



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 103

Date of Decision: 2020-08-31

IN THE MATTER OF A SECTION 45 PROCEEDING

Epic Aviation, LLC

Requesting Party

and

Imperial Oil Limited

Registered Owner

UCA03778 for EPIC

Registration

[1] At the request of Epic Aviation, LLC (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on October 19, 2017 to Imperial Oil Limited (the Owner), the registered owner of registration No. UCA03778 for the trade-mark EPIC (the Mark).

[2] The Mark is registered for use in association with the following goods: “Gasoline, lubricating oils and other petroleum products”.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with the goods specified in the registration, at any time between October 19, 2014 and October 19, 2017. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reason for the absence of such use since that date.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trademark 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.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270].

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of its Lubricants Sales Manager, Peter Shaw, sworn on April 27, 2018. Both parties filed written representations; an oral hearing was not requested.

THE OWNER’S EVIDENCE

[7] In his affidavit, Mr. Shaw states that the Owner is “an integrated energy company that explores for, produces, refines and markets energy products in Canada and in export markets”. With respect to the Mark, he states that the Owner has developed “a series of premium quality, semi synthetic all-weather greases, also known as lubricating oils, under the EPIC brand in Canada”. Mr. Shaw confirms that, as Lubricants Sales Manager for the Owner, he is responsible for “overseeing the sales and marketing of lubrication products in Canada”.

[8] Mr. Shaw specifies that, throughout the relevant period, the Mark was displayed on containers of lubricating oil products which were sold in various quantities in Canada, including 16 kilogram pails, 55 kilogram kegs, 180 kilogram drums and 1,450 kilogram bins. Attached as Exhibit A to his affidavit are two representative photographs “exemplifying how the EPIC trademark was displayed in association with lubricating oils” during the relevant period in Canada, namely “directly on the containers of the lubricating oils”.

[9] The first photograph shows a 16 kilogram pail labelled “GREASE”. The upper left corner of the label displays the notation “EPIC™ EP 102” in plain black lettering, in a thin, narrow font.

Immediately above this notation is a logo consisting of the word “Mobil” in a thick, wide font, where the letter “o” is red and the rest of the letters are blue, followed by a TM symbol. The second photograph shows a label for a 1,450 kilogram container of “GREASE”. The same “EPICTM EP 102” notation is displayed in the upper left corner, but in a slightly wider font. A winged horse design is displayed above this notation. The Mobil logo is displayed separately, without a TM symbol, closer to the upper right corner of the label.

[10] Mr. Shaw explains that there are two ways in which the Owner sold lubricating oil products displaying the Mark in Canada during the relevant period. The first method was through direct sales contracts with end users, who either took delivery of the product directly from one of the Owner’s distribution centres or had the product shipped to them directly by the Owner or an authorized distributor. The second method was through sales by Canadian distributors under agreements with the Owner. Mr. Shaw attests to sales of over a million litres of “EPIC brand lubricating oil” in Canada during the relevant period. As Exhibit B to his affidavit, he attaches a representative sample of invoices for such sales; he specifies that the “EPIC brand lubricating oil products” are identified as line items in the invoices.

[11] Exhibit B contains 15 invoices dated during the relevant period, showing sales of various products by the Owner to companies throughout Canada. Some of the invoices indicate shipment from a warehouse (“Warehse”) whereas other shipments appear to be from distributors (a couple of which appear as purchasers on a different invoice). Each invoice lists at least one product whose description includes the Mark, for example, “Mobil EPIC EP Moly, 55KG”, “MOBIL EPIC EP 102, 55KG”, “MOBIL EPIC EP 102 Electroluber, 10X1MI”, “EPIC MQ vrac lubricube, 1450KG” and “EPIC EP Moly Bik Bin, 1450KG”. I note that, on some of the invoices, the “Shipped to” address is the same as the “Bill-to” address.

PRELIMINARY REMARKS

[12] At the outset, as noted by the Requesting Party, the evidence is silent with respect to the registered goods “Gasoline”. Moreover, the Owner furnished no evidence of special circumstances excusing non-use of the Mark with respect to such goods. Accordingly, at a minimum, the goods “Gasoline” will be deleted from the registration.

[13] The evidence is also silent with respect to the registered goods “other petroleum products”. However, in its written representations, the Owner takes the position that, should the Registrar not consider its goods to be “lubricating oils”, then they “must be considered to fall under the ambit of the broad description ‘*other petroleum products*’” [emphasis in original]. I will therefore discuss “other petroleum products” following my discussion of “lubricating oils”.

[14] I would also note at this stage that the Requesting Party’s written representations include submissions based on the Mark’s registration date and on other trademarks in the Owner’s portfolio. To the extent that such submissions are based on the Requesting Party’s own research, the alleged facts are not in evidence and the resulting submissions will accordingly be disregarded. In any event, I agree with the Owner that the age of its registration and the nature of its portfolio are irrelevant in the context of a section 45 proceeding. The only matter to be resolved is whether the furnished evidence of use is sufficient to maintain the registration.

ANALYSIS

[15] Mr. Shaw makes a clear assertion of use of the Mark in association with “lubricating oils” in Canada during the relevant period. His assertion is supported by images of the Mark displayed on labelling for goods that he identifies as being “lubricating oils”—which he confirms were sold in Canada throughout the relevant period—and by invoices documenting sales and shipments of products that he identifies as “EPIC brand lubricating oils” to various companies in Canada during the relevant period.

[16] The Requesting Party submits that the evidence does not show use of the Mark *per se* but rather use of the trademark MOBIL EPIC. The Requesting Party further submits that the only documentary evidence produced is with respect to “greases”, rather than the registered good “lubricating oils”. I will address these arguments in turn.

Use of the Mark *per se*

[17] The Requesting Party submits that, as a matter of first impression, the public would likely not perceive the word EPIC as a distinct trademark, given that the word MOBIL “at all times

appears above the word ‘EPIC’”, is in a “significantly larger and thicker font”, and is “in bright, dual coloured font, while the word ‘EPIC’ is in black font”.

[18] The Requesting Party seeks to draw an analogy with the Registrar’s decision in 88766 *Canada Inc v Coca-Cola Ltd/Coca-Cola Ltée* (2006), 52 CPR (4th) 50 (TMOB), where it was found that display of the word CLASSIC under the significantly larger words COCA-COLA in a different font style would probably, as a matter of first impression, be perceived as the trademark COCA-COLA or COCA-COLA CLASSIC but not CLASSIC *per se*. It was found that the non-distinctive word CLASSIC did not stand out and would not likely create the impression of a separate trademark but rather would be viewed as referring to the character, quality, or type of the COCA-COLA brand product. The Requesting Party submits that the word EPIC would similarly be viewed as non-distinctive, describing the “superior character, quality, or type of the ‘MOBIL’ brand product”.

[19] The Requesting Party also cites *Method Law Professional Corp v Black & Decker Corp*, 2015 TMOB 225, 2015 CarswellNat 8202, where it was held that display of a trademark on invoices can provide context informing the Registrar as to what the public would perceive. More specifically, it was found that the prominent display of BLACK&DECKER at the top of invoices and price lists, separate and apart from any display of PIRANHA, supported a conclusion that the public would also perceive the display of BLACK&DECKER above PIRANHA on saw blades as two separate trademarks. The Requesting Party argues that, by contrast, MOBIL and EPIC are not displayed “separate and apart” on invoices in the present case; rather, “the word ‘MOBIL’ appears alone in most of the invoices provided ... and, when the word ‘EPIC’ does appear on the invoices, it is always subsequent to the word ‘MOBIL’”. The Requesting Party submits that the public would therefore perceive the trademark to be MOBIL or, at best, MOBIL EPIC. The Requesting Party adds that there is no evidence of a marketing campaign or general brand awareness to show that the word EPIC creates a separate impression in the minds of the public.

[20] Generally, use of a word mark in combination with additional words or design features qualifies as use of the word mark if the public, as a matter of first impression, would perceive the word mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d)

535 (TMOB)]. The issue is a question of fact, dependent upon such factors as whether the word mark stands out from the additional material, for example, by the use of different lettering or sizing, or whether the additional material would be perceived as purely descriptive matter or as a separate trademark or trade name [*Nightingale, supra*; see also *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096, 2009 CarswellNat 3400]. Although not necessarily determinative, the placement of trademark or registration symbols may be a relevant factor to consider in this respect [see *Rogers, Bereskin & Parr v Canada (Registrar of Trade Marks)* (1986), 9 CPR (3d) 260 (FCTD)].

[21] In the present case, I find that, by virtue of the differences in size and lettering, as well as in colour, the Mobil logo and the Mark stand out from each other, such that each makes a distinct impression. I would also note that, in one of the two examples provided, these two trademarks are also separated by physical distance, which reinforces the impression of separate trademarks.

[22] In my view, the present case is distinguishable from that in *Coca-Cola* in that the word EPIC does not, as a matter of immediate impression, refer to a style of grease, oil or lubricant. Additionally, in *Coca-Cola*, the positioning of a single registration symbol (“®/MD”) under the entire stacked presentation of the words “COCA-COLA CLASSIC” contributed to the Registrar’s conclusion that the public would not perceive CLASSIC as a separate trademark from COCA-COLA CLASSIC . By contrast, in the present case, both of the exhibited labels display the word EPIC with its own trademark symbol.

[23] I note that I do not consider the addition of the characters “EP 102” to alter the Mark’s identity, despite them being in the same size and style of lettering as “EPIC”. In my view, such additional matter would likely be perceived as a designation identifying a specific version or formulation of EPIC brand grease, while the Mobil logo would be perceived as an additional trademark, possibly in the nature of a house brand. In this respect, it is well established that two trademarks may be used at the same time [see *AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD); and *Loro Piana, supra*].

[24] I find that the invoices at Exhibit B reinforce this impression. Several of them contain at least one additional entry where MOBIL is immediately followed by a fanciful or coined word, for example, “MOBIL PEGASUS GMA”, “MOBIL DELVAC Extended Life”, “MOBIL

Centaur Moly 1”, and “Mobil NUTO H-C 68”. In my view, seeing the word MOBIL displayed in this manner on invoices would reinforce the impression that MOBIL is a house brand and that the word EPIC following it is a secondary trademark.

[25] In view of the foregoing, I am satisfied that display of EPIC on labels in the manner shown at Exhibit A constitutes display of the Mark *per se*. Given this conclusion, it is not necessary to consider whether display of EPIC on the exhibited invoices also constitutes display of the Mark *per se*.

Use of the Mark with the registered goods

[26] The Requesting Party submits that the only goods in evidence are “greases”, which do not fall within the scope of the registered goods “lubricating oils”.

[27] In this respect, the Requesting Party argues that Mr. Shaw merely *states* that such greases are “lubricating oils”, without actually *showing* this to be the case. The Requesting Party submits that the evidence in a section 45 proceeding must establish facts from which a conclusion would follow as a logical inference [citing *Keepsake Inc v Prestons Ltd* (1982), [1983] 2 FC 489 (FCTD); and *Gesco Industries Inc v Sim & McBurney* (1997), 76 CPR (3d) 289 (FCTD), aff’d (2000), 9 CPR (4th) 480 (FCA)] and that the facts as presented in the Shaw affidavit are “insufficient to create the logical inference that semi synthetic all-weather greases are included in ‘lubricating oils’”. The Requesting Party notes that the Owner has provided no expert evidence or other explanation in its evidence regarding its classification of such greases as “lubricating oils” and submits that this “ambiguity” should be interpreted against the Owner.

[28] In support, the Requesting Party relies on *Smart & Biggar v Constellation Brands Quebec, Inc*, 2015 TMOB 82, 138 CPR (4th) 128, wherein it was held that the registered good “*liqueurs*” did not include wine, despite a statement in the owner’s affidavit to that effect.

[29] The Requesting Party also relies on the *Merriam-Webster* dictionary’s definition of “lubricating oil” as “an oil (as a petroleum distillate or a fatty oil) used as a lubricant” as an indication that “greases” are not included.

[30] The Owner, for its part, submits that the explanation of its Lubricants Sales Manager—who is unequivocal in equating the EPIC brand greases sold in Canada with “lubricating oils”—should be given substantial weight and, in the absence of evidence to the contrary, be accepted at face value.

[31] The Owner further submits that the *Merriam-Webster* online dictionary actually supports Mr. Shaw’s explanation. The Owner notes that this dictionary defines “grease” as “oily matter” and defines “oil” as “any of numerous unctuous combustible substances that are liquid or can be liquefied easily on warming, are soluble in ether but not in water, and leave a greasy stain on paper or cloth” while also listing “oil” as being synonymous with “grease”. The Owner adds that *Dictionary.com* defines “grease” as “fatty or oily matter in general; lubricant”.

[32] Neither party provides extracts from the aforementioned dictionaries; however, the Registrar may take judicial notice of dictionary definitions [see *Tradall SA v Devil’s Martini Inc*, 2011 TMOB 65, 92 CPR (4th) 408]. Having exercised that discretion, I confirm that the online dictionaries at *merriam-webster.com* and *dictionary.com* include the definitions cited by both parties, although the listing of “grease” as a synonym for “oil” appears to be only for the verb “oil” rather than the noun.

[33] I would first note that what the Federal Court has found to be inadequate in section 45 proceedings are assertions of *use* (a matter of law) as opposed to assertions of *facts* showing use [*Mantha & Associés/Associates v Central Transport Inc* (1995), 64 CPR (3d) 354]. An owner may “show” use of its trademark in association with registered goods “by describing facts from which the Registrar or the Court can form an opinion or can logically infer use within the meaning of section 4” [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245, 56 CPR (4th) 401 at para 18]. In the present case, Mr. Shaw’s statement that that the type of greases developed under the EPIC brand in Canada are also known as “lubricating oils” is an assertion of a fact tying the images of EPIC branded products in evidence to a registered good, thereby supporting a conclusion of use of the Mark in association with that registered good.

[34] Furthermore, notwithstanding the Requesting Party’s submissions, I see no reason not to take Mr. Shaw’s characterization of the products at face value. Indeed, I accept that Mr. Shaw, by virtue of his position as Lubricants Sales Manager and his responsibility for “overseeing the

sales and marketing of lubrication products in Canada”, would be in a position to have knowledge of how lubrication products are known and described in Canada, especially those sold and marketed by the Owner in Canada. Contrary to the Requesting Party’s submissions, an affiant’s specific, factual statements must generally be accorded substantial credibility in a section 45 proceeding [*Ogilvy Renault v Compania Roca-Radiadores SA*, 2008 CarswellNat 776 (TMOB)]. The owner’s evidence must be considered as a whole and the exhibits interpreted in conjunction with the statements made in the affidavit [see, for example, *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)].

[35] I find the situation in *Constellation Brands Quebec* to be distinguishable. In that case, the registered goods were defined using the French term “*liqueurs*” (in English, “liqueurs”); however, use of the trademark at issue during the relevant period appeared to be in association with wine only. Although the Owner’s affiant affirmed that, according to her experience in the alcoholic beverages field, the term “*liqueurs*” encompasses wines, she stopped short of confirming that *the specific wines sold under the mark* could be classified as such.

[36] In the present case, Mr. Shaw is clear and unambiguous in stating that the greases developed under the Mark in Canada are also known as “lubricating oils”; in referring to the products depicted at Exhibit A as “lubricating oils”; and in referring to the products identified by the Mark in the invoices at Exhibit B as “lubricating oils”.

[37] In any event, it is well established that, when interpreting a statement of goods in a section 45 proceeding, one is not to be “astutely meticulous when dealing with [the] language used” [see *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654, 51 CPR (4th) 434 at para 17]. Furthermore, one should avoid “expunging a trade-mark, the use of which is established in accord with ss. 45(1), solely on the basis of an ambiguous description of the wares subject to [the] trade-mark” as that result would be “inconsistent with the purpose of s. 45” [see *Fetherstonhaugh & Co v ConAgra Inc*, 2002 FCT 1257, 23 CPR (4th) 49 at para 23]. Section 45 proceedings are not intended to try contested issues of fact or to provide an alternative to the usual *inter partes* attack on a trade-mark envisaged by section 57 of the Act [*Meredith & Finlayson v Canada (Registrar of Trade Marks)* (1991), 40 CPR (3d) 409 (FCA)].

[38] In the present case, the Owner has demonstrated use of the Mark in Canada during the relevant period in association with products labelled as “GREASE”. In view of Mr. Shaw’s attestations regarding the nature of these products, I accept that they fall within the scope of the goods defined in the registration as “lubricating oils”.

[39] As for “other petroleum products”, there is no evidence that the Mark has been used in Canada with any petroleum products other than the “greases” that Mr. Shaw classifies as “lubricating oils”.

DISPOSITION

[40] In view of all the foregoing, I am only satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “lubricating oils” within the meaning of sections 4 and 45 of the Act.

[41] As the Owner furnished no evidence of special circumstances excusing non-use of the Mark within the meaning of section 45(3) of the Act, the registration will be amended to delete the remaining goods.

[42] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following from the statement of goods:

Gasoline ... and other petroleum products.

[43] The amended statement of goods will be as follows:

Lubricating oils.

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No hearing held

AGENTS OF RECORD

Gowling WLG (Canada) LLP

FOR THE REGISTERED OWNER

Fillmore Riley LLP

FOR THE REQUESTING PARTY