



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 105

Date of Decision: 2024-05-31

IN THE MATTER OF AN OPPOSITION

Opponent: Engineers Canada/Ingénieurs Canada

Applicant: Group Lotus Limited

Application: 1896156 for LOTUS ENGINEERING

INTRODUCTION

[1] Group Lotus Limited (the Applicant) has filed application No. 1,896,156 (the Application) to register the trademark LOTUS ENGINEERING (the Mark) in association with the following statement of goods and services as reproduced below, together with the associated Nice classes (CI):

Goods:

CI 12 (1) Vehicles, namely automobiles; land vehicles, namely automobiles and structural fittings therefor.

Services:

CI 42 (1) Engineering services, namely automobile-engineering services; vehicle engineering services, namely automobile-engineering services; vehicle and engine design services; advisory services relating to vehicle noise reduction; design of land vehicle parts; design of land vehicles; design of tooling for the production of land vehicle parts;

consulting in the field of development of vehicles; inspection of motor vehicles for roadworthiness; design of internal combustion engines for land vehicles.

[2] Engineers Canada/Ingénieurs Canada (the Opponent) has opposed the Application on a number of grounds, most of which revolve around the Applicant's use of the term "ENGINEERING" in the Application for the Mark.

[3] For the reasons that follow, I refuse the Application.

THE RECORD

[4] The Application for the Mark was filed on April 27, 2018 and it was advertised for opposition purposes in the *Trademarks Journal* of August 19, 2020.

[5] On October 9, 2020, the Opponent filed a statement of opposition against the Application under section 38 of the *Trademarks Act*, RSC 1985, c T-13 as amended June 17, 2019 (the Act). The grounds of opposition raised were based on bad faith pursuant to section 38(2)(a.1) of the Act; non-registrability pursuant to sections 12(1)(b) and 12(1)(e) of the Act; non-distinctiveness pursuant to section 2 of the Act; that the Applicant was not using and did not propose to use the Mark pursuant to section 38(2)(e) of the Act; and non-entitlement to use pursuant to section 38(2)(f) of the Act.

[6] The Applicant filed and served its counter statement on February 25, 2021, denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed the following:

- The affidavit of Gerard McDonald, sworn June 16, 2021, together with Exhibits 1 through 25;
- The affidavit of D. Jill Roberts, sworn June 21, 2021, together with Exhibits 1 through 36; and

- The affidavit of Evelyn Spence, sworn June 10, 2021, together with Exhibit 1.

[8] In support of its Application, the Applicant filed the affidavit of Akiv Jhirad, sworn on February 18, 2022, together with Exhibits 1 through 95-C.

[9] In reply, the Opponent filed a second affidavit of Gerard McDonald, sworn August 10, 2022 (the Second McDonald Affidavit), and a second affidavit of D. Jill Roberts, sworn August 15, 2022 (the Second Roberts Affidavit). The Opponent was subsequently granted leave to file a third affidavit of Gerard McDonald, sworn September 13, 2022 (the Third McDonald Affidavit).

[10] None of the parties' affiants were cross-examined.

[11] Both parties filed written representations and attended a hearing.

[12] At the hearing the Opponent withdrew the grounds of opposition based on sections 38(2)(f), 38(2)(a.1), and 38(2)(b)/12(1)(e) of the Act. Consequently, the following decision will solely consider the remaining grounds of opposition, namely, sections 38(2)(b)/12(1)(b), 38(2)(d)/2, and 38(2)(e) of the Act.

THE EVIDENCE

The Opponent's Evidence

The First McDonald Affidavit

[13] Mr. McDonald is a civil engineer and the Chief Executive Officer of the Opponent (paras 1 and 2).

[14] The Opponent is the national non-profit organization that serves and supports twelve provincial and territorial associations responsible for regulating the practice of engineering in Canada (the Regulators). The

Regulators regulate the engineering profession in Canada in each of Canada's provinces and territories, including the licensing of the 300,000 members of the engineering profession in Canada. Each Regulator has been established under an Act of its provincial or territorial legislature and serves as its licensing authority for engineers within its jurisdiction. A list of these statutes is attached under Exhibit 2 to Mr. McDonald's affidavit (the Engineering Statutes). Each of the Regulators are the only members of the Opponent, who together with the Opponent work to advance the engineering profession in the public interest of Canadians (paras 6 to 11).

[15] At paragraphs 23 to 33 of his affidavit, Mr. McDonald describes the "broad scope of engineering", indicating that there are many branches of engineering and that each branch has sub-disciplines and specialized sub-branches focused on specific technologies, products, methods of manufacturing, subject matter or industries. Further, Mr. McDonald describes the nature of many of the various branches of engineering, including providing tables listing specific courses available for each branch of engineering at Canadian universities (paras 64 to 77). Mr. McDonald indicates that as of 2018, there were 278 engineering programs accredited by the Canadian Engineering Accreditation Board, offered through 44 engineering institutions (para 30).

[16] In addition, Mr. McDonald notes that Employment and Social Development Canada (ESDC) provides an online classification of occupations in Canada called the National Occupational Classification (NOC) (para 31). He states that based on the content of the NOC and his own experience and research, he estimates that there are hundreds of engineering sub-disciplines or specialities within the engineering profession. He attaches copies of the Index of Titles from the NOC 2011 and NOC 2016 as it pertains to the keyword "engineer" (Exhibits 8 and 9). On the Opponent's website,

the Opponent has cross-referenced the NOC codes for various engineering disciplines with accredited programs offered in Canada (Exhibit 10).

[17] According to Mr. McDonald, the “use of the terms that identify the engineering profession such as “engineer” and “engineering” and “P.Eng” are restricted by law”, and generally, “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. Further, he attests that, in Canada, an “engineer” is an individual who has been issued a license to practice engineering by a Regulator after demonstrating that they have the requisite education, skills, knowledge, and experience. He explains that an unlicensed individual with an engineering education (whether obtained in Canada or another country) may do engineering work, but only if his or her work is supervised by a licensed engineer who oversees the work and takes responsibility for it. With respect to such legislative restrictions, he provides a table that identifies the specific sections of each provincial and territorial Engineering Statute, as well as a listing of the provincial and federal statutes relating to business and corporate names at Exhibit 13 of his affidavit (paras 43 to 48).

[18] Mr. McDonald attests that in 2016, the Opponent commissioned a national public opinion survey to assess the general public’s perception of professional engineers. He states that the survey report, conducted by Innovative Research Group, indicates that 55% of the persons surveyed defined the word “engineer” as a professional designation (para 22, Exhibit 7).

[19] Mr. McDonald explains that the broad spectrum of work carried out by engineers can result in significant negative or even catastrophic consequences, if carried out by unqualified persons (para 34). He provides

historical examples in Canada in this regard (paras 35 and 49, Exhibits 11 and 14).

[20] Mr. McDonald visited the Applicant's websites at *www.lotuscars.com* and *www.lotusengineering.com* and provides excerpts from those sites. Upon examining the contents of those sites and the Application for the Mark, Mr. McDonald concludes that the Applicant's goods and services fall within the scope of goods and services that would be designed, produced and provided by or under the supervision of professional engineers (paras 57 to 63).

[21] Lastly, Mr. McDonald attests that each of the Regulators maintains a register of persons and/or entities entitled to engage in the practice of engineering within their jurisdiction and provides certificates in this regard (paras 82 and 83). He attaches certified confirmations from some of the identified provincial and territorial 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 jurisdictions (paras 84 and 85, Exhibit 24). 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 and Quebec (para 86).

The First Roberts Affidavit

[22] Ms. Roberts is a law clerk (para 1).

[23] Ms. Roberts visited a number of websites between October 2020 and June 2021. She describes such online research and attaches to her affidavit various documents, screen captures, and webpage excerpts obtained from her visits to such websites, including:

- The results from searches of membership directories of the Regulators (for Alberta, Manitoba, New Brunswick, Nova Scotia, and Yukon) for companies that are authorized by these Regulators to practice engineering and that have “engineering” in their company name (paras 2-7, Exhibits 1-6);
- Excerpts from Canadian Yellow Pages directories for the cities of Calgary, Vancouver, and Halifax, dated between 2015 to 2017, of “Engineers” listings (para 8, Exhibit 7);
- Printouts from a variety of Canadian university websites engineering programs (including automotive engineering programs) and academic calendars, including archived calendars dating back to 2015 (paras 8-18, and 35, Exhibits 8-17, and 33-34);
- Screen captures of webpages from *www.lotuscars.com* and *www.lotusengineering.com* (paras 19-21, Exhibits 18-20);
- Printouts from the Canadian Intellectual Property Office’s online patent database showing patents filed by the Applicant (para 22, Exhibit 21);
- Printouts from the results of various online searches (Canada411, Google.ca) for the name Lotus, and for the word “Lotus” for businesses (in Ottawa and Ontario) (paras 23-25, Exhibits 22-24);
- Screen captures of webpages of Ontario businesses that include/incorporate “Lotus” in their business name, including the LinkedIn profile page and the Ontario Regulator’s online membership directory listing for the founder of one such business (paras 26-29, Exhibits 25-28);

- Printouts of the results of a search for the word LOTUS on the Government of Canada Federal Corporation search page (para 30, Exhibit 29);
- A printout of the home page of the website of LOTUS STEM (www.lotusstem.org), and a copy of the Federal Corporation Information page for this company from the Government of Canada Federal Corporation search page (para 31, Exhibit 30);
- Archived articles and publications dating back to 2005, concerning automotive engineering (from McMaster University, wheels.ca, and the Globe & Mail GlobeCampus websites) (paras 32-34, Exhibits 31-33);
- A printout of US trademark registration number 5830602, for LOTUS ENGINEERING obtained from the USPTO website (para 36, Exhibit 35); and
- Excerpts from The Canadian Oxford Dictionary for the definition of the word "lotus" (para 37, Exhibit 36).

The Spence Affidavit

[24] Ms. Spence is Legal Counsel and Corporate Secretary of the Opponent (para 1).

[25] Ms. Spence attests that each of the Regulators maintains a Register of persons and/or entities entitled to engage in the practice of engineering within their jurisdiction (para 5).

[26] Ms. Spence attests that she requested certified confirmation from the Ontario and Quebec Regulators, as to whether the Applicant holds a Permit to Practice or Certificate of Authorization, as applicable, to engage in the

practice of engineering in Canada. The request also included whether any professional engineer licensed within their respective jurisdictions has listed the Applicant as his/her employer (para 6). She attaches, as Exhibit 1 to her affidavit, the responses that she received to these requests. Both responses indicated that the Applicant does not currently (and did not prior to April 27, 2018 in Ontario) hold such a Permit to Practice or Certificate of Authorization (as applicable), and that no holder of a license in these jurisdictions has identified the Applicant as their employer.

The Applicant's Evidence

The Jhirad Affidavit

[27] Mr. Jhirad is an articling student with the agent for the Applicant (para 1). Between February 16 and 17, 2022, he conducted a variety of online searches. He attaches to his affidavit excerpts from the websites he visited and dictionaries that he consulted in the course of his research.

[28] In particular, he provides the following:

- dictionary definitions for "ENGINEER" and "ENGINEERING" from *dictionary.com* (Exhibits 1 and 2);
- printouts of webpages from the Applicant's website at *www.lotusengineering.com* (Exhibits 3 to 11) and *www.lotuscars.com* (Exhibit 12);
- printouts of a variety of online articles (including from Radio Canada, BNN Bloomberg, *AutoTrader.ca*, The Globe and Mail and more) featuring the Applicant and its cars, some of its UK-based engineering directors/executives, and profiles of several of the Applicant's UK-based engineering directors/executives on LinkedIn (Exhibits 13 to 18, 26 to 30, 32 to 34, and 68 to 83);

- printouts of Wikipedia entries for “Lotus Cars”, “Jacques Villeneuve”, and 1967-2015 Canadian Grand Prix car racing results (Exhibits 19, 31, 36 to 67);
- printouts of webpages of various dealerships located in Canada that sell Lotus cars (Exhibits 20 to 25);
- printouts from the Canadian Trademarks Database of registered trademarks owned by the Applicant that include the term LOTUS (Exhibits 84-A and 84-B);
- printouts from the Canadian Trademarks Database of registered trademarks owned by non-Canadian entities that include the terms “ENGINEER” (1 result), “ENGINEERS” (6 results), “ENGINEERED” (65 results), and “ENGINEERING” (21 results) (Exhibits 85 to 88);
- printouts of search results on *www.amazon.ca* for books using the keyword “LOTUS ENGINEERING”, and for books published since 2017 that contain the words “ENGINEERING” or “ENGINEER” in the title (Exhibits 89-A to 91);
- printouts of search results on *www.chapters.indigo.ca* for English-language books using the keyword “ENGINEER” (Exhibit 92);
- printouts of search results on *www.yellowpages.ca* for businesses located in Canada using the keywords “ENGINEER” and “ENGINEERING” (Exhibits 93 and 94); and
- printouts of LinkedIn profiles of the Applicant, including its “Jobs” section using the search term “engineer” (Exhibits 95-A, 95-B, and 95-C).

The Opponent's Reply Evidence

The Second McDonald Affidavit

[29] Mr. McDonald's second affidavit is in reply to the state of the register evidence located in Mr. Jhirad's affidavit at Exhibits 85 through 88. That is, the printouts of registered trademarks identified as owned by non-Canadian entities that include the terms "ENGINEER", "ENGINEERS", "ENGINEERED", and "ENGINEERING".

[30] Mr. McDonald explains that the Opponent typically consents to trademark applications where:

- a) The applicant is authorized to engage in the practice of engineering in at least one jurisdiction in Canada, and/or the applicant employs individuals who are licensed to engage in the practice of engineering in at least one jurisdiction in Canada;
- b) The applicant is a publisher of magazines, periodicals, or journals directed toward members of the engineering profession; or
- c) The applicant is an organization of, or benefits members of, the engineering profession.

[31] Mr. McDonald then details all of the instances of trademarks located by Mr. Jhirad in his above-noted state of the register search results for trademarks including the terms ENGINEER, ENGINEERS, and ENGINEERING, wherein the trademark met one of these criteria, or was for some other reason not considered to be of concern or not relevant (*e.g.* was not for goods or services that the public would think emanate from professional engineers, was solely in respect of a design, or was registered in 1955 prior to the Opponent monitoring and opposing such marks). Following

Mr. McDonald's explanations, there remains but three unaddressed trademark registrations that include the term ENGINEERING.

[32] As for the term ENGINEERED, Mr. McDonald states that the Opponent does not generally oppose trademarks consisting of, or containing, this word, but has in some cases sought summary expungement of such trademarks. He provides a list and attaches particulars (Exhibit B) of four such trademarks that he states have recently been expunged.

The Second Roberts Affidavit

[33] On July 19, 2022, Ms. Roberts visited several of the Canadian car dealership websites that had been visited by Mr. Jhirad, to which pages were appended to his affidavit (Exhibits 20 to 25 of the Jhirad affidavit). She further examined various sections of these websites and provides screen captures in this regard under Exhibits 1 through 4 of her own affidavit.

[34] In addition, and also on July 19, 2022, Ms. Roberts once again accessed the USPTO trademarks database online and conducted a search for the term Lotus Engineering. She attaches as Exhibit 5 to her affidavit, a printout of US trademark registration number 5830602, for LOTUS ENGINEERING, owned by Group Lotus Limited PLC.

The Opponent's Leave Evidence

The Third McDonald Affidavit

[35] Mr. McDonald's third affidavit provides certified copies of the letters from the Ontario and Quebec Engineering Regulators (Exhibit 1) that were initially and originally attached as evidence under the Spence affidavit.

EVIDENTIAL BURDEN AND LEGAL ONUS

[36] 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.

[37] 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.

ASSESSMENT OF THE GROUNDS OF OPPOSITION

[38] As a 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 Regulators.
- Engineering is a regulated profession in Canada and the Engineering Regulators (through associated Engineering Statutes) regulate who is qualified to carry on the practice of engineering within their respective jurisdiction. In order to qualify to practice engineering in Canada, an individual and/or a company must meet very stringent educational and professional standards.
- The use of the term ENGINEERING is also regulated by provincial and territorial statutes. 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 in that jurisdiction. (Attached as Schedule A to the statement of opposition is a "list of these statutes and the relevant section numbers")

- 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 and services in the Application fall within the types of goods and services provided by professional engineers including, but not limited to, the goods and services provided by vehicle engineers, automotive engineers, and consulting engineers. Vehicle and automotive engineering incorporate elements of mechanical, electrical, electronic, software and safety engineering.
- 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.

Section 12(1)(b) Ground of Opposition

[39] The Opponent pleads that the Application does not comply with section 12(1)(b) of the Act, in that the Mark, whether depicted, written or sounded, is clearly descriptive or deceptively misdescriptive of the character or quality of the goods and services in association with which it is proposed to be used, or of the conditions of or the persons employed in their production. The Opponent pleads that in view of the fact that the Mark 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 of the goods and services, then the Mark is clearly descriptive of both the character and quality of the goods and services and of the persons employed in their production;
- ii. If members of the profession of engineering in Canada are not involved in the production of the goods and services, then the Mark is deceptively misdescriptive of both the character and the quality of the goods and services and of the persons employed in their production;

[40] The Opponent further pleads that the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the goods and services or of the persons employed in their production as the word LOTUS before the word ENGINEERING results in a trademark that consumers would perceive as denoting an engineering firm that employs professional engineers.

[41] The material date to assess this ground of opposition is the Application's filing date, namely, April 27, 2018 [*Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021, 28 CPR (4th) 60].

[42] The word "clearly" in section 12(1)(b) means "easy to understand, self-evident or plain"; the word "character" means "a feature, trait, or characteristic of the product" [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 23 (Ex Ct)]. In determining whether a trademark is clearly descriptive, 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, from the point of view of the average consumer or user of the associated goods or services [see *Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (FCTD)]. In this respect, 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)].

[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 CarswellNat 831 (FCTD) 2 CPR (3d) 183; and *Provenzano v Canada (Registrar of Trademarks)*, 1977 CarswellNat 676 (FCTD)].

[44] For a trademark to be "deceptively" misdescriptive, it must mislead the public as to the character or quality of the associated goods or services [*Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD)]. The descriptive character of the trademark must go to the material composition of the goods or services or refer to an obvious intrinsic quality or characteristic of the goods or services [*ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056; *Provenzano v Registrar of Trade-marks* (1977), 37 CPR (2d) 189 (FCTD), *aff'd* (1978) 40 CPR (2d) 288 (FCA)].

[45] Whether a trademark is "deceptively misdescriptive" must be considered from the point of view of the average purchaser of the associated goods or services. The issue is to be decided by considering the trademark in its entirety as a matter of immediate impression in light of the associated goods or services [see *Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD); and *Ontario Teachers' Pension Plan Board v Canada (Attorney General)*, 2012 FCA 60]. In making the determination, again, the Registrar must not only consider the evidence but also apply common sense in the assessment of the facts [*Neptune SA, supra*].

[46] The proper test to be applied is whether the deceptively misdescriptive words "so dominate the applied for trade-mark as a whole such that ... the

trade-mark would thereby be precluded from registration” [see *Canadian Council of Professional Engineers v John Brooks Co*, 2004 FC 586, 35 CPR (4th) 507 at para 21 (FCTD); *Chocosuisse Union des Fabricants – Suisses de Chocolate v Hiram Walker & Sons Ltd* (1983), 77 CPR (2d) 246 (TMOB); and *Lake Ontario Cement Ltd v Registrar of Trade-marks* (1976), 31 CPR (2d) 103 (FCTD)]

[47] If only part of a trademark is objectionable, the trademark as a whole may still be registrable provided that the objectionable part does not so dominate the applied-for trademark as a whole such that the trademark would thereby be precluded from registration [see *Canadian Council of Professional Engineers v John Brooks Co* (2004), 2004 FC 586, 35 CPR (4th) 507 (FCTD)].

Is the Mark clearly descriptive of the character and quality of the goods and services or of the persons employed in their production?

[48] The Opponent submits that “engineering” in the context of the Applicant’s goods and services clearly conveys the meaning of work done by licensed engineers. The Opponent submits that, as a whole, the Mark clearly describes to the public that Lotus Engineering is an engineering firm/company offering engineering services to the public. In support, the Opponent refers to evidence lead by Mr. McDonald and Ms. Roberts with respect to:

- engineering job titles from the Canadian government’s NOC, the Canadian government’s definitions of various fields of engineering, and accredited Canadian university programs, which he asserts show that the Applicant’s applied-for goods and services (and as shown on the Applicant’s website excerpts), fall squarely within the field of automotive engineering and other fields of engineering (including

mechanical; electrical; industrial, manufacturing and safety; software; and consulting engineering);

- the word “engineering”, being a word that is regulated across Canada in every province and territory by the Regulators serving as licensing authorities for engineers within their respective jurisdictions;
- various Canadian patents owned by Group Lotus Limited and Group Lotus PLC for their innovation in technical aspects of automotive design which the Opponent asserts indicates that their products are indeed technical and specialized such that one would expect engineers to be involved; and
- survey results indicating that 55% of persons surveyed defined the word “engineer” as a professional designation;

[49] The Opponent submits that consumers expect that the Applicant’s goods and services are provided by licensed engineers, particularly in view of the importance of safety and technical expertise in automotive engineering [citing *Engineers Canada/Ingénieurs Canada v Burtoni*, 2014 TMOB 174, 127 CPR (4th) 378 at para 47].

[50] The Opponent references a number of precedents to assert that the words “engineer” and “engineering” have taken on a clear meaning in relation to the work performed by professional engineers [see *Canadian Council of Professional Engineers v John Brooks Co*, 2004 FC 586, 35 CPR (4th) 507 at paras 19-20; *Canadian Council of Professional Engineers v Oyj* (2008), 68 CPR (4th) 228 at paras 28-29 (TMOB); *Burtoni, supra*; *Engineers Canada/Ingénieurs Canada v Financière Westrand*, 2014 TMOB 14 at para 33; *Engineers Canada/Ingénieurs Canada v REM Chemicals Inc*, 2014 FC 644, 125 CPR (4th) 245 at para 61(e); *Engineers Canada/Ingénieurs Canada v Affinia International Inc.*, 2015 TMOB 8, 132 CPR (4th) 129 at paras 28-

29; *Engineers Canada/Ingénieurs Canada v Eureka! Institute, Inc*, 2021 TMOB 2015 at paras 25 and 31; and *Engineers Canada/Ingénieurs Canada v ThyssenKrupp AG*, 2022 TMOB 118 at paras 24 and 29].

[51] The Applicant submits that the Mark, *in its entirety*, is self-evidently not descriptive, and therefore cannot be “clearly descriptive” of the character and quality of the goods and services or of the persons employed in their production. In particular, the Applicant submits that the Mark incorporates the Applicant’s registered and ‘famous’ trademark LOTUS, which it asserts is part of a broader family of registered LOTUS-formative trademarks (referring to the numerous articles and publications attached to the Jhirad affidavit regarding the Applicant, its LOTUS automobiles, and Canadian Grand Prix results between 1967 and 2015).

[52] Indeed, it is the trademark *as a whole* that must be considered, and in doing so, it is clear that the word LOTUS is not descriptive of the Applicant’s goods and services. Thus, while I accept that the Opponent has met its initial burden under this ground, the Mark as a whole cannot be said to be clearly descriptive.

Is the Mark deceptively misdescriptive of the character and quality of the goods and services or of the persons employed in their production?

[53] The Opponent submits that as the Applicant is not licensed to practice engineering in Canada and does not employ any Canadian licensed professional engineers to design and produce its proposed goods, the use of the word “Engineering” in LOTUS ENGINEERING is misleading and makes the Mark as a whole deceptively misdescriptive.

[54] Noting the test regarding deceptively misdescriptive marks, the Opponent submits that the word “Engineering” dominates the Mark, particularly in the context of the Applicant’s goods and services being in the

field of automotive engineering. The Opponent further submits that when ENGINEERING is coupled with the word LOTUS, this gives the impression of an engineering business. The Opponent submits that the evidence indeed shows that the Applicant manufactures and designs cars and employs foreign engineers at its offices outside of Canada. Further, the Opponent notes that the Applicant indicates in its Application that it has offered “Engineering services, namely automobile engineering services; vehicle engineering services, namely automobile engineering services” in association with the Mark for nearly 30 years in Canada. The Opponent submits that one would expect that engineering services offered within Canadian borders would be performed by licensed Canadian engineers as required by law.

[55] Moreover, the Opponent submits that the Federal Court has held:

The very fact that the term “engineering” is closely regulated has implications here. Most people would assume that businesses using that word in their name offer engineering services and employ professional engineers, unless the context clearly indicated otherwise” [*John Brooks, supra*].

[56] The Applicant submits that with respect to the Opponent’s allegation that the Mark is deceptively misdescriptive, this ground of opposition is comprised of two questions: (1) are the applied-for goods and services one that a typical consumer may expect to involve licensed Canadian engineers; and, if yes, (2) does “engineering” so dominate the Mark to render it deceptively misdescriptive and thus unregistrable.

[57] To begin with, the Applicant submits that the term “engineering” has numerous definitions, well beyond being restricted to services performed by licensed Canadian engineers.

[58] The Opponent, however, correctly notes that it must be considered what the word “engineering” would mean to the average consumer, as a

matter of first impression upon seeing the Mark as a whole within the context of the specific goods/services with which it is associated.

[59] In the present case, as in many of the cases cited by the Opponent [*Brooks, supra*; *Oyj, supra*; *Burtoni, supra*; *Westrand, supra*, etc], ample evidence has been provided by the Opponent that the term “engineering” is closely regulated, and that automotive engineering is a recognized field of engineering in Canada. Furthermore, as the Mark is applied for use in association with goods and services that clearly fall within the realm of automotive engineering, I am of the view that consumers would expect such goods/services to be provided by professional engineers.

[60] The Applicant has made a number of submissions with respect to the state of the register evidence filed under the Jhirad affidavit. However, I am satisfied that the evidence brought forth in the Opponent’s reply evidence (the Second McDonald Affidavit) dispels any concerns of a pattern of usage of terms such as “engineer” or “engineering” that would support the Applicant’s position.

[61] The Applicant submits that, in any event, the Mark as a whole cannot be deceptively misdescriptive, as LOTUS is the dominant part of the Mark. In this regard, the Applicant submits that “engineering” is a common and generic word that is not inherently distinctive. Further, the Applicant submits that its registered trademark LOTUS, which appears at the beginning of the Mark and which it states is exclusive to the Applicant, is the most dominant and striking portion of the Mark. It likens the present case to that found in *Canadian Council of Professional Engineers v COMSOL AB*, 2011 TMOB 3, for the trademark COMSOL ENGINEERING, where it was held that the first word COMSOL was distinctive and dominated the mark, such that the mark as a whole could not be found to be deceptively misdescriptive. The facts of that case are distinguishable however, in that it was concluded that the goods in

question in that case were intended for use by engineers and that the target audience of those goods would not be misled into thinking that a Canadian professional engineer was employed in the production of those goods.

[62] The Applicant further submits that LOTUS is particularly striking considering that (1) it is a famous brand for luxury and racing automobiles; (2) it is part of an existing family of registered marks owned by the Applicant in association with automobiles; and (3) in contrast, there is widespread use of ENGINEERS, ENGINEERED and ENGINEERING by others, making “engineering” common, inherently weak and a relatively minor aspect of the mark.

[63] I disagree, whether or not I take into account the Opponent’s criticisms of the Applicant’s evidence of its reputation for LOTUS. As was held in *Brooks, supra*, at para 21, the test for deceptive misdescriptiveness does not state that the offensive part of the trademark must be the dominant element, but rather,

[...] so dominate the applied for trade mark as a whole such that . . . the trade mark would thereby be precluded from registration . . .”: *Chocosuisse Union des Fabricants - Suisses de Chocolate v. Hiram Walker & Sons Ltd.*, (1983), 77 C.P.R. (2d) 246 (T.M.O.B.), citing *Lake Ontario Cement Ltd. v. Registrar of Trade Marks* (1976), 31 C.P.R. (2d) 103.

[64] In my view, the presence of the term “engineering” in the Mark is evident, obvious, and so dominates the Mark, particularly in context with the applied-for goods and services. Accordingly, in applying common sense to the facts of the present case, the Mark as a whole on first impression, would lead consumers to think that the associated goods and services are provided by professional engineers. However, there is no evidence that professional engineers are employed in the production of the Applicant’s goods and services. Thus, the Mark is deceptively misdescriptive of persons employed in the production of the applied for goods and services.

[65] Consequently, the ground of opposition based on section 12(1)(b) of the Act is successful.

Section 2 Ground of Opposition

[66] The Opponent pleads that the Mark is not distinctive within the meaning of section 2 of the Act, since:

- i. It does not distinguish nor is it adapted to distinguish the goods and services of the Applicant as described in the Application from the goods and services of others, including licensed engineers, engineering firms and entities that are licensed or authorized to practice engineering in Canada;
- ii. It is descriptive or misleading in that the use of the Mark by the Applicant suggests that the goods and services of the Applicant are produced, provided, sold, leased, or licensed by individuals or a company licensed and authorized to practice engineering in Canada, or that the Applicant is associated with or authorized by the Opponent or the Engineering Regulators.

[67] A trademark that is clearly descriptive or deceptively misdescriptive is necessarily not distinctive [*Canadian Council of Professional Engineers v APA - The Engineered Wood* (2000), 7 CPR (4th) 239 (FCTD) at 253, 2000 CanLII 15543 (FC)].

[68] As I have already found the Mark to be deceptively misdescriptive as of April 27, 2018 and there is no reason for me to conclude otherwise as of the filing date of the statement of opposition (namely, October 9, 2020), the non-distinctiveness ground of opposition is also successful. Consequently, I need not consider the first prong of the non-distinctiveness ground of opposition as noted above.

Section 38(2)(e) Ground of Opposition

[69] As I have already found in the Opponent's favour with respect to its grounds of opposition under sections 12(1)(b) and 2, I will refrain from addressing this remaining ground of opposition.

DISPOSITION

[70] Having regard to the aforementioned, 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.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-01-24

APPEARANCES

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