



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 165

Date of Decision: 2023-09-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: MLT Aikins LLP

Registered Owner: Over Easy Restaurants Inc.

Registration: TMA785,724 for OVER EASY

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. TMA785,724 for the trademark OVER EASY (the Mark).

[2] The Mark is registered for use in association with restaurant services.

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

PROCEEDING

[4] At the request of MLT Aikins LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on April 21, 2022, to Over Easy Restaurants Inc. (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the Mark was used in Canada in association with 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 April 21, 2019 to April 21, 2022.

[6] The relevant definition of “use” in the present case is set out in section 4 of the Act as follows:

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[7] Where the Owner does not show “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Glen Kristenbrun, sworn July 20, 2022, together with Exhibits A to C.

[9] Both parties submitted written representations and were represented at an oral hearing.

THE EVIDENCE

[10] Mr. Kristenbrun is the Owner’s President. He states that the Owner began to provide restaurant services in association with the Mark in Canada in 2000. In that year, the Owner opened a first location in Toronto on Bloor Street West (the Bloor Street Location), followed by a second location in the same city, opened in 2006, inside the Hotel Victoria on Yonge Street (the Yonge Street Location). He asserts that the Mark was used in association with restaurant services in these locations during the relevant period, and more particularly, from April 21, 2019 until March 2020 when both were

closed as a result of the Covid-19 pandemic. None of the locations reopened afterwards; the Bloor Street Location was destroyed by a fire in June 2020 and the Hotel Victoria was ultimately used to shelter homeless people [paras 2 to 7].

[11] Mr. Kristenbrun asserts that the restaurant services were advertised in both locations in three different ways, namely through exterior signage, invoices, and menus of various types [para 9]. As Exhibit A and C, he provides pictures which he states show “the manner of use of the [Mark] in advertising the [Owner’s] restaurant services in Canada in these three different ways during [the relevant period]” [para 10]. Exhibit A consists of seven pictures in total, which show the Mark displayed on exterior signages in two different premises. Exhibit C also consists of 7 pictures showing two on site menu’s covers, one menu opened, one take out menu cover, a table signage, two meals and a napkin on a table, as well as two napkins placed on a separate table. All the menus’ covers and the napkins display the Mark. The menu opened shows the headings “Specialties”, “Scrambles” and “Omelettes” with several items listed underneath. The take-out menu’s cover shows both locations’ addresses. The table-signage also displays the Mark and lists several beverages. As Exhibit B, Mr. Kristenbrun provides a picture of a receipt dated October 18, 2018. The Owner’s name and the Yonge Street Location address appear below the Mark on the top of the receipt. The receipt details an on-site consumption of two customers for a total amount of 44.58\$.

[12] Lastly, Mr. Kristenbrun provides a list of the monthly revenues earned by each location for restaurant services provided in association with the Mark from April 21, 2019 until March 2020 [para 8]. Except for the months of April 2019 and March 2020, the monthly revenues in each location exceeded 100,000\$.

REASONS FOR DECISION

[13] In its written representations and at the hearing, the Requesting Party raised two main issues: (i) the trademark in evidence is an inadmissible deviation of the Mark as registered, and (ii) the evidence fails to show any use of the Mark within the meaning of the Act. In addition, it submits that the evidence related to special circumstances is

insufficient. However, in view of my conclusions below, it is not necessary for me to consider this last submission.

The trademark in evidence amounts to display of the Mark as registered

[14] The Requesting Party notes that the pictures in evidence show the trademark as part of a design mark, which it submits is a substantial deviation of the Mark as registered. I reproduce below the design mark as it appears in the evidence:



[15] In response, the Owner relies on *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 and submits that the registration allows it to use the Mark in any font, style or presentation.

[16] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[17] In the present case, comparing the Mark to the design mark in evidence, I find that the Mark did not lose its identity and remains recognizable. Although the egg design partially covers some of the letters, both words can be easily read in the design

mark. I therefore find the disposition of the word “OVER” above the word “EASY” and the addition of the egg design to be minor. In my view, the dominant features, that is the words “OVER” and “EASY” are preserved, and the public would perceive such design mark as being use of the Mark “per se”. Moreover, as noted by the Owner, it is well established that a registration for a word mark can be supported by use of that mark in any stylized form [*Masterpiece, supra*, at paras 55 and 58].

[18] Consequently, the design mark in evidence amounts to display of the Mark as registered for the purposes of this proceeding.

Use of the Mark in association with the registered services

[19] The Requesting Party submits that Mr. Kristenbrun’s affidavit is ambiguous and contains mere assertions of use. In particular, regarding the documentary evidence, it notes that the pictures [Exhibits A and C] are undated and that Mr. Kristenbrun has not expressly attested that they were taken prior to the closing of the restaurant in March 2020. In addition, according to the Requesting Party, the pictures either show a closed restaurant [Exhibit A] or menus without explicit reference to restaurant services [Exhibit C]. It therefore submits that it is impossible to determine that the Mark was used in association with the registered services at any point during the relevant period. The Requesting Party further submits that the receipt [Exhibit B] is irrelevant as it predates the relevant period and that the sales figures are not corroborated.

[20] In response, the Owner submits that invoices are not mandatory in a section 45 proceeding and that the detailed sales figures coupled with the pictures in evidence sufficiently show use of the Mark in association with restaurant services in Canada from April 21, 2019 until March 2020.

[21] At the outset, I note that as it pertains to services, the display of a trademark in the advertisement of the services is sufficient to satisfy the requirements of the Act, from the time the owner of the trademark offers and is ready to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co (1976)*, 28 CPR (2d) 20 (TMOB)]. Therefore, the Owner’s burden is to demonstrate that its restaurant services were, at

least, advertised and that it was willing and able to perform them in Canada during the relevant period.

[22] I also note that it is well established that there is no particular type of evidence that must be provided in a section 45 proceeding and the evidence need not be perfect [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. It is clear from the jurisprudence that the burden of proof on the registered owner is not a stringent one, it must only establish a *prima facie* case of use within the meaning of section 4 of the Act [*Brouillette Kosie Prince v Orange Cove-Sanger Citrus Association*, 2007 FC 1229 at para 7].

[23] In the present case, I find that Mr. Kristenbrun's assertions that the registered services were advertised, among others, through the display of the Mark on signage and menus are more than mere or bald assertions of use of the Mark. First, Mr. Kristenbrun states that the exhibited pictures show "the manner of use" of the Mark in the advertising of the Owner's restaurant services during the relevant period, which I consider equates to a statement that such pictures are representative of the way the Mark was used in the advertising of such services during the first part of the relevant period. In this regard, I note that an affiant's statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25]. Second, his statements are corroborated by pictures showing exterior signage, menus' covers and a table signage displaying the Mark. Moreover, the table signage and the menu opened list beverages and meals [Exhibit C, pages 17 and 22], which I find constitutes explicit reference of restaurant services. I therefore conclude that the Mark was used in the advertising of the registered services in Canada from the beginning of the relevant period until March 2020.

[24] With respect to the performance of the registered services, I agree with the Requesting Party that the receipt shows use of the Mark in association with the provision of restaurant services before the relevant period. That being said, no further invoice or corroboration are required as I find that the sales figures provided in

Mr. Kristenbrun's affidavit sufficiently show that the Owner was not only willing and able to perform restaurant services, but did actually perform such services in Canada from the beginning of the relevant period until March 2020.

[25] Consequently, I am satisfied that the Owner has sufficiently demonstrated that the Mark was used in association with restaurant services within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[26] 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 maintained.

Maria Ledezma
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-09-15

APPEARANCES

For the Requesting Party: Lorraine Pinsent

For the Registered Owner: Nancy Miller

AGENTS OF RECORD

For the Requesting Party: MLT Aikins LLP

For the Registered Owner: Miller IP Law