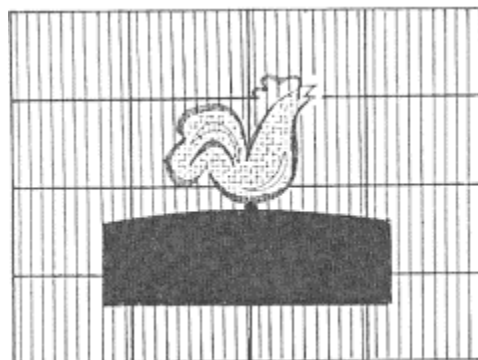


LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2014 TMOB 253**  
**Date of Decision: 2014-11-14**  
**TRANSLATION**

**IN THE MATTER OF THE SECTION 45  
PROCEEDINGS, undertaken at the request of De  
Grandpré Chait regarding Registration  
No. LMC755,904 of the SIGN WITH ROOSTER  
trade-mark (colour design) in the name of J.  
BENNY INC.**

[1] This decision pertains to a summary expungement proceeding requested against registration No. LMC755,904 of the SIGN WITH ROOSTER trade-mark (colour design) (the Mark), as reproduced below:



in association with:

restaurant services, namely operation of restaurants (The Services).

The colour is claimed as a characteristic of the trade-mark. RED for the squared background, the beak, the comb and the top feather on the rooster's tail; BLACK for the

rectangle below the rooster, the outline of the rooster and the bottom feather on the rooster's tail; YELLOW for the inside of the rooster; WHITE for the feather on the rooster's breast.

[2] 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 association with the Services within the meaning of section 4(2) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) during the Relevant Period (as defined below).

#### The proceeding

[3] On February 20, 2013, at the request of De Grandpré Chait (the Applicant), the Registrar sent the notice stipulated in section 45 of the Act to J. BENNY INC. (the Registrant)

[4] Section 45 of the Act requires the Registrant to show that it has used its Mark in Canada in association with the Software at any given time during the three years preceding the date of the notice or, if not, 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 February 20, 2010 to February 20, 2013 (the Relevant Period).

[5] 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)].

[6] A simple assertion of use of the Mark in association with the Services is not sufficient to establish its use within the meaning of section 4(2) 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)].

[7] In response to the notice, the Registrant filed the solemn declaration of Mr. Jean Benny with Exhibits JB-1 to JB-7 inclusive. The parties filed written representations and were represented at a hearing.

#### Preliminary comments

[8] 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 (CA TMOB)].

#### The evidence

[9] 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.

[10] 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. He affirms that, under this licence and these sub-licences, the Registrant directly or indirectly controlled the character and quality of the 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 some of these sub-licensees.

[11] Mr. Benny affirms that restaurant services were offered and rendered by the Registrant's sub-licensees, identified in paragraph 11 of his solemn declaration, in association with the Mark at some time during the Relevant Period under the above-mentioned franchise program, thus allowing the customers to enjoy meals served on site in these restaurants.

[12] As proof of use of the Mark in association with the Services, Mr. Benny filed:

- a photograph of the storefront of the restaurant operated by the sub-licensee 9199-4400 Québec Inc. in Blainville (Exhibit JB-4) bearing the Mark and located at the entrance of this restaurant since its opening in July 2006. This storefront is representative of the outdoor sign exhibited on the restaurants of the Registrant's franchisees;
- a document bearing the Mark (Exhibit JB-5) distributed to customers accompanied by one or more children who visited the restaurant located in Blainville from January 11, 2012 to February 19, 2013 (and subsequently). This is a colouring drawing distributed in over 300 copies. Thus, while waiting for a meal or during a meal served and paid for at the restaurant, children who received Exhibit JB-5 were able to colour a document bearing the Mark;
- a poster bearing the Mark (Exhibit JB-6) placed inside the restaurant operated by the sub-licensee in Blainville during the period from December 20, 2012 to February 19, 2013;
- a photograph (Exhibit JB-7) showing the poster (Exhibit JB-6) placed inside the Blainville restaurant near the cash registers, to be seen by the customers, from December 20, 2012 to February 19, 2013.

[13] Thus, according to Mr. Benny, the Mark was shown during the performance of the Services in Canada during the Relevant Period.

[14] Mr. Benny affirms that at least 4200 customers took advantage of the Services by eating on site and paying for meals at this Blainville restaurant during the entire month of January 2013.

#### Analysis of the Requesting Party's arguments

[15] The Requesting Party argues that Exhibit JB-5 cannot constitute evidence of use of the Brand in association with the restaurant operating services. I fully agree with the

Requesting Party. The exhibit is not used for advertising, promotion or during performance of the Services, but instead serves as a drawing object to entertain young children who accompany their parents when they visit the restaurants operated by the Registrant's sub-licensees.

[16] For Exhibits JB-6 and JB-7, the Requesting Party claims this is the same drawing that appears on an exhibit filed in another case of notices issued by the Registrar under section 45 of the Act concerning another mark of the Registrant. Moreover, the Requesting Party refers to documents attached to its written arguments to attempt to prove the Registrant uses a completely different trade-mark than the Mark. On the grounds already expressed, I am not considering these documents and, therefore, the argument developed by the Requesting Party based on these documents.

[17] The Requesting Party also argues that Exhibits JB-6 and JB-7 in no way refer to the Registrant or one of its sub-licensees [TRANSLATION] "so that we find it difficult to imagine that [the Registrant] uses such a sign to promote its services".

[18] Yet Mr. Benny affirms that poster JB-6 is shown to the customers when they are inside the restaurant operated by one of its sub-licensees. Moreover, Exhibit JB-7 is a photograph of said poster, as exhibited inside the restaurant of one of the sub-licensees. Thus, the Mark, which undeniably is printed on the poster, is exhibited to the sub-licensees' customers inside the premises operated by the sub-licensees within the context of performance of the Services.

[19] I recall that section 4(2) of the Act provides that a trade-mark is deemed to be used in association with services not only within the context of promotion of services, but also if it is displayed in their performance. The latter possibility is exactly our case. There is thus no reason to enquire into the origin of the Services.

[20] Finally, concerning Exhibit JB-4, the Requesting Party claims the mark affixed on the storefronts of the restaurants operated by the sub-licensees is not the Mark. Indeed, it argues that the words "Benny & Co. MAÎTRES ROTISSEURS DEPUIS 1960" have been added in the black rectangle above the rooster.

[21] 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)].

[22] It is therefore my opinion that the photograph of the storefront of one of the restaurants operated by one of the sub-licensees proves the use of the Mark in association with the Services. In any event, even if I were in error concerning this last conclusion, Mr. Benny's allegations in support of Exhibits JB-6 and JB-7, as well as these exhibits, constitute satisfactory evidence to prove the use of the Mark in association with the Services during the Relevant Period.

#### Disposal

[23] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, registration LMC755,904 will be maintained in compliance with the provisions of section 45 of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office  
Certified true translation

Traduction certifiée conforme  
Arnold Bennett, trad.