



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

Citation: 2014 TMOB 250
Date of Decision: 2014-11-14
TRANSLATION

IN THE MATTER OF THE SECTION 45 PROCEEDINGS, undertaken at the request of De Grandpré Chait SENCRL/LLP regarding Registration No. LMC719,446 of the DESIGN OF A ROOSTER trade-mark (colour) in the name of J. BENNY INC.

[1] This decision pertains to a summary expungement proceeding requested against registration No. LMC719,446 of the DESIGN OF A ROOSTER trade-mark (colour) (the Mark), as reproduced below:



in association with:

French fried potatoes, roasted chicken, ribs and fried fish; barbecue sandwiches and sandwiches. (French translation: pommes de terre frites, poulet rôti, côtes levées et poisson frit; sandwichs barbecue et sandwichs.) (the Wares); and

Services: *Food delivery services; restaurant services.* (French translation: Services de livraison de mets préparés; services de restaurant.) (the Services).

[2] The colour is claimed as a characteristic of the Trade-mark. Red for the upper background, the rooster's comb, the rooster's beak and one feather; Black for the rooster's outline, the rooster's eye, one feather, the rooster's foot and the mountain; Yellow for the rooster design; White for one feather.

[3] In light of the evidence on file and for the reasons described below, I conclude that the Registrant (defined hereinafter) has discharged its burden to prove use of the Mark in Canada during the Relevant Period (defined hereinafter) in association with the Wares and the Services within the meaning of section 4 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act).

The proceeding

[4] On September 28, 2012, at the request of De Grandpré Chait SENCRL/LLP (the Applicant), the Registrar sent the notice stipulated in section 45 of the Act to J. BENNY INC. (the Registrant)

[5] Section 45 of the Act requires the Registrant to show that it has used the Mark in Canada in association with each of the Wares and Services at any given time during the three years preceding the date of the notice or, if not, to provide the date on which it was last used and the reason for its absence of use since this date. The relevant period is therefore from September 28, 2009 to September 28, 2012 (the Relevant Period).

[6] The procedure pursuant to section 45 is simple and expeditious, and serves to clear “deadwood” from the register. Accordingly, the threshold to establish use of the Mark, within the meaning of section 4 of the Act, during the Relevant Period is not very high [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FCTD)]. The issue is to establish a use of the Mark *prima facie* [see *1459243 Ontario Inc v Eva Gabor International, Ltd*, 2011 FC 18 (FCTD)].

[7] A simple claim of use of the Mark in association with the Wares and Services is not sufficient to establish its use within the meaning of section 4 of the Act. There is no requirement

to produce abundant evidence. However, any ambiguity in the evidence will be interpreted against the Registrant [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980) 53 CPR (4th) 62 (FCA)].

[8] In response to the notice, the Registrant filed the solemn declaration of Mr. Jean Benny with Exhibits JB-1 to JB-23 inclusive. The parties filed written representations. The parties were represented at a hearing.

Preliminary comments

[9] Mr. Benny's solemn declaration concerns distinct proceedings instituted against the three registrations and thus three different marks. For the purposes of this decision, I will refer only to the relevant passages pertaining to the commercial activities of the Registrant and/or its sub-licensees, and those relating to the use of the Mark in association with the Wares and Services.

[10] At the hearing, the Requesting Party insinuated that certain exhibits had been manipulated and even fabricated to respond to the Registrar's different notices, in order to preserve the trade-marks that are the object of these notices pursuant to section 45 of the Act. For this purpose, in particular, it compared some of the exhibits filed to prove the use of the Mark with exhibits filed in support of the allegations of use of other trade-marks that are the object of similar proceedings.

[11] Some remarks are necessary in this regard. This is an administrative proceeding for the purpose of eliminating deadwood from the Register. These are not adversarial proceedings on contested facts. Such as it will appear from the analysis of the evidence, the Registrant has several sub-licensees. The evidence of use of the Mark in this case is not the same as the evidence filed in the other cases, and vice versa. Moreover, the evidence comes in some cases from different sub-licensees and it thus becomes difficult to draw conclusions based on a comparison of the evidence coming from one sub-licensee with the evidence coming from another sub-licensee.

[12] I noticed that the Requesting Party refers in its written representations to documents attached thereto. I informed the Requesting Party during the hearing that it could not introduce

evidence in any way within the context of proceedings under section 45 of the Act or refer to documentation that is not part of the file [see *Fasken Martineau DuMoulin LLP v In-N-Out Burgers*, 2007 CanLII 80990 (TMOB)].

The evidence

[13] Mr. Benny describes himself as the President and Secretary of the Registrant since it was constituted. He is also the President of other companies to which he refers in his solemn declaration. He filed as Exhibit JB-1 a copy of the statement of the Enterprise Register concerning the Registrant.

[14] Since Mr. Benny's solemn declaration pertains to the use of different trade-marks, I must point out that Mr. Benny discusses the use of the Mark in paragraphs 27 to 33, 40 to 43, and 79 to 90 of his solemn declaration. I will therefore deal more fully with these paragraphs and the paragraphs describing the relationships that exist among the different corporate entities identified in his solemn declaration.

[15] Mr. Benny explains that the Mark is used by BENNY & FRÈRES INC., of which he is also the President, pursuant to a licence granted by the Registrant, which includes a franchise program for operation of restaurants. He filed as Exhibit JB-1 a copy of the statement of the Enterprise Register concerning this company. He explains this franchise program includes a licence that allows BENNY & FRÈRES INC. to grant sub-licences to use the Mark. He affirms that, under this licence and these sub-licences, the Registrant directly or indirectly controlled the character and quality of the Wares and Services during the Relevant Period. He also filed as Exhibit JB-3 a copy of the confirmatory trade-mark licences between the Registrant and BENNY & FRÈRES INC., as well as those made between BENNY & FRÈRES INC. and other firms (the sub-licensees). In paragraph 15 of his solemn declaration, he lists the various sub-licensees.

Restaurant services

[16] Mr. Benny affirms that restaurant services have been offered and rendered by the Registrant's sub-licensees in association with the Mark, thus allowing the customers to enjoy meals served on site in these restaurants.

[17] As proof of use of the Mark in association with the restaurant services, Mr. Benny filed:

- a photograph (Exhibit JB-11) show a poster bearing the Mark, placed on a counter of a restaurant operated by a sub-licensee (Blainville) during the period from September 20, 2012 to September 27, 2012 inclusive;
- a photograph (Exhibit JB-12) showing the same poster as the one illustrated in Exhibit JB-11, placed at another location in the restaurant operated by this same sub-licensee during the period from September 20 to 27, 2012;
- reproduction of a promotional pamphlet (Exhibit JB-13) in which the Mark appears on the 2nd page, distributed in over 700 copies between August 20, 2012 and September 27, 2012, given to each customer who visited the restaurant operated by a sub-licensee located in Fabreville, Quebec.

Prepared food delivery services

[18] Concerning the prepared food delivery services, we must refer to paragraphs 40 to 43 of Mr. Benny's solemn declaration. He affirms that between August 20, 2012 and September 27, 2012 inclusive, a promotional pamphlet bearing the Mark (Exhibit JB-16) was provided at the same time as the prepared foods ordered from one of the sub-licensees. Over 1,800 copies of this promotional pamphlet were provided to this sub-licensee's customers. Said pamphlet was provided by the deliverymen of the restaurant operated by the sub-licensee to the customers who benefited from the prepared food delivery services, when the food they ordered was delivered to them. Exhibit JB-16 also contains a photograph showing a box and a bill dated September 19, 2012, as well as the promotional pamphlet.

The Wares

[19] Regarding the use of Mark in association with the Wares, we must refer to paragraphs 44 to 46 and 79 to 90 of Mr. Benny's solemn declaration. He explains that a customer who purchased Wares since at least August 20, 2012 at the restaurant located in Fabreville, operated by one of the Registrant's sub-licensees, received a promotional pamphlet, a copy of which was filed as Exhibit JB-13. It should be noted that this same pamphlet is also part of Exhibit JB-16.

[20] Mr. Benny explains that the promotional pamphlet is attached to the box containing the wares purchased by the customer and is thus given to the customer at the same time as the box. Exhibit JB-16 includes several documents: said advertising pamphlet, photo showing a box to

which the advertising pamphlet is attached and on which can be seen a bill dated September 19, 2012, issued by the Fabreville sub-licensee for the purchase of a club sandwich.

[21] Mr. Benny filed, as Exhibit JB-22, different statements confirming the transactions that occurred between August 20 and August 31, 2012, relating to the purchase of each of the wares identified above. He affirms it is impossible to enter the transaction date when reprinting each of these bills. However, the transaction number is reproduced and he cites the example of a transaction bearing number 825506, which occurred on August 22, 2012. He explains the Mark does not appear on the bills given to the customers but rather on the promotional pamphlet identified above.

[22] Mr. Benny lists the number of units sold of each of the Wares at one of the sub-licensees (Fabreville) during the period from August 20, 2012 to August 31, 2012, when each of the customers purchasing these wares was given said advertising pamphlet.

Analysis of the Requesting Party's arguments

The Wares

[23] Regarding the bills filed as Exhibit JB-22, the Requesting Party points out that the Mark does not appear on them. I agree these bills show that Wares were sold, but this exhibit in itself does not show the use of the Mark during the Relevant Period in association with the Wares within the meaning of section 4(1) of the Act.

[24] Regarding Exhibit JB-13, the Requesting Party points out that the mark illustrated in the advertising pamphlet is not the Mark. Indeed, it argues on the first page, in what serves as the representation of a mountain top below the rooster, the following words were added: "Benny & Co. MAÎTRES ROTISSEURS DEPUIS 1960".

[25] This case is similar to the one involved in the Registrar's decision rendered in *Ogilvy Renault v Pacific Foods Ltd.* (2001), 16 CPR (4th) 120 (TMOB). In that decision, the registered mark was the representation of a boat captain with a white rectangle below this face. The evidence filed showed the use of this figure but the words "BARNACLE BILL'S" had been added in the white rectangle. As in our case, the requesting party argued that the words added

were the dominant portion, because the consumer would identify the products associated with this mark by this addition. However, the Registrar concluded that the addition as what could be perceived as the captain's name did not prevent the public from perceiving the captain's face as one of the marks used on the products' packaging. Thus, it is always possible for an owner of several marks to use some of them simultaneously [see *John Labatt Ltd v Molson Breweries, A Partnership* (1993) 46 CPR (3d) 6 (FCTD)]. Finally, I note that we find the Mark without these additions on the second page of the advertising pamphlet.

[26] The Requesting Party argues that Exhibit JB-13 is not the advertising pamphlet itself, but rather the computer matrix of the promotional pamphlet, because the document filed contains the name of the firm that prepared the document and other information concerning the preparation of this document. It plays up the fact that Mr. Benny uses the term "reproduction" in his solemn declaration and that on the face of the evidence filed, it cannot be a reproduction.

[27] I agree that the use of the word "reproduction" may not be appropriate in the circumstances, but I find that Mr. Benny was referring to the advertising pamphlet given to the customers. Whether this is a computer matrix or a colour copy, one fact remains: the document was filed to illustrate the advertising pamphlet to which Mr. Benny refers in his solemn declaration.

[28] It is therefore my opinion that the Mark appears on the advertising pamphlet, Exhibit JB-13. From the filing of the transaction statements and the corresponding bills, we know the Wares were sold during the Relevant Period. It remains to be determined whether this is sufficient evidence to show the use of the Mark in association with the Wares.

[29] Mr. Benny affirms in paragraph 80 of his affidavit that the advertising pamphlet, Exhibit JB-13, was given to each customer from August 20 to September 27, 2012 who purchased any of the Wares. As mentioned previously, the advertising pamphlet is provided at the same time as the box containing the purchased wares. To illustrate all this, Mr. Benny filed a photo, Exhibit JB-16.

[30] The Requesting Party raises the fact that the photograph does not clearly show the box and the advertising pamphlet. It also alleges that the unobstructed part of the advertising

pamphlet shows an expiry date of October 20, 2012 for the coupons that are part of the advertising pamphlet. This expiry date is subsequent to the Relevant Period.

[31] First of all, Mr. Benny also filed a copy of the advertising pamphlet as an element of Exhibit JB-16 to enlighten us on the contents of this document, because a part is indeed obstructed in the photo, another element of Exhibit JB-16. The photo and Mr. Benny's allegations clearly illustrate how the Mark is linked to the Wares at the time of their sale. Although the full advertising pamphlet cannot be seen in the photo, since it is partially obstructed by the bill, we can clearly see the Mark on the visible portion of the advertising pamphlet.

[32] I consider this way of proceeding complies with the wording of section 4(1) of the Act, which stipulates that a trade-mark is deemed to be used in association with wares if [TRANSLATION] "...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".

[33] Mr. Benny provided proof of the sale of each of the Wares and the quantities sold by the Fabreville sub-licensee for each of the Wares between August 20 and August 31, 2012, namely within the Relevant Period.

[34] I therefore conclude that the Registrant has discharged its burden of proof concerning the Wares.

Restaurant services

[35] The Requesting Party raises the following points:

- the posters appearing in photos JB-11 and JB-12 do not contain any reference to the Registrant or to one of its sub-licensees, so that the posters cannot be associated with the Registrant.
- it is suspicious, to say the least, that these posters appeared only beginning on September 20, 2012, or about one week before the Registrar's notice was sent.

- The photos would be a montage produced after receipt of the Registrar's notice, because the photos show that the posters are not the same size as the frames in which they are placed.

[36] I will deal with these arguments in reverse order. Nothing in this evidence leads me to believe these photos were taken subsequent to the Relevant Period for the sole purpose of preserving the Registrant's rights to the Mark in association with the restaurant services. Moreover, I do not see what the Requesting Party wishes to insinuate regarding the proximity of the appearance of these posters to the end of the Relevant Period. The Registrant could not have known at the time the period of use of these posters began that the Mark would be the object of a notice under section 45 of the act within the following days. I remind the parties that the Registrant only had to file *prima facie* evidence of use of the Mark at any time within the Relevant Period.

[37] Regarding the absence of reference to the Registrant or to one of the sub-licensees on these posters, I agree with the Registrant's representations. The posters are on the premises where the services are provided to the public. The necessary link between the Mark appearing on the advertising posters and the source of the services therefore exists with the customer.

[38] Exhibits JB-13 and JB-16 and Mr. Benny's allegations in their regard contained in paragraphs 32 and 42 of his solemn declaration are sufficient to establish that the Mark was used in association with the restaurant services within the meaning of section 4(2) of the Act during the Relevant Period.

Prepared food delivery services

[39] All that remains is to determine the Mark was used in association with prepared food delivery services.

[40] For these services, the Registrant refers to Exhibits JB-13, JB-16 and JB-22. I have already expressed the opinion that Exhibits JB-13 and JB-16, combined with Mr. Benny's allegations concerning them, constituted evidence of use of the Mark in association with the

wares. But the advertising pamphlet may also contain documentary proof of use of the Mark in association with the prepared food services.

[41] The Requesting Party argues that the Registrant is using the same exhibits to show at the same time the use of a trade-mark in association with wares and services. Yet nothing seems to prohibit such a manner of proceeding.

[42] The issue is to analyze the allegations contained in Mr. Benny's solemn declaration to find out whether the advertising pamphlet was used in the course of performance of prepared meal delivery services. Yet Mr. Benny affirms in paragraph 42 of his solemn declaration that the advertising pamphlet filed as Exhibit JB-13 and included in Exhibit JB-16 was given to the customers who were able to benefit from these prepared food home delivery services between August 20 and September 2012.

[43] I find this evidence shows the use of the Mark during the Relevant Period in association with the prepared food delivery services within the meaning of section 4(2) of the Act.

Disposal

[44] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, registration LMC719,446 will be maintained for the Wares and Services in compliance with the provisions of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board

Traduction certifiée conforme
Arnold Bennett, trad.