



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 088

Date of Decision: 2023-05-30

IN THE MATTER OF AN OPPOSITION

Opponent: Engineers Canada/Ingénieurs Canada

Applicant: Kokuyo Co., Ltd.

Application: 1884969 for KOKUYO ING

INTRODUCTION

[1] Engineers Canada/Ingénieurs Canada (the Opponent) opposes registration of the trademark KOKUYO ING (the Mark), which is the subject of application No. 1884969 by Kokuyo Co., Ltd. (the Applicant).

[2] The Mark is applied for on the basis of proposed use in association with the goods “Office chairs” in Nice class 20.

[3] The opposition is essentially premised on the Opponent’s allegation that the ING element of the Mark would be perceived by consumers as referring to professional engineers in that the French word *ingénieur* (engineer) is abbreviated as “ing.” in that language.

THE RECORD

[4] The application for the Mark was filed on February 26, 2018. The application was advertised for opposition purposes on February 5, 2020.

[5] On March 18, 2020, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act. The grounds of opposition are based on non-compliance with section 38(2)(e) of the Act; non-registrability under sections 12(1)(b) and 12(1)(e) of the Act; non-distinctiveness under section 2 of the Act; non-entitlement to use under section 38(2)(f) of the Act; and bad faith under section 38(2)(a.1) of the Act.

[6] The Applicant filed a counter statement on July 9, 2020.

[7] Both parties filed evidence which is summarized below.

[8] Only the Opponent submitted written representations and was represented at a hearing.

[9] The hearing was conducted concurrently with respect to the opposition proceedings for application Nos. 1906157 (for the trademark ING KOYUYO ING 360° GLIDING CHAIR Design) and 1906158 (for the trademark KOKUYO ING 360° GLIDING CHAIR ING Design). A separate decision will issue in respect of those proceedings.

SUMMARY OF THE OPPONENT'S EVIDENCE

[10] In support of its opposition, the Opponent submitted the following evidence:

- Affidavit of Gerard McDonald, affirmed on November 2, 2022 in Ottawa (the First McDonald Affidavit);
- Affidavit of D. Jill Roberts, sworn on November 8, 2020 in Ottawa (the First Roberts Affidavit);
- Affidavit of Evelyn Spence, affirmed on November 12, 2020 in Ottawa (the Spence Affidavit);

- Second affidavit of D. Jill Roberts, sworn on September 30, 2021 (the Second Roberts Affidavit), submitted as reply evidence; and
- Second affidavit of Gerard McDonald, affirmed on September 13, 2022 (the Second McDonald Affidavit), submitted as leave evidence.

[11] None of the affiants were cross-examined.

[12] The Opponent's evidence is voluminous and therefore, while I have considered it in its entirety, the summary below focuses on those portions most pertinent in assessing the grounds of opposition and the Opponent's representations.

First McDonald Affidavit

[13] Mr. McDonald is a civil engineer and the Chief Executive Officer of the Opponent [para 1].

[14] The Opponent is the national, non-profit organization that services and supports twelve provincial and territorial associations responsible for regulating the practice of engineering in Canada (the Regulators). These Regulators act to regulate every aspect of the engineering profession in each of Canada's provinces and territories, including the licensing of 300,000 members of the engineering profession in Canada [paras 6 and 7]. Each of the Regulators has been established under a statute of its provincial or territorial legislature and serves as the licensing authority for engineers within its jurisdiction [para 8]. A list of these statutes is attached as Exhibit 2 to the affidavit.

[15] According to Mr. McDonald, "use of terms that identify the engineering profession such as ing. and P.Eng. are restricted by law" and "no person or company can use any title, designation or abbreviation in a manner that will lead to the belief that the person is permitted to engage in the practice of professional engineering in Canada, if that person or company is not properly licensed or authorized to do so" [para 47]. Mr. McDonald identifies the legislative sources of such restrictions as being the provincial statutes listed at Exhibit 2 to his affidavit, as well as the provincial and federal statutes relating to business and corporate names listed at Exhibit 13 to his affidavit [paras 43 to 48].

[16] At paragraphs 23 to 33 of his affidavit, Mr. McDonald describes the “broad scope of engineering”, stating that engineering is “the discipline that links scientific discoveries with the practical application of those discoveries to meet the needs of society and to improve quality of life” [para 23]. He explains that there are many branches of engineering and that each branch has many sub-disciplines and specialized sub-branches focused on specific technologies, products, subject matter or industries [para 24]. At paragraphs 65 to 74 of his affidavit, Mr. McDonald further describes the nature of many of these disciplines of engineering, including references to specific courses available on these subjects at Canadian universities.

[17] Mr. McDonald states that the professional designation “ing.” refers to the *permis d’ingénieur* (engineer’s permit) issued by the regulator in the province of Québec: the *Ordre des ingénieurs du Québec* (OIQ). According to Mr. McDonald, engineers use the title “ing.” after their name to indicate to the public that they are licensed to practice engineering in Quebec [para 75].

[18] Since at least as early as September 2019, the OIQ has used the logo reproduced below in association with its activities. OIQ displays the logo on its website, its magazine and social media, including Facebook, Instagram and Twitter [paras 76 to 79].



[19] Mr. McDonald states that each of the Regulators maintains a register of persons and/or entities entitled to engage in the practice of engineering within their jurisdiction. He attaches certified confirmations from some of the identified provincial Regulators that the Applicant is not licensed or registered to engage in the practice of engineering and that the Applicant does not employ any engineers licensed to practice engineering in those provinces [paras 80 to 82, Exhibit 25]. Mr. McDonald explains that, due to business disruptions as a result of the COVID-19 pandemic, the Opponent was not able

to obtain confirmations from certain provincial Regulators, namely those in the provinces of Ontario, Quebec, Alberta and British Columbia [para 83].

Spence Affidavit and Second McDonald Affidavit

[20] The Spence Affidavit and the Second McDonald Affidavit attach the four confirmations absent from the First McDonald Affidavit in uncertified and certified form, respectively.

First Roberts Affidavit

[21] Ms. Roberts is a law clerk [para 1]. She attaches to her affidavit various documents and webpage excerpts from websites she visited between August and November 2020 [paras 2 to 19, Exhibits 1 to 18].

[22] The exhibits include: results from a search of the online membership directory of the regulator in the province of New Brunswick [Exhibit 1]; documents and screen captures from the OIQ's website and social media pages [Exhibits 2 to 7]; excerpts from the Canadian Intellectual Property Office (CIPO)'s patent database showing patents filed by the Applicant [Exhibit 8]; printouts from what appear to be the Applicant's websites, *kokuyo.com* and *kokuyo-furniture.com* [Exhibits 9 and 10]; and printouts from Canadian university websites showing engineering course descriptions [Exhibits 11 to 17].

Second Roberts Affidavit

[23] Submitted as reply evidence, Ms. Roberts' second affidavit primarily consists of excerpts from third-party webpages referencing ING Bank of Canada and ING Robotic Aviation Inc. [paras 2 to 6, Exhibits A to E]. Ms. Roberts also provides a copy of a trademark examiner's report regarding the subject application, in which the examiner requested a translation "into English or French of all words in any other language that are contained" in the Mark, together with the Applicant's response stating that, "to the Applicant's knowledge, the term 'KOKUYO' has no dictionary meaning in any language" [para 7, Exhibit F].

SUMMARY OF THE APPLICANT'S EVIDENCE

[24] In support of its application, the Applicant filed the affidavit of P. Claire Gordon, sworn on March 17, 2021 in Ottawa (the Gordon Affidavit). Ms. Gordon was not cross-examined.

Gordon Affidavit

[25] Ms. Gordon is a law clerk employed by the Applicant's trademark agent. She attaches to her affidavit excerpts from websites she visited and dictionaries she consulted in March 2021.

[26] In particular, she provides results from a Canada411 search for KOKUYO and results from Google searches for the terms KOKUYO and ING [Exhibits A to C]; excerpts from dictionaries showing pages for words starting with the prefix "ing" [Exhibits D and G]; excerpts from grammar guides pertaining to abbreviations [Exhibits E and F]; excerpts from third-party websites referencing the Applicant [Exhibits H to N]; a printout of a result page for a search conducted in CIPO's trademarks register showing application No. 1860028 for the trademark GLIDING CHAIR ING [Exhibit O]; and excerpts from what appear to be the Applicant's websites, *kokuyo-furniture.com* and *kokuyo-shop.com* [Exhibits P and Q].

EVIDENTIAL BURDEN AND LEGAL ONUS

[27] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[28] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal

onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

ANALYSIS OF THE GROUNDS OF OPPOSITION

[29] As preamble to the specific grounds of opposition as set out in the statement of opposition, the Opponent pleads the following:

- The Opponent is a federation of the statutory provincial and territorial engineering Regulators.
- Engineering is a regulated profession in Canada. Statutes enacted by the legislatures of every province and territory regulate who is qualified to practice engineering within their respective jurisdiction. In order to qualify to practice engineering in Canada, an individual must meet very stringent educational and professional standards and hold a professional engineering license. These individuals are identified by the professional designations ING. in French and P.ENG. in English.
- Individuals may only call themselves a professional engineer or *ingénieur* and use the designation ING., if they possess a license issued by the Regulator of the province or territory in which they reside. The use of the designation ING. is regulated by provincial and territorial statutes of each respective province and territory. (Attached as Schedule A to the statement of opposition is a “list of these statutes and the relevant section numbers”).
- No person or corporation, including the Applicant, is permitted to represent, expressly or by implication, that they are entitled to engage in the practice of engineering or are licensed members of the engineering profession, in any jurisdiction in Canada unless they are, in fact, licensed to practice engineering within that jurisdiction.

- There is also business legislation, both federal and provincial that restricts the use of professional titles in a name. (Included in Schedule A to the statement of opposition is “a sampling of these statutes and the relevant section numbers”).
- The applied-for goods fall within the type of goods designed and provided by professional engineers including “manufacturing engineers, industrial engineers, systems engineers, industrial systems engineers, human factors engineers, ergonomics engineers”.
- To the knowledge of the Opponent, the Applicant is not itself registered to practice engineering in any jurisdiction in Canada, nor does the Applicant employ professional engineers licensed in any jurisdiction in Canada to engage in the practice of engineering or in the provision of the applied-for goods.
- Persons or companies not qualified to engage in the practice of engineering within a given province or territory, but implying (through the use of an engineering designation in their name, title or trademark that they are so qualified) pose a threat to public safety and welfare.

Not Using and Did Not Propose to Use - section 38(2)(e)

[30] The Opponent pleads that the application does not comply with section 38(2)(e) of the Act in that, at the filing date of the application, the Applicant was not using and did not propose to use the Mark in Canada in association with the applied-for goods (“Office chairs”).

[31] The material date for this ground of opposition is the filing date of the application.

[32] I first note that, as the pleaded ground merely mirrors the language of section 38(2)(e) of the Act, it is insufficiently pleaded. Pleading that an applicant was not using the subject trademark may be sufficient with respect to the first aspect of this ground. However, with respect to the second aspect, it is not sufficient to merely plead that an applicant did not propose to use such trademark. Instead, an opponent must

allege specific facts with respect to how or why the applicant did not, or could not, propose to use that trademark in Canada.

[33] In its written representations, the Opponent submits that there is no evidence showing use of the Mark in Canada in association with any product, and argues that the Applicant uses “ing” alone when describing its products, such as in references to the “ing effect”. The Opponent also points to the Applicant’s above-referenced co-pending applications for design marks in which the term ING is displayed in larger font than other elements, and to examples in the Applicant’s evidence where one of those design marks is displayed [Opponent’s written representations at paras 71 to 73, referencing the Gordon Affidavit at Exhibits H and P].

[34] Although not explicitly articulated as such, it would appear that the Opponent’s position is that the Applicant somehow has no intention of using the applied-for Mark, but rather intends only to use some variation of the Mark, perhaps where the KOKUYO element is either minimized or absent.

[35] In my view, with the aforementioned amendments to the Act, this kind of speculation regarding an applicant’s intent is not within the scope of section 38(2)(e) of the Act. Where an applicant applies for a trademark but purportedly has no intention of using that trademark (e.g., trademark “squatting”), this is more appropriately pled as a bad faith ground. Where an applicant applies for a trademark that it has not used, pursuant to section 30(1) of the Act, that applicant proposes to use the trademark. In this case, as noted above, while the subject application was filed prior to the amendments to the Act, it was filed on the basis of proposed use. As such, I accept that the Applicant proposed to use the Mark as of the filing date of the application. Nothing in the evidence indicates that the Applicant was unable to propose to do so.

[36] In view of the foregoing, at a minimum, I find that the Opponent has not met its initial evidential burden under this ground.

[37] Accordingly, the ground based on section 38(2)(e) of the Act is rejected.

Non-registrability - section 12(1)(b)

[38] Pursuant to section 38(2)(b) of the Act, the Opponent pleads that the application does not comply with section 12(1)(b) of the Act in that the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the applied-for goods, or of the conditions of or the persons employed in their production. In this respect, the Opponent further pleads that, in view of the fact that the Mark includes the term ING which is regulated in Canada, it follows that: i) if members of the profession of engineering in Canada are involved in the production of the applied-for goods, then the Mark is clearly descriptive of both the character and quality of the goods and the conditions of or the persons employed in their production; and/or ii) if members of the profession of engineering in Canada are not involved in the production of the applied-for goods, then the Mark is deceptively misdescriptive of both the character and quality of the goods and the conditions of or the persons employed in their production.

[39] The material date for assessing this ground of opposition is the filing date of the application.

[40] Section 12(1)(b) of the Act states as follows:

12(1) Subject to subsection (2), a trademark is registrable if it is not ...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.

[41] The purpose of the prohibition in section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD)].

[42] The issue as to whether a trademark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated goods. "Character" means a feature, trait or characteristic of the goods and "clearly" means easy to understand, self-evident or plain [*Drackett Co of Canada v*

American Home Products Corp, 2 Ex CR 89, 1968 CanLII 1288 (Ex Ct)]. The trademark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (FCTD) at 27; *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD) at 186; *Biofert Manufacturing Inc v Agrisol Manufacturing Inc*, 2020 FC 379 at para 183]. In other words, the trademark must not be considered in isolation, but rather in its full context in conjunction with the subject goods [*Ontario Teachers' Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60]. Finally, one must apply common sense in making the determination about descriptiveness [*Neptune SA v Canada (Attorney General)*, 2003 FCT 715 (FCTD)].

[43] The purpose of the prohibition with respect to deceptively misdescriptive trademarks is to prevent the public from being misled [*Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD); and *Provenzano v Canada (Registrar of Trademarks)* (1977), 37 CPR (2d) 189 (FCTD)]. Indeed, for a trademark to be considered deceptively misdescriptive, the trademark must mislead the public as to the character or quality of the goods. The trademark must therefore be found to be clearly descriptive before it can be found to be misdescriptive [*Oshawa Group Ltd v Canada (Registrar of Trade Marks)* (1980), 46 CPR (2d) 145 (FCTD)].

[44] The Federal Court of Appeal provided a summary of the governing principles to be applied when assessing whether a trademark is clearly descriptive, including the following points [*Ontario Teachers' Pension Plan Board, supra* at para 29]:

- the test is one of first impression in the mind of a normal or reasonable person. If such a person is unclear or uncertain as to the significance of the trademark in relation to the goods or services or if the trademark is suggestive of a meaning other than one describing the goods or services, then the word is not clearly descriptive;
- one should not arrive at a determination of the issue by critically analyzing the words of the trademark, but rather by attempting to ascertain the immediate

impression created by it in association with the goods or services with which it is used or proposed to be used; and

- the word “clearly” found in paragraph 12(1)(b) of the Act is there to convey the idea that it must be self-evident, plain or manifest, that the trademark is descriptive of the goods or services.

[45] At paragraphs 94 to 122 of its written representations, the Opponent argues that various factors would lead the public to conclude that the Applicant’s products are produced by engineers, including:

- the Applicant’s fields of business are known to be occupied by engineers and the applied-for goods (“Office chairs”) fall within the scope of goods which would normally be produced by professional engineers;
- the Applicant “advertises the technical aspects of its chair” [para 112] and emphasizes the ING element when it displays the Mark;
- engineering is known in Canada as a profession due to the longstanding existence of accredited university engineering programs;
- consumers recognize the words “engineer”, “engineering”, and the French words “ingénieur” and “ingénierie”, as related to the work performed by professional engineers; and
- the ING element of the Mark is “immediately” recognizable as being the abbreviation for the French word “ingénieur”.

[46] In support, the Opponent refers to evidence relating to Canadian university programs in the field of engineering and to statements made by Mr. McDonald regarding the Applicant’s products falling within the scope of goods that are produced by professional engineers practicing in some of those fields [First McDonald Affidavit at paras 59 to 63, 71 and 72; First Roberts Affidavit at paras 12 to 18, Exhibits 11 to 17].

[47] The Opponent also refers to patents filed in the name of the Applicant for ergonomic chairs, as well as exhibited webpages which describe the more technical aspects of the gliding mechanism of the Applicant’s chairs [First Roberts Affidavit at Exhibits 8 and 9].

[48] In addition, the Opponent points to an evidenced survey which indicates that 55% of persons surveyed defined the word “engineer” as a professional designation [First McDonald Affidavit at para 22, Exhibit 7], and to exhibits showing the name of individuals followed by the designation “ing.”, such as an excerpt from the directory of professional engineers licensed in New Brunswick, and publications of the regulator OIQ [First Roberts Affidavit at Exhibits 1 to 4].

[49] At the hearing, the Opponent also directed attention to the dictionary excerpts in the Applicant’s own evidence to point out that “ing-” is a prefix in the English and French languages which often relates to the notions of “ingenuity” and “engineering” (e.g., “ingenious”, “ingénieur”, “ingénierie”, “ingéniosité”) [Gordon Affidavit at Exhibits D and G]. The Opponent argued that where the ING element is visually emphasized, as reflected in some of the evidence, a consumer would be that much more likely to associate the Mark with engineering and engineers.

[50] In my view, the Opponent’s position rests on presumptions about the meaning and perception of the ING element, which are not supported by the evidence or common sense. The Opponent relies heavily on the recognition of the word “engineer” as a professional designation and the common usage of the abbreviation “ing.” by professional engineers as a professional designation. However, the Mark does not include the word engineer and is not composed of an individual’s name followed by the abbreviation “ing.”.

[51] As such, in view of the evidence as a whole, I am not persuaded that the Opponent has met its initial evidential burden under this ground. That being said, even if I were to accept that the Opponent has discharged its burden, I am satisfied that the Applicant meets its legal onus of demonstrating on a balance of probabilities that the Mark is not clearly descriptive of the character or quality of the applied-for goods, or of the conditions of or the persons employed in their production.

[52] In this respect, it should be noted that the evidence reflects that the abbreviation of the professional title is not simply “ing”, but “ing.” with a period. Indeed, according to the grammar guides evidenced by the Applicant, abbreviations are typically followed by

a period [Gordon Affidavit at Exhibits E and F]. As such, the absence of a period in the Mark is a mental hurdle in determining the significance and meaning of the ING element within the context of the Mark as a whole. Moreover, regarding such meaning and significance, I note that the survey relied upon by the Opponent does not appear to have been conducted in respect of *abbreviations* used to designate professional engineers, including the abbreviation “ing.”.

[53] It appears more likely that consumers would perceive the ING element as any of: a coined word; an acronym, initialism or abbreviation for another word; or as the common English suffix “-ing”. With respect to the latter, the Mark may simply be interpreted as an informal conversion of a noun into a verb (also known as denominalization), similar to the way that searching with Google is sometimes referred to as “Google-ing”.

[54] With respect to the opposition cases cited by the Opponent in its written representations [at para 106], I note that none of the trademarks at issue contained the abbreviation “ing.”, or the term ING. In those cases, the trademarks comprised at least one of the words “engineer”, “engineered”, or “engineering”, or the French “*ingénierie*” or “*génie*”, which all have dictionary meanings. As such, those cases are distinguishable, if only on the basis that the ideas conveyed by the trademarks in those cases were self-evident, plain and manifest, requiring less mental processing than an apparent abbreviation (or acronym/initialism), and of ING in particular.

[55] I further note that trademarks comprising unabbreviated engineering-related words have not necessarily been found to be clearly descriptive or deceptively misdescriptive in other opposition cases. For example, in *Canadian Council of Professional Engineers v APA - The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD) [*Engineered Wood*], the Federal Court held that the proposed trademark THE ENGINEERED WOOD ASSOCIATION was not deceptively misdescriptive of the persons engaged in the production of the applied-for laminated wood products, wood included products, and related services (see also *Canadian Council of Professional Engineers v Kelly Properties Inc*, 2010 TMOB 224, aff'd 2013 FCA 287; *Canadian*

Council of Professional Engineers v COMSOL AB, 2011 TMOB 3; and *Engineers Canada v Mmi-Ipco, LLC*, 2014 TMOB 119).

[56] Having regard to all of the foregoing, while professional engineers may well be involved in the design or development of office chairs, I do not find that, as a matter of first impression upon seeing the Mark in association with the applied-for goods, an average consumer would perceive the Mark as indicating that a professional engineer was involved in producing such goods.

[57] In my view, in order to arrive at such a conclusion, a consumer would have to resort to the sort of “mental gymnastics” contemplated by the Federal Court in *GWG Ltd v Canada (Registrar of Trade Marks)* (1981), 55 CPR (2d) 1 (FCTD). Indeed, the consumer would be required to (i) identify the ING element as an abbreviation; (ii) identify such as an abbreviation for the French word “ingénieur” in particular; and (iii) speculate that the presence of this term means that a professional engineer was somehow involved in the chair’s production. I do not consider that such a meaning is “easy to understand, self-evident or plain”.

[58] As I am not satisfied that, on a balance of probabilities, the Mark is clearly descriptive, it follows that I am also not satisfied that it is or would be deceptively misdescriptive.

[59] In view of all of the foregoing, the ground based on section 12(1)(b) of the Act is rejected.

Non-registrability - sections 12(1)(e) and 9(1)(n)(iii)

[60] Pursuant to section 38(2)(b) of the Act, the Opponent pleads that the Mark is not registrable as it contravenes section 12(1)(e) of the Act by being a sign or combination of signs whose adoption is prohibited by section 9(1)(n)(iii) of the Act. In particular, the Opponent pleads that the Applicant has adopted in connection with a business, as a trademark or otherwise, a mark consisting of or so nearly resembling as to be likely to be mistaken for the Opponent’s official mark “ING.” (No. 0903675).

[61] Section 9(1)(n)(iii) of the Act states as follows:

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

(n) any badge, crest, emblem or mark... (iii) adopted and used by any public authority, in Canada as an official mark for goods or services, in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use; ...

[62] The material date for assessing whether a trademark is registrable under section 12(1)(e) is the date of this decision.

[63] I have exercised my discretion and confirmed that the official mark “ING.” is extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. As such, the Opponent meets its initial burden.

[64] I must therefore determine whether or not the Mark consists of, or so nearly resembles as to be likely to be mistaken for, the official mark. In this regard, the Federal Court of Appeal has confirmed that the words “consists of” mean “identical to” [*Big Sisters Assn of Ontario v Big Brothers of Canada* (1997), 75 CPR (3d) 177 (FCTD); aff’d (1999), 86 CPR (3d) 504 (FCA)].

[65] Due to the presence of the element KOKUYO, as well as the absence of a period after the ING element, it is clear that the Mark does not consist of (*i.e.* is not identical to) the Opponent’s official mark “ING.”. As a result, I must still assess whether the Mark so *nearly resembles* the official mark as to be likely to be mistaken for it.

[66] The Federal Court has indicated that whether a trademark is likely to be mistaken for an official mark is not a test of straight comparison, but rather one of resemblance and imperfect recollection [*Chartered Professional Accountants of Ontario v American Institute of Certified Public Accountants*, 2021 FC 35 at para 31]. In that case, the Federal Court dismissed an appeal of the Registrar’s decision finding that THIS WAY TO CPA did not so nearly resemble the official mark CPA as to be likely mistaken for it.

[67] The scope of protection to be given official marks was canvassed by the Federal Court in *Engineered Wood* [*supra* at paras 66 to 71]. The appellant in that case (the

Opponent in this proceeding) contended that the adoption of a trademark containing an official mark in any form was prohibited by section 9 of the Act. Notably, while discussing and ultimately rejecting this argument, the Court considered the official mark “ING.” as a particular example and found it “inconceivable” that Parliament intended to give such wide ambit of protection to official marks as follows:

69 ... 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.

70 This interpretation maintains the great ambit of protection afforded to official marks, but stops short of conferring an absurdly great ambit of protection for official marks which Parliament cannot reasonably be taken to have contemplated. It is inconceivable that Parliament intended to give such wide ambit of protection to official marks through the enactment of section 9 of the Act. Were the proposition of the appellant correct and any mark that contained, in some form, the official mark could not subsequently be adopted and would be unregistrable, it would be the case that the use of “ING.” would be prohibited. Consider that no one could use the term “shopping.com”, or any other mark ending in “ING”, followed by “.com”. It is not reasonable to state that such marks are prohibited. Such is a logical extension of the appellant’s argument and results in an unreasonably vast monopoly and scope of protection. Such is not the intent of the protection for official marks.

[68] Consistent with this guidance, I do not consider the Mark to so nearly resemble the official mark so as to be likely to be mistaken for it, given the presence of the distinctive element KOKUYO and the absence of a period following the ING element (to indicate it as an abbreviation like the official mark).

[69] Accordingly, the ground of opposition based on sections 12(1)(e) and 9(1)(n)(iii) is rejected.

Non-registrability - sections 12(1)(e) and 10

[70] Pursuant to section 38(2)(b) of the Act, the Opponent pleads that the Mark is not registrable as it contravenes section 12(1)(e) by being a sign or combination of signs whose adoption is prohibited by section 10 of the Act. In this respect, the Opponent further pleads as follows:

The professional designation ING. by ordinary and *bona fide* commercial usage has become recognized in Canada as designating the kind, quality and value of goods and services provided by licensed professional engineers. As the Applicant is not licensed to engage in the practice of engineering in Canada, its use of the [Mark] would likely be misleading.

[71] As indicated above, the material date for assessing whether a trademark is registrable under section 12(1)(e) is the date of this decision.

[72] Section 10 of the Act states as follows:

If any sign or combination of signs has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any goods or services, no person shall adopt it as a trademark in association with the goods or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any sign or combination of signs so nearly resembling that sign or combination as to be likely to be mistaken for it.

[73] In the present case, the Opponent does not allege that the Mark as a whole has become a recognized sign in Canada which designates the kind, quality or value of any goods or services, nor is there evidence to support such a finding. Instead, the ground as pleaded alleges that the Mark would be likely to mislead because the “professional designation ING.” has become recognized as designating the kind, quality and value of goods and services provided by licensed professional engineers.

[74] At paragraphs 123 to 129 of its written representations, the Opponent reiterates its position that the public perceives “ING.” as a term identifying engineers; that use of the abbreviation “ing.” is restricted to the engineering profession; that this restriction is codified in provincial legislation; that Regulators in each province “take action against persons and entities that misuse these titles”; and that the Opponent educates the public about the role of engineers.

[75] In my view, there are many reasons why this ground must fail, including:

- it is not clear that this ground of opposition is valid or sufficiently pleaded because, in contrast to section 12(1)(b) of the Act, section 10 of the Act does not

include language or prohibitions relating to “persons employed in their production” *per se*;

- it is not clear that the Opponent has discharged its evidential burden because there is no evidence that “ING.” has been used to designate the kind, quality and/or value of goods generally, or of office chairs in particular, such that ING. has become “recognized” within the meaning of section 10; and
- similar to the analyses above with respect to the section 12(1)(b) and section 9(1)(n)(iii) grounds, the Mark is not likely to be perceived by consumers as indicating that a professional engineer was involved in producing the subject goods, nor does the Mark so nearly resemble the designation “ING.” as to be likely mistaken for it.

[76] Overall, even if I were to accept that the Opponent has met its evidential burden, I find that the Applicant satisfies its legal onus.

[77] Accordingly, the ground of opposition based on sections 12(1)(e) and 10 of the Act is rejected.

Non-distinctiveness - section 2

[78] Pursuant to section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act in that it does not distinguish nor is it adapted to distinguish the goods of the Applicant from the goods of others, including professional engineers using the designations ING. or P.ENG., holders of engineering licenses, and entities that are authorized to practice engineering in Canada. The Opponent further pleads that, “in addition”, any use by the Applicant of the Mark would be misleading because such use suggests that the goods of the Applicant are produced, provided, sold, leased, or licensed by individuals and companies licensed to practice engineering in Canada, or that the Applicant is authorized by the Regulators to practice engineering.

[79] The material date for this ground is the date of filing of the statement of opposition.

[80] Section 2 of the Act defines “distinctive” in relation to trademarks as follows:

“distinctive” in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them.

[81] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *AstraZeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[82] As pleaded, it is not clear to me how the Opponent would meet its initial burden under this ground or that it is even a proper ground. The Opponent’s representations are unhelpful in this respect, in that such representations focus only on the purported non-distinctiveness of “ING.” and the ING element of the Mark. In this respect, the Opponent submits that the designation ING. is not inherently adapted to distinguish the engineering goods and services of one business from those of others because the designation represents the entire class of professional engineers. Furthermore, as it did under other grounds, the Opponent argues that the Applicant’s goods fall within recognized fields of engineering, that the ING element of the Mark references engineers, and that display of such “misrepresents to the public that the Applicant is authorized to practice engineering in Canada when it is not” [Opponent’s written representations at paras 135 to 146].

[83] In any event, none of the evidence indicates that the Mark *considered in its entirety* would not distinguish the Applicant’s goods from those of others. At a minimum, the Mark includes the distinctive element KOKUYO.

[84] With respect to the “in addition” portion of the pleading, namely that use of the Mark would be “misleading”, I do not consider such to be relevant to or a valid basis for a non-distinctiveness ground. That being said, to the extent that this portion is essentially a variation of the deceptively misdescriptive aspect of the Opponent’s section 12(1)(b) pleading, it shares the same outcome in this case [for a similar approach and conclusion, see *Canadian Council of Professional Engineers v COMSOL*

AB, 2011 TMOB 3; see also *Canadian Council of Professional Engineers v John Brooks Co*, 2004 FC 586 at para 24].

[85] In view of all of the foregoing, even if I were to accept that the Opponent has met its evidential burden, the Applicant satisfies its legal onus under this ground.

[86] Accordingly, the non-distinctiveness ground of opposition is rejected.

Non-entitlement to use - section 38(2)(f)

[87] Pursuant to section 38(2)(f) of the Act, the Opponent pleads that the Applicant was not entitled to use the Mark in Canada in association with the applied-for goods because: (i) the professional designation ING. is regulated in Canada such that only qualified individuals may use that term and to the knowledge of the Opponent, neither the Applicant nor its employees are qualified; and (ii) there is provincial and federal business legislation that prohibits the use of professional designations by those that are not qualified.

[88] The relied-upon statutes and their pertinent section numbers are listed in Schedule A to the statement of opposition. The statutes are divided in two groups: first, provincial legislation identified as relating to the governance of professions; and second, provincial and federal legislation identified as relating to the governance of corporations.

[89] Section 38(2)(f) of the Act states as follows:

38(2) A statement of opposition may be based on any of the following grounds: ...

(f) that, at the filing date of the application in Canada, ... the applicant was not entitled to use the trademark in Canada in association with those goods or services.

[90] Thus, the material date for this ground is the filing date of the application.

[91] I first note that the Opponent pleads that “the professional designation ING. *is* closely regulated in Canada” and that there “*is* provincial and federal business legislation that prohibits the use of professional designations” (emphasis added).

However, in view of the material date under this ground, alleged prohibitions on the use

of ING. must have been in force at the filing date of the application. As the Opponent has neither clearly pleaded nor provided the statutory provisions that were in force at that time, it is also not clear whether this ground is properly pleaded. Indeed, it is incumbent on an opponent to clearly plead and/or evidence any relied-upon statutory provisions as of the applicable material date under this ground and it is not an appropriate exercise of the Registrar's discretion to conduct research to identify such provisions.

[92] In any event, I further note that provincial legislation likely cannot form the basis of a ground under section 38(2)(f) of the Act. Even if provincial legislation *prima facie* negated an applicant's entitlement to use a particular trademark, such prohibition would only apply to that particular province, and not across Canada. Moreover, it is well-established that it is not for the Registrar to decide if the adoption and/or use of a trademark contravenes provincial legislation regulating the use of a professional designation [see, for example, *Canadian Council of Professional Engineers v Lubrication Engineers* (1992), 68 CPR (4th) 228 (FCA)].

[93] Although not in evidence, the Opponent does submit the specific text of the federal legislation it relies upon under this ground, namely section 12(1)(a) of the *Canada Business Corporations Act* (CBCA) and section 26(c) of the *Canada Business Corporations Regulations* [Opponent's written representations at paras 78 and 80]. The text, as submitted by the Opponent, is reproduced below:

Canada Business Corporations Act, section 12(1)(a)

12.(1) A corporation shall not... carry on business under or identify itself by a name
(a) that is, as prescribed, prohibited or deceptively misdescriptive.

Canada Business Corporations Regulations, section 26(c)

26. For the purpose of section 12(1)(a) of the [CBCA], a corporate name is prohibited if it connotes that the corporation... (c) is sponsored or controlled by or is connected with a university or an association of accountants, architects, engineers, lawyers, physicians or surgeons or another professional association recognized by the laws of Canada or a province, unless the appropriate university or professional association consents in writing to the use of the name.

[94] I note that, on their face, the relied-upon provisions appear to relate to corporate names, not trademarks. While a corporate name can function as trademark and vice versa, to the extent a given trademark can be used in a manner other than as a corporate name, it is not clear how these provisions can be the *prima facie* basis for a ground based on section 38(2)(f) of the Act.

[95] In any event, even if any actual use of the Mark were somehow in violation of the CBCA, no such determination was made as of the material date, such that it could be said that the Applicant was not entitled to use the Mark more generally, especially given the broad definitions of use as set out in section 4 of the Act. By way of example only, it is not clear how these provisions of the CBCA would apply where the Applicant uses the Mark in a manner consistent with section 4(3) of the Act relating to use of a trademark for exported goods.

[96] Ultimately, section 38(2)(f) of the Act is not a speculative ground. In this case, the relied-upon provisions clearly do not constitute a *prima facie* prohibition of use of the Mark or of any trademark. Even if a court of competent jurisdiction had adjudicated the Applicant's use of the Mark with regards to these provisions of the CBCA and its regulations prior to the material date, it would be the disposition of that court that would inform whether the Applicant was not entitled to use the Mark as of the material date.

[97] In view of all of the foregoing, at a minimum, I find that the Opponent has not met its initial burden under this ground.

[98] Accordingly, the ground of opposition based on section 38(2)(f) of the Act is rejected.

Bad faith - section 38(2)(a.1)

[99] Pursuant to section 38(2)(a.1) of the Act, the Opponent pleads that the application was filed in bad faith since use of the term ING. is regulated in Canada and the Applicant knew, or ought to have known, that the Mark is deceptive and misleading in jurisdictions where it cannot practice engineering.

[100] The material date for assessing a bad faith ground is the filing date of the application, though later evidence may also be relevant where it helps to clarify the reason for filing the application [*Beijing Judian Restaurant Co Ltd v Meng*, 2022 FC 743 at para 38; *Pentastar Transport Ltd v FCA US LLC*, 2020 FC 367 at para 98].

[101] In its written representations, the Opponent submits that, because ING. is a designation that is reserved for licensed professional engineers, the adoption of ING as a “dominant feature” of a trademark is not “acceptable commercial behaviour” [Opponent’s written representations at paras 89 and 90, citing United Kingdom jurisprudence *Re CKL Holdings NV’s TM App’n no UK00003146477*, Case No O/036/18 (Dec 18, 2017) and *Red Bull GmbH v Sun Mark Ltd*, [2012] EWHC 1929 (Ch)].

[102] I note that it is at best not clear whether a bad faith ground can be premised on an allegation that an applicant “ought to have known”. I also note that regardless of whether ING is considered to be the “dominant” element of the Mark, this ground rests on the Opponent’s allegations that the Mark is deceptive and misleading. As such, in view of my conclusions above, to the extent that this ground has bases similar to those of the previously-disposed grounds, the Opponent has not met its evidential burden.

[103] In any event, the Opponent has furnished no evidence of bad faith on the part of the Applicant in this case. For example, there is no evidence that the Applicant knew or believed that the adoption of ING was prohibited in Canada.

[104] In view of all of the foregoing, at a minimum, the Opponent has not met its evidential burden under this ground.

[105] Accordingly, the bad faith ground of opposition based on section 38(2)(a.1) of the Act is rejected.

DISPOSITION

[106] Pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I reject the opposition.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-02-23

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