



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

**Citation: 2018 TMOB 146**

**Date of Decision: 2018-11-27**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**PNC IP Group Professional  
Corporation**

**Requesting Party**

**and**

**Petro Barrier Systems Incorporated**

**Registered Owner**

**TMA661,623 for PETRO BARRIER**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA661,623 for the trade-mark PETRO BARRIER (the Mark), owned by Petro Barrier Systems Incorporated.

[2] The Mark is currently registered in association with the following goods and services:

Goods:

Devices for protecting drains and water systems from contamination by containing oils, chemicals and other substances, namely, floor drain filters, berm wall filters, storm water drain filters, storm drain basket filters and filter pads.

Services:

Consulting, design and support services for devices for protecting drains and water systems from contamination by containing oils, chemicals and other substances, namely, floor drain filters, berm wall filters, storm water drain filters, storm drain basket filters and filter pads.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

#### THE PROCEEDINGS

[4] On August 9, 2016, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Petro Barrier Systems Incorporated (the Owner). The notice was sent at the request of PNC IP Group Professional Corporation (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between August 9, 2013 and August 9, 2016, in association with each of the goods and services specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered services [see

*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270].

Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Heidi Lopez, the General Manager of the Owner, sworn October 31, 2016, together with Exhibits A to K.

[9] Both parties filed written representations and attended an oral hearing in the matter.

#### THE EVIDENCE

[10] Ms. Lopez explains that the Owner's goods and services are designed to prevent, contain, or ameliorate oil spills and other environmental discharges of hydrocarbon pollutants.

[11] Ms. Lopez attests that the Owner sells its goods and services to utility companies, car agencies, municipalities, and government institutions, and marinas and yacht clubs, among other businesses and sectors. She states that the Mark was used in Canada in association with each of the goods and services during the relevant period, and that the Owner's revenues from the sale of such goods and services during the relevant period exceeded \$1.3 million CAD.

[12] With respect to the Owner's normal course of trade, Ms. Lopez explains that the Owner takes sales orders by telephone, facsimile, email, regular mail, and in person from customers' work sites. She states that the services are typically provided to customers on-site, by telephone, by facsimile, or by email. She further attests that the goods are typically delivered to customers by mail, courier, or on-site delivery in cartons bearing labels displaying the Mark as shown in Exhibits B and C to her affidavit. I note that the labels in Exhibit B and Exhibit C display the following variation of the Mark, as well as include a product description and product code:

(Petro Barrier Systems Inc. & Design)



The majority of the cartons featured in Exhibit C also include an additional label displaying the Mark as follows:

**PetroBarrier™**

[13] In addition to labels bearing the Mark, Ms. Lopez attests that packing slips, instruction sheets, and invoices bearing the Mark accompanied the goods sold by the Owner during the relevant period. In support, she provides the following:

- Exhibit D - numerous representative packing slips dated during the relevant period, most of which are for goods sold in Canada. The packing slips appear to pertain to the sale of the following goods, as per the product codes and descriptions listed on the packing slips:
- Exhibit E - representative printed instruction sheets that were placed in cartons containing the goods sold by the Owner during the relevant period; in this case, specifically, floor drain protectors, wall drain protectors, storm drain protectors, and California drain protectors.
- Exhibit G – sample invoices representative of those issued by the Owner during the relevant period. The invoices reflect sales of floor drain protectors, floor drain filters, floor drain kits, leaf barriers, wall drain filters, berm barriers and cartridges, storm drain protectors, filter floor plugs, filter pads, and related parts and fittings, etc.

The packing slips, instruction sheets, and invoices all display the Petro Barrier Inc. & Design mark as shown above, at the top of the respective documents. To assist in identifying the specific goods listed on the above documents as well as their correlation to the products identified on the labels and cartons, Ms. Lopez provides a chart to explain which product descriptors and codes fall under each registered good.

[14] With respect to the services, Ms. Lopez attests that the Owner advertised its services in Canada during the relevant period, in industry publications, on brochures, and on the Owner's website. In support, she provides the following:

- Exhibit F – sample advertisements dated during the relevant period from two industry publications in Canada. The advertisements once again feature Petro Barrier & Inc. Design as shown above, as well as refer to the Owner’s goods and services.
- Exhibit H – representative brochures advertising the Owner’s goods and services featuring the following variations of the Mark:



- Exhibits J and K – printouts of the Owner’s website as of the date of the affidavit representative of how the website looked during the relevant period, as well as archived printouts of the Owner’s website as it appeared during the relevant period. The website in both cases features the Petro Barrier Systems Inc. & Design mark as shown above and describes the goods and services provided by the Owner.

ANALYSIS AND REASONS FOR DECISION

[15] The Requesting Party submits that, aside from some isolated instances on the product carton labels and two invoices, the vast majority of the evidence displays the Owner’s corporate logo (Petro Barrier Systems Inc. & Design) and not the Mark as registered. The Requesting Party submits that although the words PETRO BARRIER appear in larger font, only the word BARRIER is shown in blue, indicating that if anything, the Owner is attempting to highlight the BARRIER portion of the trade-mark. In addition, the Requesting Party submits, the three water drops serve to group the words together, and because of these features of the mark, as a matter of first impression, customers would perceive the corporate logo as merely an identification of the corporate name. The Requesting Party further submits that this is particularly so, given the context of use as with the labels on the cartons. The Requesting Party submits that there is no evidence that the labels appear on the goods themselves, or any evidence as to why the goods

themselves cannot be marked directly. Lastly, the Requesting Party submits that with respect to the packing slips and invoices, once again it is the corporate logo that appears, and it appears in the top left portion of the packing slip/invoice, followed by the Owner's address. As such, the Requesting Party submits, this is trade-name, rather than trade-mark use [citing *Road Runner Trailer Manufacturing Ltd v Road Runner Trailer Co* (1985), 1 CPR (3d) 443 (FC); and *Borden Ladner Gervais LLP v GDC Communities*, 2015 TMOB 50]. The Requesting Party advances similar arguments with respect to the Mark as it appears on the Owner's sample advertisements (Exhibit F) and the Owner's website (Exhibits J and K).

[16] In any event, the Requesting Party submits, with respect to the invoices, the inclusion of the Mark at the top of the invoices (and at the bottom in two instances) does not qualify as evidence of use of the Mark in association with the goods. The Requesting Party submits that the Mark does not appear in the body of the invoices, is not used as a trade-mark in describing the goods contained on the invoices, and it is inappropriate to assume that the invoices would accompany the purchased goods at the time of transfer and the evidence is ambiguous in this regard [citing *Boutiques Pro Golf Inc v Canada (Registrar of Trademarks)* (1993), 54 CPR (3d) 451 (FCA); *Tint King of California Inc v Canada (Registrar of Trade Marks)*, 2006 FC 1440 (FC); *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD); and *Blake, Cassels & Graydon v Seanix Technology Inc*, 2007 CanLII 80920 (TMOB)]. Furthermore, the Requesting Party submits that the product codes listed on the several of the invoices do not correspond to any of the codes on the chart provided by Ms. Lopez.

[17] Lastly, the Requesting Party submits that the Exhibit H brochures do not advertise the registered services, but rather describe various devices and products sold by the Owner. Further to this, the Requesting Party submits that the brochures do not display the Mark as registered, but design marks that are significantly different from the Mark.

[18] The Owner, on the other hand, submits that the registration of a word mark permits an owner to use its mark in any size and with any style, lettering, colour or design [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 55; and *Pizzaiolo Restaurants Inc v Restaurants La Pizzaiolle Inc*, 2016 FCA 265, 142 CPR (4th) 329 at para 24].

[19] Particularly in all instances wherein the Requesting Party argues that the use shown is of a corporate or trade name, the Owner submits, and I agree, that the words PETRO BARRIER have a separate and recognizable identity, as they appear in a style and size of font that sets them apart from the additional matter [*Road Runner, supra*].

[20] Additionally, the Owner correctly submits that there are examples in the evidence of product labelling with the words PETRO BARRIER alone. In this regard, the Mark clearly appears on cartons containing the goods sold, which I consider to be packaging for the goods, and the cartons are clearly labelled with their contents, which I accept correspond to the registered goods.

[21] Having regard to the above, I need not consider whether the invoices accompanied the goods at their time of transfer. However, the invoices are evidence that transfers of the registered goods took place during the relevant period. With respect to the invoices containing product codes that are not included on Ms. Lopez's product code explanation chart, I do not see this as problematic, as Ms. Lopez describes the evidence as 'representative', and the invoices include word descriptions of the goods in addition to product codes.

[22] Further to this, as I accept that the Petro Barrier & Design mark constitutes use of the Mark as registered, I need not consider whether the marks appearing on the brochures also constitute use of the Mark as registered. In this regard, the industry publication advertisements (Exhibit F), and the Owner's website (Exhibits J and K) which display the Petro Barrier & Design mark clearly advertise the Owner's registered services.

DISPOSITION

[23] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in its entirety in compliance with the provisions of section 45 of the Act.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office



**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** July 31, 2018

**APPEARANCES**

Janet Fuhrer

FOR THE REGISTERED OWNER

Tapas Pain

FOR THE REQUESTING PARTY

**AGENTS OF RECORD**

Ridout & Maybee LLP

FOR THE REGISTERED OWNER

PNC IP Group Professional Corp.

FOR THE REQUESTING PARTY