

## Ordering off the Menu: Supporting “Use” of Trademarks for Restaurant Services

Sep 22, 2014

Authors: [Cynthia Rowden](#) and [Tamarah Luk](#)

Two recent non-use cancellation decisions from the Trade-marks Opposition Board provide useful guidance on the sufficiency of use in Canada to owners of trademarks covering “restaurant services”, as well as bar, lounge or other food and beverage services. Specifically, mere display of a mark on a menu, without clearly associating it with the registered services, or display that suggests a food/beverage menu item, as compared to the services, may not be enough to maintain the registration.

In *Gowling Lafleur Henderson LLP v. Padcon Ltd*, 2014 TMOB 125 [*Padcon*], the Board stated at para. 17:

the mere appearance of a trade-mark in a restaurant, even on a menu, does not necessarily constitute display of that trade-mark in association with the services performed in that restaurant. A menu in a restaurant is akin to a catalogue in a retail store. With respect to catalogues, a distinction is made between trade-marks displayed in association with particular goods appearing in that catalogue and trade-marks being displayed by the retailer, such as its store name or slogans. The former is generally display in association with wares; the latter is generally display in association with services.



In *Padcon*, the word OUTRIGGER was displayed with a single menu item and not at the top of the menu pages or “set apart from the wares in a way that would prompt customers to associate OUTRIGGER with the licensee’s restaurant services” (para. 15). This was found not to be display of the mark in association with restaurant services. The registration in *Padcon* was ultimately expunged. Not only was the display of the mark on menus found not to be in association with restaurant services, but the Registrant was also not using the mark as registered (i.e. as THE OUTRIGGER STEAKHOUSE AND BAR).

However, in *R idout & Maybee LLP v. SIR Royalty Limited Partnership*, 2014 TMOB 112 [*SIR Royalty*], the mark ARMADILLO TEXAS GRILL appeared both on interior walls, within the Registrants’ LOOSE MOOSE restaurant, as well as in several menus from the relevant period as a menu section heading and as a menu item, e.g. the heading “ARMADILLO TEXAS GRILL” with four menu items below the item ARMADILLO TEXAS GRILL® NACHOS. Although the registrant conceded it was arguable whether “ARMADILLO TEXAS GRILL® NACHOS” on one of the menus constituted display of the mark in association with wares or with restaurant services, the Board ultimately found that the display of the mark on multiple menus during the relevant period along with the display of the mark on the interior wall constituted use in association with restaurant services.

The hallmark case on this point is *McDonald’s Corp v. Phil’s Industries of Canada Ltd.* (1983), 81 CPR (2d) 260 (TMOB) [*McDonald’s*], where the opponent in that case relied on the display of the mark FILET-O-FISH on a menu board and point of purchase display signs to support a claim or prior use of “restaurant services”. The Opposition Board found that the display of the mark on a menu board was not appropriate evidence of use to distinguish the opponent’s services but instead was use on goods, namely a fish sandwich.

In *Oyen Wiggs Green & Mutala v. Aimers* (1998), 86 CPR (3d) 89 (TMOB) [*Aimers*], the display of the mark LOS ANGELES WINGS & Design on a menu was accepted as use in association with “restaurant services”. However, unlike in *SIR Royalty*, as the Board Member in that case pointed out, the trademark was also the name of the restaurant and the manner of the display was not described in the *Aimers* decision.

Adding to the small body of case law, both *SIR Royalty* and *Padcon* suggest that for owners of Canadian trademark registrations for “restaurant services”, mere display of the mark on a menu may not support “use”, if challenged, either during opposition or in a

non-use proceeding. Instead, the specific manner of the mark's display will be important. If the mark is not used in a traditional manner, e.g. on exterior or interior signage to clearly indicate the "name" of the restaurant, mere display on menus, particularly if such display seems to refer to menu food/beverage items, may not be construed as "use" in association with restaurant services. Specific facts, of course, will be important – for example, prominent display of the mark with a menu section title, and/or long term display of the mark may be sufficient.

These cases will apply to claims of "use" to support a trademark application (at least until Canada's trademark laws are amended to eliminate a use requirement for registration), and will continue to be relevant to any claim of use in opposition, cancellation or expungement proceedings.

For any questions about use, for restaurant or other goods and services, please consult us.



**Cynthia Rowden**

Partner

416.957.1617

[crowden@bereskinparr.com](mailto:crowden@bereskinparr.com)