



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 044

Date of Decision: 2023-03-09

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Marks & Clerk Canada

Registered Owner: Metro Jet Wash Corporation

Registration: TMA797,234 for METRO JET WASH MJW Design

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA797,234 for the trademark METRO JET WASH MJW Design (the Mark) as shown below:



[2] The Mark is registered for use in association with the following services: industrial, commercial and residential garbage chute, compactor, bin and parking lot cleaning, power washing and odour control services.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

THE PROCEEDING

[4] At the request of Marks & Clerk Canada (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 5, 2021 to the registered owner of the Mark, Metro Jet Wash Corporation (the Owner).

[5] The notice required the Owner to show whether the Mark was used in Canada in association with each of the services listed in the registration at any time within the three-year period immediately preceding the date of the notice and, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is February 5, 2018 to February 5, 2021 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[6] The relevant definition of use in the present case is set out in section 4(2) of the Act as follows:

A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] In response to the Registrar's notice, the Owner furnished the Affidavit of Brian De Carli, the Vice President of the Owner, sworn on August 17, 2021, together with Exhibits A to I.

[8] Neither party submitted written representations. While both parties attended a hearing, which was held in conjunction with section 45 proceedings in relation to registration Nos. TMA797,235 and TMA797,241, the Requesting Party only made submissions with respect to TMA797,235. Separate decisions will issue in each proceeding.

THE EVIDENCE

[9] Mr. De Carli describes the Owner as a property maintenance company and an industry leader in waste equipment cleaning and in drain cleaning and flushing, catch basin cleaning, parking lot cleaning and painting and odour control in industrial, residential and commercial buildings. He asserts that the Mark has been in continuous use by the Owner in Canada in association with the services listed in the registration since 2004.

[10] Mr. De Carli states that the Mark has been displayed on the Owner's fleet of trucks and on other equipment used by the Owner's employees to provide the services listed in the registration consistently since 2004. As Exhibit A, he provides photographs of the Owner's trucks and other equipment which display the Mark along with, in some cases, contact information for the Owner, including a telephone number with a 416 area code. On the side of a trailer, the following services, which correlate to the services in the registration, are listed:

“POWER WASHING, MOBILE SWEEPING
Undergrounds, Parking lots, Warehouses
Chutes, Compactors, Bins
General Commercial / Residential Power washing
ODOUR CONTROL SYSTEM SALES, SERVICE & RENTALS”

[11] Mr. De Carli states that the Mark is displayed on stickers placed on premises at the residential, commercial and industrial sites serviced by the Owner in order to provide convenient contact information for property managers and superintendents. As Exhibit B, he provides photographs of stickers which he states were placed at customer sites throughout 2018, 2019 and 2020. The stickers display the Mark, provide contact information for the Owner, including a telephone number with a 416 area code, and list the following services offered by the Owner (there is no reference to “bins” but otherwise the services correlate to the services listed in the registration):

“Compactor & Chute Cleaning
Underground & Parking Lot Sweeping / Washing
Parking Lot Painting
Drain & Catch Basin Cleaning
Odour Control, Systems, Sales & Service”

[12] Mr. De Carli states that the Mark is displayed on signage at the Owner's head office in Toronto, Ontario and provides, as Exhibit C, a Google Maps image which shows the Mark on signage and which he confirms accurately depicts the signage as it was in 2018, 2019 and 2020.

[13] Mr. De Carli states that the Mark has been displayed on the Owner's website at *www.metrojetwash.ca* since 2004 and provides, as Exhibit D, a print out from the website which displays the Mark and provides the following description of the services offered by the Owner in the "About Us" section (there is no reference to "bins" but otherwise the services correlate to the services listed in the registration):

Metro Jet Wash Corporation, a Canadian based property maintenance company, is the industry leader in waste equipment cleaning. Our team specializes in property maintenance solutions including compactor cleaning and chute cleaning, underground and parking lot pressure washing and cleaning, drain cleaning and catch basin cleaning, parking lot striping and painting, as well as odour control systems, product sales and services.

[14] Mr. De Carli states that the Owner had sales of services in association with the Mark of over \$6,000,000 in the Relevant Period.

[15] Mr. De Carli also states that the Owner spent approximately \$135,000 during the Relevant Period on advertising for the services offered in association with the Mark. In support, he provides the following material:

- Exhibit E – samples of promotional items displaying the Mark distributed at golf tournaments sponsored by the Owner in September 2019, including the London Property Management Association tournament and the Alternatives tournament. Some of the material lists the services offered by the Owner which correlate to the services listed in the registration.
- Exhibit F – representative samples of material displaying the Mark relating to London Property Management Association events in 2018, 2019 and 2020.
- Exhibit G – samples of print advertisements in the Greater Toronto Apartment Association Source Directory, Real Estate Management Industry News and Condo Business which Mr. De Carli states are representative of advertisements in use in the

Relevant Period and which depict the Mark and reference the services listed in the registration.

- Exhibit H – a photograph of a trade show display used at the Owner’s booth at the Condo Conference held in October 2019 in Toronto (various trademarks are displayed but, in so far as I can see, not the Mark).
- Exhibit I – a sample of a “mail chimp” advertisement distributed to customers and potential customers attending the 2020 Buildings Week event (various Marks are displayed but, in so far as I can see, not the Mark).

ANALYSIS AND REASONS FOR DECISION

[16] The purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. The evidence in a section 45 proceeding need not be perfect; indeed, the Owner need only establish a prima facie case of use within the meaning of sections 4 and 45 of the Act This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[17] Based on the evidence as set forth above, I am satisfied that the Owner displayed the Mark in the advertisement and performance of services offered in Canada during the Relevant Period, which services corelate to the services listed in the registration.

[18] Accordingly, I conclude that the Owner has shown use of the Mark in association with the services listed in the registration within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[19] Pursuant to the authority delegated to me under section 63(3) of the Act, and in compliance with the provisions of section 45 of the Act, the registration will be maintained.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-02-15

APPEARANCES

For the Requesting Party: Michael O'Neill

For the Registered Owner: David Reive

AGENTS OF RECORD

For the Requesting Party: Marks & Clerk

For the Registered Owner: Miller Thomson LLP