



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

**Citation: 2015 TMOB 188**  
**Date of Decision: 2015-10-26**

**IN THE MATTER OF AN OPPOSITION**

<b>The ServiceMaster Company</b>	<b>Opponent</b>
<b>and</b>	
<b>385 MKE LIMITED</b>	<b>Applicant</b>
<b>1,556,174 for MASTERCLEAN</b>	<b>Application</b>

[1] On December 14, 2011, 385229 ONTARIO LIMITED, doing business as MASTERCLEAN SERVICE COMPANY, filed application No. 1,566,174 to register the trade-mark MASTERCLEAN (the Mark). On August 17, 2012, following an amalgamation, 385MKE LIMITED (no space between 385 and MKE) was recorded as the applicant for the Mark, which entry was corrected on June 9, 2014 to the current applicant 385 MKE LIMITED (the Applicant).

[2] The application is based upon use of the Mark by the Applicant in Canada since at least as early as November 1<sup>st</sup>, 1971, in association with the following services, as revised: “General contracting services, namely restoration, renovation and cleaning services” (the Services).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 26, 2012. The ServiceMaster Company (the Opponent) opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by filing a statement of opposition on October 28, 2013. The Opponent thereafter sought leave to file an amended

statement of opposition on November 28, 2013, which request was followed by a second request for leave to file a further amended statement of opposition on November 29, 2013. By way of Office letter dated December 23, 2013, the Registrar granted leave to the Opponent to file the amended statement of opposition dated November 29, 2013.

[4] The grounds of opposition, as pleaded by the Opponent, are that:

- i) the application does not comply with the requirements of section 30(b) of the Act in that the Mark has not been used in Canada by the Applicant since the alleged date of first use, namely November 1<sup>st</sup>, 1971, as alleged in the application, in association with the services described therein;
- ii) the application does not comply with the requirements of section 30 of the Act in that the Applicant:
  - a) has not named each of its predecessors in title;
  - b) did not exist at the alleged date of first use of the Mark; and
  - c) does not currently exist as 385MKE LIMITED.

[5] In support of its opposition, the Opponent filed the affidavits of Ms. Suzete Carreira, assistant with the trade-mark agent firm representing the Opponent in the present proceeding, sworn May 22, 2014 (the Carreira affidavit), and Ms. Mary P. Noonan, trade-mark searcher with the same firm, also sworn on May 22, 2014 (the Noonan affidavit). In support of its application, the Applicant filed the affidavit of its President, Mark English, sworn September 3, 2014 (the English affidavit). None of the affiants were cross-examined.

[6] Only the Applicant filed a written argument. No hearing was held.

[7] For the reasons explained below, I find that the application ought to be refused.

#### The parties' respective burden or onus

[8] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA*

*et al* (2002), 20 CPR (4th) 155 (FCA)].

### The evidence of record

#### The Opponent's evidence

[9] The Noonan affidavit purports to introduce into evidence under Exhibits A and B, a copy of a NUANS search for 385MKE LIMITED (no space between 385 and MKE). She states that there is no corporate or business listing for 385MKE LIMITED.

[10] The Carreira affidavit purports to introduce into evidence under Exhibits A and B respectively, a copy of a corporate search for 385 MKE Limited (with a space between 385 and MKE) and 385229 Ontario Limited. Exhibit A shows that the Applicant is an amalgamated corporation resulting from the amalgamation on April 30, 2009, of 1262320 Ontario Limited and 385229 Ontario Limited. Exhibit B shows that 385229 Ontario Limited was incorporated on May 17, 1978. These facts are corroborated by Mr. English's testimony described below.

#### The Applicant's evidence

[11] The English affidavit purports to address mainly two issues.

[12] The first issue deals with the identification of the Applicant. Mr. English states that a typographical error occurred in the identification of the Applicant which was erroneously shown as 385MKE Limited (with no space). He states that this error was corrected by the Registrar who has recognized the present Applicant as 385 MKE Limited, as evidenced by a copy of an Office letter dated June 9, 2014 filed under Exhibit A to his affidavit [para 4 of the affidavit].

[13] The second issue deals with the history of the Mark and provides evidence of use of the Mark in Canada by the Applicant.

[14] More particularly, Mr. English states that Masterclean Service Company had registered in Canada the trade-mark MASTERCLEAN (that is the Mark) on November 28, 1980, under registration No. TMA253,190, in association with "restoration, renovation and cleaning services". This registration claimed a date of first use of the Mark since at least as early as

November 1<sup>st</sup>, 1971. Mr. English goes on to explain that there was a transfer in title of registration No. TMA253,190 in 1981 from Mark English trading as Masterclean Service Company, to 385229 Ontario Limited doing business as Masterclean Service Company, which was incorporated on May 17, 1978 and which amalgamated with 1261320 Ontario limited on April 30, 2009 to form the Applicant doing business as Masterclean Service Company [para 4 of the affidavit].

[15] Mr. English states that registration No. TMA253,190 was expunged due to an inadvertent clerical error by the Applicant in not giving proper instructions to renew this registration. However, he adds that the Applicant never abandoned the use of the Mark [paras 5 and 6 of the affidavit; and Exhibit B thereto consisting of a certified copy of registration No. TMA253,190 that was expunged on July 7, 2011]. Upon review of this exhibit, I note that in accordance with Mr. English's testimony, the original registrant for the Mark was identified as "MARK ENGLISH, doing business as MASTERCLEAN SERVICE COMPANY" whereas the current owner as of the time of expungement was identified as "385229 ONTARIO LIMITED, doing business as MASTERCLEAN SERVICE COMPANY." I shall further note at this point of my decision that the changes brought to the chain of title indicated in Exhibit B refer to the evidence on file No. 403836, which corresponds to registration No. TMA226,306 discussed below.

[16] Mr. English states that the Applicant by its predecessor in title had registered in Canada the trade-mark MASTER CLEAN (with a space), on February 24, 1978, under registration No. TMA226,306 in association with "carpet cleaning machines". He states that an application to extend registration No. TMA226,306 was filed on July 28, 1980 to add the services of "restoration, renovation and cleaning", claiming a date of first use since May 1<sup>st</sup>, 1980 [paras 7 and 8 of the affidavit; and Exhibit C thereto consisting of a certified copy of registration No. 226,306]. Upon review of this exhibit, I note that the original registrant for the MASTER CLEAN trade-mark was AL'S MAINTENANCE LIMITED and that the current registrant is the Applicant.

[17] Mr. English states that registration No. TMA226,306 is in good standing and further provides under Exhibit D a printout from the registration particulars of same as obtained from the Canadian Intellectual Property Office website. He further states that the Applicant "relies on

the provisions of [s]ection 54 of the [Act], which provides that an entry on the [register] is evidence of the facts set out therein” [para 10 of the affidavit].

[18] Mr. English then states that the Mark and the trade-mark MASTER CLEAN will be collectively referred to in his affidavit as the “MASTERCLEAN Marks”. Accordingly, I will do the same unless indicated otherwise.

[19] Mr. English states that the Applicant has used the MASTERCLEAN Marks continuously from respectively 1971 (with respect to the Mark) and 1980 (with respect to the trade-mark MASTER CLEAN) to the date of signature of his affidavit in association with the Services [paras 14 and 15 of the affidavit].

[20] Mr. English goes on to explain the nature of the Applicant’s Services and the channels of trade associated with these services [paras 16 to 19 of the affidavit].

[21] Mr. English provides the sales figures for the Applicant’s Services in association with the MASTERCLEAN Marks from May 1, 1996 to June 1, 2014 [paras 20 and 21 of his affidavit] as well as the Applicant’s advertising expenditures in association with these services for the same period of time [para 26 of the affidavit].

[22] Mr. English also provides various specimens of use and advertising of the MASTERCLEAN Marks [paras 22 to 25 of his affidavit, Exhibits E, F, G1 to G3, and H].

#### Analysis of the grounds of opposition

[23] While not necessarily expressly referred to in the statement of opposition, all of the pleaded grounds of opposition revolve around the non-conformity of the application with the provisions of section 30(b) of the Act.

[24] I will assess the section 30(b) ground of opposition based on the allegation that the Applicant has not named each of its predecessors in title first.

#### Failure to name the Applicant’s predecessors-in-title

[25] Section 30(b) of the Act provides that an applicant for the registration of a trade-mark

shall file with the Registrar an application containing:

[...] in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general class of goods or services described in the application.  
[my underlining]

[26] To the extent that the relevant facts pertaining to a ground of opposition based on section 30(b) of the Act are more readily available to the Applicant, the evidentiary burden on the Opponent with respect to such a ground of opposition is less onerous [see *Tune Master v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, this burden can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216]. However, the Opponent may only successfully rely upon 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 [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd* 2014 FC 323 at paras 30-38 (CanLII)].

[27] I am satisfied from the Opponent's evidence (see Exhibits A and B to the Carreira affidavit) that the Opponent has put compliance of the application with section 30(b) of the Act into issue.

[28] Because of this evidence, it was up to the Applicant to show use of the Mark since the date claimed and to include the appropriate predecessor in title in its application to support this claimed date, which it has not done.

[29] It is clear from the English affidavit that the person who first used the Mark back in November 1<sup>st</sup>, 1971 was Mark English trading as Masterclean Service Company, not the Applicant as alleged in the application.

[30] The Applicant did not exist as of the claimed date of first use of the Mark.

[31] As explained by Mr. English and corroborated by Exhibits B and D thereto detailing the changes to the chain of title recorded by the Registrar with respect to registration No. TMA253,190, the Mark was first used by Mark English, trading as Masterclean Service

Company. The Mark was later assigned on July 30, 1981 to 385229 Ontario Limited, which company ultimately amalgamated to form the Applicant.

[32] In *RWS Hoists & Cranes Inc v Richards-Wilcox Canada Inc* (2004), 41 CPR (4th) 258, former Board Member Martin wrote:

Although it is not necessary to include amalgamating companies as predecessors [see *Molson Breweries, a Partnership v John Labatt Ltd* (1994) 56 CPR (3d) 107 (TMOB)], where there has been an actual change in ownership, predecessors in titles must be included covering the period of use claimed in the application: see the opposition decisions in *Hardee's Food System, Inc v Hardee Farms International Ltd* (1984) 1 CPR (3d) 417 (TMOB) at 430, and *Sanna, Inc v Chocosuisse Union des Fabricants Suisses de Chocolat* (1986), 14 CPR (3d) 139 (TMOB) at 142].

[33] These comments apply with equal force to the present case.

[34] The Applicant's failure to name his predecessor Mark English renders the application contrary to section 30(b) of the Act.

[35] Accordingly, the section 30 ground of opposition based on the Applicant's failure to name its predecessors in title succeeds.

#### Failure to exist at the claimed date of first use

[36] In view of my findings made above, the ground of opposition based on the allegation that the application does not comply with the requirements of section 30(b) of the Act in that the Applicant did not exist at the alleged date of first use of the Mark, necessarily succeeds.

#### Remaining prongs of the section 30(b) ground of opposition

[37] As I have already refused the application under two prongs of the section 30(b) ground of opposition, I do not consider it necessary to consider the remaining prongs.

Disposition

[38] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application under section 38(8) of the Act.

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Annie Robitaille  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office



No Hearing held

Agents of Record

Gowling Lafleur Henderson LLP

For the Opponent

Riches, McKenzie & Herbert LLP

For the Applicant