

World Trademark Review Daily

Canadian Council of Professional Engineers fails to prevent registration of 'engineering' mark
Canada - Smart & Biggar/Fetherstonhaugh

**Examination/opposition
National procedures**

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Canada's Federal Court of Appeal has recently dealt the [Canadian Council of Professional Engineers](#) (CCPE) another blow against its strategy of claiming an exclusive monopoly in the words 'engineer' and 'engineering', and opposing trademark applications that include these words.

In *Kelly Properties v Canadian Council of Professional Engineers* (2013 FCA 287), the applicant was seeking to register the trademark KELLY ENGINEERING RESOURCES in connection with "personnel employment services". The CCPE, which is the umbrella organisation representing the various provincial and territorial engineering associations in Canada, opposed the application on various grounds. The primary ground of opposition was that the mark was allegedly "deceptively misdescriptive" in nature as the inclusion of the word 'engineering' within the trademark deceived consumers into believing that the applicant employs licensed Canadian engineers, which was not the case.

In the initial opposition proceedings within the Canadian Trademarks Office, the Opposition Board rejected CCPE's opposition and held, in a lengthy decision, that the mark was registrable and was not deceptively misdescriptive. Rather, the board held that the mark merely suggests that the applicant provides resources either for those looking for jobs in an area of engineering, or for engineering firms looking for personnel (who may or may not be licensed Canadian engineers).

On appeal, the [Federal Court overturned the board's decision](#) and rejected the application as a result of additional affidavit evidence filed by the CCPE. In particular, the trial judge held that new evidence relating to the interpretation and scope of provincial legislation that governs the practice of engineering in Alberta would have had a material effect on the board's decision. As a result, the trial judge held that he need not give deference to the board's decision and, further, held that the evidence established that the mark was deceptively misdescriptive in nature.

In its decision, the Federal Court of Appeal held that the trial judge had committed a palpable and overriding error by finding that the evidence would have had a material effect on the board's decision. The Court of Appeal considered the additional material relating to provincial legislation governing the practice of engineering in Alberta to be irrelevant as it was merely opinion evidence interpreting the meaning of the statute. In view of this, the standard of review should have been whether the board's decision was "reasonable", and the Court of Appeal found that the board's decision was not unreasonable.

What is to be learned from this decision?

First, oppositions brought by the CCPE against Canadian trademark applications that include the word 'engineer' and 'engineering' can be successfully defended with suitable evidence. While the CCPE had been successful in many other cases, the Court of Appeal's decision is consistent with recent oppositions in which the CCPE failed in its oppositions against the marks COMSOL ENGINEERING LAB for software, and ENGINEERING EXCELLENCE IS OUR HERITAGE for brake parts, on the basis that these marks were deceptively misdescriptive due to the applicants not employing Canadian licensed engineers.

Second, the Court of Appeal's decision underscores the difficulties in appealing decisions of the Opposition Board, and the need for parties to put their best foot forward at the outset. While additional evidence can be filed on appeal to the Federal Court, it is often very difficult to establish that the additional evidence would have had a material effect on the board's decision or that the board's decision was unreasonable.

Third, it can be valuable to rely upon more than one filing ground within a Canadian application, if alternative grounds are available. In this case, the applicant had filed the application based upon both use in Canada as well as use and registration in the United States. While the board held that the applicant's claimed date of first use in Canada was incorrect, the opposition was nevertheless rejected as the reliance upon use and registration in the United States was an independent, alternative filing basis that was sufficient for the registrability of the mark.

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