

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 018

Date of Decision: 2022-02-04

IN THE MATTER OF A SECTION 45 PROCEEDING

Maker Pizza Inc.

Requesting Party

and

Pizzaiolo Restaurants Inc.

Registered Owner

TMA610,863 for PIZZAIOLO

Registration

“THEE” PIZZA MAKER

Introduction

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA610,863 for the trademark PIZZAIOLO “THEE” PIZZA MAKER (the Mark).

[2] The Mark is registered for use in association with the following goods and services:

GOODS

Italian food, namely pizza, panzerotti, sandwiches and salads (the Goods).

SERVICES

Restaurant, take-out food and food delivery services (the Services).

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete “sandwiches”.

The Proceeding

[4] On September 5, 2019, at the request of Maker Pizza Inc. (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to Pizzaiolo Restaurants Inc. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods and Services 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 September 5, 2016 and September 5, 2019.

[5] The relevant definitions of “use” are set out in section 4 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.

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 bare statements that a trademark is in use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although 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 Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], 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 goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] In response to the Registrar's notice, the Owner submitted the affidavit of Luigi Petrella, sworn on November 26, 2020.

[8] Both parties filed written representations. No oral hearing was requested.

The Owner's Evidence

[9] In his affidavit, Mr. Petrella states that he is the President and Chief Executive Officer of the Owner, and has held that position since at least as early as 2000. He attests that the Owner owns and operates restaurant locations in the greater Toronto area which offer pizza as well as other food and beverage products. He also attests that there were approximately 35 restaurant locations in operation during the relevant period. Mr. Petrella states that the Owner's customers can eat-in, take-out, or have their order delivered.

[10] According to Mr. Petrella, the Owner operates its restaurant locations itself or through licensed franchisees. He states that, under the franchise agreements, the Owner maintains control over the character and quality of the Goods and Services sold and provided by its franchisees in association with the Mark. He explains that he is directly involved in overseeing that these standards of quality are adhered to and that he frequently visits individual restaurant locations to ensure that the required standards are met.

[11] Mr. Petrella also states that the Owner provides catering services in association with the Mark and did so during the relevant period. He explains that the Owner's catering services consist of preparing and selling food items, such as sandwiches, which are not necessarily listed on the standard menu. In this respect, he states that sandwiches "are commonly requested by the [Owner's] catering clients and were provided by [the Owner] at numerous catered events during the Relevant Period".

[12] According to Mr. Petrella, the "PIZZAIOLO brand" has achieved substantial commercial success in Canada, generating hundreds of millions of dollars in total sales since the first restaurant location was opened. He estimates that, during the relevant period, the total sales

revenues were “in excess of \$50 million across the more than thirty Pizzaiolo restaurant locations”.

[13] With respect to display of the Mark, Mr. Petrella asserts that the Mark “was used” in Canada in association with the Goods and Services throughout the relevant period. He indicates that the Mark was so “used” on “permanent restaurant signage, on pizza bags and boxes, on menus and fliers, on the side of PIZZAIOLO branded vehicles and on the Pizzaiolo website”.

Restaurant signage

[14] Mr. Petrella attests that, throughout the relevant period, the Mark was prominently featured on signage at the Owner’s restaurant locations. He explains that a Pizzaiolo restaurant located on Queen Street West in Toronto “has had a permanent exterior sign in place which reads PIZZAIOLO "THEE" PIZZA MAKER for almost twenty years, including throughout the Relevant Period.”

[15] In support, he provides a photograph of that restaurant’s storefront [Exhibit LP-1]. The photograph shows exterior signage, namely a first sign which reads “PIZZAIOLO GOURMET PIZZA” and a second sign which reads “PIZZAIOLO THEE PIZZA MAKER”, both written in white against a green oval background. Mr. Petrella attests that the exhibited photograph is representative of how the Mark appeared on interior and exterior signage at the Owner’s various restaurant locations during the relevant period.

[16] Mr. Petrella also provides screen captures from the Google Maps website showing the exterior of the aforementioned restaurant location on the street view captured in February 2017, that is, during the relevant period [Exhibit LP-2]. The screen capture shows the two aforementioned signs.

[17] The exhibited photographs are somewhat blurry, such that it is difficult to discern whether the word THEE is flanked by quotation marks on the second sign. I note, however, that Mr. Petrella attests that this sign bears the Mark. In any event, I find that the removal of quotation marks would not cause the Mark to lose its identity and the Mark would remain

identifiable [see *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull*, (1985) 4 CPR (3d) 50 23 (FCA), *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

Pizza bags and boxes

[18] Mr. Petrella states that, during the relevant period, pizza and other food items such as panzerotti were sold in boxes and bags that displayed the Mark. In support, he provides photographs of “sample boxes and bags” [Exhibit LP-3]. The photographs show a paper bag and a pizza box displaying the Mark.

[19] Mr. Petrella attests that the photographed items are representative of those “used to sell pizza and other food products” during the relevant period. He estimates that over one million boxes and over one million bags were “printed and used” across the various restaurant locations during the course of the relevant period.

Menus and flyers

[20] In addition to pizza boxes and bags, Mr. Petrella states that printed materials such as menus and flyers also displayed the Mark. He explains that the materials were included with takeout and delivery orders and distributed around the greater Toronto area to promote the Owner’s Goods and Services throughout the relevant period.

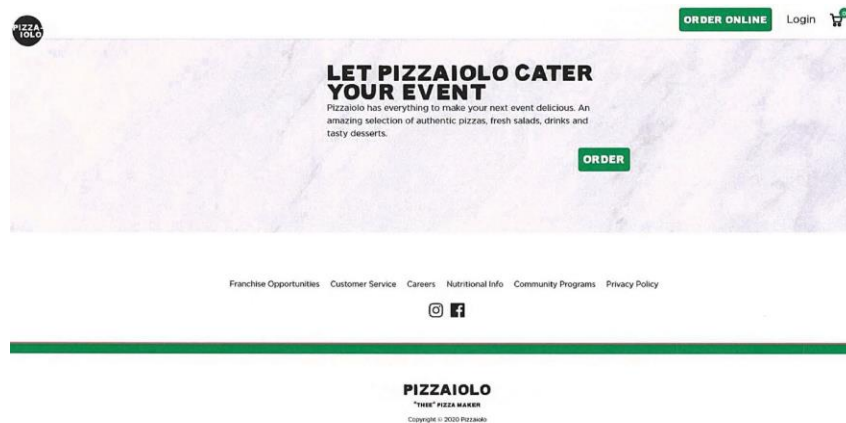
[21] In support, Mr. Petrella provides photographs of “sample menus” [Exhibit LP-4], which he attests are representative of other materials that were “printed and used” during the relevant period. Mr. Petrella confirms that the exhibited menus offered for sale “pizza, panzerotti, salads and other food and beverage items”.

[22] Exhibit LP-4 consists of photographs depicting trifold promotional flyers for at least two restaurant locations. The Mark is displayed on both of these flyers, together with the trademark shown on the Exhibit LP-1 exterior signage, namely PIZZAIOLO GOURMET PIZZA in a green oval. The flyers include a food menu and advertise “Pick-Up, Dine-In and Delivery Specials”.

Vehicles and website

[23] Mr. Petrella states that the Owner owns and operates vehicles displaying the Mark which advertise and promote the Goods and Services. In support, he provides a photograph of a truck and a close-up of the signage on that truck [Exhibit LP-5]. He confirms that this truck was in operation in the greater Toronto area during the relevant period and that it is representative of other Pizzaiolo vehicles in operation during the same time. The signage on the depicted truck displays the Mark along with a photograph of a pizza, and the words “WE DELIVER”.

[24] Mr. Petrella also states that the Owner owns and operates the website located at *www.pizzaiolo.ca* and that, during the relevant period, the Mark was “used” on this website. Mr. Petrella explains that the website allows Canadian consumers to order food for delivery or take-out from one of the Owner’s restaurant locations and that it promotes the food and beverages items offered by the Owner. In support, he provides screenshots taken from the “current version” of the Owner’s website [Exhibit LP-6], which he explains was launched after the end of the relevant period. The exhibited website screenshot is reproduced below.



[25] Mr. Petrella attests that a previous version of the Owner’s website was available to consumers in Canada during the relevant period and “was used to place customer orders for takeout and delivery services”. He confirms that the Mark also appeared on the previous website version.

Analysis

[26] The Requesting Party raises several issues with respect to the evidence. For example, it contends that the evidence “points to the fact that [the Owner] has changed its branding over the years”. It submits that the Owner first changed its branding from the Mark to the green oval PIZZAIOLO GOURMET PIZZA logo (displayed on the evidenced exterior signage), then to the black circle PIZZAIOLO logo (displayed on the evidenced website screenshot).

[27] I am not prepared to accept the Requesting Party’s submissions, including in respect of the alleged rebranding, as supporting a finding that the Mark has not been used. While there are several examples, such as the exterior signage and the exhibited menus, where the registered Mark appears together with the PIZZAIOLO GOURMET PIZZA logo, it is well established there is nothing to prevent two or more trademarks being used at the same time [*AW Allen Ltd v Warner-Lambert Canada Inc* (1985), 6 CPR (3d) 270 (FCTD)].

[28] The Requesting Party’s other arguments will be addressed where relevant below.

Restaurant, take-out food and food delivery services

[29] As noted above, Mr. Petrella states that the Owner operated, by itself or through its licensees, approximately 35 restaurant locations in the greater Toronto area during the relevant period, and that these locations offered eat-in, take-out, and delivery services. According to Mr. Petrella, the Mark was displayed on signage at those locations, including on exterior signage as shown in Exhibits LP-1 and LP-2.

[30] The Requesting Party submits that Mr. Petrella failed to indicate how many restaurant locations are owned by the Owner and how many are franchised, and failed to provide a copy of the license with franchisees. As for the exterior signage depicted in the exhibits, the Requesting Party submits that the sign is 20 years old and that, at most, the evidence establishes that “a single sign continued to exist at a single location, without a clear statement that the restaurant at that location was in operation during the Relevant Period.”

[31] In my view, the Owner is correct in pointing out that, if anything, the fact that the evidenced sign has been in place for 20 years supports the Owner's claim of ongoing use of the Mark. Further, on a fair reading of Mr. Petrella's affidavit, I conclude that despite the absence of an explicit statement to this effect, the location depicted in the exhibited photographs was in operation during the relevant period. In particular, Mr. Petrella states that this particular location "has had a permanent exterior sign in place... for almost twenty years, including throughout the entirety of the Relevant Period" and I find it reasonable to infer that the sign was in place for all of those years because the location was in operation.

[32] The Owner also furnished evidence showing display of the Mark in the course of advertising, namely photographs of a truck advertising the Owner's delivery services, and photographs of sample menus advertising foods for eat-in, take-out and delivery.

[33] The Requesting Party complains that "there is no statement of when these photos were taken" and that information on the flyers (namely references to awards won by the Owner in 2013-2015, and 2014-2016) suggest that the menus relate to a period before the relevant period. However, Mr. Petrella clearly attests that the photographed trucks and printed materials are representative of those in operation and those distributed, respectively, during the relevant period. His statements are unequivocal and I accept them at face value [per *Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at para 25].

[34] Finally, with respect to licensing, there was no need to provide the number of licensees, or the licensing contract. Mr. Petrella's clear sworn statement that the Owner maintains control is sufficient to establish that use by licensees enures to the benefit of the Owner pursuant to section 50 of the Act [see *Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84, a trademark owner can demonstrate the requisite control pursuant to section 50(1) of the Act by clearly attesting to the fact that it exerts the requisite control].

[35] In view of the foregoing, I conclude that the Owner advertised and performed its "Restaurant, take-out food and food delivery services" in Canada during the relevant period. As

such, I am satisfied that the Owner has shown use of the Mark in association with the Services within the meaning of sections 4 and 45 of the Act.

Pizza, panzerotti, sandwiches and salads

[36] In his affidavit, Mr. Petrella provides multiple statements that the Owner sold specific registered goods. For example, he attests that the Pizzaiolo locations sold “pizza and other Italian food including panzerotti, sandwiches and salads” throughout the relevant period. Similarly, he states that “pizza and other food items such as panzerotti” were sold in boxes and bags bearing the Mark, such as those shown in Exhibit LP-3. While he provides no invoices, he provides an agglomerated sales figure for sales during the relevant period.

[37] Having regard to that sales figure, as well as the approximately million boxes and million bags printed and used during the relevant period, I find it reasonable to infer that the Owner did, in fact, sell the food items listed in the Exhibit LP-4 menu, namely pizzas, salads and baked calzones. Moreover, given Mr. Petrella’s sworn statement that the Owner’s menus offered “pizza, panzerotti, salads and other food and beverage items” for sale, I accept that the “baked calzones” listed in the exhibited menu correspond to the registered goods “panzerotti”.

[38] The Requesting Party submits that Mr. Petrella “fail[ed] to state that these revenues were made in association with the [Mark]”. In my view, having regard to the evidence as a whole, such a statement was unnecessary. Given the evidenced display of the Mark on exterior signage, as well as product bags and boxes, I accept that the requisite notice of association was given to consumers at the time of transfer of goods.

[39] That being said, sandwiches are not listed in the exhibited menu and there is no evidence that these were sold at restaurant locations. The Owner has not provided evidence showing how the Mark was displayed at the catered events where sandwiches were offered, nor a statement that they were offered in bags or in boxes. Although Mr. Petrella states that “[m]enus and other materials displaying the [Mark] such as boxes (examples of which can be seen in Exhibit LP-3), were used and provided at these catered events”, there is no evidence showing that such

materials were associated to sandwiches in particular such that the requisite notice of association between the Mark and sandwiches was given.

[40] Accordingly, I am not satisfied that the Owner has shown use of the Mark in association with “sandwiches” within the meaning of sections 4 and 45 of the Act. As there is no evidence of circumstances excusing the absence of use, these goods will be deleted from the registration.

Disposition

[41] 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 amended to delete the registered goods “sandwiches”.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: No hearing held

AGENTS OF RECORD

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For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party