



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 99
Date of Decision: 2015-05-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Blake, Cassels & Graydon LLP against
registration No. TMA704,459 for the trade-mark DOLCE
DIVA in the name of Sir Royalty Limited Partnership**

[1] At the request of Blake, Cassels & Graydon LLP, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on August 12, 2013, to Sir Royalty Limited Partnership (the Owner), the registered owner of registration No. TMA704,459 for the trade-mark DOLCE DIVA (the Mark).

[2] The Mark is registered for use in association with the goods “prepared alcoholic cocktails”.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the goods 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 between August 12, 2010 and August 12, 2013.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act:

4(1) A trade-mark 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.

[5] 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 and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notice, the Owner filed the affidavit of Kim van Nieuwkoop sworn on November 19, 2013. Only the Owner furnished written representations; an oral hearing was not held.

[7] In her affidavit, Ms. van Nieuwkoop identifies herself as the General Counsel of SIR Corp., a Canadian corporation that owns and operates a portfolio of restaurants in Canada. She asserts that the Mark was used by SIR Corp. in association with prepared alcoholic cocktails during the relevant period under license from the Owner. Ms. van Nieuwkoop confirms that the Owner maintained the requisite control over the character and quality of the goods sold in association with the Mark during the relevant period.

[8] More specifically, Ms. van Nieuwkoop attests that the Mark was used in association with prepared alcoholic cocktails at various Alice Fazooli’s restaurants operated by SIR Corp. in Ontario during the relevant period. She attests that DOLCE DIVA cocktails are served in a glass to be consumed in the restaurant. She explains that customers typically see the Mark on the restaurant menu and order the cocktail by name from their server. She attests that, in many instances, the customer will still have the beverage menu and will accordingly continue to see the Mark when receiving the cocktail. Finally, when the customer receives the bill, the Mark appears on the bill as a line item.

[9] With respect to sales during the relevant period, Ms. van Nieuwkoop attests that SIR Corp. sold, on average, 80 DOLCE DIVA cocktails per week, for a total of several thousand over the course of the relevant period in Canada.

[10] In support, Ms. van Nieuwkoop attaches the following exhibits to her affidavit:

- Exhibit B is a menu page that Ms. van Nieuwkoop attests accurately represents the menu used at Alice Fazooli's locations from approximately mid-2010 to mid-2011. The Mark appears as one of the drink items listed under the "Premium Cocktails" menu category, along with a description of its contents. The Mark also appears next to a photograph of the item.
- Exhibit C is a menu page that Ms. van Nieuwkoop attests is an excerpt from the drink menu used at Alice Fazooli's locations from approximately mid-2011 to mid-2012. Again, the Mark appears as the first cocktail listed under "Premium Cocktails".
- Exhibit D is a menu page that Ms. van Nieuwkoop attests is an excerpt from the drink menu used at Alice Fazooli's locations from approximately mid-2012 to mid-2013. The Mark appears as the third cocktail listed under the menu category "Martinis".
- Exhibit E is a copy of a customer bill dated October 12, 2013 from Alice Fazooli's restaurant that shows a DOLCE DIVA cocktail as a line item. Ms. van Nieuwkoop attests that the exhibit is representative of how the Mark is displayed on customer bills.

[11] As noted by the Owner in its written representations, display of a trade-mark on menus as described above provides the requisite notice of association between the trade-mark and the particular menu item [see, for example, *Oyen Wiggs Green & Mutala v Aimers*, 1998 CanLII 18493 (TMOB) and *Gowling Lafleur Henderson LLP v Padcon Ltd*, 2014 TMOB 125 at para 17].

[12] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods during the relevant period within the meaning of sections 4(1) and 45 of the Act.

Disposition

[13] 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.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office