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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2019 TMOB 100**

**Date of Decision: 2019-09-30**

**IN THE MATTER OF AN OPPOSITION**

**Yves Levis**

**Opponent**

**and**

**Mikhail Golubev**

**Applicant**

**1,679,937 for MoldXperts**

**Application**

INTRODUCTION

[1] Mikhail Golubev (the Applicant) has applied to register the trademark MoldXperts (the Mark) in association with the following goods and services based on use of the Mark in Canada since at least as early as March 31, 2009:

Printed materials, namely, mold remediation guidelines; Residential and commercial building mold remediation and removal tools, equipment and chemicals, namely protective clothing and show covers; fungicide and disinfectant; duct tape, plastic sheeting, protective eyewear, nitrile gloves, respirator masks, hepa vacuums and vacuum bags, mold, mildew and fungi cleaning and remediation kits (the Goods)

Mold consultation and remediation services for residential and commercial buildings, namely, inspection, investigation and sampling services, air quality testing services, thermal camera inspection services, water migration mapping services, mold testing, removal and disposal, mold, mildew and fungi remediation; sale of mold, mildew and fungi removal and remediation equipment (the Services)

[2] Yves Levis (the Opponent) owns pending applications for the trademarks MOLDXPERTS and MOLDXPERTS (Design) in association with identical Services. Both of the Opponent's applications were filed after the subject application and claim a later date of first use in Canada. The Opponent has opposed the Applicant's application on a number of technical grounds, and has also challenged the distinctiveness of the Mark.

[3] For the reasons set out below, I find that the application ought to be refused.

#### THE RECORD

[4] The application for the Mark was filed on June 4, 2014, and was advertised for opposition purposes in the *Trademarks Journal* of July 15, 2015.

[5] On December 15, 2015 the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded by the Opponent include sections 30(a), 30(b), 30(i) and 2 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[6] The Applicant filed a counter statement on January 28, 2016.

[7] In support of the opposition, the Opponent filed his own affidavit (sworn June 19, 2016) (the first Levis affidavit). In support of his application, the Applicant filed his own affidavit (sworn October 12, 2016) (the Golubev affidavit). In reply, the Opponent filed a further affidavit of his own (sworn December 21, 2016) (the second Levis affidavit). Neither the Applicant nor the Opponent was cross-examined.

[8] Only the Opponent filed a written argument. However, both parties attended a hearing.

PRELIMINARY REMARKS

**Proceeding between the Opponent, the Opponent's company, and the Applicant's company in the Ontario Superior Court of Justice (Small Claims Court)**

[9] As will become apparent in reading this decision, the Opponent and the Applicant in this case are not strangers to one another, and for a time, the Opponent and the Applicant's company Bust Mold Inc. ("Bust Mold", also doing business as "Mold Busters") were in a business relationship. The nature of this relationship was among the key issues raised in a proceeding between these parties before the Ontario Superior Court of Justice (Small Claims Court) [see *Bust Mold Inc v Yves Levis, 7656041 Canada Inc and Eastern Canada MoldXperts Inc*, Superior Court File No. SC-14-00132011-0000, date of decision September 25, 2017].

[10] A certified copy of this decision was submitted by the Opponent as his jurisprudence to be relied upon at the hearing, and at the hearing, the Opponent noted some of the court's findings therein, including its view on the credibility of the testimony of Bust Mold. However, the small claims court decision is not admissible for the truth of its contents, but rather simply to establish that a decision was made and that the findings for that decision were based on the evidence before the judge in that particular case [*Scott & Ayleen v Nintendo of America Inc.* (1992), 47 CPR (3d) 102 at 105 (TMOB)].

[11] I further note that while I have considered all of the evidence and submissions of record, my decision only addresses the evidence and submissions which I find are directly relevant to my ultimate findings on each of the pleaded grounds of opposition. Accordingly, evidence more appropriately related to issues raised in the small claims court proceeding, for instance whether Mr. Levis was previously an employee of Bust Mold or an independent contractor, is not addressed.

**Admissibility of portions of the Applicant's evidence relating to "proven" facts in the small claims court proceeding**

[12] In his written argument, the Opponent submits that portions of the Golubev affidavit recite allegations as if they were proven facts, when in fact, they are not. In particular, paragraphs 11 and 15 of the Golubev affidavit refer to the Opponent's alleged actions, including theft of the Applicant's clients and use of the Applicant's Mold Busters trademarks to gain

financial benefit, being “proven” in Small Claims Court, while a decision had not in fact been rendered by the court.

[13] I do not consider these allegations to be pertinent to the issues raised in this opposition proceeding, and so have not considered them in my analysis. However, in any event, I agree with the Opponent’s submissions on this point.

### **Applicant’s attempts to file additional evidence at the hearing**

[14] At the hearing, the Applicant attempted to file new evidence. The Applicant was advised that if he wished to introduce additional evidence, then the proper course of action would be for him to seek leave to file additional evidence pursuant to section 44 of the *Trademarks Regulations*. As he did not make this request, the only evidence of record for the Applicant consists of the Golubev affidavit.

### ONUS AND MATERIAL DATES

[15] 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[16] The material dates that apply to the grounds of opposition pleaded are:

- Sections 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475], and;
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

## ANALYSIS OF THE GROUNDS OF OPPOSITION

### **Section 30(a) ground**

[17] The Opponent alleges that contrary to section 30(a) of the Act, “the Applicant did not use, and does not presently use, the Mark in Canada for the specific Goods and Services recited when the application was filed”. However, I find that such pleading, which relates more to claims of use in the application rather than whether the stated Goods and Services are in ordinary commercial terms, is more appropriately raised under section 30(b) of the Act. Accordingly, the non-compliance ground under section 30(a) of the Act is dismissed for having been improperly pleaded.

### **Section 30(b) ground**

[18] The Opponent alleges that contrary to section 30(b) of the Act, the Applicant has not used the Mark in Canada for the specific Goods and Services from the date of first use stated, namely March 31, 2009.

[19] The initial burden on an opponent is light respecting the issue of non-conformity with section 30(b) of the Act, because the facts regarding an applicant’s first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the opponent’s evidence but also to the applicant’s evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216]. However, an opponent may only successfully rely on the applicant’s evidence to meet its initial burden if the opponent shows that the applicant’s evidence puts into issue the claims set forth in the applicant’s application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 (CanLII) at paras 30-38]. To this end, pertinent portions of the record are set out below.

### Opponent’s evidence in chief – The first Levis affidavit

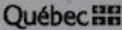
[20] Mr. Levis is the president and sole employee of 7656041 Canada Inc. and Eastern Canada MoldXperts Inc. (para 1). As summarized below, the first Levis affidavit sets out Mr. Levis’ previous business relationship with the Applicant’s company Bust Mold, and the steps Mr. Levis

later took to set up his own mold consultation and remediation business in association with the trademark and/or trade name MoldXperts. According to Mr. Levis:

- Sometime in 2010, Mr. Levis was approached by Mr. Golubev about providing professional services for Mold Busters in the province of Quebec. In consideration for paying 30% of his gross sales to Mold Busters, Mr. Levis would be provided with advertising, training, and professional help (para 4). Under this arrangement, all calls from the province of Quebec advertised on the Applicant's Mold Busters website were to be sent to Mr. Levis for processing (para 5).
- From approximately 2011 to 2013, Mr. Golubev and Mr. Levis worked together at the Applicant's Mold Busters mold consultation and remediation service in Eastern Ontario and Western Quebec using the trade name Mold Busters and the trademark MOLD BUSTERS (para 6).
- At Mr. Golubev's suggestion, Mr. Levis incorporated his business separately under 7656041 Canada Inc. and registered it to operate in Quebec under the trade name "Mold Busters" (para 7). I note that Exhibit E (excerpted below) shows Mr. Levis' registration of the names "LES EXPERTS DE LA MOISSURE" and "MOLD BUSTERS (VERSION ANGLAISE)".
- Due to a number of difficulties in the parties' relationship during the period between late 2012 and early 2013, the business relationship ended (para 8).
- On December 16, 2013, Mr. Levis purchased the domain name *moldxperts.ca* to continue to offer services in the mold identification and eradication field (para 9, Exhibit D).
- On January 14, 2014, Mr. Levis renamed his numbered company from 7656041 Canada Inc. to Eastern Canada MoldXperts Inc (para 10). As discussed later in my decision, the name change was ultimately recorded on July 21, 2014.
- An excerpt from the Certificate of Amendment (Registraire des entreprises Quebec) (Exhibit E) is shown below. I note that the corresponding trade names were also changed

from “LES EXPERTS DE LA MOISSURE” and “MOLD BUSTERS” to “Les Experts en moisissures de l’est du Canada” and “Eastern Canada MoldXperts”:

Date de mise à jour de l'index des noms		2014-07-21		
<b>Nom</b>				
Nom	Versions du nom dans une autre langue	Date de déclaration du nom	Date de déclaration du retrait du nom	Situation
Eastern Canada MoldXperts Inc.		2014-07-21		En vigueur
7656041 CANADA INC.		2010-09-22	2014-07-21	Antérieur
<b>Autres noms utilisés au Québec</b>				
Autre nom	Versions du nom dans une autre langue	Date de déclaration du nom	Date de déclaration du retrait du nom	Situation
Les Experts en moisissures de l'est du Canada	Eastern Canada MoldXperts	2014-07-21		En vigueur
LES EXPERTS DE LA MOISSURE.		2010-10-26	2014-07-21	Antérieur
MOLD BUSTERS (VERSION ANGLAISE)		2010-10-26	2014-07-21	Antérieur

  
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- In January 2014, Mr. Levis began to work with a logo developer to create logos for his business Eastern Canada MoldXperts Inc. (para 11, Exhibit F), and on January 21, 2014, Mr. Levis began to offer services under the trademarks MOLDXPERTS and MOLDXPERTS (Design) in the general field of mold identification and eradication (para 12).
- On February 4, 2014, the website at *www.moldxperts.ca* went live (para 14). A printout of this website dated July 29, 2014, taken from the website *www.wayback.com*, is attached as Exhibit G (para 15). I confirm that the printout displays ‘MoldXperts’ and appears to advertise Mr. Levis’ company’s mold identification and eradication services.
- Monthly gross sales/revenues from January 2014 to December 2014 for the services provided by Eastern Canada MoldXperts Inc. using the trademarks MOLDXPERTS and MOLDXPERTS (Design) are provided. Sales range from approximate monthly totals of \$1,000 (in February 2014) to \$47,000 (in September 2014) (para 13).

- Sometime between June and October 2014, Mr. Levis became aware that Mr. Golubev had filed the subject application for the trademark MOLDXPERTS on June 4, 2014 (para 16). Mr. Levis subsequently filed applications to register the trademarks MOLDXPERTS and MOLDXPERTS (Design) under application Nos. 1,697,812 and 1,697,817, respectively (para 17).
- Mr. Levis states that legal issues surrounding the end of his business relationship with Mr. Golubev are presently being litigated in the Ontario Superior Court of Justice (para 18). At paragraph 19 (reproduced below) he states:

19. In his Plaintiff's Claim in those proceedings, attached as Exhibit H, Mr. Golubev stated that "On January 10, 2014, we attempted to raise this issue with Mr. Levis, but he became defensive and quit. *Soon after he left our company, we discovered that Mr. Levis had started his own company ("MoldXperts" – www.moldxperts.ca) offering the same services as Mold Busters in the Ottawa-Gatineau and Montreal areas [Emphasis added]*". This clearly indicates that Mr. Golubev had not used the trademark MOLDXPERTS from the date claimed and, in fact, by his own pleadings, became aware of my own use of the trademark first.

- Mr. Levis also provides his opinions on the Applicant's satisfaction of its entitlement to use the Mark when filing the subject application, and discusses the distinctiveness of the applied for Mark (paras 23, 24). I have disregarded these statements as they amount to Mr. Levis' opinion on questions of fact and law that are to be determined by the Registrar.

#### Applicant's evidence – The Golubev affidavit

[21] Mikhail Golubev is the president of Bust Mold (para 1). Pertinent portions of Mr. Golubev's affidavit are summarized as follows:

- Bust Mold has been providing mold consultation and remediation services for residential, commercial and government clients since June 1, 2005 (para 2). Bust Mold owns registrations for, *inter alia*, the trademarks Mold Busters and Bust Mold in Canada, under registration Nos. TMA727,489 and TMA870,069, respectively (para 3).



- On March 2, 2012, Bust Mold applied for the trademark “The Mold Removal Experts” under application No. 1,566,982. The application, claiming use in Canada since June 1, 2015, was subsequently abandoned (para 4).
- Mr. Golubev states that on March 31, 2009, Bust Mold “started to use MoldXperts in marketing its services on websites and goods such as “mold remediation kit” (Exhibit A)”. Mr. Golubev cites Exhibit A in support of his claim that Bust Mold uses both “MoldXperts” and “The Mold Removal Experts” (para 13). I note that Exhibit A is comprised of a single page bearing the date “10/12/2016”, and the phrase “remediation\_kit.jpg (184x 170)”. The page also contains a photographic image or copy of what is presumably the alleged remediation kit. However, the entire image is completely blurry and cannot be seen in any reasonable level of detail. Any words that might appear on or as part of the image, including MoldXperts, are unreadable.
- In 2010, Mr. Levis joined Bust Mold and served its clients in Quebec by providing mold inspection and remediation services (para 6). Mr. Golubev alleges that Mr. Levis was fired in December 2013 (para 7).

[22] Paragraphs 8 through 10 of the Golubev affidavit are reproduced below:

8. On January 14th, 2014, Mr. Levis started a competing company Eastern Canada MoldXperts Inc., offering the exact same services as Bust Mold (which is in violation with the agreement).

9. In Exhibit B, it shows that [the] name “Les Experts en moisissures de l’est du Canada” or English version “Eastern Canada MoldXperts” was added to Yves’ company on July 21, 2014.

But you can also see that the French name “Les Experts de la Moisissure” and “Mold Busters” was used by Yves since October 26, 2010 until July 21, 2014.

Names were only updated after Bust Mold Inc., filed for a small claims court against Mr. Levis.

This proves that Bust Mold Inc. was using the names “Les Experts de la Moisissure”, which means Mold Experts or MoldXperts in English since at least 2010, which predates Mr. Levis joining Bust Mold Inc. or starting his own competing business for the exact same services.

10. On June 6th, 2014, we have applied for MoldXperts trademark (application number 1679937) which we have used in Canada since March 31, 2009 in Bust Mold Inc.

[23] I understand that the agreement cited at paragraph 8 of the Golubev affidavit relates to an alleged non-competition agreement between the parties, which was not evidenced in this case. I further note that Exhibit B of the Golubev affidavit appears to be the same excerpt from the Opponent's Certificate of Amendment reproduced above at paragraph 20 of this decision.

#### Reply evidence – the second Levis affidavit

[24] In his reply affidavit, Mr. Levis states that during his entire time in business with the Applicant, he did not ever see the type of “mold remediation kit” referred to in Exhibit A of the Golubev affidavit and which Mr. Golubev claims to have used since March 31, 2009 (para 2). However, I note that this statement is of limited usefulness given that it is not possible to make out the image in Exhibit A.

[25] Mr. Levis refutes the Applicant's claims that he was fired from Bust Mold and that he stole Bust Mold clients and funds (para 4). Mr. Levis also confirms that his request to the Quebec Corporations Branch to change his numbered company to “Les Experts en moisissures de l'est du Canada” was made on January 14, 2014, when he started conducting business under that name. However, the request papers were returned to him for correction with the result that the change was not made official until July 21, 2014 (para 5).

#### Analysis

[26] While the Applicant was under no obligation to positively evidence his use of the Mark since the claimed date of first use of March 31, 2009, he elected to do so. Further, the fact that Mr. Golubev was not cross-examined does not prevent me from assessing the value of his evidence [see *Ontario Dental Assistants Association v Canadian Dental Association*, 2013 FC 266 (CanLII) at para 31]. My review of the Golubev affidavit raises more issues than it provides evidence of the use of the Mark as of the date claimed and I find that it clearly puts into issue the claims set forth in the application.

[27] First, the Applicant's evidence at Exhibit A of the Golubev affidavit fails to substantiate his assertions of use as the image on the page is completely blurry and none of the text is

readable. Further, and as noted by the Opponent in his written argument, the date on the page is 10/12/2016, which does not necessarily speak to use as of March 31, 2009.

[28] Second, from my reading of the evidence, the Applicant appears to rely on the French name “Les experts de la Moisissure” to support his claim of use of the trademark MoldXperts. In this regard, I refer to paragraph 9 of the Golubev affidavit, portions of which are emphasized:

9. In Exhibit B, it shows that [the] name “Les Experts en moisissures de l’est du Canada” or English version “Eastern Canada MoldXperts” was added to Yves’ company on July 21, 2014.

**But you can also see that the French name “Les Experts de la Moisissure” and “Mold Busters” was used by Yves since October 26, 2010** until July 21, 2014.

Names were only updated after Bust Mold Inc., filed for a small claims court against Mr. Levis.

**This proves that Bust Mold Inc. was using the names “Les Experts de la Moisissure”, which means Mold Experts or MoldXperts in English since at least 2010,** which predates Mr. Levis joining Bust Mold Inc. or starting his own competing business for the exact same services.

[29] I do not consider the fact that “Les Experts de la Moisissure” might suggest the same or a similar meaning to the trademark MoldXperts to be sufficient to establish any use of the applied for trademark MoldXperts [see by way of analogy *Riches, McKenzie & Herbert v J.M.J. Holdings Ltd* (1992), 47 CPR (3d) 285 (TMOB) where it was held that the use of LA COLLECTION FRANCAISE was not use of THE FRENCH COLLECTION LA COLLECTION FRANCAISE].

[30] Overall, I find that the evidence in this case is sufficient to put into issue the Applicant’s claims of use. In view of this, the burden shifts to the Applicant to show that the Mark has been used in Canada in association with the Goods and Services in the application from the date claimed, up to the filing date of the application. As he has not done so, this ground of opposition is successful.

### **Section 30(i) ground**

[31] The Opponent alleges that contrary to section 30(i) of the Act, the Applicant should have been aware of the Opponent’s trademarks MOLDXPERTS and MOLDXPERTS (Design), as

shown in pending application Nos. 1,697,812 and 1,697,817, and use of these trademarks by the Opponent, and could not have been satisfied that he was entitled to use the Mark in Canada.

[32] Section 30(i) requires an applicant to indicate as part of its application that it is satisfied that it is entitled to use the trademark in Canada in association with the applied-for goods and services. The statement provided by section 30(i) purports to be evidence of the applicant's good faith in submitting its application [*Cerverceria Modelo SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB) at 366]. Where an applicant has provided the statement required by section 30(i), this ground of opposition should only succeed in exceptional cases.

[33] Based on the following, I find this to be an exceptional case and that the Opponent has met his evidential burden and demonstrated that the Applicant's evidence puts into issue the statement set forth in his application for the Mark, raising doubt about the Applicant's good faith in submitting the application [*Corporativo de Marcas GJB, SA de CV, supra*]:

- (a) The Applicant's assertions of use of the Mark in the Golubev affidavit (paras 5, 13) are wholly unsubstantiated. Exhibit A purports to show how the Mark is used in association with the Goods and Services, but it is indecipherable.
- (b) On the contrary, the Opponent's evidence clearly sets out the steps taken by Mr. Levis, following his departure from Bust Mold, to establish his own business in association with the trademarks MOLDXPERTS and MOLDXPERTS (Design).
- (c) There was a pre-existing business relationship between the parties, and the evidence suggests that the Applicant may have had prior knowledge that the Mark or a similar trademark had been adopted by the Opponent. In this regard, I refer to the plaintiff's (Bust Mold's) claim in the small claims court proceeding (Exhibit H of the First Levis Affidavit), which states "On January 10, 2014... he (Mr. Levis) became defensive and quit. Soon after he left our company, we discovered that Mr. Levis had started his own company ("MoldXperts" – *www.moldxperts.ca*) offering the same services as Mold Busters in the Ottawa-Gatineau and Montreal areas..." While hearsay, I am satisfied that it is admissible as it was necessary for the Opponent to file the document to show the

Applicant's earlier views of the Opponent's use, and as it is reliable (as the allegation was in a legal document filed by the Applicant's company, and the Applicant had an opportunity to respond to it in the subject proceeding).

- (d) The Applicant appears to have mistakenly considered that the fact its French name 'Les Experts de la Moisissure' may possess the same or a similar meaning to the applied-for trademark MoldXperts is sufficient to constitute use of the Mark (para 9 of the Golubev affidavit).

[34] Based on my understanding of the evidence, the Applicant appears to have mistakenly considered that the fact his company's French name 'Les Experts de la Moisissure' may possess the same or a similar meaning to the applied-for trademark MoldXperts is sufficient to constitute use of the Mark and therefore that he is entitled to use it in Canada.

[35] Even if the Applicant may not have understood that it was inappropriate to file the trademark application, this does not preclude the Opponent from succeeding on the section 30(i) ground since the Applicant cannot meet his burden of showing that he could make the statement he was entitled to use the Mark in Canada [*Lifestyles Improvement Centers, LLP v. Chorney* (2007), 63 CPR (4th) 261 (TMOB) at 274-275] in the face of the pre-existing relationship between the parties and the knowledge that the Opponent had commenced use of the trademark previously in the same geographic area. Accordingly, this ground of opposition is successful.

## **Section 2 ground**

[36] As I have already found in favour of the Opponent under two grounds of opposition, I do not consider it necessary to discuss the remaining ground of opposition.

DISPOSITION

[37] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

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Jennifer Galeano  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** 2019-05-14

**APPEARANCES**

David M. Wray

FOR THE OPPONENT

Mikhail Golubev

FOR THE APPLICANT

**AGENTS OF RECORD**

R. William Wray & Associates

FOR THE OPPONENT

No agent appointed

FOR THE APPLICANT