



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

Citation: 2010 TMOB 51
Date of Decision: 2010-04-26

**IN THE MATTER OF AN OPPOSITION
by Rescue Rooter Plumbing & Drain
Service Inc. to application No. 1,283,441
for the trade-mark DRAIN RESCUE in
the name of Drain Rescue Service Corp.**

THE RECORD

[1] On December 8, 2005, Drain Rescue Service Corp. filed an application to register the trade-mark DRAIN RESCUE based on use in Canada, since February 16, 1998, in association with

plumbing installation and repair services.

A trade-marks application Examiner with the Canadian Intellectual Property Office objected that (1) the applicant was required to disclaim the right to the exclusive use of the component DRAIN apart from the mark as a whole, and (2) the applied for mark DRAIN RESCUE was confusing with the marks RESCUE ROOTER and RESCUE, also covering plumbing services, both registered by another party. The applicant filed an amended application to disclaim the component DRAIN in response to the first objection. In response to the second objection, the applicant argued that (i) the first portion DRAIN of the applied for mark is not present in either of the cited marks and it is the first portion of a mark that is the most relevant when determining whether marks are confusing; (ii) RESCUE is a common word; (iii) there are 80 active trade-mark applications comprised of the component RESCUE that have proceeded to advertisement; (iv) two registered marks namely, ROOTER MAN PLUMBERS TO THE RESCUE & Design

and ROTOR MAN PLUMBERS TO THE RESCUE & Design, both covering plumbing services, stand in the name of a third party. If the two aforementioned marks can co-exist on the register with RESCUE and RESCUE ROOTER, then the applied for mark DRAIN RESCUE should be permitted to advertisement.

[2] The Examiner accepted the applicant's arguments and the subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 15, 2006. The application was opposed on January 12, 2007, by Rescue Rooter Plumbing & Drain Service Inc., the owner of the marks RESCUE ROOTER and RESCUE cited by the Examiner. The Registrar of Trade-marks forwarded a copy of the statement of opposition to the applicant on February 1, 2007 as required by s. 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent's evidence consists of the affidavit of Vern Milani. The applicant's evidence consists of the affidavit of Taras Sakharevych. Both parties filed a written argument and both parties were ably represented at an oral hearing held on March 23, 2009.

STATEMENT OF OPPOSITION

[4] The first ground of opposition, pursuant to s.30(b) of the *Trade-marks Act*, alleges that the applied for mark DRAIN RESCUE has not been used from the date claimed in the application in association with the specified wares.

[5] The second ground, pursuant to s.30(i), alleges that the applicant could not have been satisfied that it is entitled to use the applied for mark DRAIN RESCUE having regard to the opponent's trade-mark registrations and to the opponent's extensive use of its marks RESCUE and RESCUE ROOTER.

[6] The third ground, pursuant to s.12(1)(d), alleges that the applied for mark DRAIN RESCUE is not registrable because it is confusing with the opponent's registered marks RESCUE ROOTER and RESCUE covering

plumbing services namely, plumbing, mechanical

and drain cleaning services.

[7] The fourth and fifth grounds allege that the applicant is not entitled to registration, pursuant to s.16(1)(a) and (c), because at the date on which the applicant first used the applied for mark DRAIN RESCUE, it was confusing with the opponent's above mentioned marks and the opponent's trade-name Rescue Rooter Plumbing & Drain Service Inc.

[8] The sixth ground, pursuant to s.2, alleges that the applied for mark DRAIN RESCUE is not distinctive of the applicant's services in view of the opponent's prior use of its marks and trade-name for similar or identical services.

[9] At the oral hearing counsel for the opponent withdrew the second ground of opposition.

OPPONENT'S EVIDENCE

Vern Milani

[10] Mr. Milani identifies himself as President and sole shareholder of the opponent company Rescue Rooter, which company is a subsidiary of Milani Plumbing Drainage & Heating ("Milani"). Mr. Milani is also the sole shareholder of Milani, which has been a family owned company since 1956. The companies are structured to allow Milani to provide services relating to heating and cooling systems while Rescue Rooter provides most of the plumbing related services. The mark RESCUE ROOTER has been used by the opponent since at least September 24, 1988 and continues to be used by the opponent and by its parent Milani under license. The mark RESCUE has been used by the opponent since at least May 24, 1996 and continues to be used by the opponent and by its parent Milani under license. Both registrations cover "plumbing services namely, plumbing, mechanical and drain cleaning services." The opponent's business card and letterhead clearly display its marks RESCUE ROOTER and RESCUE. Sales of the opponent's plumbing services averaged about \$132,000 annually for the five-year period 2001 - 2005 and increased to \$1.4 million in 2006. Advertisements for the opponent's services are distributed as flyers door-to-door or published in Yellow Pages telephone directories. Such advertisements substantiate use of the opponent's marks RESCUE ROOTER and RESCUE, however, those advertisements are dominated by the mark MILANI: see exhibit F of Mr.

Milani's affidavit. Further, in such advertisements the mark RESCUE is used in association with heating and cooling services rather than with plumbing services. I note further from the exhibit material that the applicant appears to be based in Burnaby, British Columbia.

APPLICANT'S EVIDENCE

Tara Sakharevych

[11] Mr. Sakharevych identifies himself as the President and founder of the applicant company. He is also a certified plumber (in Ontario) and has worked as a service technician for his company since its incorporation in 1997. The applicant operates in several locations in Canada. It has about 18 employees and 7 independent contractors. It performs a wide range of plumbing installation and repair services for both residential and corporate customers. The applicant has used its mark DRAIN RESCUE in the performance and advertising of its services since February 16, 1998. In particular, the applicant's mark DRAIN RESCUE has been prominently displayed on customer invoices, letterhead, stationery, envelopes, business cards, service vehicles, office signage, Yellow Pages directories, refrigerator magnets, newspaper advertising, "fridgenotes," "door hanger" flyers, and the applicant's website. The applicant's service technicians wear a badge displaying the applicant's mark, as

shown below:



shown below:

[12] Another manner of use of the applicant's mark is together with a representation of a running plumber figure, as shown below:



[13] In my view, the two logos above substantiate use of the mark DRAIN RESCUE *per se*: in this regard see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 at p.538 under the heading *Principle 1*.

[14] The applicant's revenues for services provided under its mark DRAIN RESCUE totalled about \$800,000 for the years 1998 and 1999, thereafter averaging about \$1.85 million annually until the end of 2007. The applicant's expenses for advertising, marketing and promoting its services under its mark DRAIN RESCUE totalled about \$82,000 for the years 1998 and 1999, thereafter averaging about \$175,000 annually until the end of 2005, and increasing to about \$387,000 annually for the years 2006 and 2007.

[15] The applicant notes that the two marks shown below, covering plumbing services and owned by a third party, co-exist on the register of trade-marks with the opponent's marks:



[16] The applicant also notes that the website YellowPages.ca (for Toronto) lists the following plumbing companies: Professor Pipes Plumbing & Rooter Services, Mr. Rooter, Rooter Man, and King Rooter. The applicant has never received any contact from persons in the mistaken belief that it was the opponent, and has no knowledge of instances of actual confusion between the marks in issue. In my view, given the geographical separation of the parties, it is not surprising that the applicant has never been called by persons intending to contact the opponent for plumbing services.

LEGAL ONUS AND EVIDENTIAL BURDEN

[17] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

MAIN ISSUE

[18] The opponent has not submitted any evidence to put the first ground of opposition into issue. The first ground is therefore rejected. The main issue with respect to the remaining grounds of opposition is whether the applied for mark DRAIN RESCUE is confusing with either of the opponent's marks RESCUE ROOTER or RESCUE. The material dates to assess the issue of confusion are (i) the date of decision, with respect to the third ground of opposition alleging non-registrability: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.); (ii) the date of claimed first use of the mark, in this case February 16, 1998, with respect to the fourth and fifth grounds of opposition alleging non-entitlement: see s.16(1) of the *Trade-marks Act*; (iii) the date of opposition, in this case January 12, 2007, in respect of the final ground alleging non-distinctiveness: see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Clarco Communications Ltd. v. Sassy Publishers Inc.* (1994), 54 C.P.R.(3d) 418 (F.C.T.D.).

SECTIONS 6(2) AND 6(5)

[19] The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark DRAIN RESCUE and either of the opponent's marks RESCUE ROOTER and RESCUE:

6(2) The 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 . . . services associated with those trade-marks are . . . performed by the same person . . .

(emphasis added)

Thus, the geographical separation of the parties is not relevant to the issue of confusion although in the instant case it may provide a rationale for no instances of actual confusion. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

SECTION 6(5) FACTORS

[20] Neither of the opponent's marks possesses a high degree of inherent distinctiveness as the term RESCUE implies "assistance" and the term ROOTER describes a plumber's tool used to clean out drains and pipes. Thus, the opponent's marks are somewhat laudatory and suggestive of the opponent's services. They are relatively weak marks. Similarly, the applied for mark DRAIN RESCUE is a relatively weak mark. Further, the applicant has presented at least some evidence of third party use of the component ROOTER in trade-marks and trade-names for plumbing services. Thus, the inherent distinctiveness of the marks in issue favours neither party. The applicant cannot claim any reputation for its mark at the earliest material date February 16, 1998. Although the evidence of record indicates that the opponent first used its mark RESCUE

ROOTER in 1988 and first used its mark RESCUE in 1996, nevertheless the opponent's evidence is insufficient and too imprecise for me to assign any more than a minimal reputation to its marks at the earliest material date.

[21] Based on the evidence of record in respect of the extent of the parties' sales under its marks and advertising expenses, I conclude that the applied for mark DRAIN RESCUE had acquired a greater distinctiveness than either of the opponent's marks by the later material date January 12, 2007. Thus, the acquired distinctiveness of the marks in issue favours neither party to a meaningful extent at the earliest material date but favours the applicant at the later material dates. The length of time that the marks in issue have been in use favours the opponent, but only to a limited degree. In this regard, the opponent has not evidenced the extent of use of its marks prior to the year 2001, while the applicant's mark was in substantial use as of early 1999. The nature of the parties' services are essentially the same and in the absence of evidence to the contrary I assume that the nature of the parties' trades is also the same.

[22] The marks in issue resemble each other to a fair degree in appearance, sounding and ideas suggested owing to the component RESCUE which is common to the parties' marks. Further, the applied for mark DRAIN RESCUE incorporates the whole of the opponent's mark RESCUE. Generally, it is the first portion of a mark that is the more important for the purposes of distinction: see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 C.P.R.(2d) 183 at p.188 (F.C.T.D.). However, when a word is a common, descriptive word, its importance diminishes. Nevertheless, the component DRAIN serves to distinguish the applied for mark DRAIN RESCUE from the opponent's mark RESCUE to some extent. Applying a similar analysis as above, I conclude that the marks DRAIN RESCUE and RESCUE ROOTER resemble each other less than the marks DRAIN RESCUE and RESCUE, owing to the component ROOTER comprising the opponent's mark.

DISPOSITION

[23] Having regard to all of the above, and keeping in mind that the parties' marks are inherently weak marks, that small differences can suffice to distinguish between marks of low distinctiveness (see *GSW Ltd. v. Great West Steel Industries Ltd.*, (1975), 22 C.P.R.(2d) 154

(F.C.T.D.)) and that the opponent has not established that its mark RESCUE acquired a substantial reputation for plumbing services at any material time, I find that the applicant has met the onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark DRAIN RESCUE and either of the opponent's marks

RESCUE and RESCUE ROOTER at all material times.

[24] Accordingly, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office