstances.

Unlike in the APA - The Engineered Wood Association case, the present applicant's

trade-mark incorporates the word **ENGINEERING**, not **ENGINEERED**. Furthermore, it is used as a noun, not as a verb. The evidence in this case also shows that there is a wide variety of disciplines and sub-disciplines within the field of professional engineering such as, for example, civil engineering, chemical engineering, mechanical engineering, pipeline engineering, water resources engineering and irrigation drainage engineering. Thus, everyday users of the applicant's wares would likely assume that the words **SPRAY ENGINEERING** refer to a particular sub-discipline of professional engineering.

Given the fact that the everyday user of the applicant's wares would generally assume that professional engineers are somehow involved with those wares and given that he or she would likely view the words **SPRAY ENGINEERING** as a professional engineering sub-discipline, I find that the applicant's mark clearly describes or deceptively misdescribes the persons employed in the production of those wares. Thus, the second aspect of the second and seventh grounds is also successful in relation to the applicant's wares.

The material time for considering the circumstances respecting the fourth ground of opposition is the date of my decision: see the decisions in Allied Corporation v. Canadian Olympic Association (1989), 28 C.P.R.(3d) 161 (F.C.A.) and Olympus Optical Company Limited v. Canadian Olympic Association (1991), 38 C.P.R.(3d) 1 (F.C.A.). Furthermore, the opponent is not required to evidence use and adoption of the official marks it is relying on, at least not in the absence of evidence suggesting that the marks were not used: see page 166 of

the Allied decision. The applicant contended that the trial level decision in Techniquip Limited v. Canadian Olympic Association (1999), 3 C.P.R.(4th) 298 (F.C.A.); affg. (1998), 80 C.P.R.(3d) 225 at 233 (F.C.T.D.) is authority for the proposition that simply raising the issue of the possible non-adoption and non-use of official marks relied on is sufficient to require the opponent to evidence use of those marks. I disagree. On my reading of the trial level decision in Techniquip, it is not inconsistent with the Allied decision. To the extent that it may be, the Allied decision is to be preferred since it is a decision of the Federal Court of Appeal.

Finally, if the applicant is able to cast doubt as to whether or not an official mark owner qualifies as a public authority, the opponent may be required to evidence that status before relying on any such official mark: see page 216 of the trial level decision in Big Sisters Association of Ontario v. Big Brothers of Canada (1999), 86 C.P.R.(3d) 504 (F.C.A.); affg. (1997), 75 C.P.R.(3d) 177 (F.C.T.D.) and Heritage Canada Foundation v. New England Business Service, Inc. (1997), 78 C.P.R.(3d) 531 at 536 and 538 (T.M.O.B.).

As stated in Section 9(1)(n)(iii) of the Act, the test to be applied is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In other words, is the applicant's mark identical to, or almost the same as, any of the opponent's official marks?: see page 217 of the trial level decision in the Big Sisters case noted above. The opponent contended that the words "consists of" are not equivalent to "identical to" but Mr. Justice O'Keefe held otherwise at page 259 of the APA - The Engineered Wood Association decision as follows:

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

At pages 218-219 of the trial level decision in the Big Sisters case, Mr. Justice Gibson confirmed that in assessing the resemblance between the marks at issue, regard may be had to the factors set out in Section 6(5)(e) of the Act. Further, at page 218, Mr. Justice Gibson indicated that the test was to be applied as a matter of first impression and imperfect recollection: see also pages 302-303 of the Court of Appeal decision in Techniquip.

The Court of Appeal decision in Techniquip is also noteworthy for the Court's finding that where a party wishes to rely on a family of official marks, it is necessary to evidence use of those marks. The Court also held (at page 304 of the reported decision) that it was open to the opposite party to evidence the state of the register and the marketplace in order to negate the effect of any claimed family of marks.

The Morrow affidavit was submitted to cast doubt on the opponent's adoption and use of its official marks ENGINEER and ENGINEERING. As discussed, the Morrow affidavit

was deficient in several respects. Thus, the applicant failed to meet its evidential burden and the opponent was not obliged to evidence adoption and use of its official marks.

In the present case, none of the opponent's official marks are identical to the applicant's mark. As for the second aspect of the test, in the case of most of the opponent's official marks, there is not a high degree of resemblance to the applicant's mark. The closest official mark, of course, is the mark ENGINEERING since it is identical to the second component of the applicant's mark. In that case, there is a fair degree of resemblance between the marks at issue. However, the component SPRAY serves to distinguish the applicant's mark from the mark ENGINEERING to a significant extent. As conceded by the opponent at paragraph 50 of its written argument:

The word "SPRAY", although disclaimed, remains integral and, in fact, a dominant feature of the mark.....

Thus, it cannot be said that the applicant's mark is almost the same as any of the opponent's official marks. Furthermore, the opponent has failed to evidence use of its various marks and has therefore not established the existence of a family of marks. Thus, the fourth ground of opposition is also unsuccessful.

As for the fifth ground of opposition, Section 12(1)(e) of the Act precludes the registration of a mark the adoption of which is prohibited by Section 9 of the Act. Section 9(1)(d) reads as follows:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for.....

(d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority.....

The material time for considering the circumstances respecting this ground is the date of my decision: see Allied and Olympus Optical *supra*.

Section 9(1)(d) of the Act involves the application of a two-part test. First, it must be determined if the word ENGINEERING used for spray systems wares would lead to the belief that the wares are sold or performed under governmental patronage, approval or authority. If so, then the second part of the test is applied. As set out in Section 9(1), that test is whether or not the applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the word ENGINEERING. In other words, is the applicant's mark identical to, or almost the same as, the prohibited mark?

The applicant submitted that Section 9(1)(d) of the Act does not have the effect of importing into federal law the various prohibitions against the use of certain professional designations like ENGINEER or ENGINEERING contained in provincial statutes. However, Mr. Justice Muldoon held otherwise in Canadian Council of Professional Engineers v. Lubrication Engineers, Inc. (1984), 1 C.P.R.(3d) 309 at 320 (F.C.T.D.). In accordance with that decision, I find that the word ENGINEER or ENGINEERING would lead to the belief that related wares and services are sold or performed under governmental approval, patronage or authority. However, I find that the applicant's mark does not consist of the word ENGINEERING nor does it so resemble that word as to likely to be mistaken for it. The fifth ground of opposition is therefore also unsuccessful.

As for the sixth ground of opposition, there was an initial burden on the opponent to evidence that the word ENGINEERING has become recognized in Canada as designating the kind, quality and place of origin of the applicant's wares. The opponent failed to file evidence on point and thus the sixth ground is also unsuccessful.

To the extent that the third ground of opposition is based on the allegation of non-registrability, that matter has been dealt with in the specific grounds related to registrability. Otherwise, it is not a proper ground of opposition in that it does not comply with the provisions of Section 38(3)(a) of the Act. Apart from the matter of registrability, the opponent has simply asserted that the applicant's trade-mark is not distinctive without providing any supporting allegations of fact. In any event, the opponent has failed to evidence any third party uses of the trade-mark SPRAY ENGINEERING or any similar marks . Thus, the third ground is unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 3rd DAY OF DECEMBER, 2001.

**David J. Martin,
Member,
Trade Marks Opposition Board.**