



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

Citation: 2018 TMOB 89
Date of Decision: 2018-08-01
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF AN OPPOSITION

J. Benny Inc. and 88766 Canada Inc. **Opponent**
and

Les Placements 1360 Inc. **Applicant**

1,500,671 for BENNY BAR B Q **Application**

INTRODUCTION

[1] J. Benny Inc. (J. Benny) and 88766 Canada Inc. (hereinafter collectively referred to as “the Opponent”) oppose the registration of the BENNY BAR B Q trade-mark (the Mark), which is the object of application No. 1,500,671, in the name of Les Placements 1360 Inc. (the Applicant), for the goods and services described as follows:

[TRANSLATION] Chicken; salads; pastries; fries; poutines; non-alcoholic beverages, namely soft drinks, bottled water, fruit juice, vegetable juice, milk, coffee, tea, hot chocolate; sandwiches; breads; sauces. (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 October 21, 2010, and amended on February 2, 2015, is based upon a use in Canada by the Applicant itself since at least October 1963 in association with the Goods and the Services.

[3] The Opponent bases its opposition on the non-compliance of the registration application (section 30(b) 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.

THE RECORD

[5] The statement of opposition was filed on February 23, 2016. On July 5, 2016, 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:

- true copy of the registration of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, registration number TMA442,852;
- true copy of the letter from the Registrar dated January 15, 2014, from the record of registration of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, registration number TMA442,852;
- true copy of the original registration application for the Mark dated October 21, 2010, and the revised application dated February 2, 2015;
- true copy of the letter from Bélanger, Sauvé dated May 9, 1990, and attachments and the letter from the Registrar dated September 12, 1990, as well as the original application dated May 30, 1989, filed in the registration record of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, registered under number TMA444,852;
- true copy of the letter from the Registrar to De Grandpré Chait dated April 10, 2014, from the record of registration of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, registered under number TMA444,852, as well as the letter of the Registrar to Les Placements 1360 Inc. dated April 28, 2011;
- true copy of the original registration application of the LES RÔTISSERIES BENNY dessin (design) trade-mark dated February 21, 1992, which was registered under number TMA394,413 as well as the letter from Bélanger Sauvé dated May 9, 1990, and the corrected letter from the Registrar dated May 17, 1994;

- true copy of Pierre Benny’s statutory declaration dated July 18, 2011, including Exhibit P-7 to which it refers, filed in the context of an opposition to registration of the BENNY&CO trade-mark. AU COQ ROULANT & dessin (design), application number 1,305,413 filed on June 14, 2006, which was abandoned on February 20, 2014;
- true copy of the statutory declaration of Pierre Benny, President of the Applicant, dated July 18, 2011, from the record of registration of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, application number 633,365, registered under number TMA444,852;
- Statutory declaration of Nicolas Filiatrault dated November 4, 2016, and Exhibits NF-1 to NF-8;
- Statutory declaration of Yves Benny dated November 7, 2016, and Exhibits YB-1 to YB-17;
- Statutory declaration of Nicolas Filiatrault dated November 4, 2016, and Exhibits NF-A to NF-J;

[7] The Applicant filed no evidence;

[8] Only the Opponent filed a written argument and was represented at the hearing.

PRELIMINARY REMARKS

[9] I have studied all the evidence of record. However, given the volume of evidence adduced by the Opponent, the absence of evidence adduced by the Applicant, the absence of written arguments by the applicant, and its absence at the hearing, I will limit myself to describing excerpts from the Opponent’s evidence that appear to be the most relevant to rule on the only ground of opposition to be raised in this decision.

[10] I must mention that the registration TMA444,852 for the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark was expunged on April 10, 2014, for default of proving its use, after the sending of a notice by the Registrar under the provisions of section 45 of the Act.

[11] 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”. The Registrar rejected this argument in *J Benny Inc and 88766 Canada Inc v Les Placements 1360 Inc*, 2017 TMOB 63 (CanLII), opposing the same parties as in this case.

[12] Finally, I must mention that, such as it appears from the evidence of record, the parties have been involved in various disputes, both before the Registrar (oppositions and proceedings under section 45 of the Act) and before the Quebec Superior Court. Thus, they are not unknown to each other.

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

[13] The Opponent argues, among others, seven different points based on section 30(b) of the Act: However, for the purposes of this decision, I will only address the sixth point, which can be summarized as follows:

- There has not been continuous use of the Mark, in the normal course of trade, since the date of first use claimed (paragraph 1.6 of the statement of opposition).

The burden incumbent on the Parties

[14] 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)].

[15] 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 allegations contained in this registration application [see *Friedman and Soliman Entreprises (sic), LLC v Hunky Haulers Inc*, 2017 TMOB 11].

Relevant Date

[16] The relevant date to analyze this ground of opposition is the filing date of the registration application (October 21, 2010) [see *Georgia-Pacific Corp v Scott Paper Ltd*, 3 CPR (1984), (3d) 469 (TMOB)].

Opponent's Arguments

[17] This registration application is based on a use of the Mark in association with the Goods and the Services since October 1963. The Opponent argues that use of the Mark ceased following the adoption of Bill 101 in Quebec. Thus, since at least 1987, the Applicant has not used the Mark but rather the LES RÔTISSERIES BENNY trade-mark.

[18] In this regard, the Opponent submitted as evidence the statutory declaration of Mr. Pierre Benny, President of the Applicant, dated July 18, 2011, filed in the context of an opposition by the Applicant to registration application number 1,305,413 filed by the Opponent for registration of the BENNY&CO trade-mark. AU COQ ROULANT & dessin (design).

[19] Moreover, the Opponent refers to Mr. Nicolas Filiatrault's statutory declaration, dated November 4, 2016, in which he filed excerpts from telephone directories for Montréal's South Shore for the years 1984, 1985, 1986, 1987, 1988–1989, 1989–1990 and 1990–1991 [see paragraphs 14 to 17 and Exhibits NF-D to NF-J in his affidavit].

[20] Concerning Mr. Pierre Benny's statutory declaration, the Opponent refers to paragraph 12, which reads as follows:

[TRANSLATION] Evidence of use of the word "BENNY" by [the Applicant] in the context of its activities over the years in the fast food field is submitted, in looseleaf, as Exhibit P-7, which includes the following items:

- a. Photograph of the business at its beginnings;
- (...)
- g. New sign in the 90s.

[21] The description of some of the exhibits filed under Exhibit P-7 to which reference is made therein reads as follows:

[TRANSLATION] 7.3 photograph, dating from the 1970s, of an establishment in front of which are found the "Benny Bar B Q" sign and vehicles bearing this mark:

(...)

7.7 photograph of the sign with the new name "Les Rôtisseries Benny", changed after the adoption of Bill 101.

[22] Regarding the excerpts from telephone directories filed by Mr. Filiatrault, we find the following mention for the years 1984, 1985 and 1986:

Benny Bar-B-Q..... – Voir Rôtisseries Benny Inc (les). [See Rôtisseries Benny Inc (les)].

[23] For the subsequent years, there is no reference to a business operating under BENNY BAR-B-Q but we find “Les Rôtisseries Benny Inc.”

[24] Thus, according to the Opponent, the Applicant has not used the Mark continuously since the date of first use alleged in its registration application, namely October 1963. This would be contrary to the lessons of the jurisprudence on the question [see *Loblaws Inc. v No Frills Auto and Truck Rental Ltd*, 2006 FC 537 (CanLII) at paragraph 39].

[25] According to the Opponent, all this evidence would be sufficient to satisfy its light burden and put into issue the Applicant’s assertion that it had used the Mark itself since October 1963.

[26] This portion of the evidence leads me to conclude that I am satisfied that the Opponent has put into issue the continuous use of the Mark by the Applicant since October 1963. This use seems to have been abandoned in the mid-1980s or early 1990s in favour of a francized version, namely LES RÔTISSERIES BENNY.

[27] The Opponent having discharged its light initial burden, it was up to the Applicant to prove that it continued to use the Mark in association with the Goods and Services continuously up to October 21, 2010, namely the date of filing of this registration application.

[28] Since the Applicant adduced no evidence of record, it did not discharge its burden.

Conclusion

[29] It is therefore appropriate to accept this ground of opposition on the grounds described above.

OTHER GROUNDS OF OPPOSITION

[30] Since the Applicant did not adduce evidence or file a written argument and did not attend the hearing, I find there is no reason to address the other grounds of opposition.

DISPOSAL

In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I refuse the application for registration in application of subsection 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Arnold Bennett

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

DATE OF HEARING: 2018-07-09

APPEARANCES

Barry Gamache

FOR THE OPPONENTS

No appearance

FOR THE APPLICANT

AGENT(S) OF RECORD

Robic

FOR THE OPPONENTS

De Granpré (*sic*) Chait

FOR THE APPLICANT