



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

Citation: 2014 TMOB 258
Date of Decision: 2014-11-25

**IN THE MATTER OF an OPPOSITION
by 385MKE Limited to application
No. 1,326,184 for the trade-mark GO
GREEN WITH SERVICEMASTER
CLEAN & DESIGN in the name of The
ServiceMaster Company**

[1] The ServiceMaster Company (the Applicant) filed application No. 1,326, 184 for the trade-mark GO GREEN WITH SERVICEMASTER CLEAN & DESIGN (the Mark), as shown below, on November 29, 2006.



[2] The application for the Mark is based upon proposed use and it currently covers services which are described as: “commercial and residential building cleaning services; janitorial services; window, carpet and furniture cleaning services; building maintenance and repair, maid services”.

[3] The application for the Mark was advertised for opposition purposes in the *Trade-marks Journal* dated September 23, 2009.

[4] On November 20, 2009, 385229 Ontario Limited (doing business as Masterclean Service Company) filed a statement of opposition to oppose the application for the Mark under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[5] 385229 Ontario Limited (doing business as Masterclean Service Company) is a predecessor-in-title to 385MKE Limited (the Opponent) in these proceedings. It previously owned the trade-mark MASTER CLEAN (registration No. TMA226,306), which covers “carpet cleaning machines” and “restoration, renovation and cleaning services” and the trade-mark MASTERCLEAN (registration No. TMA253,190), which covers “restoration, renovation and cleaning services”.

[6] Registration No. TMA226,306 was assigned to the Opponent during the course of these opposition proceedings and Registration No. TMA253,190 has now been expunged.

[7] The grounds of opposition in this case are based upon sections 30(a), 30(i), 16(3)(a), 16(3)(c), 12(1)(d) and 2 of the Act.

[8] A counterstatement was filed by the Applicant on February 8, 2010.

[9] In support its opposition, the Opponent filed the affidavit of Mark English, sworn June 22, 2010 (the English affidavit). A similar affidavit was filed in related oppositions against application Nos. 1,070,731 (for SERVICEMASTER CLEAN) and 1,278,252 (for SERVICEMASTER CLEAN & Design) and cross-examinations occurred on August 21, 2007 (first English cross-examination) and on February 28, 2008 (second English cross-examination). The parties have requested that the transcripts, exhibits thereto and answers to undertakings from those cross-examinations in the related oppositions be made of record in these proceedings and consequently, they have been.

[10] In support of its application, the Applicant filed the affidavit of Ian England, sworn October 3, 2011 (the England affidavit), the affidavit of Mary P. Noonan, sworn October 3, 2011 (the Noonan affidavit), the affidavit of James C. Wassell, sworn September 30, 2011 (the Wassell affidavit) and the affidavit of Jane Griffith, sworn October 3, 2011 (the Griffith affidavit).

[11] An order for cross-examination was requested for all four affiants. Ms. Griffith was previously cross-examined in the related oppositions to application Nos. 1,070,731 and 1,278,252 and the parties have requested that the transcript of that cross-examination be made of record in these proceedings. Consequently, it has been. Mr. Wassell and Mr. England did not make themselves available for cross-examination. Consequently, their affidavits no longer form part of the record. Ms. Noonan was not cross-examined, but her affidavit has been made of record.

[12] Both parties filed written arguments and participated in a hearing.

[13] For the reasons that follow, I refuse the application.

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 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

Sections 30(a) and 30(i)

[15] A ground of opposition based upon an allegation of non-compliance with section 30(a) of the Act that does not identify which wares or services are not defined in ordinary commercial terms is insufficiently pleaded [see *K-tel International Ltd v 1033064 Canada Inc.*, (1998), 86 CPR (3d) 122 (TMOB) and *Where Magazines International et al v Nystrom Division of Herff Jones, Inc.*, (2004) 42 CPR (4th) 271 (TMOB)]. The Opponent in this case has not identified which of the services is allegedly not defined in ordinary commercial terms, nor has it filed any evidence or made any substantive submissions in support of this ground of opposition. Accordingly, this ground of opposition is summarily dismissed.

[16] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground of opposition should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is summarily dismissed.

Analysis of Remaining Grounds of Opposition

Section 12(1)(d)

[17] The Opponent has pleaded that the Mark is not registrable as it is confusing with its registered trade-marks MASTERCLEAN (registration No. TMA253,190) and MASTER CLEAN (registration No. TMA226,306).

[18] An opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registration upon which it relies is extant at the date of my decision. Since registration No. TMA253,190 has been expunged, the Opponent has only met its initial burden with respect to registration No. TMA226,306 for MASTER CLEAN, which I confirm is extant.

[19] My analysis of the likelihood of confusion under this ground will therefore be based solely on registration No. TMA226,306 for MASTER CLEAN and the Applicant must establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between this trade-mark and the Mark.

[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] It is well established that 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 section 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 [*Mattel, Inc v 3894207 Canada Inc* (2006), 2006 SCC 22 (CanLII); *Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée* (2006), 2006 SCC 23 (CanLII); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 2011 SCC 27 (CanLII)].

[22] At the outset, I wish to note that although the section 12(1)(d) ground of opposition is only being assessed based on the Opponent's registration No. TMA226,306 for MASTER CLEAN, I accept that use of MASTERCLEAN would qualify as use of MASTER CLEAN [*Nightingale Interloc Ltd v Prodesign Ltd*, (1984), 2 CPR (3d) 535]. Thus, any reference I make to the use or reputation associated with MASTER CLEAN, will also take into account any use or reputation associated with MASTERCLEAN.

[23] I will now begin my analysis of the section 6(5) factors and surrounding circumstances.

Preliminary Remarks

[24] As previously mentioned, the parties in this proceeding were previously involved in opposition proceedings in relation to application Nos. 1,070,731 (for SERVICEMASTER CLEAN) and 1,278,252 (for SERVICEMASTER CLEAN & Design). In a decision dated March 30, 2012, Member Bradbury refused both applications [*385229 Ontario Limited v ServiceMaster Company* (2012), 101 CPR (4th) 380 (TMOB)]. That decision was upheld by the Federal Court earlier this year [*The Servicemaster Company v 385229 Ontario Ltd (dba Masterclean Service Company* (2014) 122 CPR (4th) 40 (FC)]. The parties referred to this decision at length in their written submissions and at the hearing. I acknowledge that Member Bradbury's decision may be somewhat instructive. However, each case must be decided on its own facts and merit.

[25] Although the Opponent failed under its section 12(1)(d) ground in relation to application No. 1,070,731 (for SERVICEMASTER CLEAN), it did so in part because the Applicant had established significant reputation in its trade-mark and a lengthy period of co-existence between the parties' trade-marks with no resulting confusion. Those factors do not weigh in the

Applicant's favour here, as the application for the Mark is based upon proposed use. There is also no evidence of record in this case to establish any reputation in SERVICEMASTER CLEAN which forms part of the Mark. Had such evidence been filed, my conclusion may have been different.

Section 6(5)(a): the inherent distinctiveness of the trade-marks and the extent to which they have become known

[26] Neither of the parties' trade-marks is particularly inherently distinctive, in view of the fact that they are both comprised of ordinary dictionary words. As noted by Member Bradbury in *385229 Ontario Limited v ServiceMaster Company [ibid]*, CLEAN is descriptive and MASTER is laudatory. In addition, as submitted by the Opponent, the words GO GREEN suggest to consumers that they be environmentally friendly. That being said, the parties' trade-marks do possess some degree of inherent distinctiveness.

[27] A trade-mark's distinctiveness may be increased through use and promotion.

[28] The application for the Mark is based upon proposed use and there is no evidence of record to suggest that the Mark has been used or acquired any reputation.

[29] By contrast, the Opponent, or its predecessor, has used its MASTER CLEAN trade-mark continuously since 1971 in association with restoration, renovation and cleaning services [English affidavit, paras 12 and 13]. Sales from May 1, 1996 to October 31, 2006 exceeded \$44 million [English affidavit, para 18]. Sales from May 1, 2007 to April 30, 2008 were approximately \$5,025,465.00 and sales from May 1, 2008 to April 30, 2009 were approximately \$6,088,414.00 [English affidavit, para 19].

[30] The Applicant has pointed out that exhibits to the English affidavit show use of MASTERCLEAN CONTRACTING AND CLEANING, rather than MASTER CLEAN or MASTERCLEAN, *simpliciter*. However, to the extent that MASTER CLEAN appears on a separate line or in different font in some of those instances, such use would constitute use of MASTER CLEAN, *simpliciter* [*Nightingale Interloc Ltd supra*].

[31] The Opponent's restoration, renovation and cleaning services have been promoted in association with its MASTER CLEAN trade-mark through the Yellow Pages directory (both in print and online), through other directories and brochures and in the official journal of the Ontario Insurance Adjusters Association [English affidavit, paras 22 and 23]. The Opponent's advertising expenditures exceeded \$1.4 million between May 1, 1996 and October 31, 2006 [English affidavit, para 24]. From November 1, 2006 to April 30, 2007 and from May 1, 2007 to April 30, 2008, the Opponent's advertising expenditures were approximately \$81,322.00 and \$92,112.00, respectively [English affidavit, para 24].

[32] However, during cross-examination, it was revealed that a significant portion of those expenditures 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 approximately \$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 [English transcript (first English cross-examination), Q's 248-257 and Answers to Questions taken under Advisement, nos. 4 and 6].

Section 6(5)(b): the length of time each of the trade-marks has been in use

[33] Since the application for the Mark is based upon proposed use and the Applicant has not filed any evidence to suggest that use of the Mark has commenced, this factor favours the Opponent.

Sections 6(5)(c) and (d): the nature of the wares, services, trade and business

[34] When considering sections 6(5)(c) and (d) of the Act, it is the statement of services in the application for the Mark and the statement of wares and services in the Opponent's registration No. TMA226,306 for MASTER CLEAN that govern the assessment of the likelihood of confusion under section 12(1)(d) of the Act [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[35] 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), 1996 CanLII 3963 (FCA), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd*, (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd*, (2000), 5 CPR (4th) 110 (TMOB)].

[36] The statement of wares and services in the Opponent's registration covers "carpet cleaning machines" (as an aside, I note that during cross-examination, Mr. English admitted that the Opponent has never made or sold these wares) and "restoration, renovation and cleaning services". The application for the Mark covers "commercial and residential building cleaning services; janitorial services; window, carpet and furniture cleaning services; building maintenance and repair, maid services".

[37] 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 [English affidavit, paras 14-17; English transcript (second English cross-examination), Q's 223-239].

[38] At the hearing, the Applicant submitted that the evidence suggests that the Opponent's "restoration" and "renovation" services are primarily related to disaster restoration and that its "cleaning" services are also performed within this context. The Applicant submits that these types of "restoration" and "renovation" services are not the same as the "building maintenance and repair" services which are covered in the application for the Mark and that the type of "cleaning" services which are provided by the Opponent are not of the same nature as the "commercial and residential building cleaning services", "janitorial services", "window, carpet and furniture cleaning services" and "maid services", which are covered in the application for the Mark.

[39] In support of these submissions, the Applicant primarily relies on the fact that the statement of services in the application for the Mark doesn't specify that the services which are associated with the Mark are performed within the context of disaster restoration. At the hearing, the Applicant also submitted that the channels of trade of the parties wouldn't necessarily overlap, since there is no indication in the statement of services in the application for the Mark that the Applicant's services are targeted towards insurance companies.

[40] While it's true that the statement of services in the application for the Mark does not specify that the Applicant's services relate to disaster restoration or indicate that they are targeted towards insurance companies, it also doesn't say that they are not. The fact that there are no such restrictions means that the Applicant's services could very well be of the same nature as those of the Opponent and there is nothing to prevent the Applicant from targeting the same types of consumers. Moreover, the Applicant has not filed any evidence whatsoever to establish that the services in association with which it proposes to use its Mark do, in fact, differ from those of the Opponent or that they would be targeted to a different consumer.

[41] In view of the foregoing, I must conclude that there is overlap in the services which are associated with the parties' trade-marks. In view of this overlap, it is reasonable to conclude that the parties' channels of trade could also overlap [*Effigi Inc v ZAM Urban Dynamics Inc* (2011), 89 CPR (4th) 461 (TMOB)].

Section 6(5)(e): the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[42] In *Masterpiece* the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the trade-marks.

[43] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trade-mark.

[44] Furthermore, while the first portion of a trade-mark is usually the most important for the purpose of distinguishing [see *Conde Nast Publications Inc v Union des Editions Modernes*

(1979), 46 CPR (2d), 183 (FCTD) at 188], the Supreme Court of Canada in *Masterpiece* has stated that the preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[45] Not surprisingly, the parties in the present case have very different views on the degree of resemblance between the trade-marks in question. The Applicant submits that the parties' trade-marks differ significantly from one another. The Applicant submits that the words GO GREEN and the small triangle design which are at the beginning of the Mark are the more distinctive, dominant elements of the Mark. In addition, the Applicant asserts that the triangular design feature of the Mark emphasizes the word GO and not any part of the Mark which replicates the Opponent's trade-mark in any way. The Applicant submits that the differences between the trade-marks in the present case are far greater than they were between the parties' trade-marks in the related cases and in view of this, the Applicant is of the view that the Mark should be registrable. The Applicant is partly of this view because it takes the position that the Opponent's trade-mark is a weak Mark and that small differences should be sufficient to distinguish between it and other traders' marks.

[46] It is true that some aspects of the trade-marks which are at issue in the present case differ from those which were the subject of the oppositions against application Nos. 1,070,731 (for SERVICEMASTER CLEAN) and 1,278,252 (for SERVICEMASTER CLEAN & Design). However, I find that there is still some degree of resemblance between the trade-marks which are at issue in the present case.

[47] In this case, the Mark (GO GREEN WITH SERVICEMASTER CLEAN & DESIGN) functions a bit like a slogan and the Opponent submits that the beginning of the Mark (i.e. the words Go Green and the triangle design) is not the most dominant or striking part of the Mark. I do not entirely agree with the Opponent's assessment in this regard. Rather, I do find that there is a visual emphasis on the words Go Green in the Mark and I also note that those words do appear in the dominant first position of the Mark, along with the design element. That being said, the words Go Green are not particularly inherently distinctive. The idea suggested by the Mark as a whole is that consumers "Go Green" and that they do it with "ServiceMaster Clean". The word

“with” signals to consumers that the source of the services is coming next and that the source is “ServiceMaster Clean”.

[48] Thus, although the Mark begins with words and a design element that are not in the Opponent’s mark and although those features may be emphasized in the Mark, the fact remains that the Applicant has still incorporated the Opponent’s trade-mark in its entirety into the Mark and it has done so in a way that does place some emphasis or importance on that part of the Mark. The result is that there is still some degree of resemblance between the parties’ trade-marks.

Other Surrounding Circumstances

State of the Register/Marketplace Evidence

[49] The Applicant has filed state of the register (Noonan affidavit) and state of the marketplace evidence (Noonan affidavit and Griffith affidavit) with respect to the words MASTER and CLEAN.

[50] Ms. Noonan’s affidavit 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 a small number of third party trade-marks on the register that incorporate derivatives of the words MASTER and CLEAN, but these are significantly different from the trade-marks at issue.

[51] Ms. Noonan also searched for trade-names that include both MASTER and CLEAN, or derivatives of those words. She located approximately 15 business names beginning with MASTER CLEAN, 23 that start with MASTER CLEANER(S) and 11 that start with MASTER CLEANING, as well as a number of others that start with the words CLEAN MASTER or CLEANMASTER. Ms. Noonan has not provided any evidence to establish what the precise nature of these businesses is. However, in some cases the nature of the business can be surmised to some extent from the trade-names themselves.

[52] Ms. Griffith is a professional researcher. In September of 2011, Ms. Griffith contacted 11 businesses by telephone to confirm that they offer cleaning services and swore an affidavit to this

effect. In its written argument, the Applicant cites the following five active third party businesses from Ms. Griffith's evidence:

1. Master Cleaning Services offering commercial cleaning services [Griffith affidavit, para 4];
2. Master Cleaning Supplies offering cleaning supplies [Griffith affidavit, para 5];
3. Master Interiors Cleaning offering carpet and upholstery cleaning [Griffith affidavit, para 6, Exhibit A para 6 and Exhibits D to A];
4. Clean Master offering building and cleaning maintenance services Griffith affidavit, para 8, Exhibit A and para 8 and Exhibits F to A]; and
5. Clean Master offering fire damage restoration services and general contracting services [Griffith affidavit, para 9, exhibit A and Exhibits G to A].

[53] The Opponent takes the position that Ms. Griffith's evidence is hearsay and that it should be given little weight. Similar evidence was provided in the related oppositions between the parties and Member Bradbury accorded some weight to it. She did so because it seemed clear from the evidence that third parties were active under trade-names that incorporate the words MASTER and CLEAN in the general field that the parties operate within. I am prepared to take the same approach to the hearsay issue in this case, but I also echo Member Bradbury's finding that this evidence does not establish that any of the businesses which were contacted had acquired a significant reputation in the marketplace.

Conclusion

[54] Having considered all of the surrounding circumstances, I find that the probability of confusion between the parties' trade-marks is evenly balanced between a finding of confusion and a finding of no confusion.

[55] I acknowledge that it is difficult for a trader to monopolize weak words such as MASTER CLEAN and that the Opponent's trade-mark is not the sort of mark that is typically afforded a broad scope of protection, with small differences typically being sufficient to

distinguish a similar mark. However, in the words of the Opponent, a narrow scope of protection is not the same as having no protection at all.

[56] In this case, the Opponent has used its trade-mark for a lengthy period of time and it has acquired some degree of reputation. There is direct overlap in the services which are associated with the parties' trade-marks and nothing would prohibit the Applicant from targeting the same consumers as those which are targeted by the Opponent. There is also some degree of resemblance between the parties' trade-marks given that the Applicant has incorporated the whole of the Opponent's trade-mark into the Mark. In view of this, it is reasonable to conclude that a consumer, upon seeing the Mark in association with the Applicant's services would be likely to infer that those services are being performed by the Opponent.

[57] 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 and it has not done so, the section 12(1)(d) ground of opposition is successful.

Section 2

[58] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its services from those of others, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)]. Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the date of filing of the statement of opposition, its trade-mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)].

[59] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, the Opponent was successful in establishing that its MASTER CLEAN trade-mark had become quite well known as of the date of filing the statement of opposition and as a result, the Opponent has met its evidential burden. The difference in material dates is insignificant and for the reasons as identified above in my analysis of the section 12(1)(d) ground of opposition, I am not satisfied

that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' trade-marks.

[60] Accordingly, the non-distinctiveness ground is also successful.

Non-Entitlement - Sections 16(3)(a) and 16(3)(c)

[61] Since the opposition has already succeeded under two grounds, I will not address these remaining grounds of opposition.

Disposition

[62] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office