

OPIC



CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 215**

**Date of Decision: 2021-09-29**

**IN THE MATTER OF AN OPPOSITION**

**Engineers Canada / Ingénieurs  
Canada**

**Opponent**

**and**

**Eureka! Institute, Inc.**

**Applicant**

**1,671,844 for INNOVATION  
ENGINEERING**

**Application**

THE RECORD

[1] On April 8, 2014, Eureka! Institute, Inc. (the Applicant) filed an application to register the trademark INNOVATION ENGINEERING (the Mark).

[2] This application covers the services set out below (the Services) and is based on the Applicant's use and registrations in the United States. Services (1) were registered in the United States on January 28, 2014 under registration No. 4,476,049. Services (2) were registered in the United States on November 4, 2008 under registration No. 3,529,059.

(1) Business consulting services in the field of creating, implementing and marketing business products and services (2) Educational services, namely,

licensed entrepreneurship classes to be presented by accredited colleges and universities.

[3] On January 25, 2016, Engineers Canada / Ingénieurs Canada (the Opponent) filed a statement of opposition. The grounds of opposition pleaded in the statement of opposition are based on sections 30(d), 30(i), 12(1)(b), 12(1)(e) and 2 (distinctiveness) of the *Trademarks Act*, RSC 1985, c. T-13 (Act). All references in this decision are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition which refer to the Act before it was amended.

[4] The Opponent's evidence consists of the affidavits of Stephanie Price and D. Jill Roberts. Both Ms. Price and Ms. Roberts were cross-examined. The Applicant filed, as its evidence, the affidavit of Rebecca Porter.

[5] Both parties filed written arguments and attended a hearing.

[6] For the reasons that follow, I refuse the Applicant's application.

#### SUMMARY OF EVIDENCE

[7] Ms. Roberts is a law clerk who conducted a GOOGLE search for INNOVATION ENGINEERING. The Opponent submits that Ms. Roberts' evidence is that she located a number of different businesses using INNOVATION ENGINEERING, as well as businesses using terms including INNOVATION and ENGINEERING. The Internet evidence provided in Ms. Roberts' affidavit is of little assistance to the Opponent. The contents of these websites constitute hearsay evidence. Furthermore, the mere existence of a website does not show that it was accessed by Canadians at any time [*Candrug Health Solutions Inc. v Thorkelson* 2007 FC 411, reversed 2008 FCA 100]. As a result, I am only able to infer that the websites adduced as exhibits to the Roberts affidavit existed on the date they were printed.

[8] Ms. Price is the Interim Chief Executive Officer of the Opponent. Ms. Price explains that engineering is a regulated profession in Canada, where provincial and territorial associations are responsible for the regulation of the practice of engineering. Like the professions of law, architecture and medicine, members of the engineering profession must

be licensed to practice pursuant to various provincial and territorial Engineering Acts as attached to Ms. Price's affidavit (para 10; Exhibit 2). Ms. Price also identifies the fields of business engineering and engineering economics and provides with respect to engineering economics that "engineers seek solutions to problems, and the economic viability of each potential solution is normally considered along with the technical aspects" (paras 38-42; Exhibits 14-16). Ms. Price describes the Opponent's concerns with this application (para 43):

Given that the practice of engineering encompasses a wide and ever-growing field of activities, the use of the word "engineering" within a trademark, particularly when, as is the case here, it is used in Canada in association with services that overlap with those designed, developed, offered or provided by engineers, would indicate that the person or entity providing those services [...] is a member of the engineering profession, or employs licensed members of the engineering profession.

[9] Ms. Porter is an articling student with the Applicant's agent (para 1). Ms. Porter visited the website *innovationengineering.org* and obtained printouts of this website (Exhibits 1-8) and printouts of archives of this website as of March 11, 2014 and January 14, 2016 (Exhibits 9-10). Ms. Porter also attaches a memorandum from David M Lafkas, internal patent legal counsel to Eureka! Ranch International Ltd. explaining that Innovation Engineering, LLC is licensed by Eureka! Institute, Inc. to use the trademark INNOVATION ENGINEERING (para 13, Exhibit 11).

#### LEGAL ONUS AND BURDEN OF PROOF

[10] There is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD)]. If this burden is met, the Applicant then bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act.

GROUND OF OPPOSITION BASED ON SECTION 30(D) OF THE ACT

[11] The Opponent pleads that

... the application does not comply with [section 30(d)] in that the [Mark] was not used in the United States of America with the [Services] as of the date of filing the application or at any material date and, in the alternative, if the [Mark] was in use, ... any such use has not been continuous.

[12] In *Thymes, LLC v Reitmans (Canada) Ltd*, 2013 FC 127 the Federal Court found that where an application is filed based on a registration and use in another country of the Union, an applicant must have used the trademark applied-for in the named country as of the filing date of the application (April 8, 2014, in this case).

[13] The Opponent points to excerpts from Ms. Porter's affidavit as sufficient to meet its evidential burden. The Opponent submits that the trademark INNOVATION ENGINEERING is not identified on any of the archived printouts dated March 11, 2014 of the *www.innovationengineering.org* website as a trademark or is not used as a trademark (Porter affidavit, Exhibit 9). The Opponent also submits that there is no indication that it was the Applicant using the Mark and there is another company, Innovation Engineering LLC, referenced on the screenshots of January 14, 2016.

[14] I do not find the evidence sufficient to meet the Opponent's evidential burden as it is not clearly inconsistent with, nor does it put the Applicant's claim of use in the United States in doubt [*Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at paras 33-38]. First, the printouts at Exhibit 9 of Ms. Porter's affidavit appear to be incomplete and do not show all parts of the website as it would have been displayed as of the material date. Second, since none of the Services listed in the Application are limited to being provided online, I do not infer that the uses shown in Exhibit 9 are necessarily representative of how the Applicant used the Mark at the material date in the United States [*Littlewoods L. v. Grabish*, 2013 TMOB 3, 111 CPR (4th) 438 (TMOB) at para 14]. With respect to the evidence not showing use by the Applicant, the only evidence dated around the material date, the partially archived website as of March 11, 2014, references at the bottom "©, ® & or Patentable Technology used under license from Eureka! Institute, Inc.". As such, this

evidence is not clearly inconsistent with, nor casts doubt on the Applicant's claims of use in the United States.

[15] As the Opponent has not met its evidential burden, it is unnecessary for me to find whether the Applicant's evidence is sufficient to meet its legal onus including whether the letter from Mr. Lafkas attached as Exhibit 10 to Ms. Porter's affidavit is sufficient to serve as evidence of a license from the Applicant.

[16] Accordingly, this ground of opposition is rejected.

#### GROUND OF OPPOSITION BASED ON SECTION 30(I) OF THE ACT

[17] Section 30(i) of the Act only requires the Applicant to declare that it is satisfied that it is entitled to use the Mark in Canada in association with the Services. Such a statement is included in this application. An opponent may rely on section 30(i) in specific cases such as where bad faith by the applicant is alleged [see *Sapodilla Co Ld v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)] or where there is a violation of a Federal Statute.

[18] The Opponent pleads

... the application does not comply with [section 30(i)] since use of the term "engineering" is closely regulated in Canada. Given this, the Applicant could not have been and cannot be satisfied of its entitlement to use the [Mark] in Canada in association with the [Services].

[19] The material date for this ground of opposition is the filing date of the application [*Tower Conference Management Co v Canadian Management Inc* (1990), 28 CPR (3d) 428 (TMOB)].

[20] Allegations of non-compliance with provincial statutes are not an appropriate basis for a section 30(i) ground of opposition [*Interprovincial Lottery Corp v Monetary Capital Corp, supra*; and *Lubrication Engineers, Inc v Canadian Council of Professional Engineers* (1992), 41 CPR (3d) 243 (FCA) at 244]. Thus, the provincial and territorial Engineering Acts cannot form the basis of a section 30(i) ground of opposition. As such, this ground of opposition is rejected.

GROUND OF OPPOSITION BASED ON SECTION 12(1)(B) OF THE ACT

[21] The Opponent pleads that the Mark is not registrable under section 12(1)(b) of the Act:

in that [the Mark] is clearly descriptive or deceptively misdescriptive of the character or quality of the [Services] or of the conditions of the persons employed in the provision of the [Services]. Without limiting the generality of the foregoing, in view of the fact that the applied-for trademark 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 and provision of the Services, then the [Mark] is clearly descriptive of both the character and quality of the [Services] and of the persons employed in the production and provision of the [Services];

(ii) if members of the profession of engineering in Canada are not involved in the production and provision of the [Services], then the [Mark] is deceptively misdescriptive of both the character and quality of the [Services] and of the persons employed in the production and provision of the [Services].

[22] The material date for this ground of opposition is the date of filing the application [*Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021].

[23] In deciding whether the Mark is clearly descriptive or deceptively misdescriptive, the Mark must be considered as a matter of first impression within the context of the Services [*John Labatt Ltd v Carling Breweries Ltd* (1974), 18 CPR (2d) 15 at 19 (FCTD)].

“Character” means a feature, trait or characteristic of the goods and “clearly” means “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 34 (Ex Ct)]. The prohibition regarding deceptively misdescriptive marks seeks to prevent the public from being misled [*Atlantic Promotions Inc. v Canada (Registrar of Trade-marks)* (1984), 2 CPR (3d) 183 (FCTD); *Provenzano v Canada (Registrar of Trade-marks)* (1977), 37 CPR (2d) 189 (FCTD)].

[24] Finally, in determining whether a trademark is registrable under section 12(1)(b) of the Act, the Registrar must not only consider the evidence but also apply common sense [*Neptune SA v Attorney General of Canada* (2003), 29 CPR (4th) 497 (FCTD)].

## The Opponent Meets its Evidential Burden

[25] The Opponent has met its initial evidential burden with respect to the Mark being deceptively misdescriptive. That is to say, there is sufficient evidence from which it could reasonably be concluded that the trademark INNOVATION ENGINEERING would indicate to the average consumer of the Services that there are Canadian engineers employed in their production which is at odds with the evidence that there are no professional engineers in Canada employed by the Applicant.

- (a) The engineering profession is provincially and territorially regulated and its members must be licensed to practice (Price affidavit, para 10, Exhibit 2). The provincial and territorial statutes that regulate engineering include provisions regarding the use of the designations: professional engineer; P. Eng.; engineer; and engineering (Price affidavit, para 17, Exhibit 2).
- (b) There are two engineering specialties including business engineering and engineering economics which appear to be similar to the content and goals of the Services. The subspecialties business engineering and engineering economics are described by Ms. Price:

(Para 38) Business engineering (BE) refers to the development and implementation of business solutions, from business model to business processes and organization structure to information systems and information technology. ... Business engineering combines knowledge in the fields of business administration as well as information technology and connects it to all aspects of transformation, from meaning of presentation to process models to cultural and political considerations.

(Para 41) Engineering economics, previously known as engineering economy, is a subset of economics for application to engineering projects. Engineers seek solutions to problems, and the economic viability of each potential solution is normally considered along with the technical aspects. Fundamentally, engineering economics involve formulating, estimating and evaluating the economic outcomes when alternatives to accomplish a defined purpose are available.

While Ms. Price concedes that neither business engineering or engineering economics are accredited programs (Qs 132-134), she also explains that

whereas education is very broad, people tend to practice in specific areas and gives the example that one may take civil engineering but only practice as a municipal engineer, water transportation engineer or traffic engineer (Q102).

(c) A brochure downloaded from the Innovation Engineering website (Price affidavit, para 33, Exhibit 13) includes the excerpts set out below. While this evidence is hearsay, I find it admissible since it was necessary for the Opponent to file it in support of its opposition and reliable since the Applicant, being a party, has the opportunity to refute the evidence [*Reliant Web Hostings Inc v Tensing Holding BV*, 2012 TMOB 48 at para 35]. Furthermore, while there is no evidence that this brochure was available to be viewed at the material date, it is relevant to the extent that it provides information about the Services, which I infer would be similar at the material date as the evidence is consistent with the archived printout of the Applicant's website provided by Ms. Porter at Exhibit 9 to her affidavit.

i. The brochure includes the following description of engineering:

Engineering is about applying innovation to the real world. It's about discipline, system reliability, documentation, experimentation, problem solving, and making decisions based on factual data. The Chemist studies the compositions, properties, and activity of organic and inorganic substances. The Chemical Engineer applies the Chemist's discoveries in the real world of factories and products.

ii. Three out of the four instructors whose biographies are included at page 18 of the brochure are engineers. Excerpts of the biographies are below.

1. Doug Hall – Innovation Engineering Founder

Doug is the founder and CEO of the Eureka! Ranch and the Innovation Engineering Institute. He is a hands on innovation practitioner, quantitative researcher, educator and author whose life's work in applying system thinking to innovation. He is a chemical engineer by education who rose to the rank of Master Marketing Inventor at Procter & Gamble – inventing and



shipping a record nine innovations in 12 months by applying system thinking to innovation strategy and execution. ...

2. James Beaupre, Ph. D. - Academic Lead

James holds a PhD in Chemical Engineering. He leads course design and relationships with proliferation of Innovation Engineering among higher education across the US and the world. He helped plot the Innovation Engineering curriculum and continues to advocate and for the academic community. ...

3. Brad Hall – Assistant Brand Manager of Education and Graduate Student

Brad graduated with a degree in Civil Engineering and minors in Innovation Engineering and Math from the University of Maine. He leads the development and refinement of the instructor feedback system and helps with curriculum design ...

- iii. “What is Innovation Engineering?” on page 23 of Exhibit 13 which includes the following:

Innovation Engineering is a reliable methodology to Define, Discover, Develop and Deliver new ways to address a business situation (incremental and short term Core projects or disruptive, longer term Leap projects.)

It is a systematic approach to align strategy, create innovative ideas, persuasively communicate ideas, rapidly test ideas with quantitative research, patent ideas and take the idea to market with increased speed and decreased risk. ...

- (d) The Applicant is not licensed or registered to engage in the practice of engineering by any of province or territory, nor do any professional engineers list the Applicant as his or her employer (Price affidavit, para 45, Exhibit 17).

**The Applicant Fails to Meet its Legal Onus**

[26] The Applicant submits that the trademark is not deceptively misdescriptive and points to the following.

- (a) The Opponent has failed to show that INNOVATION ENGINEERING is a recognized occupation or profession.
- (b) That the word ENGINEERING has many meanings.
- (c) That it does not seek registration in association with sophisticated technical services of a nature which one might expect to be provided by a professional engineer.
- (d) That ENGINEERING does not so dominate the Mark as to preclude it from registration.

**It is not Determinative that INNOVATION ENGINEERING is not a Specialty**

[27] The Applicant submits that the Opponent has not proven that INNOVATION ENGINEERING was a recognized occupation or profession (Applicant’s written submissions, para 80). This, however, is not a requirement. In *Canadian Council of Professional Engineers v John Brooks Co.* (2004), 35 CPR (4th) 507 (FCTD) [*Brooks*], the Federal Court considered that the trademark BROOKS BROOKS SPRAY ENGINEERING, offended the provisions of section 12(1)(b) as it was deceptively misdescriptive with the services “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” even though “spray engineering” was not a recognized field of specialty. The Federal Court found so on the basis that the words spray engineering “connote a range of sophisticated technical services related to fluid handling and distribution” and there was a connection with the kinds of services one might expect an engineer to provide.

**The word ENGINEERING has many meanings**

[28] In addition to being used to describe the work done or the occupation of an engineer, the word “engineering” is also used more generally to refer to “the application of science for directly useful purposes, as construction, propulsion, communication, or manufacture” or

“the action of working artfully to bring something about” [*Canadian Oxford Dictionary*, (2d) 2005 excerpt at Price affidavit, Exhibit 8]. In her cross-examination, Ms. Price explains that for something to be part of the practice of engineering it must involve the application of engineering principles and have an impact on public welfare, broadly stated (Exhibit 4, Question 59). Given, however, the technical nature of the Services discussed below, I find that it is as likely as not that an average consumer would find the meaning of ENGINEERING in the Mark to signal or be connected to the occupation of engineering.

### **Services are of a Technical Nature**

[29] The Applicant submits that it does not seek registration in association with sophisticated technical services of a nature which one might expect to be provided by a professional engineer (Applicant’s written representations, para 26). In this case, the Mark relates to services that are provided by engineers, albeit not engineers who appear to be registered or licensed to practice in Canada (Price affidavit, para 45, Exhibit 17). Further, I find the Services to be of the type that consumers may expect to have an engineer employed in the production of given that the INNOVATION ENGINEERING system is described as “The Scientific System for Growing a Culture of Never Ending Innovation that Increases Innovation Speed (up to 6X) & Decreases Risk (30-80%)” [Porter affidavit, Exhibit 9] and that the Applicant founded INNOVATION ENGINEERING as a study blending engineering discipline, business strategy and the psychology of change [Price affidavit, Exhibit 12]. I distinguish the Services in this case from the type of services in the *Engineers Canada v Bryant*, 2016 TMOB 177 case where the Registrar found that the trademark LET NICK ENGINEER YOUR NEXT MOVE alluded to the skillful arranging of real estate services as opposed to the types of services provided by professional engineers.

### **ENGINEERING Dominates the Mark**

[30] The Applicant submits that ENGINEERING does not dominate the Mark such that it is precluded from registration [*Brooks, supra* at para 21.] I disagree and find that the word “ENGINEERING” so dominates the Mark. The word “INNOVATION” is primarily a descriptive term when considered in the context of the educational and consulting services

relating to a “scientific system for profitable growth” as seen in the printouts of the Applicant’s website (Porter affidavit, Exhibit 9):

Innovation Engineering transforms innovation from a random art into a reliable scientific system for profitable growth.

...

Engineering mindset generates quantitative results. A [missing text] the Innovation Engineering system have created and [missing text] over \$4.1 Billion worth of ideas ...]

### **Conclusion on this Ground of Opposition**

[31] In view of the above, the Applicant has failed to meet its legal onus of proving that the Mark is not deceptively misdescriptive. The Applicant has not demonstrated that as a matter of common sense and first impression the average consumer viewing the trademark INNOVATION ENGINEERING in association with the Services would not be likely to infer that the word “ENGINEERING” indicates that the person or entity employed in the production of the Services is a member of the engineering profession in Canada. Accordingly, the section 12(1)(b) ground of opposition succeeds.

[32] As an aside, if I am incorrect in finding the Mark deceptively misdescriptive as engineers (albeit not engineers registered to practice in Canada) are employed in the production of the Services, I would have found the Mark clearly descriptive for similar reasons as in *Continental Teves AG & Co. v. Canadian Council of Professional Engineers*, 2013 FC 801 at paras 52-53. In this case, the Federal Court found that the average consumer of goods sold in association with the trademark ENGINEERING EXCELLENCE IS OUR HERITAGE would believe that professional engineers were involved in the production of the goods, albeit not licensed Canadian engineers.

### GROUND OF OPPOSITION BASED ON SECTION 12(1)(E) OF THE ACT – SECTION 10 OF THE ACT

[33] The material date for this ground of opposition is the date of the Registrar’s decision [*Canadian Olympic Assn v Olympus Optical Co* (1991), 38 CPR (3d) 1 (FCA)].

[34] The Opponent alleges that the Mark is prohibited contrary to section 10 of the Act because the word “engineering” has become recognized as designating the kind, quality and

value of the goods and services provided by licensed engineers. However, section 12(1)(e) deals with an assessment of the mark as a whole. Thus, even if the Opponent was successful in establishing that “engineering” had become so recognized, this would not be sufficient to find that the Mark as a whole violates section 10 of the Act.

[35] Accordingly, the ground of opposition based on section 12(1)(e) of the Act is rejected.

#### DISTINCTIVENESS GROUND OF OPPOSITION

[36] There are two prongs to the distinctiveness ground of opposition which is plead as follows:

... [The Mark] does not distinguish nor is it adapted to distinguish nor is it capable of distinguishing the [Services] from the services of others, including professionals and entities that 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 [Services] are produced, provided, sold, leased, or licensed by the Opponent or its engineering regulators or that the Applicant is associated with or authorized by the Opponent or its engineering regulators...

... [The Mark] is not distinctive within the meaning of Section 2 in that the [Mark] is comprised of a commonly, used, English dictionary word INNOVATION and the word ENGINEERING, the combination of which is not distinctive and unregistrable that does not distinguish, nor is it adapted to distinguish the [Services].

[37] The material date for a ground of opposition based on lack of distinctiveness of a trademark is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)].

[38] For the purpose of this decision, I only need to address the first prong of this ground of opposition. It has been held that a trademark found to be clearly descriptive or deceptively misdescriptive of the character or quality of the goods or services is necessarily non-distinctive and cannot serve to distinguish those goods or services from the goods or services of others [*Canadian Council of Professional Engineers v APA - The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD)]. As I have found that this trademark is deceptively misdescriptive, and there is no evidence at the material date for this ground of opposition which would result in a different conclusion, this ground of opposition succeeds.

DISPOSITION

[39] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

---

Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

---

**HEARING DATE** 2021-05-10

**APPEARANCES**

Adele J. Finlayson

FOR THE OPPONENT

Monique M. Couture

FOR THE APPLICANT

**AGENTS OF RECORD**

Macera & Jarzyna LLP

FOR THE OPPONENT

Gowling WLG (Canada) LLP

FOR THE APPLICANT