



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

Citation: 2016 TMOB 69
Date of Decision: 2016-04-27

ECO GROUNDS CARE LIMITED **Opponent**

and

Clean Air Yard Care Inc. **Applicant**

**1,593,556 for ZERO EMISSION YARD
CARE POWERED BY SOLAR
ENERGY** **Application**

[1] On September 10, 2012, Clean Air Yard Care Inc. filed an application to register the trade-mark ZERO EMISSION YARD CARE POWERED BY SOLAR ENERGY (the Mark) on the basis of use by it and Barry McLean, its predecessor in title, with the following Goods and Services. For ease of reference, the claimed dates of first use are set out in square brackets.

Goods:

(1) Potting mixes, fertilisers; fertilising preparations; manure for agriculture, horticulture or silviculture; dolomite for agriculture, horticulture or silviculture; agricultural lime; earth for growing plants [*since at least as early as March 11, 2011*]

(2) Landscaping trailer with solar panels, inverter and batteries [*since at least as early as July 31, 2012*]

Services:

(1) Gardening services, landscape gardening, lawn mowing, lawn edge trimming, tree lopping, tree surgery, pruning, gutter cleaning, clearing of overhanging branches from roofs or power lines, removal of resultant rubbish, laying of new lawns, fertilising and weeding of lawns and gardens, top dressing, installation of gardens, laying of instant lawn, laying pavers and stepping stones, supply of fertilisers and garden and lawn products, advisory services in relation to gardens and lawns, lawn care; weed killing, supply of fertilisers and garden supplies, tree felling services; plant nursery services, snow clearing and snow sweeping [*since at least as early as March 31, 2011*]

(2) Maintenance of landscape irrigation systems [*since at least as early as August 30, 2012*]

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 19, 2013.

[3] On November 15, 2013, Eco Grounds Care Limited (the Opponent) filed a statement of opposition. In its statement of opposition, the Opponent alleges that it has been using the trade-mark ZERO EMISSIONS TEAM since March 1, 2009 and filed an application for this trade-mark on November 13, 2012. It then sets out the following grounds of opposition:

- (a) Pursuant to sections 38(2)(c) and 16(3)(a) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Applicant is not the person entitled to registration as the Mark was confusing with the Opponent's trade-mark ZERO EMISSIONS TEAM which had been previously used or made known by the Opponent.
- (b) Pursuant to section 38(2)(a) of the Act, the application does not conform to the requirements of section 30 of the Act because the Applicant could not have been satisfied that it was entitled to use the Mark in Canada.
- (c) Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the Goods and Services, nor is it adapted to distinguish the Goods and Services from the services of the Opponent.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] The Opponent filed as its evidence the affidavit of Eric Gordon. The Applicant filed as its evidence the affidavit of Barry McLean. The Opponent filed as its reply evidence a second affidavit of Eric Gordon.

[6] Both parties filed a written argument. A hearing was not held.

Preliminary Issue: Grounds of Opposition Must Appear in the Statement of Opposition

[7] In its written argument, the Opponent references the registration of its trade-mark ZERO EMISSIONS TEAM (registration No. TMA873,690) and sections 12(1)(d), 22 and 7 of the Act. The Opponent also requests that the Mark be “deemed not registrable”. As the application’s compliance with sections 7, 12 and 22 of the Act was not raised in the statement of opposition, I am precluded from considering grounds of opposition based on them [*Le Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 95 CPR (4th) 249 (FC) at paras 27-29].

[8] With respect to the Opponent’s reliance in both its statement of opposition and written argument on section 16(3)(a) of the Act (which is relevant to applications for trade-marks based on proposed use), given the wording of the ground of opposition, I consider it clear that the Opponent intended to rely on section 16(1)(a) of the Act (which is relevant to applications for trade-marks based on use).

Material Dates and Onus

[9] The material dates that apply to the grounds of opposition are as follows:

- 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];
- sections 38(2)(c)/16(1) - the dates of first use claimed [see section 16(1) of the Act]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 at 324 (FC)].

[10] Before considering each of the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

Analysis of the Grounds of Opposition

Section 30(i) Ground of Opposition

[12] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground 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]. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the section 30(i) ground is rejected.

Section 16(3)(a) Ground of Opposition

[13] The Opponent alleges that the Applicant is not the person entitled to register the Mark as it is confusing with the Opponent's trade-mark ZERO EMISSIONS TEAM, which has been made known and used in Canada. The requirements for making known and using a trade-mark in association with services are set out in sections 5 and 4(2) of the Act respectively. In order to meet its evidential burden, the Opponent must show that it had made known or used its ZERO

EMISSIONS TEAM trade-mark in Canada prior to the dates of first use claimed in the application, and that it had not abandoned this trade-mark as of June 19, 2013, the date of advertisement of the Mark. For ease of reference, I note that the application claims use of the Mark in association with goods including potting mixes and fertilizers and services including gardening, lawn care, and snow clearing since at least as early as March 31, 2011 and landscaping trailers since at least as early as July 31, 2012 and maintenance of landscape irrigation systems since at least as early as August 30, 2012.

[14] In support of its opposition, the Opponent filed the May 21, 2014 affidavit of Mr. Gordon, its founder and an officer and director (para 1). Mr. Gordon's evidence is that:

- The Opponent was incorporated on August 14, 2012 and was assigned trade-marks from 1591989 Ontario Limited including the ZERO EMISSIONS TEAM trade-mark (para 2, Exhibit B).
- Since at least March 2009, the Opponent and its predecessor entities have continuously offered the following services in association with the ZERO EMISSIONS TEAM trade-mark (the Opponent's Services) (para 4).

Residential, commercial and municipal landscaping services, namely sustainable, carbon neutral plant, yard and garden maintenance, grass cutting, garden clean up, plant care, shrub care, flowerbed care, planting, fertilizing, pruning, weed control, insect control and aerating services, irrigation system installation and maintenance, landscape lighting installation and maintenance, tree removal and planting; ice control services, namely snow removal and de-icing.

- The Opponent has spent significant sums advertising and promoting the Opponent's Services in Canada (para 7).
- As examples of the Opponent's use of the ZERO EMISSIONS TEAM trade-mark, the Opponent attaches various exhibits including a print-out of the domain name registration for *zeroemissionsteam.ca* (Exhibit 3); website printouts (Exhibit 4); photos of bikes and

carts which Mr. Gordon says display the “Zero Emissions Team” logos (Exhibits 5 and 6) and a copy of a customer proposal (Exhibit 7).

[15] A review of the exhibits attached to Mr. Gordon’s affidavit, fails to establish use or making known of the ZERO EMISSIONS TEAM trade-mark in association with landscaping services or any other services as of any of the material dates. While the website does include the ZERO EMISSIONS TEAM trade-mark (Exhibit 4), Mr. Gordon does not confirm that the screenshot is representative as of how it appeared in 2011 or 2012. While there is evidence that the domain name zeroemissionsteam.ca was registered in March 3, 2010 (Exhibit 3), this does not lead to the inference that the website was displaying the ZERO EMISSIONS TEAM trade-mark as of this date. With respect to the photos of the bikes and carts which transport landscape equipment in Exhibits 4-6, the trade-mark ZERO EMISSIONS TEAM is not visible. Rather, it is a stylized format of the phrase ZERO EMISSIONS set out below which can be seen. In view of the descriptiveness of the phrase ZERO EMISSIONS, I find that word TEAM is a dominant feature of the trade-mark ZERO EMISSIONS TEAM and the deletion of TEAM cannot be regarded as a minor deviation such that either of the designs below constitutes use of ZERO EMISSIONS TEAM [*Canada (Registrar of Trade-marks) v Cie Internationale pour l’informatique CII Honeywell Bull Sa* (1985), 4 CPR (3d) 523 (FCA); *Tasty Burger Corporation v Maple Leaf Foods Inc/Les Aliments Maple Leaf Inc*, 2014 TMOB 160 at paras 28-29].



Finally, with respect to the customer proposal at Exhibit 7 which includes the text “For your onsite grounds care we continue to utilize our eco grounds care – zero emissions team system utilizing solar charged, battery powered equipment...” I do not consider this to be use of the

ZERO EMISSIONS TEAM trade-mark since these words are not treated any differently than the remainder of the text and give no indication that they have any trade-mark significance.

[16] Given my findings above, the Opponent has failed to meet its initial evidential burden under the section 16(1)(a) ground of opposition. As the Opponent has failed to meet its initial evidential burden, it is unnecessary for me to discuss the Applicant's evidence or the Opponent's evidence in reply. This ground of opposition is rejected on the basis the Opponent has failed to meet its initial evidential burden.

Distinctiveness Ground of Opposition

[17] The Opponent alleges that the trade-mark is not distinctive as a result of its use of the ZERO EMISSIONS TEAM trade-mark. There is an evidential burden on the Opponent to establish that, as of November 15, 2013, its trade-mark ZERO EMISSIONS TEAM was known to such an extent that it could negate the distinctiveness of the Mark. In *Bojangles' International, LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) at para 33, the Federal Court provided that a mark 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 is well known in a specific area of Canada. An attack based on non-distinctiveness is not restricted to the sale of goods or services in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's trade-mark including that spread by means of word of mouth or newspaper or magazine articles [*Motel 6, Inc. v No. 6 Motel Ltd.* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[18] The Opponent's evidence is insufficient for it to meet its evidential burden as I am unable to determine the extent of use and the degree of reputation associated with the Opponent's trade-mark as of the material date. First, the Opponent has not provided evidence of total sales or advertising expenditures concerning the trade-mark ZERO EMISSIONS TEAM. Second, none of the pictures of the bikes and carts feature the trade-mark ZERO EMISSIONS TEAM. Third, while the website does feature the trade-mark ZERO EMISSIONS TEAM there is no evidence that the trade-mark was featured on the website, nor evidence of how many Canadians accessed

the website as of the material date. As the Opponent has failed to meet his evidential burden, this ground of opposition is rejected.

Disposition

[19] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

Agents of Record

ALI REZA BANIASADI

For the Opponent

DEL ELGERSMA

For the Applicant