

SECTION 45 PROCEEDINGS  
TRADE-MARK: MONTE CARLO  
REGISTRATION NO.: 283,750

On February 10, 2005 at the request of 88766 Canada Inc., the Registrar forwarded a Section 45 notice to Monte Carlo Restaurant Limited, the registered owner of the above-referenced trade-mark registration.

The trade-mark MONTE CARLO is registered for use in association with the following wares and services:

wares:

“pizza and spaghetti”.

services:

“Operation of a restaurant, food take-out, a tavern, a banquet hall and food catering”.

Section 45 of the Trade-marks 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/or services listed on 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 use since that date. The relevant period in this case is any time between February 10, 2002 and February 10, 2005.

In response to the notice, the affidavit of Mauro Galli, President of the registrant was furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

In his affidavit Mr. Galli states that the registrant has used the trade-mark continuously in Canada since 1966 and that it used it continuously between February 10, 2002 and February 10, 2005 in association with the operation of a restaurant, food take-out, a tavern, a banquet hall and food catering. He explains that the registrant has twenty-four MAMMA'S PIZZA restaurants in Southern Ontario that offer take-out and delivery of pizza, fresh homemade pasta, meat and chicken dishes, hot sandwiches and fresh salads. He adds that some of the restaurants offer a seating area for customers and some have a liquor license. He indicates that the trade-mark MONTE CARLO is used in the advertising for each of the MAMMA'S PIZZA restaurants. As Exhibit A he provides copies of four flyers, representative of the flyers used to promote the MAMMA'S PIZZA restaurants. He states that the trade-mark MONTE CARLO is prominently displayed on each flyer and he adds that more than 6 ½ million of these flyers have been distributed throughout Southern Ontario in the last five years (his affidavit is dated July 6, 2005). He concludes by stating that the trade-mark MONTE CARLO is also prominently displayed at each MAMMA'S PIZZA restaurant and as Exhibit B he attaches a copy of a picture which appears at each location.

The requesting party has raised several arguments the main ones being summarized as follows:

There is no evidence showing that the services were performed during the relevant period; further use had to be shown in association with each of the five (5) services listed in the registration.

If any use has been shown, such use has been by “franchisees” and not by the registrant.

Having considered the evidence I find that it is sufficient to permit me to conclude that the trade-mark was in use in association with the “operation of a restaurant, food take-out and food catering”. In my view, the flyers furnished in evidence show use of the trade-mark in the advertisement of such services pursuant to s-s. 4(2) of the Act. The flyers bear the trade-mark and refer to restaurant services, food take-out and food catering (in this regard one of the flyers mention the following “we cater meetings, office lunches, birthdays, etc.”). As Mr. Gally has indicated that these flyers are representative and as he has indicated that more than 6 ½ million flyers were distributed in Southern Ontario in the five years preceding the swearing of his affidavit and as the flyer offering coupons having an expiry date of July 31, 2003 would most probably have been distributed in 2003, that is during the relevant period, this satisfies me that flyers of the type furnished in evidence were distributed during the relevant period. Consequently, the evidence shows the use of the trade-mark in the advertisement of the services. Concerning performance of the services during the relevant period, I note that the July 31, 2003 flyer lists twelve (12) different locations for the restaurant and announces that two other restaurants will be opening soon. The other flyers show additional locations. Consequently, from the flyers furnished and from the evidence as a whole I have no doubt that the services namely “the operation of a restaurant, food take-out and food catering” were performed during the relevant period.

The requesting party has argued that if it is considered that use has been shown, then such use is

by “franchisees” and not by the registered owner. The registrant, on the other hand, submits that there is no clear evidence that the use of the trade-mark is by “franchisees”. I agree with the registrant. Although it is true that on each flyer the following reference appears “Mamma’s Pizza Franchises Now Available”, there is absolutely no reference to a “franchisee” on any of the flyers. Consequently, as Mr. Galli has sworn that the use is by the registrant and as the evidence does not show otherwise, I accept that the use shown is by the registrant.

Concerning the remaining services namely “operation of a tavern and a banquet hall” I find that the evidence furnished does not permit me to conclude that the trade-mark was in use in association with such services during the relevant period. Consequently, these services will be deleted from the trade-mark registration.

Concerning the wares “pizza and spaghetti”, I note that the parties have not commented on whether or not the evidence shows use in association with such wares. In my view, the evidence on that point is not overwhelming however, I am prepared to accept that the appearance of the trade-mark MONTE CARLO particularly on the flyer having coupons with an expiry date of July 31, 2003 may satisfy the requirements of s-s. 4(1) of the Act taking into consideration that the consumers would probably use the flyer when ordering the wares for delivery. Consequently, the flyer would provide the required association between the trade-mark and the wares at the time of ordering of the wares and the association would continue at the time of delivery of the wares since the consumer would still have the flyer on hand.

As I have concluded that the evidence shows use of the trade-mark MONTE CARLO in association with the registered wares and in association with the services “operation of a restaurant, food take-out and food catering” then I conclude that the trade-mark registration ought to be maintained for the wares and for these services.

Registration No. 283,750 will be amended to delete the services “a tavern and a banquet hall” accordingly in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 27TH DAY OF SEPTEMBER 2006.

D. Savard  
Senior Hearing Officer  
Section 45 Division