

**IN THE MATTER OF AN OPPOSITION by
Cargill Limited – Cargill Limitée to application No. 899,343
for the trade-mark TRUGREEN
filed by Trugreen Lawn Care a Partnership**

On December 9, 1998, the applicant, Trugreen Lawn Care a Partnership, filed an application to register the trade-mark TRUGREEN. The application is based upon proposed use of the trade-mark in Canada in association with lawn care services and has been assigned file No. 899,343.

The application was advertised for opposition purposes in the Trade-marks Journal of June 6, 2001. On November 6, 2001, the opponent, Cargill Limited – Cargill Limitée, filed a statement of opposition against the application. The applicant filed and served a counter statement.

As rule 41 evidence, the opponent filed the affidavits of Bradley Burton, Tina H. Hill, Adam Grabowski and Carin Bruckner. Although the applicant obtained orders for the cross-examination of each of these affiants on his/her affidavit, cross-examinations were never conducted.

As rule 42 evidence, the applicant filed the affidavit of Greg Brooks.

Written arguments were filed by both parties. An oral hearing was not requested.

Grounds of Opposition

Five grounds of opposition have been pleaded:

1. the application fails to comply with subsection 30(i) of the *Trade-marks Act* as the applicant was, at the date of the application, aware of registration No. 306,959 for the trade-mark TRUE-GREEN owned by the opponent, and could not, therefore, have been satisfied that it was entitled to use the trade-mark. The applicant had requested the issuance of a section 45 cancellation notice against the opponent's registration No. 306,959 for the trade-mark TRUE-GREEN on January 6, 2000. We submit that the fact that the applicant sought to cancel the opponent's registration No. 306,959 serves to indicate that the applicant considered the opponent's registration to be confusing with the trade-mark. Based on the evidence filed by the opponent in the section 45 proceedings, registration No. 306,959 was maintained;
2. the application fails to comply with subsection 30(e) of the Act because the trade-mark was used in Canada by the applicant prior to the filing date of application No. 899,343;
3. the trade-mark is not registrable under paragraph 12(1)(d) of the Act because it is confusing with the opponent's trade-mark TRUE-GREEN which is registered under No. TMA306,959 for use in association with fertilizer;
4. the applicant is not the person entitled to registration of the trade-mark because at the date the application was filed, the trade-mark was confusing with the trade-mark TRUE-GREEN which had been previously used in Canada by the opponent in association with fertilizer and which trade-mark had not been abandoned as of the advertisement of application No. 899,943; and
5. the trade-mark is not distinctive of the applicant because it does not distinguish, nor is it adapted to distinguish, the services of the applicant from the wares or services of others, and particularly from the wares in association with which the opponent has used its trade-mark TRUE-GREEN in Canada.

Onus

Although the applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, there is an initial 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*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v.*

Christian Dior, S.A. et al. (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Material Dates

The material dates with respect to the grounds of opposition are as follows: section 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; paragraph 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]; entitlement under paragraph 16(3)(a) - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

Opponent's Evidence

Burton Affidavit

Mr. Burton is the Manager of the Mount Elgin location of the opponent. He informs us that the fertilizer division of the opponent sometimes carries on business under the business name Cargill Fertilizer.

Mr. Burton provides a certified copy of registration No. 306,959, which shows that the opponent is the current owner of the registered trade-mark TRUE-GREEN for fertilizers. Mr. Burton states that TRUE-GREEN fertilizer has been manufactured and sold in Canada since as early as 1968. Until approximately 1994, the TRUE-GREEN trade-mark was owned by Cyanamid Canada Inc., but was used by the opponent under license from Cyanamid. The opponent was recorded in the Canadian Trade-mark Office as a registered user of the TRUE-GREEN trade-

mark. On April 26, 1994, the TRUE-GREEN trade-mark was assigned by Cyanamid to the opponent.

Mr. Burton provides bags representative of those that the opponent has used to sell its TRUE-GREEN fertilizer in Canada since 1994. The bags prominently display the trade-mark TRUE-GREEN and show that the opponent sells fertilizer for lawns and gardens. Mr. Burton states that the trade-mark TRUE-GREEN has also been displayed since 1994 on invoices accompanying shipments of TRUE-GREEN fertilizer, as well as on price lists and related promotional material. Representative invoices from 1996, 1997, 1999 and 2002 have been provided.

Hill Affidavit

Ms. Hill is an articling student. In April 2002, she phoned a company identified as Trugreen Lawncare in Oakville, Ontario and was informed that it sold packages of services that included the application of fertilizers.

Grabowski Affidavit

Mr. Grabowski is also an articling student. He telephoned Trugreen Lawncare on May 2, 2002 and asked it to drop an estimate off at Ms. Bruckner's residence.

Bruckner Affidavit

Ms. Bruckner, an administrative assistant, provides the package that she received in her mailbox from Trugreen Lawncare on May 2, 2002.

Applicant's Evidence

Brooks Affidavit

Mr. Brooks is one of the applicant's partners. Previously, Mr. Brooks was a franchisee of ServiceMaster Lawn Care Canada and the bulk of his affidavit is directed to his relationship with that company and that company's activities. None of that is relevant to the issues at hand.

Mr. Brooks notes that a company called TruGreen Landcare LLC owns Canadian Trade-mark Application No. 1,063,935 for TRUGREEN LANDCARE for construction and maintenance of landscape designs, which was filed August 11, 2001.

Mr. Brooks states that the applicant began using TRUGREEN on January 1, 2001 and continues to use the mark to offer lawn care programmes in the Burlington/Oakville, Mississauga area. As of April 17, 2003, the applicant had approximately 500 customers, almost all of which are residential rather than commercial customers.

The applicant provides integrated pest management, weed control and lawn nutrition services through the application of various treatments, including fertilizers. The applicant sells services only. It does not sell fertilizer or any other lawn care products. In fact, Mr. Brooks says that those who purchase the applicant's services have no need to buy lawn care products and, in particular, fertilizer for their lawn.

Mr. Brooks provides a copy of promotional materials, which appear to have been in use prior to April 1, 2003. The materials display the applied for trade-mark.

Subsection 30(i) Ground of Opposition

The first ground of opposition fails because there is no basis on which I may conclude that the applicant was aware of the opponent's registration when it filed its application. There is no evidence in the file that the applicant commenced section 45 proceedings against the opponent's registration and even if it did, according to the pleadings, this occurred more than a year after the applicant filed the present application. The opponent has therefore not met its initial burden.

Subsection 30(a) Ground of Opposition

The second ground of opposition fails because there is no evidence that the applicant began using its mark before it filed its proposed use application. Accordingly, the opponent has not met its initial burden.

Paragraph 12(1)(d) Ground of Opposition

The third ground of opposition pleads that TRUGREEN is confusing with the opponent's registered trade-mark TRUE-GREEN. The opponent has met its initial burden by providing a copy of its registration.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5)

of the Act. Those factors specifically set out in subsection 6(5) are: the inherent distinctiveness of the trade-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; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

I consider each of the marks to have the same degree of inherent distinctiveness, given that they are phonetically identical. Each mark has acquired some distinctiveness in the hands of its owner, but it is difficult to assess the relative degrees of acquired distinctiveness given the paucity of the evidence.

The length of time that each mark has been used favours the opponent.

The opponent's fertilizer wares are closely related to the applicant's lawn care services. The opponent appears to sell its TRUE-GREEN products to stores, but it is not clear who then purchases the fertilizer from these stores. The applicant appears to primarily sell its TRUGREEN services to homeowners, possibly through door-to-door sales.

There is very nearly one hundred percent resemblance between the two marks in appearance, sound and idea suggested.

A further surrounding circumstance might be the existence of the third party application for TRUGREEN LANDCARE. However, there is no evidence that such mark has ever been used in Canada and inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.); *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)] Contrary to the submissions made in the applicant's written argument, there is no evidence that the words in the parties' marks are in common use in the gardening trade.

A consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between TRUGREEN lawn care services and TRUE-GREEN fertilizer. Even though Mr. Brooks attests that his clients will not need to purchase fertilizer, this does not mean that they won't assume that TRUGREEN lawn care services and TRUE-GREEN fertilizers are not from the same source. The marks, as well as their associated wares and services, are too similar for me to not conclude that confusion is likely.

Paragraph 16(3)(a) Ground of Opposition

The opponent has met its evidential burden with respect to this ground by providing invoices evidencing sales of TRUE-GREEN fertilizer in Canada prior to December 9, 1998. Given that the applicant had not commenced use of its mark as of the material date, the opponent's case is stronger here than it was with respect to the later material date that applies with respect to

paragraph 12(1)(d). For reasons similar to those set out in my discussion of the paragraph 12(1)(d) ground, this ground of opposition also succeeds.

Distinctiveness Ground of Opposition

This ground also succeeds for reasons similar to those set out with respect to the paragraph 12(1)(d) ground of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the *Trade-marks Act*, I refuse the application pursuant to subsection 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 6th DAY OF JULY 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board