



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

**Citation: 2018 TMOB 88**  
**Date of Decision: 2018-08-01**  
**[UNREVISED ENGLISH**  
**CERTIFIED TRANSLATION]**

**IN THE MATTER OF AN OPPOSITION**

<b>J. Benny Inc. and 88766 Canada Inc.</b>	<b>Opponent</b>
<b>and</b>	
<b>Les Placements 1360 Inc.</b>	<b>Applicant</b>
<b>1,500,514 for LES RÔTISSERIES BENNY</b>	<b>Application</b>

INTRODUCTION

[1] J. Benny Inc. (J. Benny) and 88766 Canada Inc. (hereinafter collectively referred to as “the Opponent”) oppose the registration of the LES RÔTISSERIES BENNY trade-mark (the Mark), which is the object of application No. 1,500,514, 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 20, 2010, and amended twice, is based upon a use in Canada by the Applicant itself since at least October 1981 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 20, 2010, and the revised application dated September 10, 2012;
- true copy of the letter from Bélanger, Sauvé dated May 9, 1990, and attachments and the letter from the Registrar dated September 12, 1990, 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, registration number TMA444,852;
- true copy of the original application dated May 23, 1989, and the letter from Bélanger Sauvé dated May 9, 1990, as well as the corrected letter from the Registrar dated May 17, 1994, from the record of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, registered under number TMA444,852;

- 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.

[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, six different points based on section 30(b) of the Act: However, for the purposes of this decision, I will only address the second point, namely that:

- the Applicant omitted to designate a predecessor in title, contrary to the provisions of section 30(b) of the Act (paragraph 1.2 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 20, 2010) [see *Georgia-Pacific Corp v Scott Paper Ltd*, 3 CPR (1984), (3d) 469 (TMOB)].

### **Opponent’s Arguments**

[17] The first registration application was filed by Les Placements 1360 Inc. However, the Opponent argues, this is a holding company as indicated in the statement obtained from the Enterprise Registrar (CIDERQ) [*sic*] concerning this company, filed as Exhibit P-1 in support of the statutory declaration of Mr. Pierre Benny (President of the Applicant) dated July 18, 2011, which was filed in the context of proceedings following the issuing of a notice of the Registrar

under section 45 of the Act concerning registration TMA444,852 for the LES ROTISSERIES BENNY EXPRESS dessin (design) trade-mark. All this documentation was filed by the Opponent by way of certificates of authenticity issued by the Registrar.

[18] The Opponent points out that there is no mention on this CIDREQ statement 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 1981, given that it is a holding company.

[19] Moreover, the Opponent argues that the Applicant omitted to designate a predecessor in title, contrary to the provisions of section 30(b) of the Act. Indeed, this registration application is based on a use of the Mark by the Applicant itself since at least October 1981, without reference to a predecessor in title.

[20] Yet the Opponent submits, such as it appears from the true copy of the original application for registration of the LES RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, filed on May 30, 1989, application number 633,365 and subsequently registered under number TMA444,852, that Les Rôtisseries Benny Inc. filed this registration application alleging a use of this trade-mark.

[21] The Opponent also refers to the registration application filed by Les Rôtisseries Benny Inc. on May 23, 1989, for the LES RÔTISSERIES BENNY design mark on May 23, 1989, in which it alleges a use of this trade-mark. On this subject, it is appropriate to consult the true copy of the original application dated May 23, 1989, for the registration application of this trade-mark bearing number 632,691, which mark was registered on February 21, 1992, under number TMA394,413.

[22] The Opponent points out that the evidence of record shows that these two registration applications (numbers 633,365 and 632,691) were assigned to the Applicant in 1990 [in this regard, see the letters from Bélanger Sauvé dated May 9, 1990, filed in cases 633,365 and 632,691, which are part of the certificates of authenticity issued by the Registrar concerning these cases].

[23] Consequently, the Opponent points out, how could the Applicant claim to have used the Mark since October 1981, when the LES RÔTISSERIES BENNY and LES RÔTISSERIES BEENY (*sic*) EXPRESS design marks were used by Les Rôtisseries Benny Inc. according to the registration applications concerning them.

[24] Consequently, according to the Opponent, the Applicant should have designated a predecessor in title or claimed a date of first use excluding any period when Les Rôtisseries Benny Inc. alleged a use for the LES RÔTISSERIES BENNY and LES RÔTISSERIES BENNY EXPRESS design marks.

[25] The Opponent also argues that this registration application was amended at least twice to change the date of first use of the Mark and the Applicant's name, because a clerical error had been made in this regard during the filing of the initial registration application. Yet at no time during the filing of these revised applications did the Applicant see fit to amend its initial registration application to identify the predecessor(s) in title who would have used the Mark since the date of first use alleged in this registration application up to the date of filing of the registration application.

[26] The Opponent submits that the Applicant has provided no evidence to answer the following question:

How could the Applicant have affirmed in 2010 that it had used the Mark in Canada since October 1981 when, in 1989, Les Rôtisseries Benny Inc. alleged it used the LES RÔTISSERIES BENNY and LES RÔTISSERIES BENNY EXPRESS design marks?

[27] 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 1981.

[28] I am perfectly aware that all this evidence concerns the LES RÔTISSERIES BENNY and LES RÔTISSERIES BENNY EXPRESS design marks. However, as noted by the Opponent during the hearing, there is a strong similarity between these two trade-marks and the Mark. Moreover, in the statutory declaration of Pierre Benny, President of the Applicant, dated July 18, 2011, and filed in the context of the proceedings under section 45 concerning the LES

RÔTISSERIES BENNY EXPRESS dessin (design) trade-mark, he filed samples of delivery boxes as Exhibit P-4, to prove the use of this mark. However, one of these boxes does not bear the mark in question in said case, but rather bears the Mark.

[29] All this evidence leads me to conclude that I am satisfied that the Opponent put into issue the use of the Mark by the Applicant itself and that, for the rest, it omitted to identify the predecessor in title Les Rôtisseries Benny Inc. in its registration application.

[30] Since the Opponent discharged its light initial burden, it was up to the Applicant to prove that it had used the Mark itself since at least October 1981 in association with the Goods and the Services.

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

### **Conclusion**

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

### OTHER GROUNDS OF OPPOSITION

[33] 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.

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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**

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**HEARING DATE: 2017-07-09**

**APPEARANCES**

Barry Gamache

FOR THE OPPONENTS

No appearance

FOR THE APPLICANT

**AGENT(S) OF RECORD**

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FOR THE OPPONENTS

De Granpré (*sic*) Chait

FOR THE APPLICANT