



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 8

Date of Decision: 2020-01-29

IN THE MATTER OF AN OPPOSITION

Longyear TM, Inc.

Opponent

and

Raymond J. Roussy

Applicant

1,594,052 for SONIC

Application

INTRODUCTION

[1] Longyear TM, Inc. (the Opponent) opposes registration of the trademark SONIC (the Mark) which is the subject of application No. 1,594,052 (the Application) in the name of Raymond J. Roussy (the Applicant) filed on September 13, 2012.

[2] The Application is based on use of the Mark in Canada since 1979 in association with the following goods and services (the Goods and Services):

Goods

(1) Drills for geological drilling and parts therefor

Services

(1) Geological drilling services

(2) Sale of drills for geological drilling and parts therefor

[3] The Application was advertised for opposition purposes in the *Trademarks Journal* on January 20, 2016.

[4] On February 27, 2016, the Opponent filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. References in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date), or unless otherwise specified.

[5] The Opponent raises grounds of opposition based upon non-distinctiveness under section 2, non-registrability under sections 12(1)(b), 12(1)(c) and 12(1)(d), non-entitlement under section 16, and non-compliance with sections 30(a), (b) and (i) of the Act. With respect to the section 12(1)(d) and section 16 grounds of opposition, the Opponent alleges a likelihood of confusion with its trademark TRUSONIC which is the subject of Canadian registration No. TMA850,153.

[6] In support of its opposition, the Opponent filed the affidavit of Kristian Shayne Drivdahl, which is discussed in further detail, below. Mr. Drivdahl was not cross-examined on his affidavit. The Applicant elected not to file any evidence.

[7] Both parties filed written arguments and were represented at an oral hearing.

EVIDENCE

The Opponent's Evidence

[8] The Opponent's evidence is comprised of the affidavit of Kristian Shayne Drivdahl sworn November 8, 2016 (the Drivdahl Affidavit). Mr. Drivdahl is the Vice President, Engineering, of the Opponent, having held that position for 3 years and having been an employee of the Opponent for 10 years. Mr. Drivdahl describes himself as "generally familiar with the drilling business".

[9] Mr. Drivdahl describes the Opponent as follows:

The Opponent was formed on May 5, 2005 to hold the intellectual property of the Boart Longyear group of companies, which the Opponent licences to the Boart Longyear group of companies. The ultimate beneficial owner of the Opponent is Boart Longyear Limited. Boart Longyear Limited started as E.J. Longyear Company 125 years ago and began operating in Canada in 1912.

[10] Paragraph 5 of the Drivdahl Affidavit describes the Opponent's Canadian registration No. TMA850,153 for the trademark TRUSONIC, which is registered in association with the following goods and services:

Goods

(1) Earth drilling equipment and parts therefor, namely earth drilling machines.

Services

(1) Earth drilling services, namely, angle and vertical drilling, diamond, oriented and thin wall coring, commercial, industrial and municipal water well drilling.

[11] Notably, the Drivdahl Affidavit does not describe, or include examples of, any use of the trademark TRUSONIC in Canada.

[12] Instead, Mr. Drivdahl attests to the descriptive use of the term "sonic" in the geological drilling industry by the Opponent and other parties. At paragraph 8 of the Drivdahl Affidavit, Mr. Drivdahl states as follows:

The word "sonic" is a well-know [*sic*] and commonly used industry term for earth and geological drilling. Research into "sonic" drilling began in the late 1940s. In the late 1960s, Shell Oil Company supported further research and between 1976 and 1983 a British company built approximately 10 drill rigs and 15 "sonic" heads. "Sonic" drill rigs have been used by Boart Longyear and its predecessors from 1985 to the present. Further history on the development of "sonic" drilling, including a diagram on the "Basic Principle of Sonic Drilling" (Figure 1, Page 4) is attached to my Affidavit as Exhibit "A".

[13] Exhibit “A” to the Drivdahl Affidavit is an undated document from Boart Longyear titled “Sonic Drilling”. On page 3 of this document, in a section titled “The Principle of Sonic Drilling”, it states as follows:

Sonic Drilling, Rotasonic, Rotosonic, Sonicore, Vibratory or Resonantsonic Drilling, are some of the many names given to a dual cased drilling system that employs the use of high frequency mechanical vibration to take continuous core samples of overburden and most bedrock formations, and to advance casing into the ground for well construction and other purposes.

[...]

The word sonic appears in most of these names because this drilling technique vibrates the entire drill string at a frequency rate between 50 and 150 hertz or cycles per second. This frequency falls within the lower range of sound vibration that can be detected by the human ear, thus the term sonic has been commonly used to describe this drilling system.

[...]

A sonic drill rig looks and operates very much like any conventional top-drive rotary or auger rig. The main difference is that a sonic drill rig has a specially designed hydraulically powered drill head or oscillator which generates adjustable high frequency vibrational forces.

[14] The remainder of the Drivdahl Affidavit includes other examples of the use of the term “sonic” as a descriptive term in the geological drilling industry. Exhibits “B” through “L” relate to descriptive use of the term “sonic” by the Opponent (or related Boart Longyear entities), while Exhibits “M” through “W” relate to descriptive use of the term “sonic” by third parties.

[15] For example, Exhibit “G” to the Drivdahl Affidavit is a Boart Longyear promotional document entitled “PROJECT NEWS” dated “©2004”, which describes a drilling project at the WAC Bennett Dam in British Columbia in 1996. It reads in part as follows:

WAC Bennett Dam Project

Location: British Columbia, Canada

Service: Dam and Levee
Sonic Drilling

Boring Length: Up to 435 feet (132.59 m)

Completion: August 1996

[...]

The only rig in the world known to fit these requirements was a sonic rig. On June 18, Boart Longyear was called. We responded with a rig two days later and a second rig was added in July. [...]

The sonic drilling program was extremely successful. [...]

[16] Additional exhibits to the Drivdahl Affidavit are discussed in further detail, below, in the analysis of the grounds of opposition.

The Applicant's Evidence

[17] The Applicant did not file any evidence.

ONUS AND MATERIAL DATES

[18] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all of the evidence, then the issue must be decided against the Applicant. 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].

[19] The material dates with respect to the grounds of opposition are as follows:

- Sections 38(2)(a) and 30 of the Act – the filing date of the Application, namely, September 13, 2012 [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Sections 38(2)(b) and 12(1)(b) – the filing date of the Application, namely, September 13, 2012 [*General Housewares Corp v Fiesta Barbeques Ltd* (2003), 28 CPR (4th) 60 (FC)];
- Sections 38(2)(b) and 12(1)(c) – the date of my decision [*David Oppenheimer Co LLC v Imagine IP LLC*, 2011 TMOB 84, 96 CPR (4th) 438 at para 46];

- Sections 38(2)(b) and 12(1)(d) of the Act – the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c) and 16 of the Act – date of use claimed in the Application, namely, 1979 [Section 16(1) of the Act] – as discussed below, this date is treated as December 31, 1979; and
- Sections 38(2)(d) and 2 of the Act – the filing date of the opposition, namely, February 27, 2016 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317 (FC)].

GROUND OF OPPOSITION SUMMARILY DISMISSED

Section 30(a)

[20] With this ground of opposition, the Opponent contends that the descriptions “Drills for geological drilling and parts therefor” and “Sale of drills for geological drilling and parts therefor” are not in compliance with section 30(a) of the Act, because the Applicant has not provided descriptions in ordinary commercial terms of the individual “parts therefor”.

[21] At the oral hearing, the Opponent took the position that the Applicant ought to have listed each of the individual “parts” sought to be covered by the Application, and by way of example identified various drill bits, augers and head assemblies listed in the industry promotional material seen on pages 3 to 10 of Exhibit “W” to the Drivdahl Affidavit under the heading “Sonic Drilling Tools”.

[22] I do not agree with the Opponent’s submissions on this point. The fact that some industry promotional material may include additional specificity when describing certain products is alone not sufficient to demonstrate that the descriptions of Goods and Services in the Application, when considered as a whole, do not comply with section 30(a) of the Act. Further, I note that section 2.4.5.8 of the Canadian Intellectual Property Office *Trademarks Examination Manual*, entitled “Parts and fittings”, addresses this issue and states as follows: “[i]n general, ‘parts’ and ‘fittings’ are acceptable if the goods for which the ‘parts’ and ‘fittings’ are intended are acceptable [...]”. In the present case, there is no suggestion that the descriptions “Drills for

geological drilling [...]” and “Sale of drills for geological drilling [...]” do not comply with section 30(a) of the Act. Thus, I see no basis to impugn the Applicant’s reference to “and parts therefor” in the description of Goods and Services.

[23] Consequently, in my view, the Opponent has not met its initial evidential burden and I dismiss the section 30(a) ground of opposition.

Section 30(b)

[24] With this ground of opposition, the Opponent alleges that the Applicant has not used the Mark in Canada in association with the Goods and Services since the date claimed in the Application, namely, since 1979, or alternatively has not continuously used the Mark in Canada since that date.

[25] However, neither the Opponent nor the Applicant filed any evidence relating to the Applicant’s use of the Mark or the date of use claimed in the Application, and consequently there is no evidence of record by which the Opponent can meet its initial evidential burden for this ground [see *Labatt Brewing Co Ltd v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[26] At the oral hearing, the Opponent suggested that the description of the history of “sonic drilling” included at page 3 of Exhibit “A” to the Drivdahl Affidavit, was sufficient to call into question the date of use claimed in the Application and thus meet the Opponent’s initial evidential burden, because the history described in that document made no mention of the Applicant or its use of the Mark. Respectfully, this argument is without merit. The absence of a specific reference to the Applicant in a document published by the Opponent (or a related Boart Longyear entity), in my view, is not sufficient to meet the Opponent’s evidential burden under this ground.

[27] In view of the above, the Opponent has not met its initial evidential burden and the section 30(b) ground of opposition is dismissed.

Section 30(i)

[28] At paragraph 2(iii) of its statement of opposition, the Opponent pleads that, contrary to section 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark, because at the date of filing the Application, the Applicant was aware or should have been aware, of the Opponent's registered trademark TRUSONIC.

[29] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue, such as evidence of bad faith or non-compliance with a federal statute [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155; and *Canada Post Corporation v Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD)]. Mere knowledge of the existence of an opponent's trademark is not sufficient to support a section 30(i) ground of opposition [see *Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[30] In the present case, the Application contains the requisite statement and there is no evidence that this is an exceptional case involving bad faith or the violation of a federal statute.

[31] Accordingly, the section 30(i) ground of opposition is dismissed.

Section 16

[32] At paragraph 2(e) of its statement of opposition, the Opponent raises a ground of opposition based on section 38(2)(c) in conjunction with section 16 of the Act, alleging that the Applicant is not the party entitled to register the Mark because it is confusing with the trademark and trade name TRUSONIC previously used by the Opponent.

[33] I note that the statement of opposition does not identify the specific sub-section(s) of section 16 on which the Opponent relies; however, given that the Application is based on prior use of the Mark in Canada, it is apparent that the Opponent seeks to rely on section 16(1)(a) and (c) of the Act. With this ground of opposition, the Opponent had an initial evidential burden to demonstrate use of its trademark and/or trade name TRUSONIC in Canada prior to the date of

use claimed in the Applicant's Application, namely, 1979 (which for the purpose of assessing this ground of opposition is treated as December 31, 1979) [see *Khan v Turban Brand Products Ltd* (1984), 1 CPR (3d) 388 (TMOB) at para 4].

[34] However, the Opponent's evidence does not demonstrate any use of TRUSONIC as a trademark or trade name in Canada in association with any goods or services, at *any* time, let alone prior to December 31, 1979. Moreover, the Opponent has no ground of opposition available to it under section 16(1)(b) of the Act, since the Opponent's application for the trademark TRUSONIC matured to registration No. TMA850,153 on May 2, 2013 and thus was no longer pending when the Applicant's Application was advertised on January 20, 2016.

[35] Consequently, the section 16 ground of opposition is dismissed as the Opponent has not met its initial evidential burden.

SECTION 12(1)(B) GROUND OF OPPOSITION – IS THE MARK IS CLEARLY DESCRIPTIVE?

[36] The registrability of the Mark under section 12(1)(b) of the Act must be assessed as of the filing date of the application – in this case, September 13, 2012.

[37] The issue as to whether a mark is clearly descriptive or deceptively misdescriptive of the character or quality of the goods and services must be considered from the point of view of the average purchaser of the goods and services. Further, "character" means a feature, trait or characteristic of the goods and services and "clearly" means "easy to understand, self-evident or plain" [see *Drackett Co of Canada v American Home Products Corp* (1968), 55 CPR 29 (Can Ex Ct) at 34]. The mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD) at 186]. Finally, the purpose of the prohibition in section 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment v Canada (Registrar of Trade Marks)* (1990), 34 CPR (3d) 154 (FCTD) at para 14].

[38] In the present case, the key issue with respect to the section 12(1)(b) ground of opposition is whether the Opponent has satisfied its initial evidential burden. That is to say, has the Opponent provided sufficient evidence from which it could reasonably be concluded that the term “sonic” is clearly descriptive of the character or quality of the Goods and Services to the average Canadian purchaser of geological drills and drilling services? While there are weaknesses in the Opponent’s evidence on this point, in my view, for the reasons set out below, the Opponent has nevertheless met its initial evidential burden under section 12(1)(b).

[39] The word “sonic” is an English dictionary word which is defined in the *Canadian Oxford Dictionary*, 2nd Ed. as “of or relating to or using sound or sound waves” [see *Tradall SA v Devil's Martini Inc* 2011 TMOB 65 (TMOB) at para 29 which states that the Registrar may take judicial notice of dictionary definitions].

[40] As noted above, at paragraph 8 of the Drivdahl Affidavit, Mr. Drivdahl states that “[t]he word ‘sonic’ is a well-know [*sic*] and commonly used industry term for earth and geological drilling.” While I will limit the weight afforded to this statement given that Mr. Drivdahl is not a disinterested party, Mr. Drivdahl was not cross-examined on his affidavit and so the above statement is uncontested in the evidence. Moreover, the statement is supported by other evidence included in the Drivdahl Affidavit.

[41] The Drivdahl Affidavit provides multiple examples of the descriptive use of the term “sonic” by the Opponent (or related Boart Longyear entities) in association with geological drills and drilling services. For example, Exhibit “A” explains that the term “sonic” is used to describe this type of geological drill and drilling service “[...] because this drilling technique vibrates the entire drill string at a frequency rate between 50 and 150 hertz or cycles per second. This frequency falls within the lower range of sound vibration that can be detected by the human ear [...]”. Exhibits “E” and “G” to the Drivdahl Affidavit both describe a drilling project in British Columbia carried out by Boart Longyear in 1996 in which the term “sonic” is used to describe the drilling service (i.e. “sonic drilling”) and the drilling rig itself (i.e. a “sonic rig”).

[42] As noted by the Applicant in its written argument and at the oral hearing, the weaknesses in the Opponent’s evidence are generally twofold. First, the vast majority of the Opponent’s

evidence relates to descriptive use of the term “sonic” in the United States rather than Canada. Second, much of the evidence post-dates the material date, namely, September 13, 2012.

[43] However, in my view, the Opponent has nevertheless provided sufficient evidence to meet its initial evidential burden. In particular, Exhibit “G” to the Drivdahl Affidavit relates to a “sonic drilling” project in British Columbia in 1996, as described in a document dated 2004. Exhibit “E” to the Drivdahl Affidavit - a document dated 2002 - similarly references that same “sonic drilling” project in British Columbia and identifies contact information for Boart Longyear’s Canadian office.

[44] In addition, the fact that the Opponent’s evidence includes references from outside of Canada does not necessarily render them irrelevant, as the issue is not whether the term has been used in a clearly descriptive manner in Canada, but whether the term is clearly descriptive in the English or French language [see *Canadian Inovatech Inc v Burnbrae Farms Ltd* (2003), 31 CPR (4th) 151 (TMOB) at para 13 (*Canadian Inovatech*); *Guess? Inc v Slide Sportswear Inc* (2005), 44 CPR (4th) 380 (TMOB)].

[45] Exhibit “M” to the Drivdahl Affidavit was also the focus of some attention at the oral hearing. This document is a printout from the website of a third party which appears to operate in the United States under the trade name LAYNE. The webpage is entitled “Sonic Drilling” and describes the technology as follows:

The sonic drilling technology was first applied over 40 years ago in Canada.

The sonic head is based upon the principle of high frequency vibration. The hydraulic motors on the exterior of the head oscillate off set internal weights at speeds reaching 5000 rpm. As a result of the weights being off set, it creates vibration in excess of 140 HZ.

[46] At the oral hearing, the Applicant suggested that the statement in Exhibit “M” that “The sonic drilling technology was first applied over 40 years ago in Canada” was evidence that favoured the Applicant, since it was likely a reference to the Applicant and was consistent with the Applicant’s claimed date of use in the Application, namely, 1979. However, while evidence obtained from third party websites showing how a word or phrase has been used can be relevant to the question of whether a trademark is clearly descriptive [see *Canadian Inovatech, supra*], I

cannot accept a third party website printout such as Exhibit “M” as evidence of the truth of its contents [see *ITV Technologies Inc v WIC Television Ltd*, 2003 FC 1056 at para 21]. Moreover, in my view, I have no basis to infer that this website printout is referencing the Applicant. Exhibit “M” does not mention the Applicant by name, nor does Exhibit “M” appear to attribute any trademark significance to the term “sonic”. To the contrary, in Exhibit “M” the term “sonic” appears to be used in a descriptive sense, with the term “Sonic Drilling” listed on the left hand side of the webpage with a variety of other seemingly descriptive terms such as “Specialty Drilling”, and “Well Drilling”.

[47] After considering the Opponent’s evidence in its entirety, I am satisfied that the Opponent has met its initial evidential burden to provide facts which suggest that the term “sonic” in the geological drilling industry clearly describes a type of geological drill and geological drilling technique, namely, one that involves the use of vibration at a particular frequency range that can be detected by the human ear. Keeping in mind that the purpose of section 12(1)(b) is to prevent a single trader from acquiring a monopoly in a term that is clearly descriptive, I am satisfied that the Opponent has provided sufficient evidence to meet its initial evidential burden for this ground and thus shift the legal burden to the Applicant. As the Applicant has not filed any evidence to refute the suggestion that the Mark is clearly descriptive in respect of the Goods and Services, in my view, the Applicant has not satisfied its legal burden and the Opponent succeeds on the section 12(1)(b) ground.

[48] At paragraph 39 of its written argument, the Applicant contends that even if the Mark was to be considered clearly descriptive in association with “Drills for geological drilling and parts therefor” and “Geological drilling services”, it is not clearly descriptive in association with the service “Sale of drills for geological drilling and parts therefor”. However, having concluded that the Opponent has met its initial evidential burden under section 12(1)(b) in respect of the goods “Drills for geological drilling and parts therefor” and the services “Geological drilling services”, and that the Applicant has not met its legal burden, in my view, the conclusion is the same for the closely related service “Sale of drills for geological drilling and parts therefor”.

[49] I note that if the Applicant had filed evidence that the perception of the term “sonic” to the average Canadian purchaser of geological drills and drilling services was different than that

suggested by the Drivdahl Affidavit, or that through use in Canada the Mark had acquired secondary meaning, my conclusion regarding this ground of opposition might have been different. In this regard, at paragraph 40 of its written argument, the Applicant in the alternative seeks to rely on acquired distinctiveness in the Mark under section 12(2) of the Act (I refer to this provision as it read prior to June 17, 2019) based solely on the 1979 claimed date of use in the Application. However, as the Applicant filed no evidence of its use of the Mark, I have no basis on which to assess registrability under section 12(2) of the Act.

[50] In view of the above, the section 12(1)(b) ground of opposition is successful.

SECTION 2 GROUND OF OPPOSITION

[51] The relevant date for this ground of opposition is the date of filing the statement of opposition, namely, February 27, 2016.

[52] As I have found that the Opponent has met its initial evidential burden to demonstrate that the Mark is clearly descriptive under section 12(1)(b), I similarly find that the Opponent has met its initial evidential burden for the distinctiveness ground of opposition under section 2. That is to say, the Opponent has met its evidential burden to suggest that the Mark is clearly descriptive of the Goods and Services and thus is not distinctive of the Applicant. A trademark which is clearly descriptive of the character or quality of the goods and services cannot serve to distinguish an applicant's goods/services from those of others [see *Canadian Council of Professional Engineers v APA - The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD)].

[53] As the Applicant filed no evidence to address this ground of opposition, the Opponent similarly succeeds under the section 2 ground of opposition.

REMAINING GROUNDS OF OPPOSITION

[54] As I have already found in favour of the Opponent with respect to the section 12(1)(b) and section 2 grounds of opposition, I do not consider it necessary to discuss the remaining grounds of opposition under sections 12(1)(c) and 12(1)(d).

DISPOSITION

[55] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2019-12-04

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