



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

Citation: 2017 TMOB 157

Date of Decision: 2017-11-28

IN THE MATTER OF SECTION 45 PROCEEDINGS

Dentons Canada LLP

Requesting Party

and

Penn West Petroleum Ltd.

Registered Owner

TMA811,232 for UNLOCKING

Registrations

ENERGY and

TMA811,233 for UNLOCKING

ENERGY & Design

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA811,232 for the trade-mark UNLOCKING ENERGY, and TMA811,233 for the trade-mark UNLOCKING ENERGY & Design (the Design Mark), shown below (collectively, the Marks), owned by Penn West Petroleum Ltd.:



[2] The Marks are currently registered in association with the following goods and services:

Goods:

- (1) Fuels, namely, liquid petroleum gas, liquid crude oil, natural gas, natural gas liquids, natural gas condensers, and by-products thereof, all for industrial and residential use.
- (2) Natural gas and derivatives thereof, namely ethane, propane, butane and pentane.
- (3) Coal bed methane and derivatives thereof, namely methane.

Services:

- (1) Operation of oil and gas wells.
- (2) Exploration for petroleum, crude oil and natural gas.
- (3) Exploration for coal bed methane.
- (4) Extraction of petroleum, crude oil and natural gas.
- (5) Extraction of coal bed methane.
- (6) Petroleum, crude oil and natural gas refining and processing.
- (7) Refining, processing and upgrading of petroleum, crude oil, natural gas and derivatives thereof.
- (8) Transportation (by pipeline, boat, rail and truck) of petroleum, crude oil and natural gas.
- (9) Storage and delivery of petroleum, crude oil, natural gas and processed petroleum products.
- (10) Sales, brokerage, processing, transport and delivery (by pipeline, boat, rail and truck) of petroleum, crude oil, natural gas and processed petroleum products.
- (11) Management services in the field of exploration and searching for energy assets and natural resource assets, namely petroleum, crude oil, coal bed methane, oil and natural gas assets.
- (12) Management services in the field of developing, acquiring, managing, operating, holding and commercially exploiting energy assets and natural resource assets, namely petroleum, crude oil, coal bed methane and natural gas assets.

[3] For the reasons that follow, I conclude that the registrations ought to be amended to delete the goods in their entirety and amended to maintain services limited to exploration services only.

THE PROCEEDINGS

[4] On October 28, 2015, the Registrar of Trade-marks sent notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Penn West Petroleum Ltd. (the Owner). The notices were sent at the request of Dentons Canada LLP.

[5] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between October 28, 2012 and October 28, 2015, in association with each of

the goods and services specified in the registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date when the Marks were 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 notices, the Owner furnished affidavits of Kenneth A. Born, both sworn January 25, 2016. The affidavits are largely identical, with the exception of three additional exhibits (Exhibits F, G, and H) and a paragraph related thereto with respect to TMA811,233 (the Design Mark).

[9] Only the Requesting Party filed written submissions. An oral hearing was not requested.

THE EVIDENCE

[10] Mr. Born is a graphics analyst for the Owner, in the Corporate Planning & Capital Markets Department. Mr. Born attests that he originally created the graphic design that was later registered as the Design Mark.

[11] Mr. Born explains that the Owner is an oil and gas producer currently operating in Alberta, Saskatchewan and British Columbia. He states that the Owner “conducts generally the Goods and Services in its business operations”, and that he believes the Owner has used the Mark in Canada in its business operations during the relevant period.

[12] In support, Mr. Born states that, prior to December 9, 2010, he created a new business card that incorporated the Marks on the reverse side of the contact information. He attaches a copy of the business card design under Exhibit A to his affidavit. The Design Mark appears on one side of the card with a website address, while the other side features the words PennWest Exploration, with the Owner’s name in full, together with a Canadian address and contact information. Otherwise, I note that none of the particular registered goods or services are advertised on the card. He states that all new and replacement business cards for the Owner’s employees and contractor representatives were printed with this design during the period between September 11, 2012 and November 28, 2013. He attests that the company had approximately 2,000 employees in September 2012 and 1,450 employees in November 2013. He attaches as Exhibit B to his affidavit a string of emails from September 2012, which he states confirms that this business card design was used “at least from September 11, 2012 to “the end of November” 2013.”

[13] Mr. Born states that, in or about July 2013, he began designing a new business card which incorporated a new QR code in place of the Mark. He states that on November 29, 2013, he provided the Manager of the Owner’s Corporate Resources Department with updated logo files to be used for all future business card orders, with instructions that current business card supplies were to be used until they ran out. In support, he provides a copy of an email that he had sent to this individual in this regard (Exhibit C). He states that this individual, in turn, sent the updated logo files to the Owner’s stationary printer the next day, as per an email that he attaches as Exhibit D to his affidavit.

[14] Mr. Born concludes his TMA811,232 affidavit by confirming that his instructions to the Manager of the Owner’s Corporate Resources Department were that the new business card design was only to be used after the existing business cards (per Exhibit A) were depleted. He explains that, as a result, there continues to be employees who have not ordered new business

cards and are still using the earlier business card per Exhibit A for business purposes. He attests that on January 21, 2016, he randomly visited 29 of the Owner's employees and found that nine of them were still using the earlier Exhibit A version of the business card for business purposes. In support, he attaches as Exhibit E to his affidavit, the nine employee business cards that he found to still be in use based upon his inquiries. He states that based upon the number of employees that he found to still be using the older business card, that he believes a significant number of employees of the Owner continue to use the Exhibit A business card.

[15] With respect to Mr. Born's affidavit submitted in support of TMA822,233, the Design Mark, in addition to the aforementioned, he states that on or about June 2013, he created a design for oval stickers for hardhats incorporating the design portion only of the Design Mark, together with the words "Be Calm and Frac On". He states that the stickers were distributed for promotional purposes through the Owner's Drilling, Completions, Lease Construction and Well Servicing Departments, mainly to field personnel. He provides as Exhibits F, G, and H, respectively, an image of the sticker, a copy of his original graphic design, and a copy of the e-mail from the printer in respect of the job quotation, proof and order.

ANALYSIS AND REASONS FOR DECISION

Goods

[16] With respect to both registrations, the evidence only consists of business cards. At best, the use of a trade-mark on a business card constitutes advertising, and it is well established that advertising materials cannot generally serve as evidence of use for goods [see *BMW Canada Inc v Nissan Canada Inc* (2007), 60 CPR (4th) 181 (FCA)].

[17] Here, there is no evidence that the Marks were associated with the goods or that the goods were sold in Canada during the relevant period. Furthermore, there is no evidence of special circumstances which would excuse the absence of such use.

[18] Accordingly, the goods will be deleted from the registration.

Services

[19] As previously indicated, in accordance with section 4(2) of the Act, 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.

[20] In some circumstances, including where business cards have indicia of the relevant services on them or there are clear statements alleging use in the affidavit, business cards can be considered evidence of the advertisement of services [see, for example, *88766 Canada Inc v RH Lea & Associates Ltd* 2008 CarswellNat 4513 (TMOB); *Tint King of California v Canada (Registrar of Trade-marks)*, 2006 FC 1440, 56 CPR (4th) 223].

[21] The Requesting Party submits that the business card design in Exhibit A does not provide any indicia of the Owner's services and Mr. Born does not provide any details regarding the use of the business cards or of the circumstances in which the business cards were distributed during the relevant period. That is, the Requesting Party submits, and I agree, there is no evidence with respect to how many business cards were distributed, to whom the business cards were distributed, or when the business cards were distributed.

[22] I note that displayed on the business card in Exhibit A are the words PennWest and Exploration. However, absent further particulars regarding the circumstances of actual distribution of the business cards and the nature of the Owner's specific activities during the relevant period, I do not consider the mere presence of the word "Exploration" on the business cards to constitute promotion of the particular registered services set out therein. Indeed, the affiant does not speak to any actual performance of the Owner's "exploration for petroleum, crude oil and natural gas" or "exploration for coal bed methane". Rather, one is left to speculate that the Owner's exploration services, if performed or available to be performed in Canada during the relevant period, were indeed for petroleum, crude oil, natural gas and/or coal bed methane. This is compounded by the fact that Mr. Born does not even confirm that the subject business cards were distributed to customers or potential customers.

[23] Furthermore, in addition to the above-mentioned deficiencies, there are no further services indicia on the business cards, and there is nothing in the evidence that would permit me

to infer that such use of the Marks on the business cards extends to any of the remaining services.

[24] With respect to the evidence of oval stickers for hardhats incorporating the design portion only of the Design Mark, submitted in support of TMA822,233, I agree with the Requesting Party that such use is substantially different from the Design Mark. Not only is the design altered, but most importantly, the word portion “unlocking energy”, an integral feature of the Design Mark, is absent, having been replaced by the words “Be Calm and Frac On”. The Design Mark therefore is no longer recognizable [*Canada (Registrar of Trade-marks) v Cie International pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 at 525 (FCA); and *Promafil Canada Ltée v Munsingwear Inc*, 44 CPR (3d) at 59 (FCA)].

[25] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Marks in association with the registered services within the meaning of sections 4 and 45 of the Act. Furthermore, there is no evidence before me of special circumstances excusing such non-use.

DISPOSITION

[26] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registrations will be expunged in compliance with the provisions of section 45 of the Act.

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**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Burnet Duckworth & Palmer LLP

FOR THE REGISTERED OWNER

Blake, Cassels & Graydon LLP

FOR THE REQUESTING PARTY