



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

Reference: 2014 TMOB 14
Date of Decision: 2014-01-22

TRANSLATION

**IN THE MATTER OF AN OPPOSITION by
Engineers Canada/Ingénieurs Canada to
application No. 1,479,379 for the trade-mark
WESTRAND INGÉNIERIE DE L'ODEUR &
Design in the name of Financière Westrand, a
limited liability company**

Introduction

1. On May 3, 2010, Financière Westrand, a limited liability company (the Applicant) filed an application to register the trade-mark WESTRAND INGÉNIERIE DE L'ODEUR & Design as illustrated below:



based on a proposed use in association with:

Chemical products intended for industry, sciences, photography, as well as agriculture, horticulture and forestry, specifically: chemical binders, chemical agricultural products, chemical products used in the pharmaceutical industry, chemical products used in the manufacture of adhesives, chemical products used in lithography and photography, chemical fertilizers for agriculture, horticulture and forestry; soil fertilizers; fire suppressant compounds, specifically: chemical suppressants; preparations for metal tempering and welding; chemical products intended for food conservation; tanning materials; adhesives (glues) intended for

industry, specifically: adhesives for use in the packaging of consumer products; adhesives for use in the automobile industry, adhesives for use in the furniture industry, adhesives for use in the textile industry, adhesives for use in the manufacture of plywood, adhesives for use in the manufacture of furniture. Preparations for bleaching and other substances for laundry, specifically: bleach, soaps, detergents, starches, laundry blue, stain removers; preparations for cleaning, polishing, degreasing and abrading, specifically: soaps and detergents used for cleaning floors and walls, furniture polishes, cream for cleaning silverware; toilet soap, antibacterial soap for personal use; perfumery, specifically: perfumes, eau de toilette, colognes, scents, deodorants for personal use, bath and shower gels and milks; essential oils for personal use, essential oils for use in the manufacture of perfumes, for aromatherapy; cosmetics, hair lotions; toothpastes. Industrial oils and greases; industrial lubricants for automobiles, all-purpose lubricants; products for absorbing, wetting and binding dust; fuel, specifically: engine gasoline, tapers, candles, lighting wax, lighting gas, lighting grease. Hygiene products, specifically: cotton wool, wadding, compresses, distilled water; disinfectants, specifically: hand disinfectants, kennel disinfectants, disinfectants for medical instruments, all-purpose disinfectants; fungicides, herbicides. Farm machinery other than manual devices, specifically: tractors, ploughs, combine harvesters. Appliances for steam production, drying, ventilation, water distribution and sanitation facilities, specifically: fans, air conditioners, clothes dryers, air purifiers, dehumidifiers (the Wares).

2. The colour is claimed as a characteristic of the trade-mark. The circular logo is green and the text is in black. The application for registration was published on May 11, 2011 in the Trade-Marks Journal for the purposes of opposition.

3. On October 7, 2011, the Canadian Council of Professional Engineers, whose name was later changed to Engineers Canada/Ingénieurs Canada (the Opponent), filed a statement of opposition, which was later amended. The grounds of opposition currently raised are those based on sections 30(i), 30(e), 12(1)(b), 12(1)(e) and 2 of the *Trade-marks Act*, RSC (1985), c T-13 (the Act). They are described in greater detail in Appendix A of this decision. In its counter statement of opposition, the Applicant denied each and every one of these grounds of opposition.

4. The Opponent filed affidavits by John Kizas and D. Jill Roberts and an authenticated copy of the official marks numbers 903,676 and 903,677 for the INGÉNIERIE and ENGINEERING marks owned by the Opponent. The Applicant submitted no evidence. Only the Opponent filed a written argument and was represented at the hearing.

5. I will first have to determine whether the Opponent has submitted sufficient evidence to support its grounds of opposition. If such is the case, I must then decide whether each of them is well-founded.

6. For reasons described in greater detail below, I consider that the Mark is not registrable within the meaning of Section 12(1)(b) of the Act and that it is not distinctive.

Evidentiary burden

7. Under the procedure in the matter of opposition to the registration of a trade-mark, the Opponent must present sufficient elements of evidence concerning the grounds of opposition that it raises in order that it is apparent that there exist facts that can support these grounds of opposition. If the Opponent is in compliance with this requirement, the Applicant would then have to convince the registrar, according to the balance of probabilities, that the grounds of opposition should not prevent registration of the Mark [see *Joseph Seagram & Sons Ltd v. Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325(TMOB) and *John Labatt Ltd v. Molson Companies Limited* (1990), 30 CPR (3d) 293(CF 1st inst)].

Preliminary comments

8. I would like to recall that the Applicant submitted no evidence and no written arguments. At the hearing, the Opponent presented several innovative arguments. However, as it appears in my decision, I will only take into account the arguments most familiar to this field of law, which will be sufficient to rule on this matter in favour of the Opponent. This explains the brief nature of my reasons.

Ground of opposition based on Section 12(1)b) of the Act

9. The issue to be resolved is: Does the Mark constitute a clear or a deceptively misdescriptive description, in French or English, of the nature and quality of the Wares or of the individuals who produce them?

10. It is worth recalling the major guidelines that help us determine whether a mark is clearly descriptive or deceptively misdescriptive within the meaning of Section 12(1)(b) of the Act. Accordingly, Judge Cattanaich stipulated the procedure to be followed in *GWG Ltd v. Registrar of Trade-marks* (1981), 55 CPR (2d) 1:

It has been repeatedly stated based on the authority of numerous decided cases:

(1) that whether a trade mark is clearly descriptive is one of first impression;

(2) that the word "clearly" in para. 12(1)(b) of the Act is not a tautological use but it signifies a degree and is not synonymous with "accurate" but means in the context of the paragraph "easy to understand, self-evident or plain", and

(3) that it is not a proper approach to the determination of whether a trade mark is descriptive to carefully and critically analyze the words to ascertain if they have alternate implications or alternate implications when used in association with certain wares and to ascertain what those words in the context in which they are used would represent to the public at large who will see those words and will form an opinion as to what those words will connote: see *John Labatt Ltd. v. Carling Breweries Ltd.* (1974), 18 C.P.R. (2d) 15 at p. 19.

11. Case law also shows us that common sense must be used [see *Neptune SA v. Canada (Attorney General)* (2003), 29 CPR (4th) 497(CFPI) and *Ontario Teachers' Pension Plan Board v. Canada (Attorney General)* 2011 CF 58, conf 2012 CAF 60]. Also, the evaluation of the descriptive character of the Mark must be conducted while taking into account its associated Wares [see *Mitel Corporation v. Registrar of Trade Marks* (1984), 79 CPR (2d) 202 at page 208 (CF 1st inst)].

12. The Opponent argues that the non-contradictory evidence on file shows that there exists a specialty within the engineering profession that focuses on odours and perfumes. On this

point, the Opponent refers to the content of the affidavit of Ms. Jill Roberts, assistant bailiff. The latter conducted an Internet search into the term ‘Odour Engineering’. She obtained 15 million hits and submitted the first five pages of the results generated by this search. She also submitted at least five of the articles listed in the results relating to this subject.

13. Ms. Roberts also consulted the catalogue of the National Research Council’s Canada Institute for Scientific and Technical Information (CISTI) in Ottawa and found five documents concerning odour and perfume engineering and submitted them.

14. Ms. Roberts also used Google to search the Internet for the term ‘scent engineering’, which gave approximately 2,000 hits. She submitted the first three pages of the results of this search. She also attached to her affidavit some of the listed articles on this subject.

15. Lastly, Ms. Roberts conducted two separate searches on the Canada 411 website: one aiming to identify anyone having the family name of “Westrand” and the other by inserting the word ‘engineering’ in the search engine on this site. The first search gave three hits whereas the second generated 241 pages, each one comprising 40 hits. Based on the results of this latter search, we note that it is common practice for engineering firms or companies offering engineering services to include in their company names the words ‘engineering’, ‘génie’ or ‘engineers’.

16. Mr. Kizas has managed the intellectual property and the liaison committee for the Opponent since February 2009. Previously, he had been strategic development manager for the Opponent since 2001. He is an engineer by training, and a member of the Professional Engineers of Ontario (PEO). He submitted his *curriculum vitae* as Exhibit 1. He explains that during his career, he used the terms: ‘engineer’, ‘a civil engineer’, ‘a transportation engineer’, ‘a project engineer’, ‘a professional engineer’, and ‘a P.Eng.’

17. Mr. Kizas explains that the Opponent was founded in 1936 and is a national umbrella organization for the 12 provincial and territorial associations that govern the exercise of

professional engineer in Canada under their jurisdiction. These associations have in total over 250,000 members. He lists these 12 associations.

18. Mr. Kizas says that in 1965 the Opponent set up the Canadian Engineering Accreditation Board to ensure the accreditation of engineering training programs on behalf of the provincial and territorial associations.

19. Mr. Kizas submitted a copy of the provincial and territorial legislation that governs the profession of engineer. One of the main goals of these regulations is protection of the public. Engineers must meet certain requirements to obtain their licence enabling them to exercise this profession. He submitted a guide on admission to the exercise of the profession of engineer in Canada.

20. Mr. Kizas states that, with the exception of the provinces of Quebec and British Columbia, the laws governing the profession of engineer require that entities such as businesses and companies engaged in the provision of engineering services must also obtain an authorization certificate, a certificate of compliance or an exercise permit, as applicable.

21. Mr. Kizas explains that the various provincial and territorial legislation contain provisions concerning the use of the designation of ingénieur professionnel, P.Eng, ingénierie, génie, engineering, Ing. and their prohibited use. He submitted excerpts from this legislation as Exhibit 16A-J to his affidavit. Accordingly, no individual or company may use a title, a designation or an abbreviation that could lead others to believe that the former could practice the profession of professional engineer. This prohibition is explained by the fact of these unqualified individuals exercising this profession would constitute a threat to public safety.

22. Mr. Kivas asked each of these associations to check whether the Applicant was or is duly registered to exercise engineering. He also asked them to check whether a member of their association was licenced to exercise the profession of engineer under their jurisdiction, had identified the Applicant as an employer. He submitted the certificates issued by these associations confirming that the Applicant did not hold a licence to exercise the profession of

engineer and that it did not employ authorized engineers licenced to exercise the profession of engineer within their territory.

23. Mr. Kivas claims that ‘the practice of the profession of professional engineer’ means any act of planning, design, composition, evaluation, opinion, report, management or supervision that requires the application of engineering principles and which concerns protection of: life, health, property, economic interests, the public or the environment. He submitted a copy of the ‘Guideline on the Definition of the Practice of Professional Engineering’ published by the Opponent as Exhibit 17.

24. Mr. Kizas submitted the definition of the word “génie” found on the website of the Office de la langue française. He explains that engineering is no longer limited to the construction of bridges and dams and has diversified over time. Accordingly, the use of the words “ingénieurs”, “genie”, “ingénierie”, “engineer” or “engineering” in Canada, in association with services that overlap those offered by engineers will be perceived by the public as an indication that these services are provided by an individual exercising the profession of engineer or who employs members of this profession to provide these services.

25. He claims that the number of programs accredited by the Canadian Engineering Accreditation Board increased from 102 in 1965 to 264 in 2011. He filed as Exhibit 19 to his affidavit the list of these programs published in 1975, 1990 and 2008.

26. Mr. Kizas describes chemical engineering as being a branch of engineering that covers the application of physical sciences, i.e. chemistry, physics and natural sciences, in combination with mathematics and the economy, to the procedure of transforming raw materials or chemicals into substances that have use and value.

27. Mr. Kizas states being aware that the neutralization of odours is a subject of training and research in the field of engineering at several universities. There are 21 Canadian universities that offer training in chemical engineering and seven universities offer a training program in environmental engineering.

28. Mr. Kizas filed documents that refer to Purdue Agricultural Air Quality Laboratory. He also filed the following studies: ‘Odour impact assessment jointly performed by researchers in the departments of Civil Engineering and Applied Mechanics at McGill University and Civil and Environmental Engineering at the University of Windsor’; ‘Correlation between odour intensity assessed by human assessors and odour concentration measures with olfactometers’ published in *Canadian Biosystems Engineering*.

29. Mr. Kizas states that, based on his own experience and the information described above, it is clear that the Wares are wares of the type designed and manufactured by professional engineers and more specifically by engineers specialized in the field of chemical and environmental engineering.

30. Based on the overall evidence submitted by the Opponent, I conclude that there exists a specialty in the field of engineering that concerns odours and perfumes. I also note that it is regular practice for engineering firms to use a company name including the word ‘engineering’, for which the French translation is ‘ingénierie’.

31. The evidence on file shows that neither the Applicant nor any one of its employees are qualified to exercise the profession of engineer in Canada. Lastly, the word ‘Westrand’ is a family name, albeit somewhat rare. Accordingly, the Mark cannot be considered to be a clear description of the quality of the Wares or of the individuals who produce them. Moreover, the Opponent conceded this point at the hearing. However, it remains to be determined whether the Mark is deceptively misdescriptive of the quality of the Wares or of the individuals who produce them within the meaning of Section 12(1)(b) of the Act.

32. As previously mentioned, it is the first overall impression given by the Mark that is important as well as common sense. However, the Mark includes the terms ‘ingénierie de l’odeur’ which is descriptive of a discipline in the practice of the profession of engineer recognized in Canada. In addition, the design portion of the Mark includes an illustration of a flask that can be found in laboratories.

33. I must also take into account the fact that the word ‘Westrand’ is a part of the Mark. However, this word represents the Applicant’s company name. Accordingly, in applying common sense to the facts on file, the overall Mark, both visually and phonetically, gives a first impression that the Wares are designed or manufactured by engineers. However, such is not the case. In the circumstances, I conclude that the Mark is deceptively misdescriptive in French of the individuals who produce the Wares [see *Canadian Council of Professional Engineers v. John Brooks Co* (2002), 21 CPR (4th) 397 (TMOB)].

34. Accordingly, I uphold the ground of opposition based on Section 12(1)(b) of the Act.

Ground of opposition based on Section 2 of the Act (distinctive character of the Mark)

35. In the decision on *Canadian Council of Professional Engineers v APA - The Engineered Wood Assn.* (2000), 7 CPR (4th) 239 (CFPI), Judge O’Keefe stated:

A purely descriptive or a deceptively misdescriptive trade-mark is necessarily not distinctive". Therefore, based on my earlier finding that the Mark is clearly descriptive, I conclude that the Mark is also not inherently adapted to distinguish the Wares of the Applicant from similar wares of others.

36. Having determined that the Mark is deceptively misdescriptive of the quality of the Wares or of the individuals who produce them within the meaning of Section 12(1)(b) of the Act, I conclude that the Mark cannot be distinctive and I therefore also uphold the ground of opposition based on the absence of distinctive character of the Mark.

Other grounds of opposition

37. The Opponent having had two different grounds of opposition upheld, I consider it unnecessary to rule on the other grounds of opposition.

Disposal

38. Given the powers delegated to me by the Registrar of Trade-marks pursuant to the provisions of Section 63(3) of the Act, I refuse the Applicant's application for registration of the Mark, the whole as per the provisions of Section 38(8) of the Act.

Jean Carrière
Member of the Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers

Appendix A

The grounds of opposition can be summarized as follows:

1. The application for registration does not satisfy the requirements of Section 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 ("Act") in that the Applicant could not and cannot deem itself convinced that it was entitled to use the Mark in Canada in association with the Wares.
2. The application for registration does not satisfy the requirements of Section 30(e) of the Act in that the Applicant, itself or through the intermediary of a licensee, does not have the intention of using the Mark in Canada;
3. The Mark is not registrable since it contravenes the provisions of Section 12(1)(b) of the Act it being clearly descriptive or deceptively misdescriptive of the quality or nature of the Wares or of the individuals who produce them. The Wares come under the category of wares specifically designed, developed, used and offered by professional engineers, specifically engineers who specialize in chemical engineering. Without limiting the general scope of the above, since the Mark includes the word 'INGÉNIRIE', which is regulated in Canada and that the design of a flask refers to chemistry and chemical engineering, it follows that:
 - a) if the members of the engineering profession in Canada are involved in producing the Wares, the Mark is clearly descriptive of both the nature and the quality of the wares and/or of the individuals who produce them;
 - b) if the members of the engineering profession in Canada are not involved in producing the Wares, the Mark is deceptively misdescriptive of both the nature and quality of the wares and/or of the individuals who produce them.
4. The Mark is not registrable pursuant to the provisions of Section 12(1)(e) of the Act since it is prohibited by Section 10 of the Act which prohibits the registration of a mark which, due to an ordinary and authentic trade practice, has become known in Canada as designating the type, value and quality of wares or services. The word 'INGÉNÉRIE' has become known as designating the type, quality and value of wares or services provided by licenced engineers and since the Applicant is not licenced in Canada to practice the profession of engineer, its use of the Mark would be misdescriptive.
5. The Mark is not distinctive within the meaning of Section 2 of the Act in that it does not distinguish the Applicant's Wares from the wares of third-parties, including other engineers in general and other entities that hold licences to exercise the profession of engineer in Canada. Furthermore, the use of the Mark could be misdescriptive in that its use could suggest that the Wares are provided, sold, leased or under licence of the Opponent or one of its members or that the Applicant is associated with or authorized by the Opponent or one of its constituent members.