



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

**Citation: 2017 TMOB 25**  
**Date of Decision: 2017-02-27**

<b>Petronas Lubricants Italy S.p.A.</b>	<b>Opponent</b>
<b>and</b>	
<b>Sasol Olefins &amp; Surfactants GmbH</b>	<b>Applicant</b>
<b>1,593,167 for PARAFOL</b>	<b>Application</b>

[1] On September 7, 2012, Sasol Olefins & Surfactants GmbH (the Applicant) applied for registration of the trade-mark PARAFOL for use in association with goods including hydrocarbons for use as solvents, chemical raw materials and base materials, and paraffins. The Applicant's application is based on use in Canada of the trade-mark in association with the applied-for goods since May, 2009.

[2] Petronas Lubricants Italy S.p.A. (the Opponent) owns a registration for the trade-mark PARAFULL for use in association with a number of different chemicals for internal combustion engines in vehicles as well as motor fuel additives, brake fluids, antifreeze and power steering liquids.

[3] The Opponent has primarily opposed this application on the basis that the Applicant's claimed date of first use is inaccurate. The Opponent alleges that the Applicant was not using the trade-mark PARAFOL in association with the applied-for goods in Canada as of May 2009. The Opponent has also opposed this application on the basis that the trade-mark PARAFOL is confusing with its registration for the trade-mark PARAFULL.

[4] For the reasons that follow, I find that the application should be refused with respect to the applied-for goods since the Applicant has not proven that it had used the trade-mark PARAFOL as of the claimed date. I also find that the application should be refused for the applied-for goods with the exception of the goods specified as “hydrocarbons for use in cosmetics or pharmaceuticals” on the basis that the Applicant has failed to demonstrate that there is no reasonable likelihood of confusion between the trade-mark PARAFOL and the Opponent’s registered trade-mark PARAFULL.

#### File Record

[5] The application for the trade-mark PARAFOL (the Mark) was filed on September 7, 2012 on the basis of the Applicant’s use in Canada of the Mark since May 2009. When advertised on July 10, 2013, the application covered the following goods:

Hydrocarbons for use as solvents, process oils, chemical raw materials and base materials; hydrocarbon waxes and paraffins; chemical additives for latent heat storage, metalworking, industrial cleaning and drilling fluids.

[6] The Opponent filed a statement of opposition on December 9, 2013. The grounds of opposition can be summarized as follows:

- Contrary to section 30(a) of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act) the application does not contain a statement in ordinary commercial terms of the specific goods in association with which the Mark has been used.
- Contrary to section 30(b) of the Act, at the date of filing the application, the Applicant had not used the Mark, as alleged, or at all, or had subsequently abandoned the Mark.
- Contrary to section 30(i) of the Act, at the date of filing the application, the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the goods, given that a search of the Canadian Trade-marks Register would have located the Opponent’s registration No. TMA830,541 for PARAFULL. The Applicant knew or ought to have known of the Opponent’s registration prior to its date of application.

- The Mark is not registrable in view of section 12(1)(d) of the Act because it is confusing with registration No. TMA830,541 for PARAFULL.
- The Mark is not distinctive having regard to section 2 of the Act because it is not capable of distinguishing the applied-for goods from the goods and services of others, particularly the Opponent's goods sold under the trade-mark PARAFULL, nor is it adapted to so distinguish them.
- The Mark is not distinctive having regard to section 2 of the Act because the Mark is and has been used outside the scope of the permitted use provided for by section 50 of the Act.

[7] The Applicant served and filed a counter statement.

[8] In support of its opposition, the Opponent filed a certified copy of its registration and an affidavit of Jeannine Summers. In support of its application, the Applicant filed the affidavit of Dr. Thoralf Groß. Neither Ms. Summers nor Dr. Groß were cross-examined.

[9] Only the Opponent filed a written argument and both parties attended a hearing held on October 11, 2016. Just prior to the hearing, the Applicant requested that the goods be amended. As the proposed amendment is acceptable under the *Trade-marks Regulations*, SOR/96-105, the amendment has been placed of record and the application now covers the following goods (the Goods):

Hydrocarbons for use as chemical raw materials and base materials for technical applications and for use in cosmetics or pharmaceuticals; hydrocarbon waxes and paraffins; chemical additives, namely, hydrocarbons for latent heat storage; none of the aforementioned goods intended for use as antifreezes, anti-rust preparations, anti-limescale liquids, fuel stabilizers, coolants for internal combustion engines, preparations for descaling and cleaning, automotive lubricating oil, industrial lubricating oil, motor fuel additive, brake fluid, anti-freeze fluids or power steering liquid.

### Onus and Material Dates

[10] 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].

[11] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(i) - the date of filing the application [see *Georgia-Pacific Corp. v Scott Paper Ltd.* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co. v Canadian Exhibition Management Inc.* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (FC)].

### Preliminary Issue

[12] The Opponent submits that Dr. Groß's evidence is inadmissible since it is not a proper affidavit. On page 4 of Dr. Groß's affidavit, the jurat section has been crossed out and is not signed by the notary, and on page 5 the following appears:

I hereby certify that the above is the true signature, subscribed in my presence, of Mr. Dr. Thoralf Groß, of Lilienweg 4, 25541 Brunsbüttel, Germany, born 10th of September 1972, who is personally known to me.

Brunsbüttel, the 2th day of October 2014

Nagel, Notary public

[13] The Opponent submits that a document which attaches a notary's certification which merely attests to the identity of a signatory and not that the signatory has been sworn is not a proper affidavit. In support, it cites *Industria de Diseno Textil, S.A. v FFAUF S.A.*, 2015 TMOB 3 at paras 13-17. The Opponent further argues that the affidavit was not sworn in accordance with the provisions of the *Canada Evidence Act*, RSC 1985 c. C-5.

[14] I find, however, that the evidence filed by the Applicant is an affidavit of Dr. Groß as the statement of the notary public indicates "subscribed in my presence" and subscribe means "write or sign (one's name) at the bottom of esp. a document as a witness or consenting party" (see *Canadian Oxford Dictionary*, 2<sup>nd</sup> ed). Furthermore, each of the jurat sheets attached to the exhibits indicate "this is exhibit [] to this affidavit of Dr. Thoralf Groß sworn before me..." and are signed by the notary.

[15] Further in keeping with the Registrar's practice of accepting affidavits from other countries, and in the absence of any indication that this affidavit was not duly executed according to the laws of Germany, I have concluded that this affidavit is acceptable for the purposes of these proceedings [see, for example, *Fasken Martineau DuMoulin LLP v In-N-Out Burgers*, 2007 CanLII 80990 (TMOB)].

#### Analysis of the Grounds of Opposition

[16] At the hearing, the parties primarily focused on the section 30(b) and section 12(1)(d) grounds of opposition. I will therefore begin my analysis with these grounds.

#### Section 30(b) Ground of Opposition

[17] The Opponent alleges that the application does not comply with section 30(b) of the Act as the Applicant had not used the Mark as alleged, or at all, or had subsequently abandoned the Mark. Section 30(b) of the Act requires that there be continuous use of the Mark since the date claimed [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)]. The evidential burden on the Opponent respecting the issue of the Applicant's non-compliance with this section of the Act is lighter because the facts supporting the use of the

Mark are particularly within the knowledge of the Applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)].

[18] An opponent need only produce evidence to support its objections or adduce evidence from which it may reasonably be concluded that the facts alleged to support this ground of opposition exist [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at para 34]. There is no requirement that the evidence be clearly inconsistent with the claimed date of first use where an opponent is not relying on evidence filed by the applicant in the opposition proceeding [*Bacardi, supra* at para 33].

*The Opponent Meets Its Evidential Burden with Respect to the Claimed Date of Use*

[19] Ms. Summers, a paralegal employed by the agent for the Opponent, attaches to her affidavit the following evidence concerning the Applicant's use of the Mark:

- a. Printouts dated June 17, 2014 from the website *www.sasol.com* which appears to pertain to the Applicant (para 5, Exhibit B) and printouts dated September 26, 2013 from the website *www.sasoltechdata.com* which provides "different ways to locate product information" through either product family groups and product application / end use (Exhibits C and D). The printouts dated September 26, 2013 both reference the PARAFOL trade-mark.
- b. Archived versions of the pages referenced in Exhibits C and D archived by the internet archive WayBack Machine. Archived versions of the Product Information Webpage dated between July, 2009 and September, 2012 are attached and only the archived page dated September 17, 2012 displays the Mark (Exhibit E). Archived versions of the "Normal Paraffins" webpage dated July 13, 2009 and April 1, 2012 are also attached and only the archived page dated April 1, 2012 displays the Mark (Exhibit F).
- c. A printout of the MSDS (Material Safety Data Sheets) page for PARAFOL obtained through the link on the Normal Paraffins webpage with a "print date" and "revision date" of March 4, 2011 (Exhibit G). A link to this MSDS sheet

only appears on the archived versions of the website dated after May 2009 (Exhibit F).

[20] While Ms. Summers is employed by the Opponent's agent and her evidence is directed towards whether the Applicant has used the Mark in Canada, I do not find that her evidence should be afforded diminished weight as it is not the type of opinion evidence such as that in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2006 FCA 133. In this regard, website printouts obtained by affiants who are employed by agents for parties in opposition proceedings have been accepted in numerous proceedings [see, for example, *Zip.ca Inc v BBY Solutions, Inc*, 2014 TMOB 96 at para 15; *Canadian Jewellers Association v American Gem Society*, 2010 TMOB 106].

[21] Further, even though they are hearsay, I find that the printouts from *www.sasol.com* and *www.sasoltechdata.com* are admissible. In this respect it was necessary for the Opponent to file them to challenge the section 30(b) claim to use and they are reliable since the Applicant appears to have participated in their creation and had the opportunity to refute the evidence [see, for example, *Reliant Web Hostings Inc v Tensing Holding BV*, 2012 CarswellNat 836 (TMOB) at para 35]. With respect to the pages from Wayback Machine, WayBack Machine has been found to be generally reliable [*Candrug Health Solutions Inc v Thorkelson* 2007 FC 411 at para 21; reversed on other grounds 2008 FCA 100]. More particularly, Wayback Machine evidence in support of an opponent's section 30(b) ground of opposition has been found admissible [*Royal Canadian Golf Assn v O.R.C.G.A.*, 2009 CanLII 90300 (TMOB)].

[22] Although the absence of any use of a trade-mark on a party's website at the relevant time does not support a conclusion that the Mark was not in use, in my view, it may be sufficient to cast doubt on a claimed date of first use [see, for example, *Home Hardware Stores Limited v 1104559 Ontario Ltd*, 2013 TMOB 210]. Further, even though at the hearing the Applicant submitted that printouts from other websites were not included in Ms. Summers' affidavit, in particular *sasolgermany.de*, the fact that the Mark did appear after the claimed date of first use on the *www.sasoltechdata.com* website but not before is sufficient for the Opponent to meet its burden in this case. With respect to the suggestion that the Mark may have been on other

websites, if this was the case, I find that this would have been a simple matter for the Applicant to address through cross-examination or in its own evidence.

[23] I therefore find that the Opponent has met the light initial burden upon it in respect of the issue of non-conformance with section 30(b) of the Act.

*The Applicant Fails to Meet its Legal Burden With Respect to Use*

[24] As the Opponent has met its evidential burden, I must now assess whether the Applicant has proven it has used the Mark as of the date claimed in the application. As explained in *Jamieson Laboratories Ltd v Jensens Laboratories Inc*, 2013 TMOB 226 at para 34:

The Applicant must show that there has been use of the Mark, within the meaning of section 4(1) of the Act, in association with each of the Goods at the alleged date of first use mentioned in the application up to the filing date of the application. A simple bald assertion of use is not sufficient. There has to be documentary evidence to support such allegation.

[25] In his affidavit, Dr. Groß states that the Mark has been used in Canada since May 2009 by its licensee (paras 2, 10), yet only provides invoices in support dated from October 5, 2009 onwards (Exhibit I). Dr. Groß further provides that Canadian gross annual sales in 2009-2010 of PARAFOL branded products was 32,000 Euros (para 12), but provides no particulars with respect to May 2009.

[26] On a balance of probabilities standard, I conclude that Dr. Groß's evidence is insufficient to meet the Applicant's burden. His bald assertion of use in May 2009 remains uncorroborated by documentary evidence or further detailed statements which would allow me to conclude that use within the meaning of section 4(1) of the Act occurred in May 2009. On the evidence of record, I cannot find that any transfer of property in or possession of Goods bearing the Mark from the Applicant to a Canadian customer took place in May 2009. As such, the Applicant fails to meet its burden and this ground of opposition succeeds.

*Section 12(1)(d) Ground of Opposition*

[27] With respect to a section 12(1)(d) ground of opposition, an opponent's initial evidential burden is met if a registration relied upon in the statement of opposition is in good standing as of



the date of the decision. The Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd.* (1986), 11 CPR (3d) 410 (TMOB)]. In this case, I have exercised that discretion and confirm that the Opponent's registration No. TMA 830,541 for PARAFULL for use in association with the following goods is in good standing:

Chemicals, namely, antifreezes, anti-rust preparations, anti-limescale liquids, fuel stabilizers, coolants for internal combustion engines, namely, for motor vehicles, tractors, earth-moving machines, commercial and industrial vehicles, 2/4 stroke engines for motor vehicles, fixed and naval engines; preparations for descaling and cleaning radiators, internal combustion engines and related cooling circuits; automotive and industrial lubricating oils; motor fuel additives; brake fluids; protective anti-freeze fluids for compressed-air braking systems of industrial vehicles; power steering liquids. (the Registered Goods).

[28] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[29] In applying the test for confusion, the Registrar must have regard to all of the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[30] These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc. v 3894207 Canada Inc.* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc. v Alavida Lifestyles Inc.* (2011), 96 CPR (4th) 361 (SCC)].

### *Inherent Distinctiveness*

[31] The parties' trade-marks have a similar degree of inherent distinctiveness as each are coined words. They, however, don't have a high degree of inherent distinctiveness. It appears that the component "para" may suggest paraffin to some consumers or a chemical including a structure with diametrically opposite carbon atoms in a benzene ring [see definition of para in the *Canadian Oxford Dictionary* (2 ed.); see *Tradall SA v Devil's Martini Inc* (2011), 2011 TMOB 65 (CanLII), 92 CPR (4th) 408 (TMOB) at para 29 which confirms that I may take judicial notice of dictionary definitions].

### *Extent to Which Marks Have Become Known*

[32] This factor favours the Applicant, who has evidenced use of the Mark by its licensee on labels (Groß affidavit, Exhibit J) and on invoices (Groß affidavit, Exhibit I) and confirmed sales in Canada totaling over 58,000 Euros between the years 2009-2010 and 2011-2012 (Groß affidavit, para 12). I accept the use of PARAFOL followed by a numerical identifier (ie) PARAFOL 12-97 is use of the Mark [see, for example, *Rhodia Operations v Oleon, naamloze vennootschap*, 2016 TMOB 10 at para 21]. In contrast, there is no evidence that the Opponent's registered trade-mark has become known to any extent in Canada.

### *Length of Time in Use*

[33] This factor favours the Applicant, as it has established use of the Mark as of October 5, 2009 (Groß affidavit, Exhibit J). In contrast, there is no evidence that the Opponent's registered trade-mark has been in use in Canada.

### *Nature of Goods, Business and Trade*

[34] When considering the nature of the goods in respect of the issue of confusion, it is the statements of goods in the subject application and registration that govern [*Mr. Submarine Ltd. v Amandista Investments Ltd.* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc. v Dale Bohna*, [1995] 1 FCR 614]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that

might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods set out in the subject application or registration [*McDonald's Corp. v Coffee Hut Stores Ltd.*, 1996 CanLII 3963 (FCA); *Procter & Gamble Inc. v Hunter Packaging Ltd.* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp. v Alcon Pharmaceuticals Ltd.* (2000), 5 CPR (4th) 110 (TMOB)].

[35] In this case, with respect to the goods described as “hydrocarbons for use in cosmetics or pharmaceuticals”, I do not find any overlap in the nature of the goods, business or trade with any of the Opponent’s Registered Goods.

[36] However, there is at least some overlap between the remaining Goods which are not restricted to use with any particular sector and the Opponent’s Registered Goods because the Applicant’s evidence indicates that PARAFOL can be used in the automotive field for latent heat storage (Groß affidavit, Exhibits B and C). Finally, even with the restriction in the Goods, it is not clear that the remaining goods described, hydrocarbons for use as chemical raw materials and base materials for technical applications, hydrocarbon waxes and paraffins, and chemical additives for latent heat storage, are not for use in the automotive or vehicle sector.

#### *Degree of Resemblance*

[37] With respect to degree of resemblance, the parties’ trade-marks are almost identical in appearance and sound. While I do not find that I have sufficient evidence to conclude what specifically, each parties’ trade-marks would suggest to consumers, even if I found that the trade-marks suggest different ideas, given the high degree of resemblance between them in appearance and as sounded, I would still find the overall degree of resemblance to be significant.

#### *No Evidence of Confusion*

[38] The Applicant submits that the lack of evidence of confusion is a surrounding circumstance favouring it. An adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by an opponent [*Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA at para 19]. However, in the present case, I cannot draw such an inference because there is no evidence of extensive concurrent use.

### *Date of Entitlement*

[39] At the hearing, the Applicant raised the issue that its date of first use pre-dates the filing date of the application leading to the Opponent's registration for PARAFULL. I do not find this to be a surrounding circumstance which favours the Applicant. First, the validity of the Opponent's registration is not at issue in this opposition proceeding [*Molson Canada 2005 v Anheuser-Busch, Incorporated*, 2010 FC 283]. Second, in *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 412 (FCA), the Federal Court of Appeal explained that the decision to register or refuse an application should be decided at the date of decision on an accurate state of the record. Such a state of the record includes trade-mark registrations which may have a later entitlement date than that of the subject application.

### *Conclusion*

[40] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the Goods at a time when he or she has no more than an imperfect recollection of the Opponent's PARAFULL trade-mark used in association with the Opponent's Registered Goods and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée et al.*, 2006 SCC 23 at para 20].

[41] With respect to the goods specified as "hydrocarbons for use in cosmetics or pharmaceuticals", in view of my findings above, such a consumer would not, as a matter of first impression, be likely to believe that such goods associated with the Mark and the Opponent's PARAFULL trade-mark were manufactured, licensed or performed by the Opponent. While the parties' marks may be almost identical in appearance and as sounded, as these goods are directed at entirely different industries, the balance of probabilities shifts in favour of the Applicant.

[42] With respect to the remaining goods in the application, however, I find that the Applicant has not met its legal onus of demonstrating that there is no reasonable likelihood of confusion, on a balance of probabilities, due to the overwhelming resemblance between the trade-marks and the fact that these goods may be used in the automotive sector.

[43] As such, the section 12(1)(d) ground of opposition is rejected with respect to the following goods: “hydrocarbons ... for use in cosmetics or pharmaceuticals” and succeeds with respect to the following goods:

Hydrocarbons for use as chemical raw materials and base materials for technical applications ...; hydrocarbon waxes and paraffins; chemical additives for latent heat storage; none of the aforementioned goods intended for use as antifreezes, anti-rust preparations, anti-limescale liquids, fuel stabilizers, coolants for internal combustion engines, preparations for descaling and cleaning, automotive lubricating oil, industrial lubricating oil, motor fuel additive, brake fluid, anti-freeze fluids or power steering liquid

#### Remaining Grounds of Opposition

[44] Having already refused most of the Goods under two grounds, I will not discuss the remaining grounds of opposition with respect to this application.

#### Disposition

[45] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

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Natalie de Paulsen  
Member  
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: 2016-10-16

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