



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

**Citation: 2013 TMOB 97**  
**Date of Decision: 2013-05-30**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by ExxonMobil Oil Corporation against  
registration No. TMA460,114 for the trade-mark  
MARCHÉ in the name of Mövenpick-Holding AG**

[1] On January 22, 2010, at the request of ExxonMobile Oil Corporation (the Requesting Party), the Registrar of Trade-marks forwarded a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Mövenpick-Holding AG (the Registrant). The notice required the Registrant to show that its trade-mark, MARCHÉ (registration No. TMA460,114) had been used in Canada in association with the registered services within the previous three years.

[2] The trade-mark MARCHÉ is registered for use in association with the services: “*operation of restaurant*” (the Services).

[3] Section 4(2) of the Act sets out the meaning of use with respect to services:

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[4] Section 45 proceedings are considered to be summary and expeditious for clearing the register of non-active trade-marks. The expression “clearing deadwood” has often been used to describe such proceedings [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. Consequently, the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)] and evidentiary overkill is not required in order to properly reply to a section 45 notice [*Union Electric Supply Co Ltd v Registrar of Trade-marks* (1982), 63 CPR (2d) 56 (FCTD)].

[5] In response to the Registrar’s notice, the Registrant filed an affidavit of Afzal Hamid, the Country Controller Canada of Marché Restaurants Canada Ltd. (Marché Canada), a licensee of the Registrant. Both parties filed written submissions and were represented at an oral hearing.

[6] The Registrant submits that it has furnished evidence showing that it was using the trade-mark in association with the “operation of restaurant” in Canada during the relevant period. In the alternative, the Registrant submits that it has shown exceptional circumstances which would have justified the absence of use of its trade-mark during the relevant period.

[7] In his affidavit, Mr. Hamid makes no allegation nor provides evidence in an attempt to show that the trade-mark was being used at any point during the relevant period prior to September 22, 2009. Indeed, much of Mr. Hamid’s evidence is with respect to use prior to the relevant period, the circumstances surrounding the cessation in use of the trade-mark up until September 9, 2009, and activities related to resumption of use of the trade-mark, were provided as a means to demonstrate special circumstances to excuse the absence of use of the trade-mark, if required.

[8] However, with respect to the evidence of use of the trade-mark during the relevant period, Mr. Hamid explains in his affidavit that leading up to the resumption of use of the trade-mark on September 9, 2009, the Registrant began to advertise the re-launch of restaurants bearing the trade-mark in Canada. In support, he attaches Exhibits AH-4 and AH-5.

[9] Exhibit AH-4 is a copy of a news release, dated March 23, 2009, which announces the re-launching of restaurants in Toronto bearing the trade-mark in 2010. Exhibit AH-5 consists of

pages from the Registrant's website which Mr. Hamid states advertised, since February 22, 2009, employment opportunities for the restaurants to be re-launched in 2010 bearing the trade-mark.

[10] While the AH-4 news release and the AH-5 employment postings refer to the re-launch of restaurants bearing the trade-mark post relevant period, Mr. Hamid states that as a result of steps taken to resume use by the Registrant, the Registrant was actually able to re-commence performance of its MARCHÉ Services in Toronto in September 2009 during the relevant period.

[11] In support, Mr. Hamid attaches as Exhibit AH-6 to his affidavit, "a collection of photographs taken during the performance of the MARCHÉ Services in Toronto, Canada on September 9, 2009 at a restaurant outlet at the Eaton Centre." The photographs show a buffet-like presentation of food and beverage items in a hotel suite-like setting, with what appears to be several customers enjoying the buffet, as well as an employee of the "restaurant outlet". I note that similar to the AH-5 employment postings, the following mark appears in the photographs on beverage cups, signage, and on the uniform worn by the employee:



[12] Despite the surrounding elements, I have no difficulty accepting that the mark as used constitutes use of the word mark MARCHÉ [see for example, *Aliments O'Sole Mio Inc v Gennarelli Bideri Editori SRL* (2012), 105 CPR (4th) 240 (TMOB)].

[13] As evidence of continued use of its trade-mark in Canada, Mr. Hamid explains that its licensee, Marché Canada, has been operating different types of restaurants by way of stands and permanent establishments in Canada subsequent to the relevant period. In support, he provides Exhibits AH-7, AH-8 and AH-9.

[14] Exhibit AH-7 consists of a collection of photographs taken on the opening date of such a restaurant in Toronto on February 16, 2010. I note that consistent with Mr. Hamid's sworn statements, the photographs show the trade-mark on restaurant signage, on employee uniforms, and on menu boards. Exhibit AH-8 consists of a collection of photographs taken at two additional restaurant locations that have since opened. Again, the trade-mark is clearly visible on

signage and employee uniforms. Lastly, Exhibit AH-9 consists of photographs of a variety of items, such as beverage cups, serviettes, etc. displaying the trade-mark; Mr. Hamid states that these items are identical to those used to “provide foods to customers in Canada since September 9, 2009.” (I accept that Mr. Hamid’s reference in his affidavit to “September 9, 2010” is merely a typographical error, and that the evidence supports the corrected date of “September 9, 2009”.)

[15] The Requesting Party argues that the Registrant has not shown any evidence that it sold any of the food or beverage items prepared and served on September 9, 2009 at the “restaurant outlet” evidenced in Exhibit AH-6. Further to this, the Requesting Party argues that Exhibit AH-6 does not show the operation of a restaurant, but rather simply shows a single table displaying food and drinks in what appears to be a hotel suite or apartment. According to the Requesting Party, this is not the same type of “restaurant” that the Registrant purports to show operations of later on in Exhibits AH-7 and AH-8, following the relevant period.

[16] While I agree that the “restaurant outlet” in Exhibit AH-6 does not appear to be a restaurant in the *traditional* sense, based on the evidence of record, which includes sworn statements to the effect that the Registrant performed the Services through such a restaurant outlet, I accept Mr. Hamid’s sworn statements at face value [see *Rubicon Corp v Comalog Inc* (1990), 33 CPR (3d) 58 (TMOB)]. I would also note that, generally services are to be given a broad interpretation [see *Venice Simplon-Orient-Express Inc v Société Nationale des Chemins de Fer Français SNCF* (2000), 9 CPR (4th) 443 (FCA)].

[17] Furthermore, I see nothing in the evidence of record to suggest that the Services performed, as the Requesting Party is suggesting, were not of a normal commercial nature. Lastly, while it is true that the restaurant outlet in Exhibit AH-6 does not appear to be the same type of establishment as shown in Exhibits AH-7 and AH-8, the Requesting Party provided no authority to support its assertion that it needed to be of the same type, and I see no reason why it would need to be such.

[18] Having regard to the foregoing, I accept that the Registrant has shown use of the trade-mark in association with the Services within the meaning of sections 4 and 45 of the Act. Consequently, I need not decide whether the Registrant has demonstrated special circumstances that would excuse the absence of use of the trade-mark in Canada during the relevant period.

Disposition

[19] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA460,114 will be maintained in compliance with the provisions of sections 45 of the Act.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office