

SECTION 45 PROCEEDINGS
TRADE-MARK: RISTORANTE DA VINCI & DESIGN
REGISTRATION NO.: TMA402,041

[1] At the request of Selena Altro Paperman (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the “Act”) on December 6, 2006 to Les Aliments Da Vinci Ltée/Da Vinci Food Products Ltd., the registered owner of the above-referenced trade-mark at that time (the “registrant”).



[2] The trade-mark RISTORANTE DA VINCI & DESIGN (shown above) is registered for use in association with “restaurant services”.

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares and/or 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 any time between December 6, 2003 and December 6, 2006.

[4] “Use” in association with services is set out in subsections 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] In response to the Registrar's notice, the registrant furnished the affidavit of Frank Mazzaferro, sworn on June 6, 2007, together with Exhibits "A" through "C". Both parties filed written submissions; no oral hearing was held.

[6] In his affidavit, Mr. Mazzaferro states that he is the secretary of Les Aliments Da Vinci Ltée/Da Vinci Food Products Ltd.; he was also a shareholder and a director of Les Restaurants Da Vinci Inc. until November 2004. The requesting party argues that this affidavit as a whole should be disregarded since Mr. Mazzaferro does not provide any evidence of his day-to-day involvement in the registrant company with respect to its ongoing commerce, including matters regarding the subject trade-mark, nor of his involvement with Les Restaurants Da Vinci Inc. after November 2004. For those reasons, the requesting party submits that the allegations in his affidavit are based on hearsay, contrary to Rules 81(1) and (2) of the *Federal Court Rules*. In support, it relies on *Canadian Council of Professional Engineers v. AEC, Inc.* (2002), 22 C.P.R. (4th) 399 (T.M.O.B.).

[7] The facts of this case are distinguishable from those in the *Canadian Council of Professional Engineers* case. In particular, the case at hand concerns an affidavit sworn by an individual who was an officer of the registrant's company for a period of time during the relevant period whereas the evidence in the *Canadian Council of Professional Engineers* case consisted of an affidavit sworn by the registrant's trade-mark agent. The Hearing Officer in the *Canadian Council of Professional Engineers* case reasoned as follows:

Here, the allegations in the affidavit are obviously "hearsay" and the registrant has not established the necessity of submitting evidence by way of an affidavit of an employee of the trade-mark agent firm. *We have not been informed the reason an affidavit from an officer of the registrant's company could not be furnished... [Emphasis added]*

[8] Bearing in mind the purpose and the summary nature of section 45 proceedings, I am not prepared to find the entire affidavit hearsay evidence since it is reasonable to conclude that some of the evidence was based on the affiant's personal knowledge

because he was an officer of the registrant during the relevant period, and up to November 2004, he was also a director of Les Restaurants Da Vinci Inc.

[9] 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 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the wares/services specified in the registration during the relevant period.

[10] The affiant discusses extensively the registrant's involvement with Les Restaurants Da Vinci Inc., which operates a restaurant under the name of "Ristorante Da Vinci" in Montreal in association with the subject trade-mark. According to Mr. Mazzaferro, Les Restaurants Da Vinci Inc. was founded by his family in 1960 and is "closely associated with" the registrant. He attests that due to differences between family members, he sold the shares that he held in Les Restaurants Da Vinci Inc. to the remaining family members in November 2004 and resigned as a director of the company at the same time, as shown in the restaurant's corporate records attached as Exhibit "C". He further attests that Les Restaurants Da Vinci Inc. had a tacit agreement with the registrant to use the trade-mark in association with restaurant services.

[11] The evidence suggests that it is Les Restaurants Da Vinci Inc., not the registrant, who is operating a restaurant in Montreal in association with the subject trade-mark. In order to satisfy the requirements of subsection 50(1) of the Act, the registrant or the licensee needs to clearly state in the affidavit or the statutory declaration that the control required by section 50 exists [see *Gowling, Strathy & Henderson v. Samsonite Corp.* (1996), 66 C.P.R. (3d) 560 (T.M.O.B.) and *Mantha & Associates. v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354 (F.C.A.)]. Alternatively, a description of the control or a copy of the license agreement containing provisions pertaining to control would also

suffice. Furthermore, the jurisprudence is clear that if the president or the director of a corporate owner is also the president or the director of the user of the trade-mark, the requirements of section 50 may be satisfied [see *Petro-Canada v. 2946661 Canada Inc.* (1998), 83 C.P.R. (3d) 129 and *Automobility Distribution Inc. v. Jiangsu Electronics Industries Ltd.* (2005), 43 C.P.R. (4th) 157].

[12] In the present case, I am not satisfied that such control between the registrant and Les Restaurants Da Vinci Inc. has been shown during the relevant period for the following reasons. First, there is no evidence of direct or indirect control over the quality or the character of the restaurant's services provided by Les Restaurants Da Vinci Inc. Second, the registrant failed to provide any details regarding the provision of control expressed in the license agreement, tacit or otherwise. Third, there is simply not enough evidence regarding the corporate structures of both companies and the extent of Mr. Mazzaferro's role in the registrant company, aside from being its secretary before November 2004, to conclude that the registrant company exercised sufficient control over the services provided by Les Restaurants Da Vinci Inc.

[13] The affidavit describes that at one point, Da Vinci Ltée/Da Vinci Food Products Ltd. and Les Restaurants Da Vinci Inc. were operated as part of a family business and were "closely associated with" each other. It appears from the evidence that the restaurant has now been sold to "foreign investors" who are seeking to secure the trade-mark at issue. This case appears to be an unfortunate case of an apparent falling out between members of family run businesses. However, section 45 of the *Trade-marks Act* provides only for a summary expungement procedure designed to clear the register of trade-marks that are no longer in use in Canada and is not the forum to determine substantive rights in a trade-mark, such as ownership. Accordingly, I must only determine whether the registrant has provided evidence that it has used the trade-mark in Canada during the relevant period or circumstances excusing the non-use of the trade-mark during the relevant period in order to maintain the registration on the register.

[14] For the period prior to November 2004, there is no indication that Mr. Mazzaferro was in charge and in control of both Les Aliments Da Vinci Ltée/Da Vinci Food Products Ltd. and Les Restaurants Da Vinci Inc. For the period after November 2004, even though the affiant states that “it is essential for the affairs and integrity of the goodwill and reputation of Les Aliments Da Vinci Ltée/Da Vinci Food Products Ltd. to continue owning, controlling, licencing and using the [subject] trade-mark in conjunction with [the registrant’s] vast business activities”, no details regarding its agreement with Les Restaurants Da Vinci Inc.’s use of the trade-mark has been provided. All that I am able to conclude from the corporate records attached as Exhibit “A” is that the two companies discussed the assignment of the subject trade-mark without any results in November 2006. Under these circumstances, I am unable to infer that the registrant had control over the quality or character of the restaurant services provided by Les Restaurants Da Vinci Inc. within the meaning of subsection 50(1) of the Act.

[15] Other evidence of use of the trade-mark provided by Mr. Mazzaferro consists of printouts of Ristorante Da Vinci’s website at www.davinci.ca attached as Exhibit “B”. The affiant also indicates that the website is registered to Da Vinci Ltd. As in the case of Les Restaurants Da Vinci Inc., the registrant failed to provide any pertinent details concerning its relationship with Da Vinci Ltd. or that between the latter and the restaurant. In any event, the advertising of a service has to be coupled with its performance, or at least its availability, in Canada in order to show use of a trade-mark within the meaning of section 4 of the Act [*Porter v. Don the Beachcomber* (1996), 48 C.P.R. 280 (Ex. Court) and *Wenward (Canada) Ltd. v. Dynaturf Co.* (1976), 28 C.P.R. (2d) 20 (T.M.O.B.)]. In view of the evidence, the registrant has not shown use of the subject trade-mark in association with restaurant services during the relevant period, through its own use or that of a licensee as defined in subsection 50(1) of the Act.

[16] Having decided that the registrant failed to clearly identify its control over the quality or the character of the restaurant services provided by a third party, there is no need to assess the relevance of Mr. Mazzaferro’s remaining evidence regarding use of the subject trade-mark.

[17] In view of all of the foregoing, the registrant failed to show use of the subject trade-mark within the meaning of section 45 and subsection 4(2) of the Act in association with “restaurant services” during the relevant period. Accordingly, and pursuant to the authority delegated to me under subsection 63(3) of the Act, registration TMA402,041 for the trade-mark RISTORANTE DA VINCI & DESIGN ought to be expunged from the Register in compliance with the provisions of section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT MONTREAL, QUEBEC THIS 17TH DAY OF DECEMBER 2009.

P. Fung
Hearing Officer
Trade-marks Opposition Board