



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

Citation: 2012 TMOB 59
Date of Decision: 2012-03-30

**IN THE MATTER OF OPPOSITIONS
by 385229 Ontario Limited, dba
Masterclean Service Company to
application Nos. 1,070,731 and 1,278,252
for the trade-marks SERVICEMASTER
CLEAN and SERVICEMASTER
CLEAN & Design in the name of The
ServiceMaster Company**

[1] On August 10, 2000, The ServiceMaster Company (the Applicant) filed application No. 1,070,731 to register the trade-mark SERVICEMASTER CLEAN (the Word Mark). The application disclaims the right to the exclusive use of the word CLEAN apart from the mark.

[2] On November 3, 2005, the Applicant filed application No. 1,278,252 to register the trade-mark SERVICEMASTER CLEAN & Design (the Design Mark), which is shown below:



Colour is claimed as a feature of the Design Mark. The word SERVICEMASTER is in turquoise and the triangle design is in yellow. The application disclaims the right to the exclusive use of the words SERVICE and CLEAN apart from the mark.

[3] Application No. 1,070,731 was advertised for opposition purposes in the *Trade-marks Journal* on May 25, 2005 whereas application No. 1,278,252 was advertised on September 13, 2006.

[4] When advertised, each application covered the following services:

Business advisory, business consulting and franchising services, namely, offering technical assistance in the establishment or operation or both of cleaning, building management, or building repair management services companies; providing technical assistance in the establishment and operation of a business; providing technical assistance in the establishment and operation of cleaning services; cleaning services for the interiors of buildings, including private homes, commercial buildings, health care institutions, industrial facilities, and educational facilities, and the furnishings thereof, including carpets, floors, walls, furniture and fixtures; janitorial services; disaster restoration services, namely restoring building interiors and exteriors damaged by fire, flood, and other disasters.

[5] However, in 2009 the statement of services was amended in each application to delete “or building repair management; disaster restoration services, namely restoring building interiors and exteriors damaged by fire, flood, and other disasters.” Thus the statements of services now read:

Business advisory, business consulting and franchising services, namely, offering technical assistance in the establishment or operation or both of cleaning or building management services companies; providing technical assistance in the establishment and operation of a business; providing technical assistance in the establishment and operation of cleaning services; cleaning services for the interiors of buildings, including private homes, commercial buildings, health care institutions, industrial facilities, and educational facilities, and the furnishings thereof, including carpets, floors, walls, furniture and fixtures; janitorial services.

[6] Application No. 1,070,731 claims use of the Word Mark since at least as early as October 1997. Application No. 1,278,252 claims use of the Design Mark since at least as early as October 1, 1997.

[7] 385229 Ontario Limited, dba Masterclean Service Company, (the Opponent) filed a statement of opposition against the applications for the Mark and the Design Mark on October 25, 2005 and November 6, 2006, respectively. The Applicant filed and served counter statements in which it denied the Opponent’s allegations.

[8] I will now focus my discussion on the opposition to the application for the Word Mark.

Application No. 1,070,731

[9] In support of its opposition, the Opponent filed an affidavit of Mark English. Mr. English was cross-examined on his affidavit and the transcript has been filed.

[10] In support of its application, the Applicant filed affidavits of Ian England, Stephan Roy, Lisa Salzman, Jane Griffith, James Wassell and Natalie de Paulsen, plus certified copies of five Canadian trade-mark applications and seven Canadian trade-mark registrations. Each of the affiants, except for Ms. de Paulsen, was cross-examined and the transcripts have been filed.

[11] Each party filed a written argument and participated in an oral hearing.

Summary of Grounds of Opposition and Applicable Material Dates

[12] 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. 30, the application does not contain a statement in ordinary commercial terms of the specific services in association with which the Word Mark has been claimed to have been used;
2. contrary to s. 30, the application does not contain a date from which the Applicant has so used the Word Mark in association with each of the general classes of services described in the application;
3. contrary to s. 12(1)(d), the Word Mark is not registrable because it is confusing with a registered trade-mark, namely MASTERCLEAN (registration No. TMA253,190) and MASTER CLEAN (registration No. TMA226,306);
4. contrary to s. 16, the Applicant is not the person entitled to registration of the Word Mark because at the date upon which the Applicant has claimed that it first used the Word Mark, it was confusing with the Opponent's previously used trade-marks MASTERCLEAN and MASTER CLEAN;
5. contrary to s. 16, the Applicant is not the person entitled to registration of the Word Mark because at the date upon which the Applicant has claimed that it first used the Word Mark, it was confusing with the Opponent's previously used trade-name MASTERCLEAN SERVICE COMPANY;

6. contrary to s. 2, the Word Mark is not distinctive because the Word Mark does not actually distinguish the services in association with which it has been claimed to have been used from the services of the Opponent nor is it adapted so as to distinguish them and in particular, the restoration, renovation and cleaning services which have been performed by the Opponent in Canada since at least as early as November 1, 1971 in association with the trade-mark MASTERCLEAN and restoration, renovation and cleaning services which have been performed by the Opponent in Canada since at least as early as May 1, 1980 in association with the trade-mark MASTER CLEAN.

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

- s. 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. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16 – the Applicant’s claimed date of first use;
- s. 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

[14] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies 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].

Section 30 Grounds of Opposition

[15] The Opponent has not met its initial burden with respect to either of its s. 30 grounds of opposition because there is no evidence that supports the allegations that underlie these grounds.

[16] Regarding the second s. 30 ground, the Opponent has argued that the Applicant’s own affidants did not make it clear that there was use as of the date claimed, However, I do not find the Applicant’s evidence to be clearly inconsistent with the use claim [see *York Barbell Holdings*

Ltd. v. ICON Health & Fitness, Inc. (2001), 13 C.P.R. (4th) 156 at 162 (T.M.O.B.)). Moreover, as pointed out by the Applicant, the Opponent cross-examined the affiants but did not take that opportunity to request evidence to establish the claimed date of first use.

[17] The s. 30 grounds of opposition are accordingly dismissed.

Section 12(1)(d) Grounds of Opposition

[18] An opponent's initial burden is met with respect to a s. 12(1)(d) ground of opposition if the registration upon which it relies is extant at the date of my decision. Registration No. TMA253,190 was expunged on July 7, 2011. Therefore the Opponent has only met its initial burden insofar as the pleadings rely upon the extant registration No. TMA226,306 and my discussion of the likelihood of confusion under this ground will be based solely on that registered mark, namely MASTER CLEAN, which is registered for: carpet cleaning machines; restoration, renovation and cleaning services. Registration No. TMA226,306 disclaims the right to the exclusive use of the word CLEAN apart from the mark.

[19] The Applicant must establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Word Mark and the mark registered under No. TMA226,306.

[20] Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[21] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or

sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.), *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C).]

[22] While the s. 12(1)(d) ground is only being assessed based on the Opponent's registration for MASTER CLEAN, it is clear that use of MASTERCLEAN would qualify as use of MASTER CLEAN under the tests set out in *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535. Therefore, when I refer below to the use or reputation associated with MASTER CLEAN, I will be referring to the use or reputation of both MASTERCLEAN and MASTER CLEAN combined.

the inherent distinctiveness of the marks, the extent to which each mark has become known, and the length of time the marks have been in use

[23] Neither mark is inherently strong since both are comprised of ordinary dictionary words, but each possesses some degree of inherent distinctiveness.

[24] The Applicant submitted at the oral hearing that its state of the register evidence showing more than 80 marks that include the word MASTER and more than 500 marks that include the word CLEAN goes in part to show that the Opponent's mark is not inherently strong, but as noted by it, the results of the search are not surprising given that CLEAN is descriptive and MASTER is laudatory.

[25] A mark's distinctiveness may be increased through use and promotion. The Applicant has used SERVICEMASTER in Canada since at least 1954 and it adopted SERVICEMASTER CLEAN in 1997 to better distinguish its divisions that offered cleaning-related services. Use of the Word Mark in Canada has been continuous since 1997 and the associated national ad fund exceeded \$3.5 million between 1997 and 2007. The Word Mark has been advertised on the website *www.servicemaster.ca*, in magazines, in directories, through pamphlets, at trade shows and conferences, through the sponsorship of events, via direct mailings, on franchisees' service vehicles, and by radio advertisements. Sales associated with SERVICEMASTER CLEAN services in Canada between 1997 and 2006 exceeded \$1.28 billion, which is broken down by

division approximately as follows: disaster restoration – \$800 million; residential cleaning services – \$25 million; commercial cleaning services - \$138 million; janitorial services - \$320 million.

[26] The Opponent, or its predecessor, has used MASTER CLEAN continuously since 1971. Sales from May 1, 1996 to October 31, 2006 exceeded \$44 million. The MASTER CLEAN mark has been promoted through the Yellow Pages directory (both in print and online), through other directories, through brochures, and in the official journal of the Ontario Insurance Adjusters Association. The Opponent's advertising expenditures exceeded \$1.4 million between May 1, 1996 and October 31, 2006, but during the cross-examination of the Opponent's President, Mr. English, it was revealed that a significant portion of that amount was spent on meals and entertainment as opposed to direct advertisement of MASTER CLEAN. For example, for the year May 1, 2005 to April 30, 2006, of the \$129,000 spent, only \$27,329.09 was spent on print advertising, while \$58,000 was spent on part ownership of a box at the Air Canada Centre [see answers to questions taken under advisement, numbers 4 and 6].

[27] I note that although the Opponent's registration covers carpet cleaning machines, during cross-examination, Mr. English advised that his company had never made or sold carpet cleaning machines.

the nature of the wares, services, business and trade

[28] When considering the wares and services of the parties, it is the statement of wares and services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the wares or services covered in the application or registration at issue [*McDonald's Corp. v. Coffee Hut Stores Ltd.* (1996), 68 C.P.R. (3d) 168 (F.C.A.); *Procter & Gamble Inc. v. Hunter Packaging Ltd.* (1999), 2 C.P.R. (4th) 266

(T.M.O.B.); *American Optical Corp. v. Alcon Pharmaceuticals Ltd.* (2000), 5 C.P.R. (4th) 110 (T.M.O.B.)].

[29] Prior to the removal of the disaster restoration services from the Applicant's statement of services, there was a greater overlap between the parties' services. There is however still some overlap between the Applicant's applied-for services and the Opponent's registered services because they both refer to cleaning services.

[30] The Opponent is a company specializing in property loss mitigation and restoration construction; it uses MASTER CLEAN in association with restoration, renovation and cleaning services that are targeted primarily to insurance companies but are also provided directly to property owners.

[31] The Applicant's SERVICEMASTER business began as a carpet cleaning business but it expanded over the years to offer a wider range of services including lawn care and maintenance services, disaster restoration services, commercial and residential cleaning services, furniture repair services, home inspection services and pest control services. It adopted the SERVICEMASTER CLEAN mark in 1997 "to better distinguish [its] professional cleaning services and franchise systems from its other expanding service groups, such as its home health care, lawn care, and food service management groups. This mark was adopted to highlight the fact that the associated services were being offered by SERVICEMASTER and were related to *cleaning*." [paragraph 10, Wassell affidavit]

[32] The Applicant is a franchisor and offers SERVICEMASTER CLEAN, MERRY MAIDS, FURNITURE MEDIC, and AMERISPEC franchises in Canada.

[33] When Mr. England signed his affidavit in April 2007, the two largest divisions associated with the Applicant's SERVICEMASTER CLEAN mark were disaster restoration and janitorial/commercial cleaning. The disaster restoration services are targeted primarily at insurance adjusters and others in the insurance industry. The janitorial/commercial cleaning services are typically contracted for by building owners and operators or the facilities managers for the companies that employ the Applicant for daily, weekly or monthly cleaning of their office or retail facilities.

[34] Despite the deletion of certain services from the Applicant's application, the evidence makes it clear that the parties are direct competitors, which indicates that their channels of trade would overlap.

the degree of resemblance between the marks

[35] The Supreme Court in *Masterpiece* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique. In the present case, each of the marks is comprised of ordinary, suggestive words, with their common last word CLEAN being clearly descriptive (as acknowledged by each party's disclaimer to the right of the exclusive use of such word). Therefore I find that there is no aspect of either mark that is particularly striking or unique. As a result, I accept that the dominant feature of each mark would be its first portion, i.e. MASTER insofar as the Opponent's mark is concerned and SERVICEMASTER insofar as the Applicant's Word Mark is concerned. As acknowledged by the Supreme Court in *Masterpiece*, it is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.)].

[36] Although the Word Mark begins with a word that is not in the Opponent's mark, the Applicant has incorporated the Opponent's mark in its entirety into its Word Mark. This results in there being a fair degree of resemblance between the marks in appearance, sound and ideas suggested. I note however that the Applicant has argued that, due to the existing reputation of the Applicant's SERVICEMASTER mark/name, the Word Mark would suggest cleaning services offered by Servicemaster while the Opponent's mark suggests that they are the masters of cleaning. While I recognize that the Applicant's ownership of a registration for SERVICEMASTER does not give it the automatic right to obtain any further registrations no matter how closely they may be related to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc.* (1984), 4 C.P.R. (3d) 108 at 115 (T.M.O.B.)], I nevertheless accept that a reputation established for the first and dominant portion of the Word Mark would be of assistance in distinguishing the source of the services associated with the Word Mark, especially in a case such as this where one is dealing with inherently weak marks.

other surrounding circumstances

i) state of the register and marketplace

[37] The Applicant has introduced evidence of the state of both the Canadian trade-marks register and the marketplace with respect to the words MASTER and CLEAN.

[38] Ms. Saltzman's evidence shows that the only marks located on the register that have the word MASTER followed by the word CLEAN in the parties' fields belong to the parties. She did find three third party marks on the register that incorporate derivatives of the words MASTER and CLEAN (THE MASTERS BRUSH CLEANER AND PRESERVER & Design, J & L MASTER WINDOW CLEANING & Design, and SANITONE CERTIFIED MASTER DRYCLEANER & Design), but these are significantly different from the marks at issue. Therefore the state of the register does not assist the Applicant's case.

[39] Ms. Saltzman also searched for trade-names that include both MASTER and CLEAN, or derivatives of those words. She located numerous business names, including more than 25 that start with MASTER CLEAN, plus 15 that start with MASTER CLEANER(S) and 12 that start with MASTER CLEANING, as well as more than 25 that start with the words CLEAN MASTER or CLEANMASTER. However, her searches did not reveal the nature of such businesses, beyond what might be surmised from the trade-names themselves.

[40] Ms. Griffith was provided with a NUANS search that listed 259 business names that contained the word MASTER and CLEAN and was asked to confirm that a random sampling of those listings represented active businesses. In 2008, Ms. Griffith telephoned businesses and checked the Internet in an effort to determine if certain businesses were actively operating in relevant fields. In its written argument, the Applicant cites the following six active third party businesses from Ms. Griffith's evidence:

1. Clean Masters Janitorial Services offering janitorial and cleaning services;
2. Master Cleaning Services offering commercial cleaning services;
3. Clean Master offering building and cleaning maintenance services;

4. Clean Master offering fire damage restoration service and general contracting services;
5. Master Interiors Cleaning offering carpet and upholstery cleaning;
6. Master Cleaning Supplies offering cleaning supplies.

[41] It is the Opponent's position that Ms. Griffith's evidence is hearsay that should be given little weight, because she does not know whom she spoke with at the businesses that she contacted by telephone and because the websites of the companies that she reviewed cannot be considered as evidence of the truth of their contents.

[42] I am prepared to accord some weight to the Griffith's evidence as it seems clear that third parties are active under trade-names that incorporate the words MASTER and CLEAN in the general field that the parties operate within. However, I note that there is no evidence that any of these third party trade-names has acquired a significant reputation in the marketplace.

ii) co-existence without confusion

[43] It is of course not necessary for the Opponent to evidence confusion in order for me to find that there is a likelihood of confusion but an adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the Opponent [*Christian Dior S.A. v. Dion Neckwear Ltd.* (2002), 20 C.P.R. (4th) 155 (F.C.A.) at para. 19].

[44] The Opponent alleges that there has been one documented instance of confusion. In particular, Mr. English attests at paragraph 32 of his affidavit, "...Exhibit 'J' to this my affidavit is a copy of an invoice dated October 16, 2006 received by Masterclean from one of its suppliers, for services rendered in association with wall tile installation. The work was requisitioned by Masterclean, the invoice was sent to Masterclean, but the invoice was made out to 'Servicemaster'..." This does not appear to me to be evidence of confusion as to source as opposed to merely clerical error. Moreover, I agree with the Applicant that, if this is evidence of confusion, then it is evidence of confusion between the junior mark MASTERCLEAN and the senior mark SERVICEMASTER, there being no reference to the Word Mark in the invoice.

[45] It is also noted that the Applicant's affiants have attested that they are not aware of any incidents of confusion.

[46] To sum up, I find that there is no evidence of confusion as to source despite more than a decade of coexistence.

iii) other registrations owned by Applicant

[47] As shown in Exhibit A to the England affidavit, the Applicant owns a number of registrations for marks that consist of or include SERVICEMASTER (including a black and white version of the Design Mark). However, as noted earlier, such registrations do not give the Applicant the automatic right to obtain a further registration no matter how closely it may be related.

iv) other trade-marks used by Applicant

[48] The Applicant submits that it has merely added the descriptive word CLEAN to a mark that it has already made strong, namely SERVICEMASTER, and that therefore clients will know that it is the source of the SERVICEMASTER CLEAN services.

v) U.S. decision

[49] The Applicant directed me to a U.S. court decision issued in 2002 concerning a dispute with respect to the trade-marks SERVICEMASTER CLEAN and MASTER CLEAN, which was attached as Exhibit C to the Wassell affidavit. However, the owner of the MASTER CLEAN mark in that dispute is a third party, not the Opponent. Although the facts in the U.S. decision are somewhat similar to those before me, the U.S. decision is not relevant to the case at hand given the differences in parties, facts and applicable law.

conclusion

[50] Having considered all of the surrounding circumstances, I find that the Applicant has established, on a balance of probabilities, that confusion is not likely between

SERVICEMASTER CLEAN and MASTER CLEAN as of today's date for the reasons that follow.

[51] It is difficult to monopolize weak words such as "master clean". While acknowledging that the Opponent has acquired a reputation of some extent in association with MASTER CLEAN, this is the sort of mark that is typically not given a broad scope of protection, with small differences being sufficient to distinguish a similar mark. SERVICEMASTER CLEAN does resemble MASTERCLEAN, but given that the first, more dominant portion is different, the marks are sufficiently different to make confusion unlikely, especially in view of the fact that the Applicant has established a significant reputation in association with SERVICEMASTER CLEAN. The lack of evidence of any confusion as to source despite more than 10 years coexistence further supports my conclusion.

[52] The s. 12(1)(d) ground of opposition accordingly fails.

Section 16 Grounds of Opposition

[53] In order to meet its initial burden with respect to the first of its s. 16 grounds (which falls under s. 16(1)(a) of the Act), the Opponent must show that it used MASTERCLEAN or MASTER CLEAN prior to October 1997 and had not abandoned such use as of May 25, 2005 (see s. 16(5)).

[54] The Opponent's evidence concerning use of its mark prior to October 1997 is as follows. Mr. English attests that the Opponent and its predecessor have used MASTER CLEAN continuously since 1980 in association with restoration, renovation and cleaning services. In his affidavit he states that sales from May 1, 1996 to April 30, 1997 were \$2,093,828. In addition, at Question 356 of his cross-examination he was asked what the sales were prior to May 1, 1996 and responded that sales "hovered on the 2-million range for several years ... [and that his company] had 34 years of continuous growth, but always the same, a little bit per year." I am therefore satisfied that there were substantial sales of MASTER CLEAN services prior to the Applicant's claimed date of first use.

[55] The Applicant has submitted that the Opponent has not met its initial burden because Mr. English's evidence shows use of MASTERCLEAN CONTRACTING AND CLEANING, not MASTER CLEAN or MASTERCLEAN *simpliciter*. While it is true that the words CONTRACTING & CLEANING typically follow MASTERCLEAN, such use does qualify as use of MASTERCLEAN *simpliciter* when MASTERCLEAN appears on a separate line or in a different font, as on the business card attached as Exhibit D to Mr. English's affidavit. I further note that on cross-examination, Mr. English confirmed that although Exhibit D is a current business card, the major elements of the Opponent's business card have remained the same since the business began in 1971.

[56] In his affidavit, Mr. English also attests that advertising expenditures associated with the Opponent's mark were \$92,065 between May 1, 1996 and April 30, 1997.

[57] Of course, as of the Applicant's claimed date of first use there had been no use or advertising of the Word Mark, with the result that a consideration of the length of time that the marks had been in use and the extent to which each had become known necessarily favours the Opponent.

[58] The Applicant's position is clearly less strong under this ground than under the s. 12(1)(d) ground. I note that the evidence of state of the marketplace postdates the material date under this ground and so is of no avail to the Applicant.

[59] The question therefore becomes whether the differences between the marks at issue are sufficient to outweigh the countervailing factors. As stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 at 149 (F.C.T.D.), "Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances."

[60] Having considered all of the surrounding circumstances, I arrive at the conclusion that the probabilities of confusion between MASTER CLEAN and SERVICEMASTER CLEAN as of October 1997 are evenly balanced between a finding of confusion and of no confusion. I reach

this conclusion because on the one hand MASTER CLEAN is not the type of mark that is typically accorded a broad scope of protection and the Applicant's Mark has a different beginning from the Opponent's mark, but on the other hand, only the Opponent had acquired a reputation in association with its mark as of October 1997, the parties are competitors and the Applicant's Word Mark consists of the Opponent's entire mark preceded by the inherently weak word SERVICE. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's trade-mark, the s. 16(1)(a) ground succeeds. I note that the difference in outcome between this ground and the s. 12(1)(d) ground is also attributable in part to the fact that the evidence of coexistence without confusion, as well as the evidence of third party use of similar marks, cannot be considered under this ground.

[61] In order to meet its initial burden with respect to the second of its s. 16 grounds (which falls under s. 16(1)(c) of the Act), the Opponent must show that it used the trade-name Masterclean Service Company prior to October 1997 and had not abandoned such use as of May 25, 2005 (see s. 16(5)). There is no evidence showing use of such trade-name and so the s. 16(1)(c) ground is dismissed.

Distinctiveness Ground of Opposition

[62] In order to meet its initial burden with respect to its distinctiveness ground of opposition the Opponent must evidence that its MASTER CLEAN trade-mark had become sufficiently known as of October 25, 2005 to negate the distinctiveness of the Word Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.) and *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. If this burden is met, then the Applicant has a legal onus to show, on a balance of probabilities, that the Word Mark was not likely to create confusion with the Opponent's trade-mark as of October 25, 2005 [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)].

[63] Mr. English's evidence satisfies the Opponent's initial burden. However, I find that under this ground of opposition the Applicant has met its legal onus, primarily because as of this ground's material date there had been substantial use and promotion of the Word Mark and eight years coexistence without confusion. The distinctiveness ground accordingly fails.

[64] I turn now to the opposition against the application for the Design Mark.

Application No. 1,278,252

[65] The evidence and grounds of opposition with respect to application No. 1,278,252 are similar to those with respect to application No. 1,070,731. However, I note that the two cross-examinations of Mr. English contain some differences, such as the fact that only with respect to the Word Mark did Mr. English provide information concerning the Opponent's sales prior to May 1996. In my analysis below, where I have not addressed issues that were previously discussed with respect to the application for the Word Mark, my comments above should be taken to apply, unless it is indicated otherwise.

Section 30 Grounds of Opposition

[66] Despite the differences in the material dates for assessing the s. 30 grounds of opposition, my analysis of these grounds with respect to application No. 1,070,731 applies equally to application No. 1,278,252. Accordingly, I am dismissing the s. 30 grounds of opposition.

Section 12(1)(d) Grounds of Opposition

[67] The main difference with respect to the analysis of the likelihood of confusion between MASTER CLEAN and SERVICEMASTER CLEAN & Design as opposed to between MASTER CLEAN and SERVICEMASTER CLEAN arises from the differences between the Applicant's two marks. I shall therefore focus below mostly on the impact of the degree of resemblance between the parties' marks in appearance. Concerning any other surrounding circumstances which are not specifically referred to below, I adopt the discussion set out above with respect to the s. 12(1)(d) grounds against application No. 1,070,731.

[68] The Opponent submits that the design features of the mark that is the subject of application No. 1,278,252 serve to emphasize the words MASTER CLEAN, both because these two words are largely within a triangle design and because they alone are highlighted by the colour yellow. To put it another way, the Opponent submits that the yellow triangle serves to shine a spotlight on the words MASTER CLEAN in the Design Mark. I consider this to be a fair statement.

[69] As noted earlier, the Supreme Court in *Masterpiece* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique. With respect to the SERVICEMASTER CLEAN & Design mark it is arguable that it is the highlighted words MASTER CLEAN that are particularly striking. The emphasis that the design places on the last two words in the Design Mark results in the general rule that the first portion of a mark is typically the dominant portion being overridden.

[70] Another factor whereby the analysis with respect to the Applicant's Design Mark differs from that with respect to the Applicant's Word Mark is the extent to which the Applicant's mark has become known. For example, Mr. England has provided sales and advertising figures for the Applicant's services annually since 1997; however, each figure provided relates to both the Word Mark and the Design Mark. While use of the Design Mark qualifies as use of the Word Mark, the reverse is not true. Therefore, it is unclear what percentage of those figures is attributable to the Design Mark. Therefore, to some degree the sales and advertising figures provided by the Applicant must be accorded reduced weight.

[71] Having considered all of the surrounding circumstances, I arrive at the conclusion that as of today's date the probabilities of confusion between MASTER CLEAN and the Design Mark are evenly balanced between a finding of confusion and of no confusion. I reach this conclusion because on the one hand MASTER CLEAN is not the type of mark that is typically accorded a broad scope of protection and there are differences between the Opponent's mark and the Design Mark, while on the other hand, the parties are competitors and the Applicant has chosen a design that emphasizes the words in its mark that comprise the Opponent's entire mark. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Design Mark is not confusing with the Opponent's trade-mark, the s. 12(1)(d) ground succeeds based on registration No. TMA226,306. I note that the difference in outcome under s. 12(1)(d) between the Design Mark and the Word Mark is also attributable in part due to the vague evidence concerning the reputation acquired by the Design Mark, which resulted in me being unable to draw any inference from the lack of evidence of confusion.

Section 16 Grounds of Opposition

[72] In order to meet its initial burden with respect to the first of its s. 16 grounds (which falls under s. 16(1)(a) of the Act), the Opponent must show that it used MASTERCLEAN or MASTER CLEAN prior to October 1, 1997 and had not abandoned such use as of September 13, 2006 (see s. 16(5)).

[73] The Opponent's evidence concerning use of its mark prior to October 1, 1997 in the opposition against the Design Mark is less than it is with respect to the Word Mark because when Mr. English was cross-examined with respect to the application for the Design Mark he was not asked to evidence sales prior to May 1996. Nevertheless, in his affidavit he did provide sales and advertising figures for the time period May 1, 1996 to April 30, 1997 and I find that the Opponent has met its initial burden under s. 16(1)(a) with respect to the Design Mark. I note that the Applicant once again argued that the Opponent was not using the mark that it relied upon in its pleadings, but my response to that argument is as indicated earlier with respect to the Word Mark.

[74] Of course, as of the Applicant's claimed date of first use there had been no use or advertising of the Design Mark, with the result that a consideration of the length of time that the marks had been in use and the extent to which each had become known necessarily favours the Opponent.

[75] Having considered all of the surrounding circumstances, I arrive at the conclusion that as of October 1, 1997 the probabilities of confusion between MASTER CLEAN and the Design Mark are evenly balanced between a finding of confusion and of no confusion. I reach this conclusion because on the one hand MASTER CLEAN is not the type of mark that is typically accorded a broad scope of protection and there are differences between MASTER CLEAN and the Design Mark, but on the other hand, only the Opponent had acquired a reputation in association with its mark as of October 1, 1997, the parties are competitors and the design features of the Applicant's Design Mark emphasize that portion of the Design Mark that replicates the Opponent's mark in its entirety. As the legal burden is on the Applicant to establish, on a balance of probabilities, that the Mark is not confusing with the Opponent's trademark, the s. 16(1)(a) ground succeeds. As noted with respect to the Word Mark, any evidence of

coexistence without confusion or third party use of similar marks postdates the material date under this ground and cannot be considered.

[76] The outcome of the s. 16(1)(c) ground with respect to the Design Mark is the same as with respect to the Word Mark, i.e. it fails because the Opponent did not evidence that it used the trade-name Masterclean Service Company prior to October 1, 1997 and had not abandoned such use as of September 13, 2006 (see s. 16(5)). In fact, in the cross-examination with respect to the Design Mark, Mr. English informed us in response to a question taken under advisement that he stopped using the name Masterclean Service Company on letterhead and correspondence 20 to 25 years ago.

Distinctiveness Ground of Opposition

[77] In order to meet its initial burden with respect to its distinctiveness ground of opposition the Opponent must evidence that its MASTER CLEAN trade-mark had become sufficiently known as of November 6, 2006 to negate the distinctiveness of the Design Mark. Mr. English's evidence satisfies the Opponent's initial burden.

[78] The Applicant's position as of November 6, 2006 is no stronger than it is as of today's date under the s. 12(1)(d) ground of opposition and for reasons similar to those discussed with respect to the s. 12(1)(d) ground, the distinctiveness ground of opposition succeeds with respect to the Design Mark.

Disposition

[79] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse both application No. 1,070,731 and application No. 1,278,252, pursuant to s. 38(8) of the Act.

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