



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

Citation: 2019 TMOB 9

Date of decision: 2019-01-30

[UNREVISED ENGLISH

CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

Earth to Table Inc.

Requesting Party

and

Restaurants Pacini Inc.

Registered Owner

TMA332,862 for BAR A PAIN

Registration

INTRODUCTION

[1] This decision concerns a summary expungement proceeding against Registration No. TMA332,862, property of Restaurants Pacini Inc. (the Owner), for the BAR À PAIN trade-mark (the Mark), covering “services d’exploitation d’un restaurant” (services for operation of a restaurant) (the Services).

[2] On the following grounds, I conclude that the registration must be maintained.

THE PROCEDURE

[3] On December 9, 2016, the Trade-marks Registrar sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c. T-13 (the Act) to the Owner. The notice was issued at the request of Earth to Table Inc. (the Requesting Party).

[4] Section 45 of the Act requires the Owner to show that it has used its Mark in Canada in association with the Services at any given time during the three years preceding the date of the notice or, if not, provide the date on which it was last used and the reason for its absence of use since this date. The relevant period is therefore from December 9, 2013, to December 9, 2016 (the Relevant Period).

[5] The procedure pursuant to section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the meaning of section 4 of the Act, during the Relevant Period is not very high [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, (2004) 31 CPR (4th) 270 (FCTD)]. The issue is to establish a use of the Mark prima facie [see *1459243 Ontario Inc v Eva Gabor International, Ltd*, 2011 FC 18 (FCTD)].

[6] A simple assertion of use of the Mark in association with the Services is not sufficient to establish its use within the meaning of section 4(2) of the Act. Which reads as follows:

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.

[7] Finally, there is no need to file overabundant evidence [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (4th) 62 (FCA)].

[8] In response to the notice, the Owner filed Ms. Nathalie Lehoux’s affidavit and Exhibits NL-1 to NL-10.

[9] The parties filed written representations and there was no hearing.

THE EVIDENCE OF RECORD

[10] Ms. Nathalie Lehoux is the President of the Owner, a position she has held since April 23, 2014. Previously she held the position of First Vice-President and Chief Financial Officer, effective from April 2002. She affirms that the Owner offers services for operation of a restaurant.

[11] Ms. Lehoux affirms that the Owner has used the Mark in Canada since as early as October 1982, in association with the Services. She declares that the Owner used and still uses the Mark in the normal course of its business in Canada, in relation to the Services. To support these allegations, Ms. Lehoux filed the following exhibits:

- Exhibit NL-1: excerpts from the Owner's website showing the Mark in advertising of the Services. Although these excerpts are dated previous and subsequent to the Relevant Period, Ms. Lehoux affirms that the same excerpts were available during the Relevant Period;
- Exhibit NL-2: the traffic statistics of the Owner's websites and the page dedicated to the Mark during the Relevant Period;
- Exhibit NL-3: photos of the Owner's restaurants, including the section of the restaurants dedicated to the Services sold under the Mark;
- Exhibit NL-4: excerpts from the Owner's website showing the Mark in advertising of the Services during the Relevant Period;
- Exhibit NL-5: the traffic statistics of the Owner's restaurants in which the Services in association with the Mark were sold for the period from September 2014 to September 2016;
- Exhibit NL-6: samples of menus to which the Owner's customers had access during the Relevant Period showing the use of the Mark in advertising of the Services;
- Exhibit NL-7: examples of advertising done by the Owner during the Relevant Period and showing the Mark in advertising of the Services;
- Exhibit NL-8 (but under tab 9): A pamphlet used by the Owner during the Relevant Period during the Franchise Show for the years 2013 and 2016, showing the Owner's Mark in advertising of the Services;
- Exhibit NL-9 (but under tab 10): several articles and excerpts from third-party websites referring to the Mark in association with the Services offered by the Owner during the Relevant Period.

[12] I must determine whether this evidence proves the use of the Mark in Canada by the Owner in association with the Services during the Relevant Period.

PRELIMINARY REMARKS

[13] I must point out that all this evidence shows that the restaurants operated by the Owner and/or its franchisees are operated in association with the PACINI trade-mark. Moreover, within these restaurants, there is an area where customers can toast bread and apply different spreads offered to the bread thus toasted [see Exhibit NL-3].

[14] It is important to emphasize, as the Owner pointed out, that the Requesting Party, in its written arguments, puts enormous emphasis on the English-language description of the Services, namely: “*operation of a restaurant*”. The application for registration was filed in French and therefore the English description of the Services is a translation. For the purposes of my decision, I will refer to the original French version of the description Services, namely “*services d’exploitation d’un restaurant*”. This is the description used by the Owner in the filing of the application, which led to the registration that is the object of this opinion.

ANALYSIS OF THE REQUESTING PARTY’S EVIDENCE AND ARGUMENTS

[15] The Requesting Party’s main argument is that the foregoing evidence does not show that the Owner “operates any restaurant” in association with the Mark. It submits that the documentary evidence attached to Ms. Lehoux’s affidavit shows that the Mark is used to identify one of the features of the Owner’s restaurants, which are operated in association with the PACINI trade-mark. This is a bar where customers can toast bread. It adds that the photographs filed by Ms. Lehoux show that there is no sign displaying the Mark near these areas within the restaurants.

[16] The Requesting Party argues that the goodwill statistics of the Owner’s restaurants during the Relevant Period concern the network of restaurants offered under the PACINI banner. This is not the customer traffic of restaurants operated in association with the Mark.

[17] Regarding the advertising and the different menus produced, the Requesting Party argues that they show the use of the PACINI trade-mark in association with operation of restaurants. The reference to the Mark on the advertising and menus would serve to identify one of the features of the PACINI restaurants, namely the presence of a bread bar.

[18] Finally, the Requesting Party points out that the Owner has not filed any evidence of receipts or invoices showing the use of the Mark in association with the Services during the Relevant Period.

[19] I recall that it is well established that a trade-mark owner may use two or more of its trade-marks simultaneously in association with the same goods and/or services [see *AW Allen Ltd v Canada (Registrar of Trade Marks)* (1985), 6 CPR (3d) 270 (FCTD)]. Thus, despite the presence of the PACINI mark on most of the exhibits filed by Ms. Lehoux, I must determine whether the Owner nonetheless used the Mark in Canada in association with the Services during the Relevant Period.

[20] I find that the description of the Services encompasses all the services performed in the course of operation of a restaurant. The recent jurisprudence regarding Section 45 proceedings teaches us, when the registration concerns services, to adopt a liberal interpretation. Thus, if the evidence proves the use of the Mark in association with ancillary services that pertain to the services described in the register, the registration of this mark then will be maintained [see *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FC) and by analogy *Doctor's Associates Inc v American Multi-Cinema, Inc*, 2012 TMOB 77].

[21] By applying the principle of a liberal interpretation of the description of the Services, I consider that offering, within the restaurants operated under the PACINI banner, the service of an area where customers can choose a type of bread, toast it and apply different spreads offered, constitutes a service that pertains to the services of operation of a restaurant. It remains to be determined whether this service is offered in association with the Mark.

[22] The Mark clearly appears on the different menus filed in evidence. I refer to Exhibit NL-6. The following excerpts can be read in this exhibit:

- Express menu: “Inclus... Vous pouvez également profiter du Bar à Pain ^{MD}, où tartinades et confitures vous sont offertes à volonté.” [TRANSDUCTION] (Included... all-you-can-eat Bread Bar TM with spreads and jam)
- Noon menu: “Inclus... Bar à Pain ^{MD} à volonté.” [TRANSDUCTION] (Included... all-you-can-eat Bread Bar TM)

- Evening menu: “Inclus...Bar à Pain ^{MD} à volonté.” [TRANSDUCTION] (Included... all-you-can-eat Bread Bar TM)

[23] Thus, the price of the different dishes described in these menus includes a place where the customer can choose his bread, toast it and apply the spread of his choice. Therefore, this service is offered in exchange for compensation in the context of operation of a restaurant.

[24] It has been decided that a trade-mark is used in association with services if this mark appears on a menu to designate a service as opposed to a specific good [see *Ridout & Maybee LLP v SIR Royalty Limited Partnership* 2014 TMOB 112]. In our case, I find that this indeed is a service.

[25] I would add that the Owner proceeded to advertise this service in association with the Mark on its website and its Facebook page (Exhibits NL-1 and NL-4). Moreover, the Owner has promoted this ancillary service in association with the Mark in advertising (Exhibit NL-7).

[26] Due to all this evidence, I conclude that the Owner proved the use of the Mark in Canada in association with the Services during the Relevant Period.

DISPOSAL

[27] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration TMA332,862 will be maintained in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

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

No hearing held

AGENT(S) IN THE CASE

Lavery, De Billy, L.L.P.

Michele Ballagh

FOR THE REGISTERED OWNER

FOR THE REQUESTING PARTY