Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 94

Date of Decision: 2024-05-09

IN THE MATTER OF OPPOSITIONS

Opponent: Naborly Inc.

Applicant: Neighborly Assetco LLC

Applications: 1,919,268 for NEIGHBOURLY, and

1,922,309 for NEIGHBORLY

INTRODUCTION

[1] Neighborly Assetco LLC has applied to register the trademarks NEIGHBOURLY, application number 1,919,268 (the NEIGHBOURLY Mark), and NEIGHBORLY, application number 1,922,309 (the NEIGHBORLY Mark; collectively, the Marks).

[2] Each of the Marks is registered in association with the same list of goods and services, encompassing a range of home maintenance, repair, and enhancement goods and services, set out in Schedule A to this decision (collectively, the Applicant's Goods and Services).

[3] Naborly Inc. (the Opponent) opposes registration of the Marks. The oppositions are based primarily on allegations that each Mark is confusing with the registered

trademark NABORLY (the Opponent's Trademark), registration No. TMA1,019,654, registered in association with the following services (collectively, the Opponent's Services):

> (1) Business administration services, namely the screening of tenants, the processing of tenant applications and the processing tenant lease reassignment and subletting applications; processing of insurance applications.
>
> (2) Financial credit scoring services; financial risk assessment services; rent collection services; administrative processing of insurance claims and payment data.
>
> (3) Software as a service provider in the field of financial credit scoring services and risk assessment services; software as a service featuring software for enabling online commerce in the nature of credit reporting and tenant screening services, for receiving and processing tenant applications, for receiving and processing rental payments and rent guarantee payments, for receiving and processing lease reassignment and subletting applications and for receiving and processing tenant and landlord insurance applications.

[4] For the reasons that follow, the applications are each refused in part.

THE RECORD

[5] The application for the NEIGHBOURLY Mark was filed on September 11, 2018. The application for the NEIGHBORLY Mark was filed on September 27, 2018. Each of the Marks was advertised for opposition purposes in the *Trademarks Journal* on August 11, 2021. On October 12, 2021, the Opponent opposed each application by filing statements of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[6] The grounds of opposition are the same for each opposition and are summarized below.

- Pursuant to sections 38(2)(a.1) of the Act, the applications were filed in bad faith as the Applicant would have been aware, or ought to have been aware, at the time of filing that the Opponent enjoyed prior rights in the Opponent's Trademark which conflicted with the Applicant's claimed entitlement to use and register the Marks.

- Pursuant to sections 38(2)(b) and 12(1)(d) of the Act, the Marks are not registrable because each Mark is confusing with the Opponent's Trademark.
- Pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Applicant is not entitled to registration of the Marks in Canada because the Opponent's Trademark had been used and made known prior to the filing date of the applications.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Marks are not distinctive because they do not distinguish, nor are they adapted to distinguish, the Applicant's Services from the Opponent's Services in association with which the Opponent had previously used and made known the Opponent's Trademark in Canada.
- Pursuant to section 38(2)(e) of the Act, the Applicant was not using and did not propose to use the Marks in Canada in association with the Applicant's Services.
- Pursuant to section 38(2)(f) of the Act, at the filing date of the application, the Applicant was not entitled to use the Marks in Canada in association with the Applicant's Services given the Opponent's prior rights acquired through use of the Opponent's Trademark.

[7] I note that several of the aforementioned grounds of opposition appear to pertain only to the Applicant's Services, and not the Applicant's Goods; however, as set out below, nothing in this decision turns on this distinction.

[8] On June 13, 2022, the Applicant served and filed counter statements in response to each of the statements of opposition. Both parties filed evidence; however, the Opponent's evidence in each proceeding was limited to a certified copy of the Opponent's Trademark. No cross examinations were conducted with respect to any evidence filed in these proceedings. Only the Applicant filed written representations; no oral hearing was held.

APPLICANT'S EVIDENCE

[9] As its evidence in these proceedings, the Applicant filed the affidavit of Mary Thompson, Chief Operating Officer of Dwyer Franchising LLC, the parent company of the Applicant, sworn May 11, 2023. The affidavits are substantially the same for each

proceeding. She explains that the Applicant “is a home services network that connects consumers to service professionals in their communities who cater to their specific home maintenance, repair, and enhancement needs”, and acts as “a single source for consumers to connect with high quality vetted home service experts and provides the information they need to make informed choices, including ratings, reviews, and licence information”.

[10] Ms. Thompson states that the Applicant and its predecessors have operated in Canada for three decades, and began providing its services to individual homeowners and other customers in association with the “NEIGHBOURLY” brand at least as early as 2018. The Applicant has a number of “sub brands” that provide services including home cleaning, drains, glass, restoration, lawn, and other services. She states that the Applicant’s service offerings include all of the Applicant’s Goods and Services, which are provided to the public through locally owned and operated franchisees, including the sub brands. She further states that the Applicant controls the character and quality of services provided by the franchisees in association with the Marks.

[11] In addition, Ms. Thompson’s affidavit and exhibits include the following information:

- Estimated system-wide sales figures for the years 2019 through 2023 for the Applicant’s Goods and Services, in the tens of millions USD for Canada for each year, and estimated revenues for the same years in the millions USD for Canada for each year.
- Information relating to advertising in association with the Marks, including screenshots from the Applicant’s website, social media, franchisee websites, and information showing advertising through trade shows and publications. She states that the Applicant’s total investment in advertising and promotion in Canada between 2018 and 2022 was in excess of $6 million CAD.
- Particulars and certified copies for seventeen “NEIGHBOURLY”-formative Canadian trademark registrations, and particulars and certificates for three

"NEIGHBORLY"-formative United States trademark registrations, owned by the Applicant.

- Screenshots from a website which Ms. Thompson states is the Opponent's website, and a news article relating to the Opponent's acquisition by a competitor in late 2022. Ms. Thompson states that these materials suggest that the Opponent provides services related to landlord and tenant screening, which she states are not related to the services provided by the Applicant and are not advertised to the same kinds of customers.
- Particulars and a certificate for the Opponent's United States trademark "NABORLY". Ms. Thompson states that the Opponent's NABORLY trademarks have coexisted for years with the Applicant's registrations in the United States and Canada without objection or challenge from the Opponent. She further states that the Applicant is not aware of any instances of confusion between the goods and services of the Applicant and Opponent.

ANALYSIS

Ground of Opposition: Section 12(1)(d)

[12] The Opponent alleges that pursuant to section 12(1)(d) of the Act, the Marks are not registrable because they are confusing with the Opponent's registration for the Opponent's Trademark. I have exercised my discretion to check the register and confirm that this registration remains extant [per *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden for the section 12(1)(d) grounds of opposition.

[13] Since the Opponent has discharged its evidentiary burden regarding these grounds of opposition, I must assess whether the Applicant has discharged its legal onus to prove, on balance of probabilities, that there is no reasonable likelihood of confusion between the Applicant's Marks and the Opponent's Trademark. The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[14] 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 trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22, and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 (*Masterpiece*)]. Moreover, in *Masterpiece*, the Supreme Court stated that the degree of resemblance between the trademarks is often likely to have the greatest effect on the confusion analysis.

[15] Finally, section 6(2) of the Act does not concern confusion between the trademarks themselves, but confusion regarding goods or services from one source as being from another source. In this case, the question posed by section 6(2) is whether there would be confusion regarding the goods and services sold under the Marks such that they would be thought to have emanated from the Opponent.

[16] As a preliminary matter, I note that certain evidence shows that the Applicant used the spelling “Neighbourly” as opposed to “Neighborly”, or vice versa. Nevertheless, I am satisfied that despite the presence or absence of the letter “u”, each of the respective word marks does not lose its identity and remains recognizable [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)], and the “dominant features” of each Mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

Inherent and acquired distinctiveness

[17] The Applicant submits that the Marks have an equivalent amount of inherent distinctiveness as the Opponent’s Trademark, since none of these trademarks are suggestive of the parties’ respective goods or services. In this respect, the Applicant submits that the word “neighbourly” means “a state of being, or mindset, characteristic

of friendly neighbours or congeniality"; I note that *The Canadian Oxford Dictionary* (2 ed) defines "neighbourly" as "characteristic of a good neighbour; friendly; kind" [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 645, for the proposition that the Registrar may take judicial notice of the dictionary definitions of words found in trademarks]. As such, I agree that the trademarks are not suggestive of the parties' goods or services. However, the Opponent's Trademark is a coined word, even though it is phonetically identical to the word "neighbourly". As such, I find that the Opponent's Trademark has a slightly higher degree of inherent distinctiveness than the Marks.

[18] The distinctiveness of a trademark can be increased through its use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. In this case, since the Applicant has filed evidence of revenues for provision of its goods and services displaying the Marks in Canada since 2019, and has confirmed that it spent over $6 million on advertising since 2018, while the Opponent has filed no evidence of the extent of its use of its trademark, I find that the Marks have a considerably higher degree of acquired distinctiveness than the Opponent's Trademark.

[19] On balance, I find that this factor favours the Applicant.

Length of time in use

[20] As noted above, the Applicant has provided sales figures for services provided in association with the Marks since 2019, while the Opponent has submitted no evidence of the extent of use of the Opponent's Trademark in Canada. While the certified copy of the Opponent's Trademark shows a claimed date of first use of December 31, 2014, I can only infer *de minimis* use of this trademark from the certified copy submitted in evidence and, moreover, a registration in itself is not evidence that the registered trademark has been used continuously since the claimed date [see *Tokai of Canada v Kingsford Products Company*, LLC, 2018 FC 951; and *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[21] Accordingly, this factor favours the Applicant.

Nature of the goods, services or business and nature of the trade

[22] The Applicant submits that the Opponent's Services deal exclusively with tenancy applications, financial risk assessment, rent payment, and insurance applications. Although the Applicant's and Opponent's Services include overlapping Nice classifications 35, 36, and 42, the Applicant submits that none of its services relate to the types of services associated with the Opponent's Trademark. The Applicant submits that in the absence of substantive evidence from the Opponent, there is nothing to prove that the goods and/or services of the Applicant overlap with those of the Opponent. For this proposition, the Applicant cites *Eagle's Flight, Creative Training Excellence Inc v Yara International ASA*, 2020 TMOB 125; however, in that case, the Registrar found that in the absence of evidence from the applicant, there was nothing to show that the parties' safety-focused training services would *not* overlap or involve similar channels of trade [para 42]. In any event, it is trite law that the onus is on the Applicant to show that there is no reasonable likelihood of confusion once the Opponent has met its initial burden.

[23] I agree with the Applicant that for the most part, its goods and services are of a different nature. For instance, the Applicant's class 35 services all relate to information services, client referral programs, franchise services and cooperative buying programs, all relating to home maintenance and repair, none of which are particularly closely related to the Opponent's services which include tenancy applications, insurance applications, financial risk assessment and credit scoring. Similarly, the Applicant's class 42 software services include information storage and software relating to tracking household tasks and repair, and other services relating to outdoor décor and lighting, while the Opponent's software services relate to credit scoring, risk assessment, and tenant rentals.

[24] However, the Applicant's applied-for services also include the following class 36 services:

> (2) Real estate management services; assessment and management of real estate; real estate management consultation; real estate management services; real estate rental services, namely, rental of residential housing; real estate service, namely, rental

> property management; real estate services, namely, property management services for condominium associations, homeowner associations and apartment buildings; real estate services, namely, rental, brokerage, leasing and management of commercial property, offices and office space

[25] The Applicant submits that "there is no overlap, either direct or indirect", in the nature of the parties' services. However, although the Applicant's Services do not specifically relate to tenancy applications, financial risk assessment, rent payment, or insurance applications, I find that the Applicant's class 36 services, which encompass real estate management services, property management services, and real estate rental services, have some overlap with the Opponent's Services relating to the processing of tenant applications, tenant lease reassignment and subletting applications, and rent collection services.

[26] In terms of channels of trade, the Applicant submits that its services are provided on site by franchisees, whereas the Opponent's Services are provided online, as shown in the screenshots of the Opponent's website attached to Ms. Thompson's affidavit. However, the fact that the parties' services may be provided in this manner is not determinative, since while evidence of the parties' actual trades may be useful [see *McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963 (FCA); *McDonald's Corp v Silcorp Ltd* (1989), 55 CPR (2d) 207 (FCTD), aff'd (1992), 41 CPR (3d) 67 (FCA)], it is the statement of goods and services in the Applicant's applications and the Opponent's registration that governs assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. In other words, there would be nothing preventing the Applicant from offering its services online should the Marks proceed to registration; indeed, it is clear from the Applicant's evidence, including the website screenshots attached as Exhibit B, that part of its business is delivered through a smartphone app.

[27] In any event, it appears from the nature of the Opponent's services that they are directed towards landlords and owners of rental properties; in my view, there is some

potential for overlap, particularly with respect to the Applicant's class 36 services which specifically include real estate management services and real estate rental services.

[28] Accordingly, I find that the above factors favour the Applicant, except with respect to the Applicant's class 36 services, for which these factors favour the Opponent.

Degree of resemblance

[29] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks. The Supreme Court of Canada in *Masterpiece* has advised that the preferable approach when comparing trademarks is to begin by determining whether there is an aspect of the trademark that is particularly striking or unique.

[30] The Applicant submits that each of its Marks consist of a recognizable English word, while the Opponent's Trademark is shorter, with an unusual spelling which would be noticed by members of the public and serves to differentiate the trademarks as a matter of first impression.

[31] I find that the parties' trademarks have some degree of visual resemblance as they are different spellings of the same word. Phonetically, the trademarks are identical. To the extent that the Opponent's Trademark would be recognized as an intentional misspelling of "neighbourly", the parties' trademarks convey identical ideas.

[32] Overall, I find that this factor favours the Opponent.

Additional surrounding circumstance: no instances of actual confusion

[33] Evidence of instances of actual confusion is not required in order to demonstrate a likelihood of confusion. However, concurrent use of two trademarks without such instances of actual confusion is a surrounding circumstance which can suggest an absence of a likelihood of confusion, depending on the specific nature and duration of

that concurrent use [see *Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155 (FCA) at para 19; see also *Maple Leaf Consumer Foods Inc v Kelbro Enterprises Inc*, 2012 TMOB 28, 99 CPR (4th) 424].

[34] In this case, the Applicant notes that the parties' trademarks have coexisted for more than five years, and submits that it is a relevant surrounding circumstance that there is no evidence of any instances of confusion, citing *Institute of Advanced Financial Planners v The Financial Advisors Association of Canada*, 2017 TMOB 164.

[35] However, it is not clear how long, and to what extent, the Opponent's Trademark has been used in Canada. As noted above, I am not prepared to conclude that the Opponent's Trademark has been used in Canada to any extent based solely on the date of first use indicated in the certified copy for that trademark. While the Applicant has attached screenshots from the Opponent's website retrieved in May 2023 [Exhibit P] and an article from October 2022 indicating that the Opponent was acquired by an entity called SingleKey [Exhibit Q], these documents do not show the length of time or extent of use of the Opponent's Trademark in Canada. As such, I am not prepared to draw any conclusions on the basis of there being no evidence of actual confusion.

Additional surrounding circumstance: family of trademarks

[36] The Applicant submits that the Marks are part of a family of trademarks owned by the Applicant. In order to rely on a family of trademarks, a party must prove use of each mark of the alleged family [*McDonald's Corp v Alberto-Culver Co* (1995), 61 CPR (3d) 382 (TMOB); *McDonald's Corp v Yogi Yogurt Ltd* (1982), 66 CPR (2d) 101 (FCTD)].

[37] In this case, the trademarks in the Applicant's alleged family include NEIGHBOURLY (registration No. TMA1,051,639) and NEIGHBOURLY Design (registration No. TMA1,051,640), both registered in association with information and software services, as well as a variety of NEIGHBOURLY-formative trademarks such as NEIGHBOURLY GARAGE DOOR, NEIGHBOURLY MAIDS, NEIGHBOURLY GLASS, and the like. I accept that the Applicant's evidence, such as the Applicant's website screenshots attached as Exhibit B, at least shows use of the NEIGHBOURLY and

NEIGHBOURLY Design trademarks in association with the information services of "providing consumer information to homeowners about service providers available for home repair projects and home maintenance projects", since such information is provided on the webpage where both trademarks are prominently displayed.

[38] However, the Applicant has not pointed to any example in evidence of use of any of the other NEIGHBOURLY-formative trademarks in its alleged family. While I note that certain of the posts from the Applicant's Facebook and Twitter pages [Exhibits C and D] include such tags as "#Neighborly #GlassRepair", I do not find this to constitute trademark use as the hashtags are not treated differently from any of the other hashtags in the text, and give no indication that they hold any trademark significance [see *Lost Craft Inc v 101217990 Saskatchewan Ltd dba Direct Brewing Company*, 2021 TMOB 168 at para 28, aff'd 2022 FC 1254]. Accordingly, I am not satisfied that the Applicant has proven use of any of its other NEIGHBOURLY-formative trademarks within the meaning of the Act. Since a party seeking to establish a family of marks must establish that it is using more than one or two trademarks within the alleged family [*Techniquip Ltd v Canadian Olympic Assn* (1998), 1998 CanLII 7573 (FC), 145 FTR 59 (FCTD), aff'd 250 NR 302 (FCA); *Now Communications Inc v CHUM Ltd* (2003), 32 CPR (4th) 168 (TMOB)], I do not find that this is a relevant factor in the Applicant's favour.

Conclusion

[39] The question posed by section 6(2) of the Act is whether customers of the goods and services provided in association with the Marks NEIGHBOURLY and NEIGHBORLY would believe that these goods and services are provided, authorized, or licensed by the Opponent owing to its NABORLY Trademark. I have assessed this as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the NEIGHBOURLY and/or NEIGHBORLY Mark at a time when they have no more than an imperfect recollection of the Opponent's Trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks.

[40] In this case, despite the degree of resemblance between the trademarks, I find that the difference in the nature of goods and services, as well as the Applicant's evidence of greater acquired distinctiveness and length of time in use for each Mark, is sufficient for the Applicant to meet its burden to show that there is no reasonable likelihood of confusion with respect to the applied-for goods and all of the applied-for services except for the class 36 services.

[41] With respect to the class 36 services, due to the degree of resemblance between the trademarks and the overlapping nature of the services and the trade, I find that at best for the Applicant, the probability of confusion between each of its Marks and the Opponent's Trademark is evenly balanced. As a result, the Applicant has not discharged its burden to show that there is no likelihood of confusion between each of its Marks and the Opponent's Trademark with respect to these services.

[42] Accordingly, the section 12(1)(d) ground of opposition is rejected with respect to all of the Applicant's Goods and Services with the exception of the Applicant's class 36 services. The section 12(1)(d) ground of opposition succeeds with respect to the Applicant's class 36 services.

Ground of Opposition: Section 38(2)(a.1)

[43] The Opponent alleges that the application was filed in bad faith as the Applicant would have been aware, or ought to have been aware, at the time of filing that the Opponent enjoyed prior rights in the Opponent's Trademark which conflicted with the Applicant's claimed entitlement to use and register the Marks. The material date for the analysis under section 38(2)(a.1) of the Act is the date the applications were filed.

[44] It is well established that mere knowledge of another's trademark does not in and of itself support an allegation of bad faith [*Woot Inc v Woot Restaurants Inc / Les Restaurants Woot Inc*, 2012 TMOB 197]. Mere wilful blindness or a failure to inquire into a competitor's rights is also insufficient to constitute bad faith [*Blossman Gas Inc v Alliance Autopropane Inc*, 2022 FC 1794]. In this case, the Opponent has filed no evidence (aside from the certified copy of the Opponent's Trademark) or

representations, and therefore has not met its burden with respect to this ground of opposition. As such, this ground of opposition is rejected.

Ground of Opposition: Section 16(1)(a)

[45] Pursuant to sections 38(2)(c) and 16(1)(a) of the Act, the Opponent pleads that the Applicant is not entitled to registration of the Marks in Canada because the Opponent's Trademark had been used and made known prior to the filing date of the application.

[46] In order to meet its initial burden under this ground, the Opponent must show that its trademark was used prior to the Applicant's filing date and was not abandoned at the date of the advertisement of the application. Accordingly, the relevant evidence on which the Opponent can rely is evidence of use that pre-dates the filing date of the application. However, the mere filing of a certified copy of the Opponent's registration is not sufficient to satisfy its evidential burden with respect to grounds of opposition based on allegations of non-entitlement [see *Rooxs, Inc v Edit-SRL*, 2002 CanLII 61421, 23 CPR (4th) 265 (TMOB)].

[47] As the Opponent has filed no other evidence to allow it to meet its burden, this ground of opposition is dismissed.

Ground of Opposition: Section 2

[48] The Opponent has also pleaded that pursuant to section 2 of the Act, the Marks are not distinctive because they do not distinguish, nor are they adapted to distinguish, the Applicant's Services from the Opponent's Services in association with which the Opponent had previously used and made known the Opponent's Trademark in Canada. The material date for a ground of opposition based on non-distinctiveness is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185 at para 25].

[49] *In Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33-34, the Federal Court provided that a trademark could negate another mark's distinctiveness if it was known to some extent at least and its reputation in Canada was

substantial, significant or sufficient or, alternatively, if it was well known in a specific area of Canada.

[50] The Opponent has filed no evidence (aside from the certified copy of the Opponent's Trademark) or representations, and therefore has not met its burden with respect to this ground of opposition. Accordingly, this ground of opposition is dismissed.

Ground of Opposition: Section 38(2)(e)

[51] The Opponent has pleaded that the Applicant was not using and did not propose to use the Marks in Canada in association with the Applicant's Services. The material date for this ground of opposition is the filing date of the application.

[52] The principles set out in cases relating to the former section 30(e) ground of opposition, based upon whether an applicant had a *bona fide* intention to use the trademark in Canada, can be instructive in regards to this new ground. As with the former section 30(e) ground, since the relevant facts are more readily available to and particularly within the knowledge of the applicant under a section 38(2)(e) ground of opposition, the evidential burden on an opponent in respect of this ground is light and the amount of evidence needed to discharge it may be very slight [*Allergan Inc v Lancôme Parfums & Beauté & Cie, société en nom collectif* (2007), 64 CPR (4th) 147 (TMOB); *Canadian National Railway v Schwauss* (1991), 35 CPR (3d) 90 (TMOB); *Green Spot Co v John M Boese Ltd* (1986), 12 CPR (3d) 206 at 210-11 (TMOB)].

[53] However, the Opponent has filed no evidence (aside from the certified copy of the Opponent's Trademark) or representations, and therefore has not met its burden with respect to this ground of opposition. Accordingly, this ground of opposition is dismissed.

Ground of Opposition: Section 38(2)(f)

[54] The Opponent alleges that at the filing date of the application, the Applicant was not entitled to use the Marks in Canada in association with the Applicant's Services given the Opponent's prior rights acquired through use of the Opponent's Trademark.

[55] However, section 38(2)(f) addresses the Applicant's lawful entitlement to use the trademark (*i.e.*, in compliance with relevant federal legislation and other legal obligations) as opposed to the Applicant's entitlement to register the mark (relative to another person's trademark, pursuant to section 16 of the Act) [see *Premier Tech Home & Garden Inc v Ishihara Sangyo Kaisha, Ltd*, 2022 TMOB 25 at para 20; *DCK Concessions Limited v Hong Xia ZHANG*, 2022 TMOB 200 at para 39]. The facts as pleaded are therefore not ones that can support a section 38(2)(f) ground of opposition. Furthermore, the Opponent has filed no evidence (aside from the certified copy of the Opponent's Trademark) or representations to support this ground. As such, this ground of opposition is dismissed.

DISPOSITION

[56] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse each application only with respect to the class 36 services listed as services (2) in each of the applications, set out below:

> (2) Real estate management services; assessment and management of real estate; real estate management consultation; real estate management services; real estate rental services, namely, rental of residential housing; real estate service, namely, rental property management; real estate services, namely, property management services for condominium associations, homeowner associations and apartment buildings; real estate services, namely, rental, brokerage, leasing and management of commercial property, offices and office space

[57] I reject each opposition with respect to the remainder of the Applicant's Goods and Services.

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G.M. Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: No agent appointed

For the Applicant: Cassels Brock & Blackwell LLP

SCHEDULE A

NEIGHBOURLY, application number 1,919,268, and NEIGHBORLY, application number 1,922,309

Goods (Nice class & Statement)

16 (1) Printed publications, namely, newsletters for franchisees and their associates in the fields of residential heating and air conditioning, painting, glass repair and installation, maid and laundry, appliance repair, electrical, home repair and general maintenance, plumbing and drain, carpet, upholstery and drapery cleaning and odor removal, mold inhibition, lawn care and landscaping, window cleaning and protection, pressure washing, gutter cleaning, real estate management services, commercial and residential pipe inspection services for the detection of leaks and design, installation, maintenance, repair of outdoor décor and decorative electrical lighting services and window and door installation services

Services (Nice class & Statement)

35 (1) Information services, namely, providing consumer information to homeowners about service providers available for home repair projects and home maintenance projects; providing client referral programs for commercial and residential plumbing service, electrical service, appliance service, glass repair and installation service, heating and air conditioning service; providing client referral programs for disaster restoration service, namely, restoring building interiors, carpet and furnishings damaged by fire, water, smoke and other disasters and commercial and residential building cleaning and mold prevention service and carpet, upholstery and drapery cleaning, spot, stain removal service; providing client referral programs for carpet, drapery and upholstery deodorizing service; providing client referral programs for professional lawn and grounds care service; providing client referral programs for residential, commercial, and industrial painting services; providing client referral programs for gutter installation and repair services, pressure washing services, concrete cleaning services, and carpentry services; providing client referral programs for home repair and general maintenance services; providing client referral programs for residential and commercial cleaning services, including temporary maid services; franchise services, namely, offering business management assistance in the establishment and operation of residential heating and air conditioning, painting, glass repair and installation, maid and laundry, appliance repair, electrical, home repair and general maintenance, plumbing and drain, carpet, upholstery and drapery cleaning and odor removal, mold inhibition, lawn care and landscaping, window cleaning and protection, pressure washing, gutter cleaning, real estate management services, commercial and residential pipe inspection services for the detection of leaks and design, installation, maintenance, repair of outdoor décor and decorative electrical lighting services and window and door installation services; cooperative buying services provided for others in the field of heating, ventilation, and air conditioning (HVAC) equipment and supplies

36 (2) Real estate management services; assessment and management of real estate; real estate management consultation; real estate management services; real estate rental services, namely, rental of residential housing; real estate service, namely, rental

property management; real estate services, namely, property management services for condominium associations, homeowner associations and apartment buildings; real estate services, namely, rental, brokerage, leasing and management of commercial property, offices and office space

37 (3) Installation, maintenance and repair of heating and air conditioning equipment; residential, commercial and industrial painting services; gutter installation and repair services; pressure washing services; concrete cleaning services; carpentry services; installation, repair and replacement of glass in buildings and vehicles; maid services; cleaning of residential and commercial premises; ironing and cleaning of clothing; laundry services; installation and repair of household appliances, electrical, freezing and heating equipment; kitchen equipment installation; installation, repair and refurbishment of all types of household appliances; electrical repair, maintenance and installation services; home repair and general maintenance services; building construction; installation services, namely, installation of heating, ventilating and air conditioning systems, residential, commercial and automobile glass, household appliances and equipment, electrical systems and components, gutters, doors, windows, light fixtures, enclosures, namely, wiring enclosures for use in connection with light fixtures and electrical enclosure boxes, cabinets and panels therefor, décor and systems, namely, landscape lighting, Christmas lighting, deck lighting, patio lighting and pool lighting, lighting control systems, and timers and sensors; commercial and residential plumbing, sewer, grease trap and drain cleaning services; plumbing services; carpet, upholstery and drapery cleaning, and spot and stain removal services, air-duct cleaning services, disaster restoration services, namely, restoring building interiors, carpet and furnishings damaged by fire, water, smoke and other disasters; carpet repair services, commercial and residential building cleaning services; window cleaning, application of protective window film for residential and commercial buildings and structures, pressure washing, and gutter cleaning services; installation, maintenance, and repair of outdoor décor and decorative electrical lighting; consulting in the fields of installation, maintenance, and repair of outdoor décor and decorative electrical lighting; installation of windows, screens, glass doors, greenhouses, garage and overhead doors, porch enclosures, patio doors, tub and shower enclosures, automobile glass and replacement glass for commercial and residential buildings; building construction and repair; building construction services; building inspection; building maintenance and repair; cleaning of buildings; residential and commercial property construction consultancy; general building contractor services; land development services, namely, planning and laying out of commercial buildings; residential and building construction consulting; snow removal services; inspection services, namely inspections inside and outside of commercial buildings, residential buildings and pipes for the detection of leaks

39 (4) Storage of outdoor décor and decorative electrical lighting; consulting in the field of storage of outdoor décor and decorative electrical lighting; junk, trash and debris removal

40 (5) Carpet, upholstery and drapery odor removal services, mold inhibition services of buildings and their contents; providing carpet and upholstery dyeing, tinting and colorizing services

41 (6) Providing blogs and non-downloadable publications in the nature of articles in the fields of home entertainment, design and décor, money management, residential heating and air conditioning, painting, glass repair and installation, maid and laundry, appliance

repair, electrical, home repair and general maintenance, plumbing and drain, carpet, upholstery and drapery cleaning and odor removal, mold inhibition, lawn care and landscaping, window cleaning and protection, pressure washing, gutter cleaning, real estate management services, commercial and residential pipe inspection services for the detection of leaks and design, installation, maintenance, repair of outdoor décor and decorative electrical lighting services and window and door installation via a website

42 (7) Temporary electronic storage of information relating to service providers used by homeowners for household tasks, home repair projects and home maintenance projects; providing temporary use of on-line non-downloadable software for use by homeowners to manage and track household tasks, home repair projects and home maintenance projects; design of outdoor décor and decorative electrical lighting pertaining to commercial and residential applications; consulting in the field of design of outdoor décor and decorative electrical lighting

44 (8) Lawn care; lawn mowing and trimming services; tree care services; landscape design; landscape gardening; horticultural services, namely, installing sod and lawn and vegetation fertilization and treatment