



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 165**

**Date of Decision: 2022-08-25**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Smiths IP**

**Requesting Party**

**and**

**Overeasly Breakfast Ltd.**

**Registered Owner**

**TMA840,211 for SOUL IN A BOWL**

**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. TMA840,211 for the trademark SOUL IN A BOWL (the Mark).

[2] The Mark is registered for use in association with the following good: Poutine.

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

## THE PROCEEDING

[4] On May 14, 2021, at the request of Smiths IP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Overeasy Breakfast Ltd. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with the good 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 the Mark 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 May 14, 2018 and May 14, 2021 (the Relevant Period).

[5] The relevant definition of “use” is set out in section 4(1) of the Act as follows:

4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[6] In response to the Registrar’s notice, the Owner submitted the affidavit of Mr. Mauro Martina, the Owner and CEO, sworn on July 28, 2021.

[7] Neither party submitted written representations and no oral hearing was held.

## THE OWNER’S EVIDENCE

[8] Mr. Martina explains that the Owner operates a restaurant that opened in 2009 and serves breakfast and brunch [para 4]. The “SOUL IN A BOWL” was created in 2009 and is served as a breakfast poutine and is listed in the menu [para 5]. Mr. Martina also provides samples of advertising on Instagram, Facebook and online magazine *Foodology.ca* for “Soul in a bowl” [paras 6, 7 and 11].

[9] Mr. Martina also explains that the Owner changed the name of its restaurants to OEB Breakfast Co. [para 4], that the Owner entered into a licensing agreement with OEB Breakfast Co. [para 8].

[10] In support, Mr. Martina attaches the following relevant exhibits to his affidavit:

- Exhibit A: A menu displaying an item called “Soul in a bowl” in the signature breakfast poutine section accompanied by the ® symbol. Mr. Martina explains that it is a printout of the menu of OEB Breakfast Co. and he confirms that “Soul in a Bowl” is accompanied by ® next to it indicating it is a registered trademark [para 5].
- Exhibit B: Instagram post screenshots from “OEB\_breakfast” dated from the Relevant Period featuring pictures of the “Soul in a bowl”, listing its ingredients and promoting its availability in various restaurants in Canada. Mr. Martina explains that these screenshots from Instagram are dated from December 14, 2019 to April 23, 2021 [para 6].
- Exhibit D: A copy of a partly redacted trademark license agreement for the Mark between the Owner and OEB Breakfast Co. (the Licensee) dated November 1, 2018 [para 8].
- Exhibit “E”: Printout from the Licensee’s website *eatoeb.com*, providing the addresses of the various locations of its restaurants in Calgary, Edmonton, Saskatoon and Vancouver. Mr. Martina states that there are eight restaurant locations in Canada [para 10].

#### ANALYSIS AND REASONS FOR DECISION

[11] While the evidence in a section 45 proceeding need not be perfect, a registered owner must still establish a prima facie case of use, meaning that the evidence must supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

#### USE BY A LICENSEE

[12] When the owner of a trademark seeks to benefit from the use of its trademark by another party, the owner must show direct or indirect control of the character or quality of the goods or services associated with that trademark [section 50(1) of the Act].

[13] As stated by the Federal Court, there are three main methods by which a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides for the requisite control [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102]. In the present case, a copy of the license agreement is provided in Exhibit D, confirming that use of the Mark by the Licensee is under the control of the Owner.

#### USE OF THE MARK

[14] Generally, if a trademark is displayed in association with one menu item, it is open to conclude that the trademark is associated with this particular menu item [*Ridout & Maybee LLP v SIR Royalty Limited Partnership*, 2014 TMOB 112]. In the present case, the appellation of the menu item is identical to the Mark and is accompanied by the ® symbol, indicating it is a registered trademark, making the association of the Mark to the registered good, “poutine”, clear to consumers when ordering.

[15] As Mr. Martina indicates that the Owner’s “Soul in a bowl” poutine has been served since 2009, and in view of: the menu showing how the Mark was displayed and seen by consumers (Exhibit A); Instagram promotions of “Soul in a bowl” during the Relevant Period (Exhibit B); the copy of the trademark license agreement for “Soul in a bowl” between the Owner and the Licensee signed in 2018 (Exhibit D); and the eight restaurant locations of the Licensee in Canada (Exhibit E), I am satisfied that the Owner has established a prima facie case of use of the Mark in association with the registered good in Canada during the Relevant Period.

DISPOSITION

[16] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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Martin Béliveau  
Chairperson  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

MLT Aikins LLP

For the Registered Owner

Oyen Wiggs Green & Mutala LLP

For the Requesting Party