



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

Citation: 2014 TMOB 252
Date of Decision: 2014-11-14
TRADUCTION

**IN THE MATTER OF THE SECTION 45
PROCEEDINGS, undertaken at the request of De
Grandpré Chait SENCRL/LLP regarding Registration
No. LMC714,621 of the DESIGN OF A ROOSTER WITH
MOUNTAIN trade-mark (black and white) in the name of
J. BENNY INC.**

[1] This decision pertains to a summary expungement proceeding requested against registration No. LMC714,621 of the DESIGN OF A ROOSTER WITH MOUNTAIN trade-mark (black and white) (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] In light of the evidence on file and for the reasons described below, I reach the conclusion that the Registrant (hereinafter defined) showed use of the Mark in Canada 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) during the Relevant Period (as defined below).

The proceeding

[3] 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)

[4] Section 45 of the Act requires the Registrant to show that it has used its Mark in Canada in association with each of the Wares and Services specified in the registration 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).

[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 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)].

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

Preliminary comments

[8] 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.

[9] 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.

[10] Some remarks are necessary in this regard. This is an administrative proceeding for the purpose of eliminating deadwood from the Register. This is not an adversarial proceeding 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.

[11] 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

[12] 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.

[13] 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 21 to 26, 37 to 39, and 67 to 78 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.

[14] 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-2 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 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

[15] 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.

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

- reproductions of posters (Exhibit JB-8) bearing the Mark, placed inside at least two restaurants operated by the Registrant's sub-licensees during the period from September 20, 2012 to September 27, 2012 inclusive;

- two photographs (Exhibit JB-9) showing one of the posters placed on the counter of an establishment operated by a sub-licensee during the period from September 20 to 27, 2012;
- transaction statement dated February 2, 2012 and duplicate of a bill issued by one of the Registrant's sub-licensees dated April 24, 2013 (Exhibit JB-10), on which the Mark appears.

[17] Mr. Benny explains why the reproduction of the bill does not bear the transaction date. He affirms that it is impossible to enter the transaction date when reprinting each of these bills. However, the transaction number appears on it. Thus, the bill reproduced refers to the transaction bearing number 658037, which occurred on February 2, 2012.

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

Prepared food delivery services

[19] Concerning the prepared food delivery services, we must refer to paragraphs 37 to 39 of Mr. Benny's solemn declaration. Mr. Benny affirms that effective January 2012, each bill given to each customer who ordered food from one of his sub-licensees bore the Mark. As an example, he cites the case of the sub-licensee located in Anjou. He filed an example of such a bill (Exhibit JB-15) bearing the Mark and affirms that during the month of August 2012, at least 4,000 bills bearing the Mark were given to customers in this manner.

The Wares

[20] Regarding the use of Mark in association with the Wares, we must refer to paragraphs 44 to 46 and 67 to 78 of Mr. Benny's solemn declaration. He explains that a customer who visits one of the establishments operated by the sub-licensees may go to a counter to buy the various dishes or foods described on the counter menu for takeout. He filed a copy of this counter menu as Exhibit JB-17. He mentions that the menu presentation may have changed during the Relevant Period but that all the Wares were offered during that period.

[21] I must point out that the watermark representation of a rooster can be seen at the left end of Exhibit JB-17 and that the Wares are identified therein. However, I do not consider this

representation of a rooster to be a representation of the Mark. Indeed, it is only possible to see the mountain, the vertical line that serves to illustrate the rooster's feet, and the rectangle framing the rooster and the mountain [See *Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull SA*, (1985) 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc.* (1992), 44 CPR (3d) 59 (FCA)].

[22] Mr. Benny affirms that the Mark is present on the front of the bill given since at least January 2012 to the customers who have purchased the Wares at one of the sub-licensees located in Blainville. He filed as Exhibit JB-20 an example of a bill (duplicate) issued by this sub-licensee between January and September 2012 and a photocopy of a bill issued on January 4, 2012 by another sub-licensee located in Auteuil. Thus, a customer leaving this restaurant has in his possession the box containing the food purchased and the bill bearing the Mark.

[23] Mr. Benny provides the number of units sold of each of the Wares during the month of August 2012 at the Blainville restaurant. He produced as Exhibit JB-21 different statements conforming some of the transactions that occurred during the month of August 2012. He explains that the reprinted bills differ from the original bills in that it is impossible to show the transaction date on the reprinted bills. However, each bill bears the original transaction number. It is therefore possible to make the correlation between the transaction statement and the duplicate bill by referring to the transaction number appearing both on each transaction statement and on the duplicate bill.

Analysis of the Requesting Party's arguments

The Wares

[24] I have already explained the reasons why I do not consider Exhibit JB-17 to be evidence of use of the Mark. However, the Mark appears on Exhibits JB-20 and JB-21.

[25] Regarding Exhibit JB-20 (two bills), the Requesting Party points out there is a difference between the first and the second bill. However, I find the bills were issued by different sub-licensees (Blainville and Auteuil). Mr. Benny points out in paragraph 69 of his solemn

declaration that the bill dated April 24, 2013, although issued after the Relevant Period, is representative of the type of bill used during the month of August 2012 by his Blainville sub-licensee. He also explains the reasons why the bills differ, particularly the addition of a legal notice concerning the trade-mark. Mr. Benny affirms this notice appeared on the bills only beginning in September 2012. The second bill filed under Exhibit JB-20 does not contain the legal notice, because it is dated January 4, 2012.

[26] The Requesting Party invited me to compare the bill dated April 4, 2013, which is part of Exhibit JB-20 with the bill bearing the same date, which is part of Exhibit JB-10. It notes that the legal notice concerning the trade-mark does not appear on that bill. However, these bill were issued by different sub-licensees and, moreover, bill JB-10 is a photocopy of the merchant's copy for internal use.

[27] Although Exhibits JB-20 and JB-21 are photocopies of copies of bills, I consider these exhibits must be analyzed in light of the allegations contained in paragraphs 67 to 78 of Mr. Benny's solemn declaration. I must recall the remarks of Justice Martineau of the Federal Court in *Promotions C D Inc. v. Sim & McBurney*, 2008 FC 1071:

The test to be met for a proceeding under section 45 of the Act is not severe. In fact, evidence of one single sale may be sufficient (*Cordon Bleu International Ltée / Cordon Bleu International Ltd. c. Renaud Cointreau & Cie* (2000), 10 C.P.R. (4th) 367, [2000] F.C.J. No. 1416 (Fed. T.D.)). No specific form of evidence is required in a proceeding under section 45 of the Act. That being said, it is not sufficient to simply allege that the trade-mark is used, but rather it is necessary to describe the use made of this trade-mark (*Renaud Cointreau & Cie c. Cordon Bleu International Ltd.*, [2000] F.C.J. No. 882 (Fed. T.D.), at paragraph 36, (2000), 193 F.T.R. 182 (Fed. T.D.)). On this point, a photocopy may be acceptable (*Mantha & Associates v. Cravatte di Pancaldi S.r.l.*, [1998] F.C.J. No. 1636 (Fed. T.D.), at paragraphs 18-20, (1998), 84 C.P.R. (3d) 455 (Fed. T.D.)). In this case, evidence of a label may be acceptable if the facts described in the affidavit or the statutory declaration show use (*Renaud Cointreau & Cie c. Cordon Bleu International Ltd.*, [2000] F.C.J. No. 882 (Fed. T.D.), at paragraphs 17 and 35, (2000), 193 F.T.R. 182 (Fed. T.D.)).

[28] During its arguments at the hearing, the Requesting Party argued that the trade-mark used by the Registrant is not either of the trade-marks which are the object of the different proceedings pursuant to section 45 of the Act, but rather a completely different trade-mark, namely the Mark to which is added "Benny & Co MAÎTRE ROTISSEUR DEPUIS 1960". This would be the

original mark and subsequently the Registrant would have registered different variants by stripping the original mark of some of its characteristics. The Requesting Party adds that the evidence shows that the Wares were delivered in a box and that the real mark used in association with the Wares is the mark affixed to the boxes.

[29] To support its claims, the Requesting Party refers to documents that are not part of the file. Moreover, as mentioned by the Registrant during the hearing, regardless of the mark that would appear on the box containing the Wares, it is always lawful for an owner of several registered marks to use one or more of its marks simultaneously in association with wares [see *John Labatt v Molson Breweries, A Partnership* (1993), 46 CPR (3d) 6 (FCTD)]. This is precisely the case here.

[30] The proof shows that a bill of the type filed as Exhibits JB-20 and JB-21 is issued during the sale of the Wares; that it is given to the customers of the sub-licensees when they take possession of the Wares; and that it bears the Mark. 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".

[31] Mr. Benny provided proof of the sale of each of the Wares and the quantities sold for each of the Wares during the month of August 2012, namely within the Relevant Period.

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

Restaurant services

[33] For restaurant services, the Requesting Party claims that the posters (Exhibit JB-8) we find in the photos (Exhibit JB-9) inside a restaurant operated by one of the Registrant's sub-licensees, at most constitute proof of use of the Mark in association with wares, and not with restaurant services.

[34] The use of the Mark on the posters placed inside two restaurants operated by the Registrant's sub-licensees is amply described in paragraphs 23 to 25 of Mr. Benny's solemn declaration. He indicates these posters were exhibited from September 20 to 27, 2012, namely within the Relevant Period. He mentions the number of customers who ate on site during that period, when the posters were found there.

[35] Mr. Benny also filed, as Exhibit JB-10, a computerized statement and a reproduction of a bill bearing the Mark for a transaction that occurred on February 2, 2012 for a meal eaten on site at the establishment of one of the Registrant's sub-licensees. I have already described the explanations provided by Mr. Benny concerning the date that appears on the reproduction of this bill.

Prepared food delivery services

[36] I find that the allegations contained in Mr. Benny's solemn declaration and the above-mentioned documentary evidence show that the Registrant used the Mark within the meaning of section 4(2) of the Act in association with the restaurant services.

[37] All that remains is to determine whether the evidence of record shows the use of the Mark in association with prepared food delivery services.

[38] The Requesting Party argues that Exhibit JB-15 is an incomplete photocopy of a bill and thus does not represent a complete reproduction of an original.

[39] This is a photocopy of a bill for delivery services. I have already dealt with the Requesting Party's argument concerning the production of photocopies of bills.

[40] The Requesting Party plays up the apparent differences between this exhibit and the bills to which I referred previously in this decision.

[41] The bill, Exhibit JB-15, is dated January 4, 2012 and was issued by a sub-licensee (Anjou) other than those (Blainville and Auteuil) who issued the bills on which I commented previously. Moreover, since this is a bill for the delivery of prepared food, it is normal for it to bear the address where the delivery must be made. The customer's telephone number and the family name of a person have been obliterated on the bill. It is not clear where this is the name of

the person who placed the order or the name of the sub-licensee's employee who took the order. Regardless, this information is irrelevant for the purposes of this decision.

[42] I find that the text at the bottom of the bill was copied during photocopying. I do not see how the absence of this information affects the conclusive value of the documentary evidence. The essential elements for the purposes of our case, namely the date of the bill, the Mark and the services required, clearly appear on the bill. Moreover, Mr. Benny explains in detail the delivery process and the context in which the bills of the type in Exhibit JB-10 are issued.

[43] I find that the record contains evidence of 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 LMC714,621 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
Canadian Intellectual Property Office
Certified true translation

Traduction certifiée conforme
Arnold Bennett, trad.