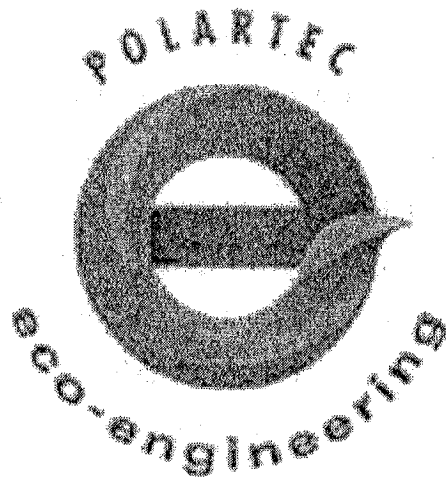


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2014 TMOB 119
Date of Decision: 2014-06-12

**IN THE MATTER OF AN OPPOSITION
by Engineers Canada/ Ingénieurs Canada
to application No. 1,368,809 for the trade-
mark POLARTEC ECO-
ENGINEERING DESIGN in the name of
MMI-IPCO, LLC**

[1] MMI-IPCO, LLC (the Applicant) has applied to register the trade-mark POLARTEC ECO-ENGINEERING DESIGN (the Mark), as shown below.



[2] The application contains the following colour claim:

“Colour is claimed as a feature of the trade-mark, namely, green. The mark consists of varying shades of green which are claimed as a feature of this mark. The mark consists of a stylized letter "E" comprised of various swirls in different shades of green. The straight portion of the mark is a dark shade of green which gets progressively lighter with

definitive lines outlining lighter shades of green ending with the leaf as the lightest shade of green”.

[3] The application is based upon proposed use of the Mark in Canada, as well as use and registration of the Mark in the United States and covers the following wares:

Textile fabrics for use in the manufacture of clothing, home furnishings, upholstery, furniture, housewares furnishings, carpets, floor coverings, wall coverings, curtains, furniture covers, blankets, pillows, bed linens, bath linens and kitchen linens; Textile fabric piece goods sold as a component of clothing, namely coats, jackets, parkas, raincoats, pullovers, shirts, sports jerseys, trousers, pants, dresses, skirts, pajamas, underclothing, scarves, shawls, gloves, mittens, headwear, namely hats, caps, headbands, and visors, footwear, namely sport and leisure shoes, slippers, socks, tights, stockings, and hosiery.

[4] Engineers Canada/ Ingénieurs Canada (the Opponent) is a federation of twelve provincial and territorial associations of engineers of Canada. These twelve associations which make up the Opponent are responsible for regulating the profession of engineering and licensing its members in Canada. The Opponent has opposed the application, as it takes issue with the inclusion of the term “engineering” in the Mark.

[5] Although several grounds of opposition have been raised, the opposition is primarily based upon an allegation that the Mark is not registrable as it is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in the application or of the persons employed in their production. The Opponent takes the position that the wares in the application for the Mark fall within the scope of wares which would normally be designed, developed, used and offered by professional engineers. The Opponent alleges that if members of the profession of engineering in Canada are involved in the production of the wares, then the Mark is clearly descriptive of both the character and quality of the wares and of the persons employed in their production. Alternatively, the Opponent submits that if members of the profession of engineering in Canada are not involved in the production of the wares, then the Mark is deceptively misdescriptive of both the character and quality of the wares and of the persons employed in their production.

[6] For the reasons that follow, the opposition is rejected.

File History

- [7] The Applicant filed its application to register the Mark on October 15, 2007.
- [8] The application for the Mark was advertised in the *Trade-marks Journal* for opposition purposes on May 26, 2010.
- [9] The Opponent opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition on July 26, 2010.
- [10] The grounds of opposition, which will be set out in more detail below, are based upon sections 30(d), 30(e), 30(i), 12(1)(b), 12(1)(e) and 2 of the Act.
- [11] In support of its opposition, the Opponent filed the affidavit of Marisa Hood, sworn February 10, 2011, the affidavit of John Kizas, sworn May 10, 2011, the affidavit of D. Jill Roberts, sworn May 11, 2011 and a certified copy of application no. 903,677 for the official mark ENGINEERING.
- [12] In support of its application, the Applicant filed the affidavit of Danielle Booton, sworn November 13, 2012.
- [13] No cross-examinations were held.
- [14] Both parties filed a written argument.
- [15] A hearing was held and attended by both parties.

Onus

- [16] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, 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 [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Preliminary Matter

[17] As a preliminary matter, I note that one of the Opponent's section 12(1)(e) grounds of opposition was initially based upon section 9(1)(n)(iii) of the Act. However, in its written argument the Opponent withdrew this ground of opposition and indicated that it would no longer be relying on its official mark no. 903,677 for ENGINEERING. In addition, at the hearing, the Opponent also withdrew its ground of opposition based upon section 30(d) of the Act. Since these grounds of opposition have been withdrawn, I will not be addressing them in my decision.

Analysis of Remaining Grounds of Opposition

Non-Compliance Grounds of Opposition

Section 30(e)

[18] The Opponent has pleaded that contrary to section 30(e) of the Act, at the time of filing the application, the Applicant did not intend to use the Mark in Canada as alleged or at all.

[19] Since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the trade-mark in Canada, it formally complies with section 30(e) of the Act. The issue therefore becomes whether or not the Applicant has substantially complied with section 30(e) of the Act (i.e. was the Applicant's statement that it intended to use the Mark true?) [*Home Quarters Warehouse, Inc v Home Depot, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB)].

[20] Since the facts regarding an applicant's intentions are particularly within the knowledge of the applicant, the initial burden on an opponent under a section 30(e) ground is lighter than usual [*Molson Canada v Anheuser-Busch* (2003), 29 CPR (4th) 315 (FCTD)].

[21] The Opponent contends that the manner in which the Applicant intends to use the Mark is not "use" within the meaning of section 4 of the Act. In support of this contention, the Opponent relies upon excerpts from the Applicant's website which suggest that the words POLARTEC ECO-ENGINEERING are used by the Applicant to promote environmentally friendly fabric "technology". The Opponent contends that there is no indication that there is an actual brand of

POLARTEC ECO-ENGINEERING fabric or clothing line on the Applicant's website [Kizas affidavit, Exhibit 48, Hood affidavit, Exhibit 28 C, pages 2-3].

[22] I am not satisfied that the evidence upon which the Opponent relies is sufficient for it to meet its initial burden under section 30(e) of the Act. First, I note that the application for the Mark is based upon proposed use. In view of this, there is no requirement for the Applicant to show use of its Mark at this stage [*Molson Canada v Anheuser Busch, supra*]. Thus, the fact that the Applicant's website may not currently show or suggest use of the Mark in association with the Applicant's wares pursuant to section 4(1) of the Act is irrelevant. Second, the fact that the Mark may have been used in association with the promotion of environmentally friendly fabric "technology" to date does not necessarily lead to a conclusion that the Applicant does not intend to use the Mark in association with the wares which are actually covered in the application in the future.

[23] The section 30(e) ground of opposition is therefore dismissed.

Section 30(i)

[24] The Opponent has pleaded that the application does not comply with section 30(i) of the Act as the Applicant could not have been satisfied that it was entitled to use the Mark in association with the wares set out in the application in Canada.

[25] The Opponent states that engineering is a profession which is regulated in Canada by provincial and territorial statutes, which provide that only candidates meeting their requirements are permitted to practice engineering. The Opponent also submits that there are various Acts in the provinces and territories which regulate the use of professional designations such as "engineering" and prohibit the use of the term "engineering" by those who are not licensed or authorized to practice engineering within their jurisdiction [Kizas affidavit, paras 22 to 27, Exhibits 2-14 and 19A-19J]. The Opponent further submits that it has established that the Applicant is not licensed or registered to provide engineering services anywhere in Canada and that there is no evidence that it employs any engineers who are licensed to practice engineering in Canada [Kizas affidavit, paras 24, 50-51 and Exhibits 18 and 49].

[26] In a nutshell, the Opponent takes the position that the Applicant is in breach of statutes which govern the practice of engineering and therefore cannot have been satisfied that it was entitled to use the Mark at the time of filing the application pursuant to section 30(i) of the Act.

[27] First, I note that the application for the Mark does not cover engineering services. Second, it has been held that allegations of non-compliance with provincial/territorial statutes are not an appropriate basis for a section 30(i) ground of opposition [*Interprovincial Lottery Corp v Monetary Capital Corp* (2006), 51 CPR (4th) 447 (TMOB); *Lubrication Engineers, Inc v Canadian Council of Professional Engineers* (1992), 41 CPR (3d) 243 (FCA) at 244].

[28] The section 30(i) ground of opposition is therefore dismissed.

Non-registrability Grounds of Opposition

Section 12(1)(b)

[29] The Opponent has pleaded that the Mark is not registrable under section 12(1)(b) of the Act because it is “clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is used or proposed to be used or of the conditions of the persons employed in the production of the wares”.

[30] The Opponent’s section 12(1)(b) ground of opposition has been pleaded in two parts:

- i) if members of the profession of engineering in Canada are involved in the production of the wares, then the Mark is clearly descriptive of both the character and quality of the wares and of the persons employed in their production; and
- ii) if members of the profession of engineering in Canada are not involved in the production of the wares, then the Mark is deceptively misdescriptive of both the character and quality of the wares and of the persons employed in their production.

[31] The material date for assessing a section 12(1)(b) ground of opposition is the filing date of the application [*Shell Canada Limited v PT Sari Incofood Corporation* (2005), 41 CPR (4th)

250 (FC); *Fiesta Barbeques Limited v General Housewares Corporation* (2003), 28 CPR (4th) 60 (FC)].

[32] When conducting an analysis under section 12(1)(b) of the Act, a trade-mark must be considered as a matter of first impression, in its entirety and not dissected into its constituent parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186].

[33] The word “character” in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product and the word “clearly” has been held to mean “easy to understand, self-evident or plain” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[34] The test to be applied when assessing whether a trade-mark violates section 12(1)(b) of the Act has more recently been summarized by the Federal Court of Appeal in *Ontario Teachers’ Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) at para 29:

It is trite law that the proper test for a determination of whether a trade-mark is clearly descriptive is one of first impression in the mind of a normal or reasonable person. [...] One should not arrive at a determination of the issue by critically analyzing the words of the trade-mark, but rather by attempting to ascertain the immediate impression created by the trade-mark in association with the wares or services with which it is used or proposed to be used. In other words, the trade-mark must not be considered in isolation, but rather in its full context in conjunction with the wares and services.

[35] Having briefly reviewed some of the relevant case law, I will now go on to consider each part of the Opponent’s section 12(1)(b) ground of opposition in detail.

i) Is the Mark clearly descriptive of the character and quality of the wares and of the persons employed in their production?

[36] This first part of the Opponent’s section 12(1)(b) ground of opposition has been dealt with in a number of other decisions involving the Opponent in the past [see, for example, *Canadian Council of Professional Engineers v Comsol AB* 2011 TMOB 3; *Canadian Council of*

Professional Engineers v REM Chemicals, Inc 2013 TMOB 144; and *Canadian Council of Professional Engineers v Mizuno Corp* 2013 TMOB 47].

[37] In each of those cases, evidence was put forward to establish that the Applicant was not registered to provide engineering services and there was no evidence put forward to suggest that any engineers were employed in the production of the wares associated with the trade-marks in question. In view of this, in each of those cases, the Registrar held that it was not necessary to give any further consideration to the Opponent's allegation that the applicant's trade-mark was clearly descriptive of the persons employed in the production of the wares.

[38] While each case must be decided on its own merit and facts, I see no reason why the same approach should not be taken in the present case.

[39] In this regard, I note that Mr. Kizas has provided copies of various statutes which regulate the engineering profession in Canada and highlighted the provisions regulating the use of the engineering designations [Kizas affidavit, paras 10, 14 and 22 and Exhibits "2"- "14"]. He has also provided confirmation from all the constituent associations that the Applicant is not registered to engage in the practice of engineering in Canada [Kizas affidavit, paras 50-51 and Exhibit "49"]. In addition, there is no evidence before me that registered engineers are employed in the production of the Applicant's wares

[40] Accordingly, I see no need to pursue the Opponent's allegation that the Mark is clearly descriptive of the persons employed in the production of the wares. I also find it unnecessary to further pursue the Opponent's allegation that the Mark is clearly descriptive of the character or quality of the wares, since this aspect of the Opponent's pleading also hinges on a member of the profession of engineering in Canada being involved in the production of the wares and that is not the case.

[41] I will therefore now go on to consider the second part of the Opponent's section 12(1)(b) ground of opposition.

ii) *Is the Mark is deceptively misdescriptive of the character or quality of the wares and services and of the persons employed in their production?*

[42] The Opponent submits that the use of the word “engineering” in the Mark has a clear meaning related to work performed by professional engineers. The Opponent asserts that most people would assume that a business using the word “engineer” would employ professional engineers, unless the context clearly indicates otherwise. The Opponent relies upon several cases in support of these submissions [*Canadian Council of Professional Engineers v Tekla Oyj* (2008), 68 CPR (4th) 228 at 236 (TMOB); *Canadian Council of Professional Engineers v John Brooks Co* (2004), 35 CPR (4th) 507 at 513 (FC); *Lubrication Engineers, Inc v Canadian Council of Professional Engineers* (1992), 41 CPR (3d) 243 (FCA)]. Suffice it to say, each case must be decided on its own facts and merit.

[43] The Opponent is of the view that the wares in the application for the Mark would fall squarely within the scope of wares which would normally be designed, developed or offered by professional engineers.

[44] In support of its position, the Opponent relies upon an excerpt from the *World Book Encyclopaedia*, which references the disciplines of “environmental engineering” (a branch of which the Opponent contends is “eco-engineering”) and “textile engineering” [Kizas affidavit, Exhibit “27”].

[45] The Opponent also notes that the Canadian Government (Human Resources and Skills Development Canada (HRSDC)) has also recognized both “textile engineer” and “environmental engineer” as specialized engineering occupations in its National Occupational Classification (NOC) and that many Canadian universities offer accredited programs in “environmental engineering” [Kizas affidavit, Exhibits “24”, “25” and “26” and Hood affidavit, para 12, Exhibits “26 A” and “26 B”]. The NOC describes textile engineers as engineers who “design and develop processes, equipment and procedures for the production of fibres, yarns and textiles” [Kizas affidavit, paras 34 and 35, Exhibit “25”]. Notably, the application for the Mark does not cover services relating to the design and development of processes, equipment and procedures for textile production. Rather, it covers wares and in particular, textile fabrics and textile fabric piece goods.

[46] The Opponent also relies upon the Roberts affidavit in support of its position. Ms. Roberts attended at various libraries in Ottawa and conducted searches for scientific works, scientific dictionaries and articles in engineering and scientific journals containing information related to textile engineering and ecological engineering. In her affidavit, Ms. Roberts makes reference to various textbooks, journals and conference papers which she located in her search [Roberts affidavit, paras 4-23, Exhibits "A"-“R”]. At least some of these materials pre-date the filing date of the application for the Mark. For example, Ms. Roberts located a book entitled *Contemporary Textile Engineering* published in 1982 (Exhibit “I”); a book entitled *Biomechanical Engineering of Textiles and Clothing* published in 2006 (Exhibits “C1” and “C2”); a book entitled *Textile Engineering Processes* published in 1959 (Exhibit “K”); books entitled *Eco-Design*, published in 2002 and 2009, which the Opponent submits show eco-friendly clothing designs (Exhibits “Q” and “R”); an Environment Canada publication entitled *Environmental Assessment of the Canadian Textile Industry* published in 1989 (Exhibit “E”); a book entitled *Smart Fibres, Fabrics and Clothing* published in 2001 (Exhibit “L”); and other similar publications.

[47] The Opponent also relies on the Hood affidavit, wherein Ms. Hood provides evidence that the Applicant is the owner of 18 granted patents and one pending patent application for inventions relating to fabrics, including heated fabrics, wind proof and water resistant fabrics and an “advanced engineered garment” [Hood affidavit, paras 2-5, Exhibits “3”-“22”]. The Opponent submits that textile engineers would be involved in the design, development or manufacturing of all of the products described in these patents.

[48] The Opponent submits that there is ample evidence that “environmental engineering” and “textile engineering” are specialities within the engineering profession and that engineers are involved in the research and design of textiles and textiles for clothing and in reducing the impact the textile industry has on the environment.

[49] The Opponent further submits that an average consumer, when faced with the Mark, would have the impression that the Applicant sells eco-friendly fabrics and clothing that are designed by engineers. The Opponent submits that the term “eco” in the Mark sends the message

to consumers that the Applicant's products are environmentally sustainable or environmentally friendly.

[50] In further support of this contention, the Opponent refers to the Applicant's website, which suggests that the Applicant makes an effort to design products in a way which minimizes the impact on the environment by using recycled materials and renewable resources [Hood affidavit, Exhibit "28 C"; Kizas affidavit, Exhibit "48"]. The Opponent notes that the Applicant's website contains claims about how it uncovers "ways in which we can lessen our ecological footprint – all while continuing to make the most advanced fabrics in the world...we call it eco-engineering (tm)" [Hood affidavit, Exhibit "28 C"]. The Opponent submits that these statements are calculated to deliver a clear message to the public that the Applicant's fabric and clothing are specially designed by engineers in an effort to preserve the environment.

[51] The Opponent is therefore of the view that the use of the term "eco-engineering" in the Mark by the Applicant (an entity which is not authorized to practice engineering in Canada and which does not employ any engineers), renders use of the Mark in its entirety deceptively misdescriptive of the character and quality of the wares and of the persons employed in the production of the wares.

[52] I am not sure that I agree with the Opponent, as it seems to me that arriving at this conclusion would require some speculation and mental processing on the part of the average consumer. In other words, I do not think that the meaning of the words "eco-engineering" is "easy to understand, self-evident or plain" in the context of the textile fabrics or textile fabric piece goods, as set out in the application for the Mark.

[53] I accept that "textile engineering" and "environmental engineering", may well exist as disciplines within the engineering field. I also accept that it is not new for textile and clothing manufacturers to adopt strategies to protect the environment or minimize their impact on the environment and that the Applicant itself purports to do so. However, I am not convinced that a consumer, as a matter of first impression, upon seeing the Mark on an article of clothing (for example), would be likely to infer that a professional engineer was somehow involved in its design, development or manufacture.

[54] As mentioned previously, the application for the Mark does not cover services relating to the design and development of processes, equipment and procedures for textile production. Rather, it covers wares and in particular, textile fabrics and textile fabric piece goods, *per se*. In my view, the word “engineering”, has a much broader application in the context of these goods.

[55] In this regard, I note that 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” [see on-line *Canadian Oxford Dictionary*, (2d) 2005]. For authority that I can take judicial notice of dictionary definitions, see *Envirodrive Inc v 836442 Alberta Ltd*; 2005 ABQB 446 (Alta QB) and *Tradall SA v Devil's Martini Inc* (2011), 92 CPR (4th) 408 (TMOB) para 29.

[56] I am mindful of the jurisprudence which suggests that most people would assume that businesses using the word “engineering” in their name offer engineering services and employ professional engineers, unless the context clearly indicates otherwise [*Canadian Council of Professional Engineers v John Brooks, supra*]. However, in my view, this case law is distinguishable. In the present case, we are not dealing with sophisticated technical services of a nature of which one may expect to be provided by a professional engineer. We are dealing with wares which are relatively simple in nature. In particular, textile fabrics for use in the manufacture of items such as clothing, curtains, blankets, etc. and textile fabric piece goods which are sold as a component of clothing.

[57] While professional engineers may well be involved in the design or development of processes, equipment and procedures for textile production, I am not sure that this would lead the average consumer, as a matter of first impression upon seeing the Mark on, for example, a component of an article of clothing or a piece of fabric for a blanket or curtains, to infer that a professional engineer was somehow involved in the manufacture of that article. Rather, in my view, it is more likely that the average consumer would, in the context of those goods, consider the word to be used in its more general or ordinary sense. Moreover, I note that the Mark does not simply contain the word “engineering”. It contains the word “eco-engineering”, which would

necessitate some further reflection on the part of the consumer as to the meaning of the Mark in the context of the Applicant's goods.

[58] Accordingly, I do not find the meaning of the words "eco-engineering" in the Mark to be "easy to understand, self-evident or plain" within the specific context of the wares which are covered by the application for the Mark.

[59] However, even if I were to accept the Opponent's submissions that consumers would be likely to infer that the words "eco-engineering" in the Mark mean that the Applicant's wares are "eco" or "environmentally" friendly products which have been developed, designed or produced by engineers and that these words are consequently deceptively misdescriptive in view of the fact that the Applicant is not licensed to provide engineering services and does not employ any engineers, this does not necessarily render the trade-mark as a whole deceptively misdescriptive within the meaning of section 12(1)(b) of the Act.

[60] In this regard, I note that in order to determine whether a trade-mark is deceptively misdescriptive, the proper test to be applied is to ask whether the deceptively misdescriptive word(s) "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 supra* at 507, para 21; citing *Chocosuisse Union des Fabricants – Suisses de Chocolate v Hiram Walker & Sons Ltd* (1983), 77 CPR (2d) 246 (TMOB); citing *Lake Ontario Cement Ltd v Registrar of Trade-marks* (1976), 31 CPR (2d) 103 (FCTD)].

[61] At the hearing, the Opponent submitted that all of the words in the Mark are equally dominant and that when sounded, the word "engineering" is what sticks in the mind, as it suggests a profession and all that goes along with it. I disagree.

[62] First, I note that the Mark does not contain the word "engineering" in isolation. It is the word "eco-engineering" which appears in the Mark. In addition, the Mark includes (in large upper case block letters) the non-descriptive word POLARTEC, a coined word, which, in my view, is quite distinctive. The Mark also includes a large green colored design which may be seen to be a letter "e", in combination with a leaf or other fanciful design. The combination of these elements forms the largest part of the mark when depicted and appears in the first, most

prominent position of the Mark, when depicted or written. The term “eco-engineering” appears in smaller, lower case letters at the bottom or end of the Mark. I am therefore of the view that the term “eco-engineering” does not form a significant part of the whole of the Mark, when it’s written or depicted.

[63] With respect to how the Mark is sounded, the fact remains that the relatively distinctive word POLARTEC would be spoken first and would, in my view form a greater overall first impression in the mind of the consumer than the word “eco-engineering”, which appears at the end of the Mark and which is considerably less distinctive in nature.

[64] In view of the secondary placement of the words “eco-engineering” and the fact that the Mark is primarily comprised of other more distinctive elements which are in a more prominent position, I find that the words “eco-engineering” do not so dominate the Mark as a whole so as to render it unregistrable under section 12(1)(b) of the Act.

[65] Having reviewed all of the evidence of record, as well as the parties’ submissions, I am therefore satisfied that the Applicant has met its burden of establishing that the Mark is not deceptively misdescriptive of the character and quality of the Applicant’s wares or of the persons employed in their production.

[66] Accordingly, the section 12(1)(b) ground of opposition is dismissed.

Section 12(1)(e)

[67] The Opponent has pleaded that the Mark is not registrable, as it is contrary to section 10 of the Act, which prohibits the registration of a mark which has by ordinary and *bona fide* commercial use become recognized in Canada as designating the kind, quality and value of any wares and/or services. The precise wording of section 10 is reproduced below:

Where any mark 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 wares or services, no person shall adopt it as a trade-mark in association with such wares 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 marks so nearly resembling that mark as to be likely to be mistaken therefore.

[68] In this case, the Opponent asserts that the word “engineering” has become recognized in Canada as designating the kind, quality or value of wares and services which are provided by licensed engineers. It further asserts that since the public would think that the Applicant is licensed in or throughout Canada to engage in the practice of engineering, the use of the Mark would likely be misleading.

[69] It is clear that section 12(1)(e) of the Act deals with an assessment of a 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.

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

Non-distinctiveness Ground of Opposition

[71] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act, as it does not distinguish nor is it adapted to distinguish the wares of the Applicant from those of others, including other professional engineers in general and other entities which are licensed to practice engineering in Canada.

[72] The Opponent has also pleaded that any use by the Applicant of the Mark would be misleading, in that such use would suggest that the wares of the Applicant are designed, produced, developed, sold, leased, or licensed by the Opponent or its constituent members or that the Applicant is associated with, or authorized by the Opponent or its constituent members.

[73] In its written argument, the Opponent asserts that the Applicant does not associate the Mark with its textiles products, but rather, with textiles technology and to promote the Applicant’s eco-friendly ideology. Thus, the Opponent takes the position that the Mark does not and cannot distinguish the Applicant’s wares from those of others.

[74] The material date for assessing this ground is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[75] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

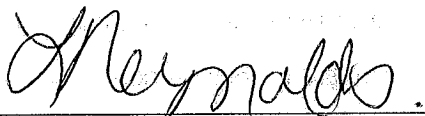
[76] In support of this ground of opposition, the Opponent essentially relies upon similar submissions to those which were made under its section 30(e) and 12(1)(b) grounds.

[77] Ultimately, my findings under the sections 30(e) and 12(1)(b) grounds of opposition apply equally at the later material date for assessing the non-distinctiveness ground of opposition.

[78] Accordingly, this ground of opposition is also dismissed.

Disposition

[79] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.



Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office