



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 176

Date of Decision: 2021-08-09

IN THE MATTER OF A SECTION 45 PROCEEDING

LOW MURCHISON RADNOFF LLP

Requesting Party

and

IMPERIAL OIL LIMITED

Registered Owner

TMA429,543 for EXPRESS PAY

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA429,543 for the trademark EXPRESS PAY (the Mark), currently owned by Imperial Oil Limited (the Owner).

[2] All references are to the Act as amended June 17, 2019 (the Act), unless otherwise noted.

[3] The Mark is registered for use in association with the following services:

Credit card services, namely point of sale services by machine.

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

THE PROCEEDINGS

[5] At the request of Low Murchison Radnoff LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on March 8, 2019, to the Owner of the Mark.

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with the services specified in the registration at any time within the three-year period immediately preceding the date of the notice. In this case, the relevant period for showing use is March 8, 2016 to March 8, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case is set out in section 4(2) of the Act as follows:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[8] 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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[9] In response to the Registrar’s notice, the Owner furnished the Affidavit of Felipe Jaramillo, Programs Coordinator of Retail Fuels Marketing at Imperial Oil Limited, declared on October 7, 2019, together with Exhibits A and B.

[10] Only the Owner submitted written representations and no oral hearing was held.

THE EVIDENCE

[11] Mr. Jaramillo explains that the Owner is an integrated energy company that explores for, produces, refines and markets energy products in Canada and abroad. The Owner also owns the consumer brand “Esso” [para 5].

[12] Mr. Jaramillo states that the Mark was used by the Owner and its licensees operating Esso branded gas stations in Canada during the Relevant Period by providing of point of sale payment services allowing consumers to pay for fuel directly at the pump with a credit card [para 6]. The Mark was displayed on signage on or immediately adjacent to gas pumps at Esso branded gas stations [para 7 & Exhibit A] and used in promotion and advertising on the Owner’s website *www.esso.ca* [para 8 & Exhibit B].

[13] In support, Mr. Jaramillo attaches the Exhibits A and B to his Affidavit:

- Exhibit A: Six undated photographs of gas station fuel pumps which Mr. Jaramillo states are representative of how the Mark was displayed at Esso branded gas station pumps in Canada during the Relevant Period. These show the Mark displayed on signage on or immediately adjacent to the fuel pumps.
- Exhibit B: Three screenshots from the website *www.esso.ca* taken from the internet archiving service Wayback Machine, the first dated August 23, 2016; the second April 9, 2017; and, the third June 23, 2018 showing the Mark accompanied by an explanation of the services offered: “Get back on the road faster with self-serve Express Pay pumps. Pay right at the pump at more than 900 Esso stations across Canada using your favourite payment card...”.

[14] In his affidavit, Mr. Jaramillo [para 9] states that during the Relevant Period many customers purchased fuel from Esso gas stations in Canada with payment processed through the Express Pay services in association with the Mark.

ANALYSIS AND REASONS FOR DECISION

USE BY A LICENSEE

[15] Section 50(1) of the Act requires the owner of a trademark to control, either directly or indirectly, the character or quality of the goods or services sold under that trademark.

[16] As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the licence agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[17] Given Mr. Jaramillo's role at Imperial Oil Limited and his clear statement in his affidavit that "Imperial Oil Limited exercised direct or indirect control over the character and quality of the EXPRESS PAY services provided by duly authorized licensees in association with the EXPRESS PAY trademark" [para 6], I am satisfied that any evidenced use of the Mark by authorized licensees, in this case Esso branded gas stations, in association with the services is to the Owner's benefit.

ANALYSIS OF USE

[18] It has been held that services should be given a broad and liberal interpretation. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), aff'd 2002 FCA 11; *Live! Holdings LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042, aff'd 2020 FCA 120].

[19] According to Mr. Jaramillo's affidavit many customers used the Express Pay services to pay for fuel directly at the pumps with a credit card during the Relevant Period [para 9] in Canada at Esso gas station, duly authorized licensees of the Owner [para 6]. Pictures provided in Exhibit A show how the Mark was displayed on or adjacent to Esso gas station fuel pumps.

[20] The Mark was also used in online advertising of the services during the Relevant Period [para 8] as displayed on website screenshots provided in Exhibit B.

[21] Based on the evidence described above, I am satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[22] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Martin Béliveau
Chairperson
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

For the Registered Owner

MOFFAT & CO.

For the Requesting Party