



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

Citation: 2014 TMOB 112
Date of Decision: 2014-05-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Ridout & Maybee LLP against registration
No. TMA418,949 for the trade-mark ARMADILLO
TEXAS GRILL in the name of SIR Royalty Limited
Partnership**

[1] At the request of Ridout & Maybee LLP, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on April 27, 2012, to SIR Royalty Limited Partnership (the Owner), the registered owner of registration No. TMA418,949 for the trade-mark ARMADILLO TEXAS GRILL (the Mark).

[2] The Mark is registered for use in association with “restaurant 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 the 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 April 27, 2009 and April 27, 2012.

[4] The relevant definition of “use” with respect to services is set out in section 4(2) of the Act:

4(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 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 and, as

such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Kim van Nieuwkoop, sworn on October 25, 2012. Both parties filed written representations; only the Owner was represented at an oral hearing.

[7] In her affidavit, Ms. van Nieuwkoop identifies herself as the General Counsel of SIR Corp., a Canadian corporation that owns and operates a portfolio of restaurants in Canada. She attests that the Mark was used and displayed by SIR Corp. in association with restaurant services during the relevant period under license from the Owner. Ms. van Nieuwkoop confirms that the Owner maintained the requisite control over the character and quality of the services performed in association with the Mark during the relevant period.

[8] Ms. van Nieuwkoop explains that one of the restaurants owned and operated by SIR Corp. is the Loose Moose Tap & Grill, a sports bar and restaurant located in Toronto, Ontario that has several million dollars in sales of food and beverages annually. She attests that the Mark was used during the relevant period and continues to be used in association with restaurant services at this location. In support, the following exhibits are attached to her affidavit:

- Exhibit B consists of copies of two menus that Ms. van Nieuwkoop attests were provided to all dining customers in the Loose Moose restaurant from January 2008 until at least September 2009. The menus differ only with respect to the background graphics and otherwise display the same food selections. Both menus are two pages, and are divided into eight distinct sections: Starters, Chicken & Ribs, Salads, Burgers & Sandwiches, Famously-Good Fajitas, Armadillo Texas Grill, F.I.S.H! and Delicious Additions. The section entitled Armadillo Texas Grill displays four menu items underneath it, and I note that the ® symbol is displayed next to the Mark.
- Exhibit C consists of a printout of a downloadable version of the same Loose Moose menu provided at Exhibit B, which Ms. van Nieuwkoop attests was available for download from the website *www.theloosemoose.ca* from January 2008 until at least

September 2009. This menu is a text version of the Exhibit B menus, without the graphics.

- Exhibit D consists of a copy of the “current” Loose Moose restaurant menu, that Ms. van Nieuwkoop attests “has been in use since September 2012”, both in the restaurant and online. The Mark appears in association with one menu item, “ARMADILLO TEXAS GRILL® NACHOS”. Although the exhibited menu is from after the relevant period, Ms. van Nieuwkoop attests that this same menu item appeared on the Loose Moose restaurant dinner menus used in the restaurant and online between October 2009 and September 2010; however, she states that a copy of that menu “was not available”.
- Exhibit E consists of a photograph of part of one of the interior brick walls at the Loose Moose restaurant in Toronto. Ms. van Nieuwkoop attests that the Mark is displayed as a part of a large painted logo on the wall, and appeared on the wall through the entire relevant period. As noted by the Requesting Party, the entirety of the Mark is not visible in the exhibited photograph, as it is partially blocked by a stuffed moose head and otherwise cut off on the edges of the photograph. However, most of the Mark is identifiable and Ms. van Nieuwkoop states that she “can confirm that the entire mark consisting of the words ARMADILLO TEXAS GRILL appears on the wall as part of the logo”.

[9] In its written representations, the Requesting Party submitted that the exhibited menus are insufficient to demonstrate use of the Mark in association with “restaurant services”. In this respect, it cites *McDonald’s Corp v Phil’s Industries of Canada Ltd* (1983), 81 CPR (2d) 260 (TMOB), a decision in an opposition proceeding, where it was questioned whether a menu board and point-of-purchase display signs could properly establish that a trade-mark was clearly displayed in the performance of restaurant services. The Requesting Party noted that the display of the trade-mark FILET-O-FISH on the menu board was not considered appropriate evidence of use to distinguish the opponent’s restaurant services and the ground of opposition was accordingly restricted to prior use in association with *wares* only. Analogous to that decision, the Requesting Party submits that the exhibited menus in this case fail to show use or display of the Mark in the performance of restaurant services. Rather, it submits that the average member

of the public would perceive the Mark not as a service mark but as a type of food available at the licensee's restaurant.

[10] In response, the Owner cited *Oyen Wiggs Green & Mutala v Aimers*, [March 26, 1998 TMOB (unreported), registration No. TMA374,160] regarding the registered trade-mark L.A. WINGS, as being directly on point. In that case, the Registrar accepted display of the trade-mark on a menu as use in association with restaurant services. I would note, however, that the trade-mark appeared to also be the name of the restaurant in that case and that the manner of display of the trade-mark on the menu was not described in the decision. In this case, the Mark is not the name of the restaurant. Furthermore, at the oral hearing, the Owner conceded that it was arguable whether the display of the Mark on the Exhibit D menu constituted display of the Mark in association with wares, being nachos, or in association with the licensee's restaurant services more generally.

[11] Whether a particular trade-mark displayed on a menu can be considered display in the advertisement or performance of restaurant services generally or only in association with particular menu items will depend on the facts of each case. In this case, considering the evidence as a whole, I am satisfied that the display of the Mark on multiple menus during the relevant period in conjunction with the display of the Mark on an interior wall in the restaurant constitutes use of the Mark in association with restaurant services.

[12] In any event, the Mark was displayed in association with multiple menu items on the Exhibit B and C menus. Generally, if a trade-mark is displayed in association with only one menu item, it is open to conclude that the trade-mark is associated with only the particular menu item, as may have otherwise been the conclusion had the Owner's evidence consisted solely of the Exhibit D menu.

[13] In this respect, the mere appearance of a trade-mark in a restaurant, even on a menu, does not necessarily constitute display of that trade-mark in association with the services performed in that restaurant. A menu in a restaurant is akin to a catalogue in a retail store. With respect to catalogues, a distinction is made between trade-marks displayed in association with particular goods appearing in that catalogue and trade-marks being displayed by the retailer, such as its store name or slogans. The former is generally display in association with wares; the latter is

generally display in association with services. (Of course, whether such display constitutes use within the meaning of section 4 of the Act will depend on the facts of each case.) Similarly, a trade-mark displayed in a menu is not necessarily a trade-mark displayed in association with restaurant services. As noted above, the Owner conceded that, considered in isolation, the display of the Mark in the menu at Exhibit D was arguably only use of the Mark in association with the wares “nachos”.

[14] Nevertheless, I accept the display of the Mark on the Exhibit B menu as display in association with the licensee’s restaurant services. In the Exhibit B menu, the Mark is displayed above a selection of menu items, thus associating it with the services of the licensee, rather than any particular menu item or ware. Further, the display of the Mark on the interior wall of the restaurant in and of itself constitutes display in association with restaurant services and would provide sufficient context to conclude that the display of the Mark on the Exhibit D menu would also be in association with the restaurant services more generally and not merely in association with “nachos”.

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

Disposition

[16] Accordingly, 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 maintained.

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