

SECTION 45 PROCEEDINGS
TRADE-MARK: DOUBLE DOUBLE
REGISTRATION NO: TMA 496,628

At the request of Messrs Fasken Martineau DuMoulin LLP (the “requesting party”) the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on May 19th, 2004 to In-N-Out Burgers, the registered owner of the above referenced trade-mark (the “registrant”).

The trade-mark DOUBLE DOUBLE is registered for use in association with the wares “*cheeseburgers*” and the services “*specialty prepared sandwich as part of restaurant services*”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 wares and/or services listed on 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 use since that date. Section 45 requires the proof of use be established by way of an affidavit or statutory declaration. In this case the relevant period for showing use is any time between May 19th, 2001 and May 19th, 2004.

Use in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

A trade-mark is deemed to have been used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

Special provisions relating to the export of wares are contained in subsection 4(3) of the *Act* and do not apply in the present proceedings.

In response to the Registrar's notice, the registrant furnished the affidavit of Mr. Arnold M. Wensinger that attached as Exhibit 1 the affidavit of Mr. Rick G. Pendleton. Both parties filed written submissions and an oral hearing was held.

In its written argument the requesting party made reference to correspondence between the registrant and one of its competitors, and attached copies of such documents to its submissions.

Section 45(2) of the *Act* provides:

The Registrar shall not receive any evidence other than the affidavit or statutory declaration [of the registrant as per ss.45(1)], but may hear representations made by or on behalf of the registered owner or the trade-mark or by or on behalf of the persona whose request the notice was given.

Further it is well established in the jurisprudence that the requesting party cannot file its own evidence before the Registrar or even on an appeal from a decision of the Registrar in s. 45 proceedings, (*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980). 53 C.P.R. (2d) 62 (F.C.A.); *Société Nationale des Chemis de Fer Franccais SNCF v. Venice Simplon-Orient-Express, Inc.* (1996), 64 C.P.R. (3d) 87 at 89.).

In view of the provisions of s.45 (2) of the *Act* and the jurisprudence, it was ruled at the hearing that the documents and any references thereto would be disregarded in these proceedings.

The requesting party made several technical arguments concerning the registrant's evidence. Firstly, the Requesting party submitted that the failure of the Wensinger Affidavit and the Pendleton Affidavit to make reference to having been made under "oath" should render these affidavits inadmissible. I note, however, that both affidavits begin with the phrase "I, ...resident of..., California, having been duly sworn, depose and say as follows", and both affidavits conclude with a jurat "sworn before me at the City of

...” and the signature and seal of a Notary Public with a commission for taking affidavits in California.

On the basis of the foregoing, and in view of the ss.52 (e), 53 and 54 (2) of the *Canada Evidence Act* which provide for the admissibility of affidavits taken outside Canada, and in keeping with the Registrar’s practice of accepting affidavits sworn in other countries, and in the absence of any indication that these affidavits were *not* duly sworn and executed according to the laws of California, I have concluded that the affidavits are acceptable for the purposes of these proceedings.

The requesting party made further objections to the evidence based on technical grounds, namely that the exhibits are not acceptable since they have not been notarized. Whether or not California law requires the attestation of exhibits, this objection is a technical argument that rather goes against the purpose and intent of s. 45 of the *Act* which is to be a summary procedure for clearing deadwood and providing a safeguard for the protection of the registered owner of a trade-mark against any unwarranted attempt to have it expunged” (*Re Wolfville Holland Bakery Ltd.*, (1964) 42 C.P.R. 88 (Can. Ex. Ct.)).

In *Beiersdorf AG v. Future International Diversified Inc.* (2003), 23 C.P.R. (4th) 555, Mr. Partington, Chairperson of the Trade-marks Opposition Board (as he then was) noted that,

Although a court would likely rule such exhibits inadmissible see for example *Andres Wines Ltd. V. E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 (F.C.A.) at pp. 135-136), the Registrar does not strictly adhere to the rules of Federal Court relating to the admissibility of exhibits. Thus, the Registrar will consider unnotarized exhibits admissible where no objection is raised by the other party or where an objection is raised at such a late state of the opposition that the party which submitted the evidence has little or no opportunity to correct the deficiency.

I find this case instructive in so far as it makes clear that the Registrar does not have to strictly adhere to the Federal Court Rules relating to the admissibility of exhibits. Further, keeping in mind the intent and purpose of s.45 proceedings, and in the absence of any argument that notarized exhibits are required under in California law, I am prepared to accept the non-notarized exhibits.

The Requesting party also takes issue with the fact that the Pendleton affidavit is attached as an exhibit to the Wensinger affidavit. I note that there is no bar against the filing of more than one affidavit by the registrant (*Registrar of Trade Marks v. Harris Knitting Mills Ltd.* (1985), 4 C.P.R. (3d) 488), in s. 45 proceedings, and that it would have been possible for the registrant to file the Pendleton affidavit independently. In any event, Mr. Wensinger states clearly in paragraph 5 of his affidavit that he is personally aware of and confirms the truth of the statements made in the Pendleton affidavit, which are in accord with his personal experience and his company's records. Further, he adopts Mr. Pendleton's statements as his personal testimony. I therefore find that the Pendleton affidavit is acceptable for these proceedings.

On the basis of the foregoing, and in the context of ensuring that s. 45 matters proceed with the goal as expressed in *Re Wolfville Holland Bakery Ltd (supra)* of ridding the register of deadwood yet safeguarding the registered owner against unwarranted attempts to have the mark expunged, I am prepared to accept the Wensinger and Pendleton affidavits in their entirety.

Turning to the substance of the evidence, I have summarized the pertinent points in the Wensinger and Pendleton affidavits below:

Mr. Wensinger states that the registrant has not used the subject trade-mark DOUBLE DOUBLE in Canada except on July 16th, 2003. Mr. Wensinger states that in about the spring of 2003 his company decided to undertake sales and marketing of its fast-food products in Canada, targeting the summer of 2003 for the event. On July 16th his company put on a cookout on the premises of Volvo Trucks of Vancouver, details of

which are set out in the Pendleton affidavit. Specifically, Mr. Wensinger states that his company entered into a contract with Volvo to provide burgers including cheeseburgers, and a specially prepared sandwich as part of restaurant services. At the cookout many DOUBLE DOUBLE cheeseburgers were served in wrappers marked with the subject trade-mark, a sample of which is attached as Exhibit K to the Pendleton affidavit. Attached as Exhibit B to the Pendleton affidavit are copies of the contract for mobile food services, an Addendum A that itemizes the food items that the registrant makes available in its cookout, including DOUBLE DOUBLE cheeseburgers, as well as the invoice to Volvo Trucks of Vancouver for the cookout, which lists food items sold and includes reference to the DOUBLE DOUBLE cheeseburgers. A copy of an advertisement for DOUBLE DOUBLE cheeseburgers and their availability at Volvo Trucks of Vancouver on July 16th for anyone with a “Class 1” driver’s license is attached as Exhibit J to the Pendleton affidavit. Mr. Pendleton details his responsibilities as Manager of In-N-Out Burger’s Cookout Trailer activities in paragraph 3. He states that Cookout Trailer activities are available year around for use at temporary locations, where a permanent restaurant facility is not yet established; as well, a copy of a web-page is attached which sets out that Cookout Trailer services are available for hire at special events.

It appears clear from both affidavits that the registrant operates restaurants in the United States which includes mobile restaurant services that are for hire for special events and also used for the test marketing and promotion of the registrant’s food in new areas. In fact, the registrant employs a manger of its mobile cookout services – Mr. Pendleton. It is also appears that the services and food provided to Volvo Trucks of Canada included DOUBLE DOUBLE cheeseburgers, which were provided to the public marked with the subject trade-mark in the overall context of a commercial transaction between the registrant and Volvo.

The requesting party argued that since the registrant has not yet made the decision to establish restaurants in Canada, the isolated activities on July 16th should be understood as “token use” and not use in the normal course of trade in Canada. The law is settled

with respect to this issue, that evidence of a single sale, whether wholesale or retail, in the normal course of trade, can suffice to satisfy the provisions of s.45 of the *Act* so long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration for the trade-mark at issue (*Osler, Hoskin & Harcourt v. Canada (Registrar of Trade Marks)*, (1997) 77 C.P.R. (3d) 475; *Philip Morris Inc. V. Imperial Tobacco Ltd.*, (1987) 13 C.P.R. (3d) 289 at 293; *Quarry Corp.v. Bacardi & Co.* (1996) 72 C.P.R. (3d) 25; *Philip Morris Inc.V. Imperial Tobacco Ltd. et al. (No.2)*, (1987) 17 C.P.R. (3d) 237; *Coscelebre, Inc. V. Canada (Registrar of Trade Marks)* (1991) 35 C.P.R. (3d) 74; *Pernod Ricard v. Molson Companies Ltd.*, (1987) 18 C.P.R. (3d) 160).

The facts in these proceedings differ from the circumstances in the decision in *Sim & McBurney v. Majdell Mfg. Co. Ltd.* (1986), 11 C.P.R. (3d) 306 (F.C.T.D.) relied on by the requesting party, since in that case, no statement was provided that the sales were in the normal course of trade and no indicia at all were provided that would allow the Court make a determination as to the nature of the normal course of trade of the registrant. Contrary to the *Sim & McBurney* decision, here there is ample evidence that goes to the context of the event on July 16th. Since the registrant states that the July 16th activity is the only occasion of sales in Canada, one could not reasonably expect the registrant to provide details of volume of sales, numbers and locations of purchasers, etc., in Canada, as the requesting party suggests is needed. On a fair reading of the affidavit, I accept that the events of July 16th followed a pattern of genuine commercial transaction – in that the provision of mobile cookout services through which DOUBLE DOUBLE cheeseburgers were provided, were established services which form part of the registrant’s normal business activities.

Furthermore, it is important to consider the affidavit as a whole, including the nature of the registrant’s business and the type of evidence available, as opposed to evidence that might be desirable. I note the statements of Mahoney J in *Union Electric Supply Co. Ltd. V. Registrar of Trade Marks* 63 C.P.R. (2d) 56 at p.60:

“The type of evidence necessary to “show” use of a trade mark in Canada will doubtless vary from case to case depending, to some extent, on the nature of its owner’s business, e.g., manufacturer, retailer or importer, and merchandising practices”.

An overly technical approach is inconsistent with the purpose of s.45 proceedings, as stated in *John Labatt Ltd. v Rainier Brewer Co. et al.* (1984), 80 C.P.R. (2d) 228:

“Use must be shown to satisfy the Registrar. Trade mark legislation does not create a highly technical process to be used by a third party to usurp the rights of a prior user of the mark”.

On the face of the affidavit evidence, I am prepared to conclude that the occasion on July 16, 2003 of the sale of DOUBLE DOUBLE burgers to Volvo and the subsequent provision of them to the public was use of the subject trade-mark on the wares and services in the normal course of trade in Canada. If the requesting party wishes to provide evidence contrary to the affidavit, there are other avenues to pursue.

With respect to the issue of whether or not the registrant’s wares and services as described in the evidence fall within the scope of the registration, I note the definition of “sandwich” in *The American Heritage® Dictionary of the English Language, Fourth Edition*. Houghton Mifflin Company, 2004. Dictionary.com:

- 1 a: two or more slices of bread or a split roll having a filling in between
- b: one slice of bread covered with food

A definition of “restaurant” is provided in the *English Language, Fourth Edition*. Houghton Mifflin Company, 2004. Dictionary.com:

A place where meals are served to the public

Based on the foregoing dictionary definitions, I am prepared to accept on a reasonable reading of the statement of services in the registration that the registrant’s sales of DOUBLE DOUBLE cheeseburgers can be considered a “specially prepared sandwich as

part of restaurant service”, since a cheeseburger by definition has two slices of bread or roll with a filling (the cheeseburger) between them. Furthermore, I am satisfied that the services of a mobile cookout trailer can be considered restaurant services since in this case the In-N-Out Burger trailer is a place where meals are served to the public.

In view of all of the foregoing, it is my conclusion that trade-mark No: TMA No. 496,628 for DOUBLE DOUBLE ought to be maintained on the Register, pursuant to Section 45(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 27th DAY OF MARCH 2007.

P. Heidi Sprung
Member, Trade-marks Opposition Board