



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 013

Date of Decision: 2022-01-28

IN THE MATTER OF A SECTION 45 PROCEEDING

**Perley-Robertson, Hill & McDougall
LLP / S.R.L**

Requesting Party

and

1337184 Ontario Limited

Registered Owner

TMA882,007 for IVY

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA882,007 for the trademark IVY (the Mark), owned by 1337184 Ontario Limited (the Owner).

[2] All references are to the Act as amended June 17, 2019.

[3] The Mark is registered for use in association with the following: operation of a restaurant, pub, nightclub and bar (the Services).

[4] For the reasons that follow, I conclude that the registration ought to be expunged.

THE PROCEEDING

[5] At the request of Perley-Robertson, Hill & McDougall LLP / S.R.L. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on July 16, 2019, to 1337184 Ontario Limited, the registered owner of the Mark.

[6] The notice required the Owner to show whether the trademark was used in Canada in association with each of 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 July 16, 2016 to July 16, 2019 (the Relevant Period).

[7] The relevant definition of use in the present case is set out in section 4(2) of the Act 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.

[8] 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. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the mark was used in association with the services.

[9] In response to the Registrar’s notice, the Owner furnished an Affidavit of Andrew Donaldson, sworn on October 16, 2019, to which were attached Exhibits 1 to 4.

[10] Only the Requesting Party submitted written representations. No oral hearing was held.

THE EVIDENCE

[11] Mr. Donaldson describes himself as the sole officer, director and shareholder of the Owner.

[12] Mr. Donaldson states that the Owner licensed the use of the Mark to 2234185 Ontario Inc., of which he is an officer, director and shareholder, for the purposes of operating a restaurant, pub, nightclub and bar at 3330 South Service Road in Burlington, Ontario. He states that the business opened in March 2012 under the name IVY BAR + KITCHEN and operated continuously until March 12, 2018 when it was closed. He states that the business employed 40 to 50 individuals during the period of its operations and that the business was promoted through radio and television advertisements, local print media and on the Internet.

[13] Mr. Donaldson describes the business as featuring two bars, one indoor and one outdoor. He states that the bar aspect of the business included a bar menu available during specific hours of operation. He also states that, at the end of each restaurant seating period on Friday and Saturday nights, tables were cleared and the location became a full night club featuring D.J.'s and dance floor. Finally, he states the business also featured a number of craft beers and specific menu items associated with pub-style restaurants.

[14] In support, Mr. Donaldson attaches the following Exhibits:

- Exhibit 1 is described as “a sample of true advertisements” used by the business during the period it operated. In fact, Exhibit 1 contains interior and exterior photographs of what appears to be a restaurant. Most of the photographs do not show any use of the Mark. Some of the photographs include an image of menus on which a variation of the IVY logo (as discussed below) appears (*i.e.*, without the word KITCHEN).
- Exhibit 2 is described as a series of photographs of the business taken during the period it operated. In fact, Exhibit 2 contains various advertisements which display IVY BAR + KITCHEN and the following logo (the IVY logo):



- Exhibit 3 consists of sample menus for the business used during the period it operated which show the IVY logo.

- Exhibit 4 is a copy of a bar menu last used in March 2018. The only use of IVY in this exhibit is on a page titled IVY DESSERT and on specific menu items such as IVY KITCHEN DOUGHNUTS and THE IVY COFFEE.

[15] As noted by the Requesting Party, it appears that the Affiant mixed up Exhibits 1 and 2. To the extent that this is a technical deficiency in the Affidavit, it is not of concern. Especially in the context of section 45 proceedings - which are intended to be summary and expeditious - the Registrar has frequently considered certain deficiencies in affidavits to be mere technicalities [see, for example, *Brouillette, Kosie v Luxo Laboratories Ltd* (1997), 80 CPR (3d) 312 (TMOB); and *88766 Canada Inc v Tootsie Roll Industries Inc* (2006), 56 CPR (4th) 76 (TMOB)].

PRELIMINARY MATTER

[16] The Requesting Party submits that 1337184 Ontario Limited was not the owner of the mark at any time, including the Relevant Period.

[17] It is well established that section 45 proceedings are not intended to determine substantive rights such as ownership, distinctiveness, descriptiveness or abandonment of a registered trademark [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 (*United Grain Growers*); *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)].

[18] Given that 1337184 Ontario Limited was the registered owner of the Mark at all times, there is no basis for me to question ownership of the Mark.

[19] As well, the Requesting Party makes reference to facts not in evidence concerning that corporate history of 2234185 Ontario Inc. These submissions will be disregarded [*Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)].

ANALYSIS AND REASONS FOR DECISION

[20] The Requesting Party submits that:

- The trademark depicted in evidence is not the Mark as registered;
- There is no evidence of use of the Mark in association with the Services; and,

- Even if there was use of the Mark in association with the Services, such use would not accrue to the benefit of the Owner.

Deviation from the Mark as registered

[21] The Requesting Party submits that the Owner uses the mark IVY BAR + KITCHEN instead of the Mark as registered.

[22] If a trademark is used in combination with additional words or features, use will be considered when the public, as a matter of first impression, would perceive the mark as being used *per se* [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. This is a question of fact which is dependent on whether the trademark stands out from additional material, for example, by the use of different lettering, sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename [*Nightingale*; see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[23] The IVY logo appeared on menus used in the business and in advertisements for the business. As well, IVY BAR + KITCHEN appeared in advertisements for the business.

[24] I do not consider the addition of the words BAR and KITCHEN to the Mark, especially in a smaller type face as used in the IVY logo, to be fatal. The Mark remains recognizable. Therefore, I accept that use of the IVY logo and use of IVY BAR + KITCHEN constitutes use of the Mark as registered.

Use of the Mark in association with Services

[25] The Requesting Party submits that Mr. Donaldson does not state that the Services were performed in the normal course of trade or provide any information or details as to what constitutes the normal course of trade in the Owner's industry.

[26] While use in the normal course of trade is an element of section 4(1) of the Act in relation to goods, it is not an element of section 4(2) of the Act in relation to services. All that the Owner must show is that the Mark was used or displayed in the performance or advertising of the Services.

[27] Evidence in a section 45 proceeding must be considered as a whole, and focusing on individual pieces of evidence in isolation is not the proper approach [see *Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB); and *Fraser Milner Casgrain LLP v Canadian Distribution Channel Inc* (2009), 78 CPR (4th) 278 (TMOB)]. As well, reasonable inferences can be made from the evidence provided [see *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64].

[28] Mr. Donaldson states that the business, which was operated by 2234185 Ontario Inc., opened in March 2012 and closed in March 12, 2018. His evidence is that the business consisted of two bar areas and also offered restaurant seating which, on Friday and Saturday nights, would be cleared away so that the area could be turned into a night club. Exhibit 2 contains several advertisements for the business all of which display the Mark and which Mr. Donaldson states were used during the period the business operated. Exhibit 3 contains menus which display the Mark and which Mr. Donaldson states were used during the period the business operated.

[29] Applying the principles outlined above to these facts, I am satisfied that 2234185 Ontario Inc. used the Mark in Canada during the Relevant Period in association with the operation of a restaurant, nightclub and bar.

[30] With respect to the operation of a pub, Mr. Donaldson states that the business featured craft beer and specific menu items associated with pub style restaurants, although he does not identify what those are. This is not sufficient to permit a reasonable inference that the Mark was used in Canada during the Relevant Period in association with the operation of a pub.

[31] Therefore, I am not satisfied that 2234185 Ontario Inc. used the Mark in Canada during the Relevant Period in association with the operation of a pub.

Use of the Mark by a licensee

[32] As noted above, use of the Mark was by 2234185 Ontario Inc.

[33] Section 50(1) of the Act requires the owner of a trademark to control the character or quality of the services performed under that trademark. A trademark owner can demonstrate the requisite control of the character or quality of the services performed pursuant to section 50(1) of

the Act either by attesting to the fact that it exerts the requisite control or by providing evidence that demonstrates that it exerts the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102].

[34] The facts in evidence are as follows:

- (a) Mr. Donaldson is “the sole officer, director and shareholder” of the Owner (emphasis added);
- (b) The Owner licensed the use of the Mark to 2234185 Ontario Inc.
- (c) Mr. Donaldson is “an officer, director and shareholder” of 2234185 Ontario Inc. (emphasis added).

[35] Absent from Mr. Donaldson’s evidence is any statement that the Owner controlled the use of the Mark by 2234185 Ontario Inc. or any evidence of public notice that would enable the Owner to claim the benefit of the presumption under section 50(2) of the Act.

[36] A corporate relationship alone is insufficient to establish use that accrues to the benefit of the owner of a trademark [*Live! Holdings, LLC v Oyen Wiggs Green & Mutala LLP*, 2020 FCA 120 at para 47].

[37] This is not a case where the requisite control over the character or quality of the services can be inferred from the evidence. This case is distinguishable from cases where the requisite control was inferred owing to the presence of a common controlling individual for the trademark owner and the licensee [see, for example, *Lindy v Canada (Registrar of Trade Marks)*, 1999 CarswellNat 652 (FCA); *Petro-Canada v 2946661 Canada Inc.*, 1998 CanLII 9107 (FC)].

[38] In this instance, Mr. Donaldson does not state that control is exercised. The only evidence I have before me is that Mr. Donaldson is an officer, director and shareholder of both companies. I have no evidence as to his position with the companies (*i.e.*, was he the President as in *Lindy*) or that he was the person in charge of the companies (as in *Petro-Canada*).

[39] Applying the principles outlined above to these facts, I am not satisfied that the facts described in Mr. Donaldson’s affidavit show or permit a reasonable inference that the Owner had

direct or indirect control over the character or quality of the services offered by the licensee pursuant to the licence nor is there any evidence of a public notice of the licence which would enable me to apply the presumption under section 50(2) of the Act. Accordingly, I am not in a position to conclude that the use of the Mark by 2234185 Ontario Inc. constituted use of the Mark by the Owner under section 50(1) of the Act.

DISPOSITION

[40] In view of the above, I am not satisfied that the evidence demonstrates use of the Mark in Canada during the Relevant Period in association with the Services by the Owner.

[41] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be expunged.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

No Agent Appointed

For the Registered Owner

Perley-Robertson, Hill & McDougall LLP / S.R.L.

For the Requesting Party