



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 003

Date of Decision: 2024-01-05

IN THE MATTER OF SECTION 45 PROCEEDINGS

Requesting Party: Gelato Kings Holding Ltd.

Registered Owner: Pizzeria Uno Corporation (A Delaware Corporation)

Registrations: TMA352,120 for PIZZERIA UNO,
TMA352,124 for UNO,
TMA659,075 for UNO CHICAGO GRILL,
TMA787,785 for UNO EXPRESS, and
TMA896,761 for EXPRESS BY UNO

INTRODUCTION

[1] This is a decision involving five summary expungement proceedings under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration Nos. TMA352,120 (PIZZERIA UNO); TMA352,124 (UNO); TMA659,075 (UNO CHICAGO GRILL); TMA787,785 (UNO EXPRESS); and TMA896,761 (EXPRESS BY UNO), owned by Pizzeria Uno Corporation (the Owner). The subject trademarks will be collectively referred to hereafter as the Marks.

[2] For the reasons that follow, I conclude that the registrations ought to be expunged.

THE RECORD

[3] At the request of Gelato Kings Holding Ltd. (the Requesting Party), the Registrar of Trademarks issued section 45 notices with respect to all five of the aforementioned registrations to the Owner on September 28, 2022. The notices required the Owner to show whether each of the Marks had been used in Canada in association with each of the services specified in the registrations at any time within the three-year period immediately preceding the date of the notices and, if not, the date when it was last used and the reason for the absence of use since that date. In all five cases, the relevant period for showing use is the same, namely, from September 28, 2019 to September 28, 2022.

[4] Registration Nos. TMA352,120 (PIZZERIA UNO), TMA352,124 (UNO), TMA659,075 (UNO CHICAGO GRILL) are all registered solely in association with “restaurant services”. Registration No. TMA787,785 (UNO EXPRESS) is registered in association with “restaurant services and take-out food services”, and registration No. TMA896,761 (EXPRESS BY UNO Design) is registered in association with “carry-out restaurants; restaurant services; take-out restaurant services”.

[5] 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.

[6] It is well established that the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the services specified in the registration during the relevant period.

[7] In response to the Registrar's notices, the Owner furnished the affidavit of Erik Frederick, the Chief Executive Officer of the Owner, sworn on April 28, 2023. Only the Requesting Party filed written representations, applicable to all five section 45 proceedings. No oral hearing was held.

THE EVIDENCE

[8] Mr. Frederick states in his brief affidavit, that the Owner is well-known for its "Chicago-Style deep dish pizza" and owns and franchises restaurants across the world operating under the UNO and PIZZERIA UNO trademarks, as well as under other UNO-formative marks. Indeed, he explains that the first PIZZERIA UNO restaurant opened in Chicago in 1943, which continues as a landmark tourist destination. He states that the Owner's restaurant business has expanded to in excess of 80 restaurant locations in the United States and abroad, including several in upstate New York and in major cities visited by Canadians, like New York, Chicago, Philadelphia, Boston, and Washington D.C., as well as in Saudi Arabia and India.

[9] Mr. Frederick states that over the years, the Owner has engaged in discussions with various Canadian companies concerning the potential licensing of the Owner's trademarks in connection with restaurant services. He states that the Owner has also in the past had an effective Franchise Disclosure Document that allowed the Owner to pursue the sale of franchises in the Province of Ontario.

[10] Lastly, Mr. Frederick attests that beginning around September 2022, the Owner began negotiations with a third party regarding the sale of its Uno Foods business and licensing of certain trademarks for use with food items, including the marks UNO and PIZZERIA UNO, in the United States and Canada and in several other countries. He states that the parties consummated that agreement in March 2023, and that under that agreement, the Owner retained ownership of the licensed marks. He states that the third party licensee currently sells pizza products in Canada and intends to explore ways to bring the Uno Foods brand into Canada as contemplated by its license agreement.

ANALYSIS AND REASONS FOR DECISION

[11] The Requesting Party submits that the Owner's evidence contains no indication or claim that the Owner has used the Marks in Canada, and does not describe any activities in Canada during the relevant period that could reasonably be claimed to be use of any of the Marks in association with the registered services.

[12] Furthermore, the Requesting Party submits that there is no evidence that the Owner displayed any of the Marks on advertising distributed to Canadians while the Owner was offering or prepared to perform the advertised services in Canada. Moreover, the Requesting Party submits that the Owner has not demonstrated nor offered any evidence as to whether people in Canada have derived a material benefit from either primary or ancillary services that are performed in Canada [citing *Miller Thomson LLP v Hilton Worldwide Holding LLP*, 2020 FCA 134 at para 152].

[13] Lastly, the Requesting Party submits that the Owner has not demonstrated special circumstances that excuse the absence of use of the Marks. In this regard, the Requesting Party submits that the Owner has not demonstrated any circumstances surrounding non-use that were "unusual, uncommon, and exceptional" [per *John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)], and outside of the control of the Owner which would qualify as "circumstances not found in most cases of absence of use of the Mark" [per *Scott Paper Limited v Smart & Biggar*, 2008 FCA 129]. Moreover, the Requesting Party submits that the Owner has not demonstrated any use of the Marks in Canada since the registration of the Marks (which ranges from 8 to 34 years of non-use depending upon the Mark in question), which must weigh heavily against excusing the non-use of the Marks. Lastly, the Requesting Party submits that the Owner has failed to establish that the Owner has a serious intention to shortly resume use of the Marks. In this regard, the Requesting Party submits that the fact that a third-party licensee sells pizza and intends to explore ways to bring the Uno Foods brand into Canada, this is not evidence of an intention to resume use of the Marks in association with the registered services. In any event, the Requesting Party submits, even if the third-party licensee had demonstrated an intention to use the Marks in Canada in association with the registered services, this intention to begin use would be

insufficient to establish circumstances excusing the extensive period of non-use. Moreover, the Requesting Party submits, “plans for future use do not explain the period of non-use and therefore, cannot amount to special circumstances” [per *Scott Paper, supra*].

[14] I agree with the Requesting Party that the Owner has not provided any evidence of use of its Marks pursuant to section 4(2) of the Act. The Owner has not provided any evidence of use or display in the performance or advertising of its Marks at all, let alone *in Canada*. Mr. Frederick merely makes unsupported attestations that the Marks have been used in the United States and abroad, without any further evidence to support that consumers in Canada have derived a material benefit from the registered services without having to leave the country. Indeed, some aspect of the services must be performed or delivered in Canada or be available to be performed in Canada [*Hilton, supra; Wenward (Canada) Ltd v Dynaturf Co (1976)*, 28 CPR (2d) 20 (TMOB); *TSA Stores, Inc v Registrar of Trade-Marks*, 2011 FC 273].

[15] Furthermore, I agree with the Requesting Party that the Owner has not demonstrated special circumstances that excuse the absence of use of its Marks. Indeed, Mr. Frederick offers no explanation regarding non-use of the Marks and simply refers to use of the Marks elsewhere with vague intentions to begin using the Marks in Canada through an unnamed third party. Thus, there are no circumstances evidenced that were “unusual, uncommon, and exceptional” and “beyond the Owner’s control”; indeed, there are no reasons given at all.

[16] Consequently, the Owner has failed to establish that special circumstances existed that would excuse the absence of use of the Marks.

DISPOSITION

[17] Having regard to the aforementioned, 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, each of the registrations will be expunged.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Oyen Wiggs Green & Mutala LLP

For the Registered Owner: Smart & Biggar LLP