



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 148**

**Date of Decision: 2021-01-05**

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

**DS Lawyers Canada LLP**

**Requesting Party**

**and**

**Imperial Oil Limited**

**Registered Owner**

**TMDA38,268 for MARVELUBE**

**Registration**

**INTRODUCTION**

[1] At the request of DS Lawyers Canada LLP (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 February 27, 2018, to Imperial Oil Limited (the Owner), the registered owner of registration No. TMDA38,268 for the trademark MARVELUBE (the Mark).

[2] The Mark is registered for use in association with the following goods: “Lubricating oils and other petroleum products, namely, gear oil and grease”.

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

[4] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods specified in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is February 27, 2015 to February 27, 2018.

[5] The relevant definition of use in the present case 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.

[6] It is well established that while the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with *each* of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA) (*John Labatt*)].

[7] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Peter Shaw, Lubricants Sales Manager for the Owner, sworn on September 17, 2018.

[9] Only the Owner submitted written representations. No oral hearing was held.

#### THE EVIDENCE

[10] In his affidavit, Mr. Shaw states that the Owner has sold water-resistant grease products, also known as lubricating oils, in Canada in association with the Mark during the relevant period.

He explains that throughout the relevant period, the Mark was displayed on the container of grease products primarily sold in Canada in 16 kilogram pails.

[11] In support, Mr. Shaw attaches the following exhibits to his affidavit:

- Exhibit A: a photograph of a container of product identified as “grease”, displaying the Mark, “EP9F” and material code “00111164”. Mr. Shaw attests that this exhibit is a representative photograph of a 16 kilogram pail of MARVELUBE grease product that was sold in Canada during the relevant period.
- Exhibit B: an image of a label for a product identified as “grease”, displaying the Mark and “EP9F”. Mr. Shaw describes this exhibit as a representative image of an updated version of the label appearing in Exhibit A, which was also used by the Owner in association with MARVELUBE grease products sold during the relevant period in Canada.
- Exhibit C: copies of invoices issued by the Owner during the relevant period showing sales to customers in Canada of various products, including “MARVELUBE EP 9F, 16KG” with product number “111164”. Mr. Shaw states that these invoices are representative of sales of MARVELUBE brand grease to Canadian customers during the relevant period.

#### ANALYSIS AND REASONS FOR DECISION

[12] Given that the Owner has shown sales of its grease product in Canada during the relevant period, and has shown that the Mark appeared on the packaging for this product, I am satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act in association with grease.

[13] However, there is no evidence to establish use of the Mark in association with “other petroleum products” or “gear oil”. In this respect, I note that Mr. Shaw indicates that the Owner’s grease products are also known as lubricating oils, but provides no evidence regarding petroleum products other than these goods. Similarly, Mr. Shaw repeatedly refers to the use of the Mark in association with “grease”, “greases”, and “grease products”, but does not mention

“gear oil” or provide any exhibits which relate to use of the Mark in association with gear oil. Having distinguished between these various goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [*John Labatt*]. As such, the Owner’s evidence does not contain sufficient facts upon which I could conclude that there was use of the Mark in association with “other petroleum products” or “gear oil”. Further, the Owner has provided no special circumstances that would excuse non-use of the Mark in association with these goods. Accordingly, I am not satisfied that the Owner has used the Mark in association with these registered goods within the meaning of the Act.

#### DISPOSITION

[14] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete “other petroleum products” and “gear oil”, in compliance with the provisions of section 45 of the Act.

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

Lubricating oils, namely grease.

---

G.M. Melchin  
Hearing Officer  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

---

**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Gowling WLG (Canada) LLP

For the Registered Owner

DS Avocats Canada, S.E.N.C.R.L. / DS Lawyers  
Canada, LLP

For the Requesting Party