



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

Citation: 2012 TMOB 259
Date of Decision: 2012-12-05

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Hudson's Bay Co. against registration
No. TMA622,649 for the trade-mark LE GOÛT D'ÊTRE
ENSEMBLE in the name of PDM Royalties Limited
Partnership**

[1] At the request of Hudson's Bay Co., the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on November 15, 2010 to PDM Royalties Limited Partnership (the Registrant), the registered owner of registration No. TMA622,649 for the trade-mark LE GOÛT D'ÊTRE ENSEMBLE (the Mark).

[2] The Mark is registered for use in association with the following wares and services:

Wares: (1) Pizza; pasta; donairs; sandwiches; salads, namely, caesar, pasta; panzerottis.
(2) Merchandise used in the operation of restaurants, take-outs and meal delivery, namely, delivery boxes, stickers, paper wrappings, folders, balloons, matches, badges, ornamental label pins, ornamental novelty pins, novelty buttons, pens, invoices, sales slips, menus, placemats, napkins, banners and flyers.

Services: (1) Restaurant services, take-out services, and meal delivery services.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and services specified 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 between November 15, 2007 and November 15, 2010 (the Relevant Period).

[4] The relevant definitions of “use” in the present case are set out in sections 4(1) and (2) of the Act:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares and services specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of André Levesque, sworn on February 9, 2011. Only the Registrant filed written representations; an oral hearing was not held.

[7] In his affidavit, Mr. Levesque identifies himself as Vice-President Marketing, Pizza Delight Division of Invescor Restaurant Group Inc. (Invescor) since July 2010. He attests that Invescor is the exclusive licensee of PDM Royalties Limited Partnership (PDM) in respect of the Mark. Mr. Levesque explains that Invescor operates 96 Pizza Delight restaurants, which are family-style restaurants focused on pizza, pasta, and salads, located throughout Canada.

Use with respect to Wares (1)

[8] With respect to wares (1), Mr. Levesque provides Exhibits A and B as evidence of the manner in which the Mark was used in Canada during the Relevant Period. Exhibit A consists of

a copy of the printed menu used by the Riverview, New Brunswick and New Glasgow, Nova Scotia Pizza Delight restaurants between September 2007 and August 2008. Exhibit B consists of a copy of the printed menu used by the Edmundston, New Brunswick Pizza Delight restaurant between September 10 and November 18, 2008.

[9] I note that the Mark is prominently displayed on the front cover of these menus. As well, the registered wares (1), namely, pizza, pasta, donairs, sandwiches, Caesar salads, pasta salads, and panzarottis, and their corresponding prices, are all listed as items for sale in both menus.

[10] Considering that a customer would use the menu displaying the Mark to order and purchase the specified food wares at a Pizza Delight restaurant, I am satisfied that the notice of association required by section 4(1) of the Act was given to customers at the time of transfer in the normal course of trade. I note that Mr. Levesque provides no direct evidence of sales of these food wares. However, given the nature of Invescor's business and its operation of 96 restaurants in Canada during the Relevant Period, I consider it reasonable to conclude, in combination with Mr. Levesque's statements of use of the Mark with respect to these wares, that the Registrant has demonstrated use of the Mark in association with the named wares (1) above, within the meaning of sections 45 and 4(1) of the Act.

Use with respect to Wares (2)

[11] With respect to wares (2), on the other hand, Mr. Levesque makes no assertion of use and provides no evidence of sales; furthermore, the Registrant provides no evidence of special circumstances excusing non-use. Therefore, these wares will be deleted from the registration.

Use with respect to Services

[12] In his affidavit, Mr. Levesque states that the menus displaying the Mark, as furnished in Exhibits A and B, are used in the performance of the restaurant, take-out, and meal delivery services to allow customers to place orders.

[13] Mr. Levesque also asserts that throughout 2009, Invescor advertised its restaurant, take-out, and meal delivery services in television commercials which were broadcast on CBAFT-SRC

Moncton to New Brunswick cities and surrounding communities. Attached as Exhibit C is a DVD containing four such television commercials.

[14] Having viewed the contents of the exhibited DVD, I note that the Mark is prominently displayed at the end of each commercial in the advertisement of Pizza Delight's restaurant service and seasonal deals on menu items. Although the commercials primarily advertise Pizza Delight's restaurant service, they also reference special price offers for take out and delivery services.

[15] In view of the foregoing, I am satisfied that the Registrant has demonstrated use of the Mark in association with the registered services, within the meaning of sections 45 and 4(2) of the Act.

Disposition

[16] In view of the foregoing, pursuant to the authority delegated to me under subsection 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete wares (2) only.

Andrew Bene
Section 45 Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office