

# Canadian Intellectual Property Office

## THE REGISTRAR OF TRADEMARKS

**Citation:** 2024 TMOB 76

**Date of Decision:** 2024-04-18

## IN THE MATTER OF A SECTION 45 PROCEEDING

**Requesting Party:** Crêpinos inc.

**Registered Owner:** 3986055 Canada Inc.

**Registration:** TMA641,475 for Petinos & design

### 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. TMA641,475 for the trademark Petinos & design (the Mark), reproduced below.



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

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

### **PROCEEDING**

[4] At the request of Crêpinos inc. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 10, 2023, to 3986055 Canada 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 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 from February 10, 2020 to February 10, 2023.

[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] In response to the Registrar’s notice, the Owner furnished the affidavit of its Franchisor General Manager, Manuel Medeiros, solemnly affirmed on September 11, 2023, together with Exhibits MM-1 to MM-10.

[8] Both parties filed written representations; no oral hearing was held.

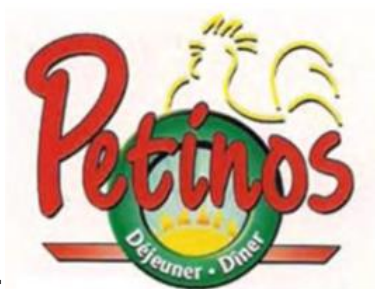
### **EVIDENCE AND ANALYSIS**

[9] In his affidavit, Mr. Medeiros states that the Owner is a small family-run business founded in 1998 that started operating two restaurant locations in association with the Mark in the province of Québec. In 2014, the Owner created a franchising program and currently has 17 restaurants

operating across the province. In these franchised restaurant locations, the Owner serves food and beverages, including eggs and omelets, waffles, hamburgers, salads, sandwiches, coffees, milkshakes and cocktails [paras 8-12].

[10] Mr. Medeiros states that the 17 restaurant locations operate pursuant to franchise agreements through which the Owner grants its franchisees a license to provide restaurant services in association with the Mark. He asserts that the Owner exerts direct and indirect control over the character and quality of the restaurant services offered by its franchisees [paras 18-22]. In support, he provides a partially redacted franchise agreement [Exhibit MM-5], which he states was signed during the relevant period. The “Franchisor’s Services” section of the agreement establishes that the Owner will provide up to 14-day pre-opening assistance and training as well as assistance to set up standard control systems for administration and general operating procedures [Exhibit MM-5, page 6].

[11] Regarding the display of the Mark, Mr. Medeiros explains that in 2014 the Owner decided to “modernize” the Mark. He reproduces in his affidavit the first version, as it was used from 1998, and the new version as it has been used since 2014 (reproduced below). He asserts that the 2014 version has since remained unchanged [paras 15-16].



1998 version:



2014 version:

[12] With respect to the use of the Mark, Mr. Medeiros asserts that the Mark has been continuously displayed in the advertising and performance of

restaurant and franchising services, including during the relevant period [paras 17, 24 and 32].

[13] In support of the advertising of restaurant services, Mr. Medeiros provides 17 examples of photographs [Exhibit MM-6]. The photographs show the 2014 version of the Mark displayed on the 17 restaurants' front exterior, on carpets and disposable tablecloths inside the restaurant locations as well as on the uniforms worn by the Owner's employees. He asserts that all the restaurant locations shown in these photographs were in operation or opened during the relevant period. He specifies the year of opening and the location on the photographs [para 25]. I note that the Lasalle and Brossard locations opened in 2021. Mr. Medeiros also provides screen captures taken from the Wayback Machine during the relevant period [Exhibit MM-8]. The screen captures show the "Home" and "Restaurant" pages of the Owner's website, which display the 2014 version of the Mark. In support of the performance of restaurant services, Mr. Medeiros asserts that over 850,000 clients were served in the Owner's restaurants in 2022.

[14] As for the use of the Mark in association with franchising services, Mr. Medeiros states that the Owner advertises its franchising program and the opportunity to become a franchisee on its website. In addition, he asserts that the Owner was contacted by several potential franchisees through its website and concluded four new franchise agreements during the relevant period [para 32-34]. In support, he provides a screen capture taken from the Wayback Machine during the relevant period showing the "Franchises" webpage [Exhibit MM-10]. The screen capture displays the 2014 version of the Mark and includes [TRANSLATION] "Upload" and "Apply" link buttons under the heading [TRANSLATION] "Become a Franchisee".

### ***The variation of the Mark***

[15] In its written representations, the Requesting Party questions whether the use of the 2014 version of the Mark amounts to display of the Mark as registered. In particular, it points to four changes to “significant components” of the Mark as registered, namely:

1. the removal of the central round element through which the sun rises and where the words “Déjeuner – Diner” are written;
2. the removal of the strip under the word Petinos;
3. the shortening of the rooster’s representation in the background; and
4. the dissociation of the words “Déjeuner – Diner” from the design, which appear in some front exteriors separately from the word Petinos and the representation of the rooster in the background.

[16] The Requesting Party submits that the above changes result in a version that is so far apart that the Mark as registered cannot be considered in use. It also submits that the 2014 version would likely deceive the public as to the origin of the services [relying on *North Brewing Company Ltd. v DLA Piper (Canada) LLP*, 2023 FC 1188; *Dallevigne S.P.A. v Maison des Futailles SEC*, 2017 TMOB 32; *Thompson Dorfman Sweatman LLP v CWI, Inc.*, 2017 TMOB 152, aff’d 2018 FC 941; and *Trademark Tools Inc. v Miller Thomson LLP*, 2017 FCA 98 at para 6] [Requesting Party’s written representations paras 6-7, 13-17 and 22].

[17] 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 CanLII 12831, 44 CPR (3d) 59 (FCA); *Pizzaiolo Restaurants Inc v Les Restaurants La Pizzaiolle Inc*, 2016 FCA 265]. Further, as noted in one of the cases relied upon by the Requesting Party, questions of what elements are the dominant features of a trademark and whether the variation is so minor as to find that the trademark as registered has been used are questions of fact to be determined on a case-by-case basis [*North Brewing, supra*, at para 43]

[18] In the present case, comparing the Mark as registered with the 2014 version reproduced above, I find all the differences between them to be minor. In my view, an unaware customer would be likely to infer that both, in spite of their differences, identify services having the same origin. I therefore conclude the 2014 version would not deceive the public as to the origin of the services [per *Honeywell* and *North Brewing, supra*]. Further, in my view, the dominant features of the Mark are the word “Petinos”, written in a particular stylized lettering, and the stylized representation of a rooster in the background. Both of these features are preserved in the 2014 version of the Mark. As the round element and the strip appear between Petinos and the representation of the rooster, I find their removal to be minor. I also find that the change of sizing of the rooster is insignificant and that the dissociation of the words “Déjeuner – Diner”, which are descriptive in nature, is unimportant. As the stylized word “Petinos” and the rooster element have been preserved, I find that the Mark does not lose its identity and remains recognizable in spite of all the changes noted by the Requesting Party.

[19] Further, in my view, the four last cases relied upon by the Requesting Party are distinguishable from the present case. With respect to *Dallevigne* and *Thompson Dorfman, supra*, I note that the evidence before the Registrar

showed partial views of the dominant features of the registered trademarks, namely the bottom half of Mona Lisa's face in *Dallevigne* and the superior half part of the globe design replacing the letter "O" in *Thompson Dorfman*. As the Registrar considered that Mona Lisa's head-and-shoulders and the entire globe were the dominant features of the respective trademarks, he concluded that they had not been preserved. In this case, the 2014 version is not a partial view and the dominant features of the Mark as registered have been preserved. As for *Trademark Tools, supra*, the differences between the registered design trademark and the trademark in evidence were such that the only remaining similarity was the word and the spelling of "LOGIX". The Federal Court therefore concluded that the dominant features of the registered design trademark had not been preserved. In this case, as neither the word and spelling of Petinos nor its particular stylized lettering have been changed, the dominant feature of the Mark, including the background element, has been preserved.

[20] In view of the above, I conclude that use of the 2014 version of the Mark constitutes use of the Mark as registered for the purpose of this proceeding.

***The use of the Mark in association with the registered services***

[21] With respect to restaurant services, the photographs showing storefronts, carpets, disposable tablecloths and employees' t-shirts bearing the 2014 version of the Mark demonstrate that the Mark was used in the advertising of restaurant services. As these photographs were provided as examples and as they show at least two restaurant locations (Lasalle and Brossard) opened during the relevant period, I conclude that these photographs show the way the Mark was associated with restaurant services in Canada during the relevant period. Furthermore, in view of the number of

customers served within the year 2022, I am satisfied that the Owner provided restaurant services in Canada during the relevant period.

[22] As for the franchising services, the screen capture of the “Franchises” webpage, displaying the 2014 version of the Mark and showing the “Upload” and “Apply” link buttons, allows me to conclude that potential Canadian franchisees were able to obtain further information concerning the Owner’s franchising program and to apply for through its website during the relevant period. In addition, in view of the content of the franchise agreement and Mr. Medeiros’ statements concerning the number of franchise agreements concluded during the relevant period, I am satisfied that the Owner advertised its franchising services in association with the Mark, and was at least willing and able to perform franchise services in Canada during the relevant period [per *Oyen Wiggs Green & Mutala LLP v Atari Interactive, Inc*, 2018 TMOB 79 at para 25; and *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[23] In view of all the above, I am satisfied that the Owner has demonstrated use of the Mark in association with restaurant services and franchising within the meaning of sections 4(2) and 45 of the Act.

#### **DISPOSITION**

[24] 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:** No hearing held

## **AGENTS OF RECORD**

**For the Requesting Party:** Isabelle Deshaies (ID Marque / Trademark)

**For the Registered Owner:** Smart & Biggar LP