



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

Citation: 2017 TMOB 63

Date of Decision: 2017-06-06

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF AN OPPOSITION

J. Benny Inc. and 88766 Canada Inc.

Opponent

and

Les Placements 1360 Inc.

Applicant

1,515,581 for www.rotisseriesbenny.com

Application

INTRODUCTION

[1] J. Benny Inc. (J. Benny) and 88766 Canada Inc. (hereinafter collectively referred to as "the Opponent") oppose the registration of the www.rotisseriesbenny.com trade-mark (the MARK), which is the object of application No. 1,515,581, in the name of Les Placements 1360 Inc. (the Applicant), for the goods and services described as follows:

[TRANSLATION] chickens, salads, pastries, fries, poutines, sandwiches, breads, spaghetti, pizzas, hamburgers, steaks, eggs, ice cream, dairy bar, coffee, tea, chocolate, soft drinks, mineral waters, beer, wine, wine aperitif (hereinafter collectively referred to as the "Goods"); and

[TRANSLATION] restaurant operation services and delivery of prepared foods (the "Services").

[2] The registration application, filed on February 16, 2011, is based on a proposed use in Canada for the Goods and on a use since at least as early as October 31, 2005 for the Services.

[3] The Opponent bases its opposition on the non-compliance of the registration application (sections 30(a), (b) and (e) of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act)) and the non-distinctiveness of the Mark (section 2 of the Act).

[4] I consider it appropriate to refuse the application in part.

THE RECORD

[5] The statement of opposition was filed on March 2, 2015. On May 12, 2015, the Applicant filed a counter statement denying the grounds of opposition argued by the Opponent.

[6] In support of its opposition, the Opponent filed as evidence in chief:

- a statutory declaration of Nicolas Filiatrault dated September 4, 2015, to which are attached Exhibits NF-1 to NF-202;
- a statutory declaration of Mr. Filiatrault dated September 14, 2015, to which are attached Exhibits NF-A to NF-G;
- a true copy of the Registrar's decision dated December 23, 2013 related to the proceedings under section 45 concerning registration TMA444,852;
- a true copy of registration TMA444,852, expunged on April 10, 2014;
- certificates of compliance relating to 9061-9966 Québec Inc., 9153-3661 Québec Inc., 9241-3178 Québec Inc., and 9278-3638 Québec Inc.

[7] The Applicant filed Mr. Frédérick Benny's statutory declaration dated January 13, 2016 to which Exhibits P-1 to P-11 were attached.

[8] The parties filed written arguments and only the Opponent participated in the hearing held in this case.

PRELIMINARY COMMENTS

[9] I have studied all the evidence of record. However, given the volume of the evidence filed by the parties, and more specifically the Opponent's evidence, I will limit myself to describing the excerpts that appear most relevant to me to rule on the grounds of opposition argued.

[10] Mr. Filiatrault represents he was employed by the Opponent J. Benny between May 2010 and December 31, 2010. Since January 1, 2011, he has been employed by Benny et Frères Inc. (Benny et Frères). He affirms that Benny et Frères and J. Benny both have their place of business at the same location and that he is aware of J. Benny's business. Finally, he represents he has access to all the documents and information concerning J. Benny and he has full authority to represent Benny & Frères and J. Benny in this opposition.

[11] Mr. Frédérick Benny's statutory declaration primarily pertains to the use of the LES RÔTISSERIES BENNY and Design trade-mark, as illustrated hereinafter:



which is not the Mark and thus has little relevance in this matter. However, the mention *www.rotisseriesbenny.com* appears on one of the exhibits filed, namely a menu (Exhibit P-9). It remains to be seen if this is a use as a trade-mark within the meaning of section 4 of the Act.

ANALYSIS OF THE GROUND OF OPPOSITION BASED ON SECTION 30(B) OF THE ACT

[12] The Opponent argues, among others, six different points based on section 30(b) of the Act, namely that:

- the Applicant did not use, as is stated in the application under opposition, the Mark in association with each of the Services;
- the mark allegedly used is not the Mark but a mark other than the one mentioned in the application under opposition;
- the date of first use claimed is erroneous;
- the Mark was not used as a trade-mark to distinguish the source of the Services;
- the alleged use of the Mark in association with each of the Services is discontinued or even absent, for all or part of the Services;
- any alleged use of the Mark was made by the Applicant or did not profit or benefit the Applicant in accordance with the relevant provisions of the Act in this regard.

The burden incumbent on the Parties

[13] It is initially up to the Opponent to establish that its opposition is well-founded. However, the legal onus of showing that the Mark is registrable falls to the Applicant, according to the balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[14] In the context of a ground of opposition based on section 30(b) of the Act, an opponent has an initial burden qualified as light [see *Loblaws Inc v NoFrills Auto Truck Rental Ltd*, 2006 FC 537]. The Opponent submits that, under this ground of opposition, it only has to present evidence that "put[s] into issue" the validity of the date of first use of the Mark alleged in this registration application [see *Friedman and Soliman Entreprises (sic), LLC v Hunky Haulers Inc*, 2017 TMOB 11].

[15] It must also be remembered section 30(b) requires that the use of the trade-marks be continuous in the normal course of trade from the date of first use claimed to the filing date of the registration application [see *Benson & Hedges Canada Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD)].

Relevant Date

[16] The relevant date to analyze this ground of opposition is the filing date of the registration application (February 16, 2011) [see *Georgia-Pacific Corp c Scott Paper Ltd*, 3 CPR (1984), (3d) 469 (TMOB)]. One of the Opponent's claims is that, according to the evidence of record, the Mark was not used by the Applicant between October 31, 2005 and October 20, 2010.

Opponent's Arguments

Applicant's Identity

[17] This registration application was filed by Les Placements 1360 Inc. This is a holding company, as indicated in the slip obtained from the Enterprise Registrar concerning this company, filed as Exhibit NF-202 in support of Mr. Filiatrault's solemn declaration of September 4, 2015. There is no mention on this slip that the Applicant would be or would have been involved in the restaurant field. Thus, in the first place, a serious doubt would exist regarding the

veracity of the Applicant's declaration in its registration application to the effect that it had used the Mark since October 31, 2005, given that it is a holding company.

[18] Moreover, this fact is corroborated by the Applicant's evidence. Indeed, Mr. Frédéric Benny, who describes himself as the Applicant's person responsible for business development and licensed franchisee relations, filed as Exhibit P-1 in support of this statutory declaration a statement of information of a legal person in the Enterprise Register concerning the Applicant. It is also indicated in this document that the Applicant is a holding company.

[19] During the hearing, the Opponent conceded it would have been possible for the Applicant to file a registration application based on a use of the mark by a predecessor in title and/or a licensee or licensees. However, on this point, the Opponent presented the evidence described hereinafter.

The Applicant's licenses and/or franchisees

[20] Mr. Benny, in paragraphs 4 to 9 inclusive of his statutory declaration, identifies the following companies as franchisees:

- LES RÔTISSERIES 3066 INC. (3066);
- BENNY BBQ LONGUEUIL INC. (LONGUEUIL);
- BENNY BBQ ST-HUBERT INC. (ST-HUBERT);
- BENNY BBQ BELOEIL INC. (BELOEIL);
- BENNY BBQ BOUCHERVILLE INC. (BOUCHERVILLE);
- BENNY BBQ LAPRAIRIE INC. (LAPRAIRIE).

[21] For each of these companies, Mr. Benny filed a copy of the Québec Enterprise Register which provides, among other information, the date of constitution of each of them and their principal activity (Exhibit P-6). He also filed a copy of the franchise contracts made with each of them (Exhibits P-3 and P-5).

[22] First of all, the Opponent argues that the registration application makes no reference to the use of the Mark by a predecessor or predecessors in title or by licensees. Moreover, BOUCHERVILLE was incorporated in 2006, whereas 3066, LONGUEUIL and ST-HUBERT were incorporated in 2008, and finally, BELOEIL and LAPRAIRIE were incorporated in 2012. Thus, none of these franchisees existed on the date of first use alleged in the registration

application. Consequently, they could not have used the Mark in association with the Services since October 31, 2005, as alleged in the registration application.

[23] Moreover, the licensing agreements for 3066, LONGUEUIL and ST-HUBERT, filed by Mr. Benny as Exhibit P-3, are all dated November 1, 2008, whereas the one with BELOEIL was made in January 2013, the one with BOUCHERVILLE in October 2012 and the one with LAPRAIRIE in November 2012 (Exhibit P-5). Thus, each of these licences was concluded subsequent to the date of first use of the Mark alleged in the registration application.

[24] I must mention that Mr. Benny alleges, in paragraph 20 of his statutory declaration, that the Applicant has been the holder of the domain name *www.rotisseriesbenny.com* since October 31, 2005, namely the date of first use alleged in this registration application. He filed, as Exhibit P-10, a copy of the online register kept by the Whois company. However, just as the incorporation date of a company does not prove the use of the trade name of that company as a trade-mark effective from that date, the registration of a domain name is not proof of the use of that domain name as a trade-mark effective from the date of its registration.

[25] As indicated previously, Mr. Benny filed certain evidence (paragraphs 10 to 16 of Mr. Benny's statutory declaration) tending to prove the use of the Mark. However, the mark to which he refers in these paragraphs is instead the LES RÔTISSERIES BENNY and Design mark reproduced above.

[26] The use of this trade-mark cannot constitute a use of the Mark [see *Canada (Registrar of Trade-marks) v Cie Internationale pour l'informatique CII Honeywell Bull, SA* (1985), CPR (3d) 523 (FCA)].

[27] During the hearing, the Opponent pointed out that the only exhibit where we find the Mark is a menu filed by Mr. Benny as Exhibit P-9. I agree with the Opponent when it argues this exhibit cannot constitute proof of use of the Mark, since the mention *www.rotisseriesbenny.com* appears below the following mentions:

Menu livraison (Delivery menu)
450-907-4644
www.bennybbq.com

[28] This is additional information provided to consumers who wish to order dishes by Internet for home delivery [see *Colba.Net inc v ColbaNet Inc* 2012 TMOB 204]. This is a second Internet address, just like *www.bennybbq.com*. I am aware that an Internet address, just like a telephone number, could be used as a trade-mark, provided that the Applicant uses it for this purpose and not as information [see *Runaway Beauty Inc v Hernandez* 2013 TMOB 79].

[29] All these reasons are sufficient to accept the ground of opposition based on section 30(b) of the Act, for the Services. Thus, I will not raise the question of whether the use of the Mark was continuous from the date of first use alleged in the registration application.

ANALYSIS OF THE GROUND OF OPPOSITION BASED ON SECTION 30(B) OF THE ACT

[30] The relevant date for the examination of the ground of opposition is the filing date of the registration application (February 16, 2011) [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB)].

[31] The registration application is based on a proposed use by the Applicant itself or through a licensee for the Goods, whereas for the Services the Applicant claimed a use of the Mark in Canada. Thus, the argument raised by the Opponent concerning the impossibility for the Applicant to have used the Mark in association with the Services due to the type of activity it carries on no longer holds true under this ground of opposition.

[32] In its written argument and during the hearing, the Opponent argued that the evidence of use of the Mark in association with the Services proves that the Applicant does not intend to use the Mark as a trade-mark in association with the Goods, but rather simply as information in the same capacity as an address or a telephone number, the whole such as it appears from the menu filed by Mr. Benny as Exhibit P-9. It referred to the following excerpt from the ruling *Pizza Ltd v Registrar of Trade-marks* (1989), 26 CPR (3d) 355 (FCA), reproduced on page 17 of the Applicant's written argument:

Domain names, despite their functional purpose, and like trade names and telephone numbers can function as trade-marks if they are in fact used as trade-marks (my underlining).

[33] The Opponent would like me to infer, from the use of the Mark on the menu (Exhibit P-9 at Mr. Benny's affidavit) as a domain name and not as a trade-mark, that the Applicant did not intend to use the Mark as a trade-mark in association with the Goods at the time the registration application was filed. I disagree.

[34] A distinction exists between the use of a trade-mark in association with services and the use of the same trade-mark in association with goods. This distinction appears clearly from the wording of the definition of use of a trade-mark, which we find in section 4 of the Act. Thus, for example, the offering of a service in Canada can be sufficient to conclude the use of a trade-mark in association with this service, provided that it is available in Canada, whereas the offering of goods for sale would not be sufficient to conclude the use of the same trade-mark in association with these Goods. In the latter case, it would be necessary to have evidence of a transfer of ownership or possession of the goods bearing the trade-mark.

[35] Although I decided previously that the Applicant did not use the Mark in association with the Services, I cannot conclude that the Applicant did not have the intention to use it in association with the Goods, for the following reasons. First of all, the registration application refers to a proposed use by the Applicant itself or one or more licensee(s), whereas for the Services, the registration application was based on a use by the Applicant alone.

[36] Moreover, there is no evidence of record of the use of the Mark in association with the Goods. I cannot infer that the Applicant intends to use it in association with the Goods in the same way it currently uses it in association with the Services. It is very possible that we would find the Mark on the packaging of the Goods and that this clearly involves a use as a trade-mark and not a reference as information, as discussed previously.

[37] The ground of opposition based on section 30(e) of the Act, for Goods, is therefore rejected, because the Opponent has not discharged its initial burden.

ANALYSIS OF THE GROUND OF OPPOSITION BASED ON SECTION 30(A) OF THE ACT

[38] The Opponent raises as a ground of opposition that the term "bar laitier" (dairy bar) does not describe a good but rather a service and that, for this good, the registration application does not contain a description in ordinary commercial terms.

[39] As evidence, Mr. Filiatrault filed excerpts from certain dictionaries in which we find definitions of the word "bar". Moreover, Mr. Filiatrault filed an excerpt from *Multi Dictionnaire de la langue française*, Marie-Éva de Villiers, Montréal, Éditions Québec Amérique, 2003, in which we find the following definition: "Bar laitier. Établissement où l'on sert principalement des produits laitiers (glace, sorbet, yaourt, lait fouetté, etc.)". (Dairy bar. Establishment that mainly serves dairy products (ice, sherbet, yogurt, milkshake, etc.)

[40] In this regard, the Applicant, in its written argument, argues that the expression "bar laitier" (diary bar) is [TRANSLATION] "commonly used in Quebec to cover the dairy products frequently offered in this type of establishment, namely milk, chocolate milk various ice creams; this is thus a terminological shortcut making it possible to describe the general category of goods related to dairy products". (my underlining)

[41] By the Applicant's admission, the expression "bar laitier" (dairy bar) refers to an establishment where certain dairy products are offered. This involves an establishment where services are offered, including the sale of certain dairy products. This term does not refer to a good or goods, just as the word "bar" might not refer to beer, for example, even though this good is sold in this type of establishment.

[42] In the circumstances, I accept the ground of opposition based on section 30(a) of the Act for the good "bar laitier" (dairy bar) only. This term thus will be expunged from the list of Goods.

ANALYSIS OF THE GROUND OF OPPOSITION BASED ON NON-DISTINCTIVENESS OF THE MARK

[43] This ground of opposition involves three parts:

- the Mark would not be distinctive because multiple entities, which would not be related to the Applicant, operate or have operated restaurants completely independent of the Applicant, or still offer or have offered, and thereby have sold similar goods in the restaurant field, in Canada, under the BENNY name or under a sign composed of or containing this word. Thus, the term BENNY alone is not distinctive in itself in association with goods and services in relation to restaurants;
- the Mark is not intended and was not intended to distinguish the Goods and Services from those of others, but is purely functional, because in this case it is only a domain name;
- the Applicant has permitted third parties, particularly Resto Servibec Inc (Servibec), to use the Mark in Canada, or a variant thereof including the term BENNY- and thereby these third parties have used it - outside the frameworks of the legislative provisions governing the use of a mark under licence and contrary to the provisions of section 50 of the Act.

[44] It is generally acknowledged that this ground of opposition must be analyzed as of the filing date of the statement of opposition (March 2, 2015) [see *Andres Wines Ltd* and *E & J Gallo Winery* (1975), 25 CPR (2d) 126 at page 130 (FCA) and *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

Agreements with Servibec

[45] I will dispose immediately of the last part of this ground of opposition. The Opponent refers to Servibec in its statement of opposition. According to the Opponent's allegations, Servibec used several trade-marks containing the term BENNY or the expression LES RÔTISSERIES BENNY, under agreements that did not comply with the provisions of section 50 of the Act. However, there is no evidence of record in this regard. This part of the ground of opposition, based on the non-distinctiveness of the Mark, is therefore rejected.

The Mark cannot be distinctive because it involves a domain name

[46] The second part of this ground of opposition is similar to one of the parts of the ground of opposition based on section 30(b) of the Act, to the effect that would have been no use of the

Mark as a trade-mark because the Mark would have been used instead as information (domain name).

[47] As more fully discussed previously, the evidence of record pertaining to the use of the Mark only concerns the Services. This evidence proves that the Mark indeed was used in association with the Services as information (domain name) for consumers and not to distinguish the Services from the services of third parties. I therefore accept this part of this ground of opposition with regard to Services.

[48] As for the Goods, I have no evidence of use of the Mark in association with these Goods as of the filing date of the statement of opposition. I have already discussed the possibility of using a domain name as a trade-mark in association with Goods. Since it is speculative to claim that the Mark will not be used as a trade-mark in association with the Goods, given that the registration application is based on a proposed use for Goods and that there is no evidence on use of the Mark on record in this regard, I reject this part of this ground of opposition concerning the Goods.

Non-distinctiveness of the Mark due to use by third parties of the word BENNY

[49] The Federal Court, in *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427, ruled that:

- a mark should be known in Canada to some extent at least to negate another mark's distinctiveness; or
- a mark could negate the distinctiveness of another mark if it is well known in a specific region of Canada.

[50] The Opponent thus had the initial burden of proving that at least one of the trade names mentioned hereinafter containing the word BENNY was known in Canada to some extent or was well known in a specific region of Canada on March 2, 2015. For the following reasons, I conclude the Opponent did not discharge its initial burden.

[51] Despite the voluminous evidence concerning the ground of opposition attacking the distinctiveness of the Mark, apart from a detailed summary of this evidence, very little was said in the Opponent's written argument regarding this evidence. Moreover, during the hearing, the

Opponent made no representation concerning the non-distinctiveness of the Mark, in view of the use of the word BENNY by third parties. I therefore intend to summarize this evidence very succinctly.

[52] This evidence of use of the word BENNY by third parties concerns the following entities:

- Bennys, in Waterloo, Ontario;
- Benny's Bistro, in Ottawa, Ontario;
- Benny's, in Burlington, Ontario;
- Chez Benny, in Montreal, Quebec;
- Chez Benny Express, in Ville Saint-Laurent, Quebec;
- Pizza Benny, in Ville Saint-Laurent, Quebec;
- Casse-Croûte chez Benny, in Saint-Anselme, Quebec;
- Benny's Bistro, in Nipawin, Saskatchewan

[53] This evidence includes, for the majority of these establishments:

- a visit to the premises (except for the establishments located in Nipawin and Saint-Anselme) by Mr. Filiatrault to take photographs and consume food;
- filing of excerpts from local and national daily newspapers and guides referring to these establishments;
- filing of excerpts from websites containing texts on each of these establishments.

[54] The Opponent proved, by Mr. Filiatrault's visits to these establishments, that they exist and operate under the trade names described above. By the publication date of some of the excerpts from the daily newspapers and guides, the Opponent proved these establishments were in operation on the relevant date. As for the name recognition of each of them, the filing of these same excerpts proves they were published on the dates mentioned therein, but these excerpts do not prove the accuracy of their contents. Moreover, I have no information as to the number of Canadians who visited these websites or the number of Canadians who read the excerpts from the daily newspapers or magazines filed by Mr. Filiatrault. Even if I can take judicial cognizance that some of the daily newspapers from which some of the excerpts filed are taken (for example, *The Globe and Mail*, *Le Droit*, *The Ottawa Citizen* and *The Gazette*) are distributed in Canada, I have no information on the number of people who could have read the excerpts filed from these newspapers.

[55] On these grounds, I conclude the Opponent did not discharge its initial burden of proving that one of these establishments was known to a certain extent in Canada or was well known in a specific region of Canada, so that the Mark would be deprived of distinctiveness.

[56] The first part of the ground of opposition based on the non-distinctiveness of the Mark is also rejected.

RESPONSES TO CERTAIN COMMENTS FORMULATED BY THE APPLICANT IN ITS COUNTER STATEMENT AND ITS WRITTEN ARGUMENT

[57] First of all, for the majority of the grounds of opposition argued by the Opponent, the Applicant points out, in its written argument, that it does not know the basis on which the Opponent raises each of the grounds of opposition argued. Yet the Applicant has never filed a motion to obtain the expungement of these grounds of opposition on the pretext they were argued insufficiently. Moreover, the Federal Court of Appeal in *Novopharm v AstraZeneca AB*, 2002 FCA 387, 21 CPR (4th) 289 has clearly indicated that once the evidence is filed, a ground of opposition must be read in conjunction with this evidence. There is no doubt in mind, once the Opponent's evidence was filed on the record, that the Applicant knew or should have known what it had to face in this opposition.

[58] The Applicant mentioned in its counter statement that the opposition should be rejected on the ground that it was filed by [TRANSLATION] "two opponents acting jointly, which is contrary to the provisions set out in section 38(1) of the Act". No jurisprudence was cited by the Applicant in its written argument to support this position. Moreover, section 38(1) stipulates "any person." This expression does not limit the filing of a statement of opposition to a single entity. Also, in *Practice in Trademark Opposition Proceedings*, in force since March 31, 2009, it is clearly provided in Division III that a statement of opposition may jointly cite any number of persons as opponents.

DECISION

[59] Under the powers delegated to me pursuant to section 63(3) of the Act, I refuse the registration application in application of section 38(8) of the Act for Services and for the "bar

laitier" (dairy bar) good, and I reject the opposition for Goods except for the "bar laitier" (dairy bar) good [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority in the matter of split decisions].

Jean Carrière
Member
Trade-marks Opposition Board
Office de la propriété intellectuelle du Canada

Certified translation
Arnold Bennett

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS REGISTERED IN THE CASE**

DATE OF HEARING: 2017-04-25

APPEARANCES

Barry Gamache

FOR THE OPPONENTS

No appearance

FOR THE APPLICANT

AGENT(S) IN THE CASE

Robic

FOR THE OPPONENTS

De Granpré (sic) Chait

FOR THE APPLICANT