

SECTION 45 PROCEEDINGS
TRADE-MARK: MARY BROWN HAS THE BEST LEGS IN TOWN
REGISTRATION NO. TMA234,798

On June 2, 2006, at the request of Canad Corporation of Manitoba Ltd., the Registrar issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to Mary Brown’s Inc., the registered owner of registration No. TMA234,798 for the trade-mark MARY BROWN HAS THE BEST LEGS IN TOWN (the “Mark”). The Mark is registered in association with “restaurant services”.

Section 45 requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between June 2, 2003 and June 2, 2006. If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date.

What qualifies as use of a trade-mark in association with services is defined in s. 4(2) of the Act, which is reproduced below:

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.

In response to the s. 45 notice, the registered owner filed the affidavits of Albert Stone and Nigel Beattie. Each party filed a written argument. An oral hearing was not requested.

I will summarize below those portions of the evidence that I considered to be the most relevant.

Mr. Beattie is the registrant’s Vice President Operations and Development. He attests that the registrant carries on a restaurant business in Canada through corporate owned restaurants as well as franchised restaurants. As of June 2, 2006, there were approximately 68 franchisees and 1 corporate

restaurant operating in Canada. “These franchisees are all licensed to use the [registrant’s] trade-marks in association with their restaurant services and the [registrant] exercises control over the character and quality of the services in association with which the licensed marks are used pursuant to the provisions of the franchise agreement.” [paragraph 2, Beattie affidavit]

Paragraph 3 of Mr. Beattie’s affidavit reads:

On the date of the Section 45 Notice, namely June 2, 2006, and prior and subsequent to the said date, the [registrant] has been using the trade-mark MARY BROWN HAS THE BEST LEGS IN TOWN in Canada in association with restaurant services. The [registrant] has been using the trade-mark both directly and through its licensed franchisees on advertising for the restaurant services in newspapers, on business cards, in school yearbooks, to sponsor local sports teams, on flyers and in association with in-store specials.

Mr. Stone is the President of 706216 Ontario Limited (the “Franchisee”), which he attests is a franchisee of the registrant. Paragraphs 2, 3, 7 and 8 of his affidavit read:

2. The Franchisee has been a franchisee of the [registrant] since December 1988 and has been licensed, pursuant to the terms of the franchise agreement, to use the trade-marks owned by the [registrant], including the mark MARY BROWN HAS THE BEST LEGS IN TOWN, in association with the MARY BROWN’S restaurant (the “Restaurant”). The [registrant] maintains control over the character and quality of the services used in association with its trade-marks pursuant to the terms of the franchise agreement.

3. In August 2003 I agreed to sponsor a player on the local junior ice hockey team, The Central Ontario Wolves, by placing an advertisement in their souvenir program. This advertisement cost approximately \$50.00. Attached hereto and marked as Exhibit “A” is a copy of the first 11 pages from the 2003-2004 souvenir program for The Central Ontario Wolves which was distributed to all the team members, their families and the sponsors, in Lindsay, Ontario and the surrounding area. On the ninth page is an advertisement for the Restaurant services using the trade-mark MARY BROWN HAS THE BEST LEGS IN TOWN.

7. The trade-mark MARY BROWN HAS THE BEST LEGS IN TOWN has also been used on my business card continuously for at least the last 17 years. This business card is handed out to potential customers at various social events, is reproduced in newspapers and other local publications for advertising, and is distributed at the Restaurant as advertising. The business card also carries the trade-mark MARY BROWN’S FRIED CHICKEN and provides information on the Restaurant such as its address and the following: “Open 7 days a week. Catering. Group Rates”.

As I understand it, the requesting party's main submission is that the evidence provided by the registrant is insufficient to demonstrate use of the mark as required by s. 45. It submits that "the paucity of evidence is more revealing than the evidence supplied."

It is often the case that it would appear that more evidence could have been forthcoming. However, s. 45 proceedings are intended to be summary proceedings and the owner of the trade-mark is only required to provide some evidence that the registered trade-mark was being used in Canada during the relevant period in association with the wares and/or services [see *Union Electric Supply Co. Ltd. v. Registrar of Trade-marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)]. The test that has to be met by a registrant is not a heavy one; all the registrant has to do is establish a *prima facie* case of use [see *Austin Nichols & Co. v. Cinnabon, Inc.* (1998), 82 C.P.R. (3d) 513 (F.C.A.) at 525].

Returning to the evidence, I note that both a representative of the registrant and a franchisee confirm that the registrant's marks are used in Canada pursuant to licence agreements whereby the registrant controls the character and quality of the services. Such statements are sufficient to invoke the benefit of s. 50 in s. 45 proceedings [see *Fitzsimmons, MacFarlane v. Caitlin Financial Corp. N.V.* (1997), 79 C.P.R. (3d) 154 at 157; *Sim & McBurney v. LeSage Inc.* (1996), 67 C.P.R. (3d) 571].

Mr. Stone, the President of a franchise, explains how that franchise uses MARY BROWN HAS THE BEST LEGS IN TOWN. In particular, he attests that business cards displaying the mark have been distributed in Canada in various ways continuously during the relevant time period. It is true that no dated documentary evidence has been provided in support of this general attestation. However, we have been provided with one dated piece of evidence showing how the same business card has been displayed in a publication circulated in Canada in 2003/2004. I find that the appearance of the business card in this publication qualifies as advertisement of the franchised restaurant in association with the mark MARY BROWN HAS THE BEST LEGS IN TOWN. This is use in accordance with

s. 4(2) of the Act.

Based on the foregoing, I conclude that MARY BROWN HAS THE BEST LEGS IN TOWN is *bona fide* claimed by its owner as an active trade-mark. In particular, I find that the evidence shows use of MARY BROWN HAS THE BEST LEGS IN TOWN in Canada in association with restaurant services during the relevant three-year period by a party whose use enured to the benefit of the registrant.

For the foregoing reasons, registration TMA234,798 will be maintained, in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO THIS 21st DAY OF FEBRUARY 2008.

Jill W. Bradbury
Member
Trade-marks Opposition Board