LE REGISTRAR DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2013 T.M.O.B. 229
Date of Decision: 2013-12-23

TRANSLATION

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Sim & McBurney against registration No. TMA444,852 for the trade-mark LES RÔTISSERIES BENNY EXPRESS Design in the name of Les Placements 1360 Inc.

[1] This decision pertains to a summary expungement proceeding requested against registration No. TMA444,852 for the trade-mark LES RÔTISSERIES BENNY EXPRESS Design (the Mark) reproduced below:

[2] The Wares and Services covered by the registration are:

> Wares: chicken, salads, pastries [sic], fries, poutines, sandwiches, breads, sauces, spaghetti, pizzas, hamburgers [sic], steaks, eggs, ice cream [sic], dairy bar, coffee, tea, chocolate, soft drinks, mineral water, beer, wine, aperitif wine (the Wares).
>
> Services: restaurant operation services and delivery of prepared foods (the Services).
>
> [TRANSLATION]

[3] For the following reasons, I conclude in favour of expungement of the registration.

The proceeding

[4] On April 28, 2011, the Registrar addressed a notice under section 45 of the *Trade-Marks Act*, RSC (1985), c. T-13 (the Act) to Les Placements 1360 Inc. (Placements), registered owner of registration No. TMA444,852. This notice was addressed at the request of Sim & McBurney (the Requesting Party).

[5] The Registrar's notice enjoined Placements to prove the use of the Mark in Canada, at some time between April 28, 2008 and April 28, 2011, in association with each of the Wares and each of the services specified in the registration. In the absence of use, the Registrar's notice enjoined Placements to prove the date when the Mark was used for the last time and the reason for its absence of use since that date.

[6] It is well established that the purpose and the scope of section 45 of the Act are to provide for a simple, summary and expeditious procedure for removing "deadwood" from the register. The criterion for establishing use is not demanding and evidentiary overkill is unnecessary. However, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the Wares or services mentioned in the registration during the relevant period [see *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.)]. Bare allegations of use are insufficient to prove the use of the Mark [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)].

[7] In response to the Registrar, Placements filed a statutory declaration by its president, Pierre Benny, made on July 18, 2011.

[8] Only Placements filed written representations.

[9] The Requesting Party and Placements were both represented at the hearing held on August 27, 2013 jointly with the hearing concerning the summary expungement proceeding regarding registration No. TMA394,413 for the trade-mark LES RÔTISSERIES BENNY & Design. The latter proceeding is the subject of a separate decision.

[10] On August 21, 2013, less than one week before the hearing, Placements requested a retroactive extension of time for filing an additional statutory declaration by Pierre Benny, in

order to complete his evidence in response to the Registrar's notice. Before proceeding any further, I will rule officially on this request, which I rejected at the beginning of the hearing.

Request for retroactive extension of time

[11] Below, I reproduce the second paragraph and part of the third paragraph of the letter of August 21, 2013, which essentially state the reasons invoked by Placements in support of its request for retroactive extension of time.

> A rereading of the affidavit [sic] of Mr. Pierre Benny, initially submitted, shows that certain additional information would specify the use made of the Mark, adequately complete the evidence and dispel any ambiguity in this regard. We understand, given the fact that Mr. Pierre Benny cannot be cross-examined [sic] on his affidavit [sic], and even though the section 45 proceeding is one that need not be excessively technical, that the concept of use nonetheless must be adequately "proved".
>
> We are well aware of the fact that this request is made very late in the process; we respectfully submit, however, that the purpose of this additional declaration is only to complete the evidence already submitted, and that the necessity of these clarifications appeared useful or necessary only upon rereading the status of the file in anticipation of the next hearing. […]
>
> [TRANSLATION]

[12] For the following reasons, Placements' representations did not convince me that its failure to file the proposed evidence within the time limit, namely on or before July 28, 2011, was not reasonably avoidable, as required by section 47(2) of the Act.

[13] There was no representation by Placements allowing a conclusion that the proposed evidence was unavailable at the time of preparation of Mr. Benny's first statutory declaration. Moreover, the fact that Placements realized the necessity for clarifications only upon rereading the file in anticipation of the hearing is not clearly a fact that existed on or before July 28, 2011.

[14] Therefore, I will disregard Mr. Benny's additional statutory declaration in considering the evidence in the file of this proceeding.

Summary of the representations of the Requesting Party

[15] At the hearing, the Requesting Party first submitted that the proven use is not a use by Placements, nor a use that benefits Placements pursuant to section 50(1) of the Act. This section stipulates that the owner of a trade-mark must have direct or indirect control of the character or quality of the Wares or services to benefit from the use of his trade-mark by an entity licensed by the owner to use it.

[16] Subject to its position to the effect that Placements cannot claim the benefit of the use of the Mark, the Requesting Party made additional representations on the evidence. In general, these additional representations are to the effect that:

a) the evidence does not prove the use of the Mark in association with the Wares within the meaning of section 4(1) of the Act, applicable in the case at bar;
b) the evidence does not prove the use of the Mark in association with each of the Wares;
c) the Mark as used in association with the Wares is not the Mark as registered; and
d) the evidence does not prove the use of the Mark in association with the services "delivery of prepared foods".

[17] Before examining the questions raised by the representations of the Requesting Party, I will review the evidence provided by Pierre Benny in his statutory declaration of July 18, 2011, including his Exhibits P-1 to P-8.

The evidence

[18] Mr. Benny affirms in paragraph 5 of his statutory declaration, reproduced below, that Placements licensed Resto Servibec inc. to use the Mark:

> [Placements] granted a license to use the Mark to the licensee Resto Servibec inc., which operates a restaurant at the Autoroute 40, Lavaltrie rest stop. A copy of the declaration of the licensee Resto Servibec inc. concerning this licence is attached hereto as Exhibit P-3.

[19] To facilitate understanding of my future discussion of the representations of the parties concerning the licensed use of the Mark, the declaration attached as Exhibit P-3 is reproduced in Appendix A of my decision.

[20] According to Mr. Benny's assertions, Placements [TRANSLATION] "has used and uses the Mark, directly or through its duly authorized licensee, in association with each of the classes of wares and services" identified as follows in its declaration [para. 3 and 6 of the statutory declaration]:

Wares	Identifier of classes of wares/services
Chicken	M1
Salads	M2
Pastries	M3
Fries	M4
Poutines	M5
Sandwiches	M6
Breads	M7
Sauces	M8
Spaghetti	M9
Pizzas	M10
Hamburgers	M11
Steaks	M12
Eggs	M13
Ice cream	M14
Dairy bar	M15
Coffee	M16
Tea	M17
Chocolate	M18
Soft drinks	M19
Mineral water	M20
Beer	M21
Wine	M22
Aperitif wine	M23
Services	
Restaurant operation services and delivery of prepared foods	S1

[21] According to Mr. Benny's assertions, Exhibits P-4 to P-8 prove the use of the Mark at a given time during the relevant period in association with [TRANSLATION] "the class of wares

or services, identified [sic] by the identifier of classes of wares or services indicated in the foregoing table" [para. 7 of the statutory declaration].

[22] Exhibits P-4 to P-8 are described in a table presented based on Mr. Benny's statutory declaration. This table is essentially reproduced below.

Exhibit	Description	Identifier of Wares /Services
P-4	Sample of foldable delivery box intended [sic] to contain the edible goods ordered, on which the Mark appears	M1, M2, M4, M7, M8, M19
P-5	Exterior photograph of the Licensee's restaurant, on which the sign bearing the Mark appears	S1
P-6	Photograph of the interior of the Licensee's restaurant (including enlarged portions thereof […]), showing the menu, as displayed on the wall of the Licensee's restaurant since at least January 2011, listing the edible foods offered for sale to the customers under the Mark, and which can be ordered at the Licensee's restaurant operating under the Mark	M1, M2, M3, M4, M5, M6, M7, M8, M9, M10, M11, M12, M13, M16, M17, M18, M19, M20, S1
P-7	Photograph of the interior of the Licensee's restaurant, showing promotions posted on the ice cream and milkshake wall, offered for sale to the customers under the Mark, and which can be ordered at the Licensee's restaurant operating under the Mark	M14, M15, S1
P-8	Copies of invoices, dated from 2010, concerning the manufacturing of delivery boxes, a sample of which is provided as Exhibit P-4	

[23] Finally, to facilitate understanding of my future discussion of questions raised by the representations of the Requesting Party, I reproduce, in Appendix B of my decision, what appears on the back of the delivery box attached as Exhibit P-4.

Examination of the questions in the case at bar

[24] I note from the outset that, although Mr. Benny affirms that Placements has used and uses the Mark *directly* or through its duly authorized licensee, his statutory declaration shows that all the evidence concerns the use of the Mark by Resto Servibec inc. (Resto) as licensee of Placements. In other words, there is no evidence concerning the use of the Mark by Placements *itself* during the relevant period.

[25] Therefore, the questions raised by the representations of the Requesting Party are as follows:

1. Does the evidence prove that Placements benefits from the use of the Mark by Resto?
2. Does the evidence prove the use of the Mark within the meaning of section 4(1) of the Act, in association with each of the Wares?
3. Is the Mark as used in association with the Wares the Mark as registered?
4. Does the evidence prove the use of the Mark in association with the "delivery of prepared foods" services?

[26] My examination of the first question is conclusive in the case at bar, because I conclude that it must be decided against Placements. In other words, since the answer to the first question is "no", I can conclude in favour of expungement of the registration without it being necessary to examine the other three questions. This having been said, I consider it useful to discuss some of the representations of the parties concerning the other three questions, particularly because they made admissions during the hearing.

Does the evidence prove that Placements benefits from the use of the Mark by Resto?

[27] Section 50(1) of the Act stipulates that the owner of a trade-mark must have direct or indirect control of the character or quality of the Wares or services to benefit from the use of his trade-mark by an entity licensed by the owner. For the following reasons, I consider that Placements' evidence does not prove that the use of the Mark by Resto meets the requirements of section 50(1) of the Act.

[28] Placements is not bound to indicate the conditions of the licence or to explain the real control it exercised over the character or quality of the Wares and Services. Indeed, under a section 45 proceeding, it is possible to satisfy the requirements of section 50(1) of the Act by means of a declaration whereby the owner or the licensee shows that the control required by section 50(1) actually exists [see *Mantha & Associés/Associates v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354 (F.C.A.); and *Shapiro Cohen Andrews & Finlayson v. 1089751 Ontario Ltd.* (2003), 28 C.P.R. (4th) 124 (T.M.O.B.)].

[29] In the present case, Mr. Benny only affirms that Placements licensed Resto to use the Mark. Mr. Benny makes no assertion to the effect that Placements has direct or indirect control of the character or quality of the Wares and Services under the terms of this licence.

[30] Moreover, I fully subscribe to the Requesting Party's representations to the effect that no probative force can be given to the copy of the declaration introduced as Exhibit P-3 [see Appendix A]. The fact that Mr. Benny filed the [TRANSLATION] "declaration [of Resto] concerning this licence" cannot serve to prove the veracity of the allegations contained therein. At most, I accept that Exhibit P-3 proves that Jean-Marc Lavoie, President of Resto, signed a declaration for the purpose of [TRANSLATION] Confirmation of trade-mark licence" on July 13, 2011.

[31] I consider it useful to add that the Requesting Party submitted that the copy of the declaration signed by Mr. Lavoie does not contain any assertion to the effect that Placements has direct or indirect control of the character or quality of the Wares and Services under the terms of the licence to use the Mark. I agree. Therefore, even if Mr. Lavoie had made a similar declaration in the form of a statutory declaration or affidavit, I nonetheless would have concluded the absence of evidence proving that the use of the Mark by Resto meets the requirements of section 50(1) of the Act.

Does the evidence prove the use of the Mark within the meaning of section 4(1) of the Act, in association with each of the Wares?

[32] Section 4(1) of the Act, applicable in the case at bar, defines the use of a trade-mark in association with wares as follows:

> A trade-mark is deemed to be 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.

[33] I will briefly discuss the question under consideration in two parts, namely:

a) use within the meaning of section 4(1) of the Act; and
b) use in association with each of the Wares.

Use of the Mark within the meaning of section 4(1) of the Act

[34] The Requesting Party told the hearing that it accepts that the application of the Mark on the delivery box corresponds to the application of the Mark on the packages in which the Wares would have been distributed. The Requesting Party instead submits that Mr. Benny's statutory declaration does not prove the use of the Mark in the *normal course of trade*, as required by section 4(1) of the Act.

[35] More specifically, the Requesting Party submits that due to the absence of precise allegation of sales, as such, of Wares or documentary evidence proving sales of the Wares, such as invoices, it is impossible to conclude that there were business transactions resulting in a transfer of property or possession of the Wares. I disagree.

[36] The jurisprudence clearly indicates that there is no specific type of evidence to provide in response to a notice stipulated in section 45 of the Act [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483 (F.C.T.D.) p 486]. It is sufficient to say that I agree with Placements that a reasonable reading of Mr. Benny's statutory declaration, as a whole, allows me to conclude that there were business transactions involving the Wares.

Use in association with each of the Wares

[37] During the hearing, Placements conceded that its evidence does not allow a conclusion of the use of the Mark in association with the Wares "eggs", "chocolate", "soft drinks", "beer", "wine" and "aperitif wine" set out in the registration. Placements also conceded that it has no

proof of special circumstances justifying the absence of use of the Mark in association with these wares.

[38] Therefore, even if I had concluded that Placements benefited from the use of the Mark by Resto, I would have concluded nonetheless that the registration must be amended to expunge the Wares "…eggs…chocolate, soft drinks…beer, wine, aperitif wine" set out therein.

Is the Mark as used in association with the Wares the Mark as registered?

[39] The Requesting Party submits that the Mark as used on the delivery box cannot constitute a use of the Mark as registered because the terms "LES RÔTISSERIES BENNY EXPRESS" are found on the same line [see Appendix B]. I disagree.

[40] Indeed, in my opinion, the Mark retains its essential character, namely "BENNY" displayed predominantly in combination with "LES RÔTISSERIES" and "EXPRESS". I therefore subscribe completely to Placements' representations to the effect that the difference between the position of "BENNY' in relation to "LES RÔTISSERIES" and "EXPRESS" in the Mark, as used and as registered, is inconsequential. The Mark has not lost its identity and has remained recognizable [*Canada (Registrar of Trade-marks) v. Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 (F.C.A.); and *Promafil Canada Ltd. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.)].

[41] In addition, in my opinion, the illustration of a chicken can be perceived as a trade-mark distinct from the Mark. Therefore, the illustration of a chicken near the Mark is unlikely to mislead, deceive or injure the public in any way [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)].

Does the evidence prove the use of the Mark in association with the "delivery of prepared foods" services?

[42] The Requesting Party pointed out at the hearing that the back of the box shows an address without a telephone number [see Appendix B]. Therefore, it submits that it is reasonable to conclude that the "delivery of prepared foods" services are not services offered by Resto. The

Requesting Party also noted the absence of reference to these services in the declaration attached as Exhibit P-3 [see Appendix A]

[43] Placements acknowledged at the hearing that a reasonable reading of the copy of the declaration attached as Exhibit P-3 gives reason to conclude that the services licensed to Resto are those set out in paragraph 3 of this declaration. However, as I mentioned to Placements during the hearing, the "delivery of prepared foods" services are not set out in paragraph 3 of the declaration, which Placements also acknowledged. Thus, it is reasonable to conclude that the licence granted to Resto did not cover the "delivery of prepared foods" services.

[44] Moreover, Placements also acknowledged at the hearing that it presented no evidence of special circumstances justifying the absence of use of the Mark in association with the "delivery of prepared foods" services during the relevant period.

[45] Accordingly, even if I had concluded that the evidence proves that Placements benefited from the use of the Mark by Resto, I would have concluded that the registration must be amended to expunge the "delivery of prepared foods" services set out therein.

Decision

[46] Since I consider that the evidence does not prove that the use of the Mark by Resto meets the requirements of section 50(1) of the Act, I conclude that Placements did not prove that it used the Mark in Canada, within the meaning of sections 4 and 45 of the Act, in association with each of the Wares and each of the services set out in the registration.

[47] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, I decide that registration No. TMA444,852 will be expunged pursuant to section 45 of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Arnold Bennett, trad.

Appendix A

DÉCLARATION

Le 13 juillet 2011

À : Les Placements 1360 inc. (« **Placements** »)

DE : Resto Servibec inc. (« **Resto** »)

OBJET : Confirmation de licence de marque

La soussignée, Resto, représentée par M. Jean-Marc Lavoie, son président, déclare ce qui suit :

1. La soussignée déclare avoir acquis le 11 juillet 2001 de Servibec Gestion Alimentaire inc. (« **Servibec** ») un restaurant (« **Restaurant** ») identifié sous la bannière « Rôtisseries Benny Express », situé au 250 autoroute 40, sortie 118, Lavaltrie, Québec.

2. La soussignée déclare avoir pris connaissance, lors de cette acquisition, des termes et conditions de la licence (« **Licence** »), intervenue entre 2629-7523 Québec inc. (« **2629** ») et Servibec, à titre de licencié, le 17 avril 1998, laquelle Licence est afférente à l'emploi de la marque « **RÔTISSERIES BENNY EXPRESS** et dessin») enregistrée au Canada sous le numéro LMC444852 (« **Marque** »), en liaison avec les marchandises et services énoncés ci-après. Placements est signataire à la Licence, à titre de concédant, afin d'en confirmer l'octroi et l'acceptation de ses dispositions.

3. Les marchandises et services en liaison avec lesquels la Marque est enregistrée sont les suivants :

   Marchandises : poulet, salades, pâtisseries, frites, poutines, sandwichs, pains, sauces, spaghetti, pizzas, hamburgers, steaks, œufs, crème glacée, bar laitier, café, thé, chocolat, liqueurs douces, eau minérale, bière, vin, vin apéritif.

   Services : services d'opération de restaurant.

   (« **Marchandises et Services** »)

Resto

4. La soussignée déclare et reconnaît être liée, depuis son acquisition du Restaurant en 2001, à titre de licencié, envers Placements, à titre de concédant, par les termes et conditions de la Licence, et, depuis cette date, y avoir toujours employé la Marque, dans le cadre de son exploitation, de manière constante et ininterrompue, en liaison avec toutes et chacune des catégories de Marchandises et Services, et selon les termes et modalités de la Licence.

5. La soussignée, advenant sa dérogation à l'égard de l'un ou l'autre des engagements auxquels elle a souscrits aux termes de la Licence, déclare et reconnaît que Placements, à titre de concédant, pourra exercer tous ses droits et recours selon ce qui est prévu dans un tel cas à la Licence.

Déclaré et signé à LONGUEUIL, province de Québec, à la date mentionnée ci-dessus.

RESTO SERVIBEC INC.

Par : Jean-Marc Lavoie
Jean-Marc Lavoie, président

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Appendix B


LES RÔTISSERIES Benny EXPRESS
Aire de service ESSO / Autoroute 40 (Près Joliette)