



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

Citation: 2011 TMOB 118
Date of Decision: 2011-06-30

**IN THE MATTER OF OPPOSITIONS
by Pope and Sons Refrigeration Ltd. to
applications Nos. 1,353,120, 1,353,122 and
1,353,129 for the trade-marks SERVICE
EXPERTS & S Design, SERVICE
EXPERTS & Man Design and SERVICE
EXPERTS & Design in the name of
Service Experts LLC**

[1] On June 26, 2007, Service Experts Inc. (the Applicant) filed applications to register the following three trade-marks:

i) No. 1,353,120 for SERVICE EXPERTS & S Design, as shown below:



ii) No. 1,353,122 for SERVICE EXPERTS & Man Design, as shown below:



iii) No. 1,353,129 for SERVICE EXPERTS & Design, as shown below:



[2] The applications are all based on: i) use of the mark in Canada; and ii) use and registration of the mark in the United States of America. The statement of services for both bases reads: maintenance, repair, servicing, and installation services for air conditioning, heating, plumbing and electrical equipment, namely air conditioners, furnaces, heat pumps, boilers, air filters, humidifiers, dehumidifiers, blowers, ventilation ducts, ventilation zoning controls and dampers, faucets, toilets, tubs, showers, sinks, water distribution piping, waste removal piping, electrical panels, distribution wiring and service entrance wiring. The dates of first use claimed in Canada differ by trade-mark as follows: i) at least as early as September 2005; ii) at least as early as June 2005; and iii) at least as early as November 2001.

[3] The applications were advertised for opposition purposes in the *Trade-marks Journal* of i) May 14, 2008, ii) May 14, 2008 and iii) June 4, 2008, respectively.

[4] Pope and Sons Refrigeration Ltd. (the Opponent) filed a statement of opposition with respect to each of the applications on the following dates: i) June 27, 2008, ii) June 27, 2008 and

iii) July 17, 2008. The Applicant filed and served counter statements in which it denied the Opponent's allegations.

[5] The same evidence has been filed with respect to each proceeding. The Opponent has filed affidavits of David Pope and Earl Scott, while the Applicant has filed affidavits of Gregg Barnard, Ian McKeen and Timothy G. Inch. No cross-examinations were conducted.

[6] In 2009, the Applicant changed its name to Service Experts LLC.

[7] Only the Applicant filed written arguments. An oral hearing was not held.

Summary of Grounds of Opposition and Applicable Material Dates

[8] The grounds of opposition pleaded by the Opponent pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are summarized below:

1. contrary to s. 38(2)(a) and 30(b), the Applicant did not use the applied for mark in Canada in association with the specific services set out in the application since at least as early as the date alleged in the application;
2. contrary to s. 38(2)(a) and 30(d), the Applicant, at the time of filing the application, had not used the applied for mark in the United States in association with the specific services set out in the application;
3. contrary to s. 38(2)(a) and 30(i), the Applicant could not have been satisfied that it was entitled to use the applied for mark having regard to the Opponent's prior extensive use of the trade-mark CANADIAN HVAC SERVICE EXPERTS in association with maintenance, repair, service and installation services for plumbing, heating, air conditioning, refrigeration equipment, food service equipment, solar powered equipment, electrical equipment, recreational vehicles, offshore oil rig air conditioners and refrigeration equipment and renewable energy equipment;
4. contrary to s. 38(2)(c) and 16(1)(a), at all relevant times, the Applicant's mark was confusing with the Opponent's previously used trade-mark CANADIAN HVAC SERVICE EXPERTS;
5. contrary to s. 38(2)(c) and 16(2)(a), at all relevant times, the Applicant's mark was confusing with the Opponent's previously used trade-mark CANADIAN HVAC SERVICE EXPERTS;
6. contrary to s. 38(2)(d) and 2, the applied for mark is not distinctive of the Applicant because the Mark is confusing with the Opponent's trade-mark.

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

- s. 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 38(2)(c)/16(1) – the claimed date of first use;
- s. 38(2)(c)/16(2) – the filing date of the application;
- s. 38(2)(d)/2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Likelihood of Confusion - Prior Decisions Between the Parties

[11] There have been two prior decisions issued by this Board in regards to the present parties that relate to the marks at issue here, or to marks that are very similar thereto. These are i) *Pope & Sons Refrigeration Ltd. v. Service Experts Inc.*, 2009 CarswellNat 4118 and ii) *Service Experts Inc. v. Pope & Sons Refrigeration Ltd.*, 2011 TMOB 64. In the first, my colleague Board Member Herzig held that there was no likelihood of confusion between SERVICE EXPERTS and CANADIAN HVAC SERVICE EXPERTS, with the result that the application for SERVICE EXPERTS issued to registration in the name of the Applicant. In the second, I ruled that the present Opponent was entitled to register its CANADIAN HVAC SERVICE EXPERTS mark.

[12] The evidence in the present case is not significantly different from that in the two earlier decisions between the parties. Moreover, as a result of the design features, each of the marks presently applied for is more distinguished from CANADIAN HVAC SERVICE EXPERTS than is the word mark SERVICE EXPERTS. There is therefore little need to go into a detailed

analysis of the likelihood of confusion in the present case. As held by the Supreme Court of Canada in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27, the most significant factor with respect to the likelihood of confusion is the resemblance between the marks and the marks at issue here are sufficiently different to make confusion unlikely. This conclusion is supported by the prior case law referred to above. In particular, the conclusion reached by Board Member Herzig at paragraph 17 of his decision applies *mutatis mutandis* to the case at hand:

Considering all of the [s. 6(5)] factors, and taking into account the similarities in the parties' marks as well as their differences, and that small differences may suffice to distinguish between weak marks (see *GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R. (2d) 154 (Fed. T.D.)), I am satisfied that, despite the fact that the applied for mark is a very weak mark, the applicant has met the legal onus on it show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark SERVICE EXPERTS and the opponent's mark CANADIAN HVAC SERVICE EXPERTS at the material date...The third ground of opposition is therefore rejected.

[13] I therefore find that none of the grounds of opposition based on a likelihood of confusion between the marks succeed. The fourth, fifth and sixth grounds of opposition are accordingly rejected.

Section 30 Grounds of Opposition

[14] The Opponent has not met its initial burden with respect to the first, second or third grounds of opposition. Those grounds of opposition are accordingly also rejected.

Disposition

[15] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the oppositions, pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office