

TRADUCTION/TRANSLATION

PROCEEDINGS UNDER SECTION 45 OF
THE *TRADE-MARKS ACT*
CERTIFICATION MARK: MARCHÉ EXTRA & DESIGN
REGISTRATION NO.: 412,448

On July 8, 2003, at the request of Provigo Distribution Inc., the Registrar sent the notice prescribed in section 45 of the Act to Metro Richelieu Inc., the registered owner of the above-mentioned registration.

The certification mark MARCHÉ EXTRA & Design (shown below) is registered in association with the following services:

services: operation of food stores and convenience stores



Section 45 of the *Trade-marks Act* requires that the registered owner of the trade-mark indicate whether the trade-mark was in use in Canada in association with each of the wares or services specified in the registration at any time during the three year period immediately preceding the date of the notice and, if not, the date when it was last so in use and the reason for the absence of

such use since that date.

The affidavit of Pierre Laliberté was provided. Both parties filed written submissions and were represented at the hearing.

Mr. Laliberté, director of middle banners development for the Western region for Metro Richelieu Inc., indicates that he is familiar with the facts alleged in his affidavit, either by personal knowledge or after consulting the trade-mark holder's registers. He claims that the holder has been operating food stores and convenience stores under the mark in the province of Quebec for at least seven years (his affidavit is dated December 17, 2003). He points out that the holder does not operate the food stores and convenience stores under the mark but that on December 17, 2003, it licensed over 145 food stores and convenience stores to operate under the mark in accordance with the defined standards in the province of Quebec. He adds that the overwhelming majority of these food stores and convenience stores operated under the mark prior to July 16, 2003.

He explains that the food stores and convenience stores licensed to operate under the mark each signed a commercial agreement similar to the one produced as Exhibit A and that under that commercial agreement, they undertook to comply with the sales policies of the Marché Extra! & Design banner. As Exhibit B, he attaches what he describes as a photograph of a food store displaying the mark. As Exhibit C, he attaches flyers advertising the products sold at the food

stores and convenience stores displaying the mark. As Exhibit D, he attaches an advertisement which appeared in the *Journal L'Alimentation* in March 2000. As Exhibit E, he attaches an excerpt from the holder's site advertising the Marché Extra! & Design banner.

The applicant raises a number of arguments, the main ones being that the evidence provided by the owner is not admissible, does not meet the requirements of section 45 of the Act and does not demonstrate that the certification mark was used in accordance with the specific requirements applicable to certification marks at any time during the relevant period.

Section 2 of the Act defines a trade-mark as follows:

“trade-mark”

(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,

(b) a certification mark,

©) a distinguishing guise, or

(d) a proposed trade-mark.

With respect to the use of a trade-mark in association with services, subsection 4(2) provides as follows:

(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.

Specifics of a certification mark

Section 2 defines a certification mark as follows:

“certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to

- (a) the character or quality of the wares or services,
 - (b) the working conditions under which the wares have been produced or the services performed,
 - (c) the class of persons by whom the wares have been produced or the services performed, or
 - (d) the area within which the wares have been produced or the services performed,
- from wares or services that are not of that defined standard.

In addition, subsections 23(1) and (2) of the Act, involving certification marks, provides as follows:

(1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

(2) The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

Therefore, according to subsection 23(1) of the Act, it is clear that the owner of a certification mark cannot use the mark in association with services covered by the registration. Furthermore, the owner may license others to use the mark in association with services that meet the defined standard (subsection 23(2)).

Admissibility of evidence

The requesting party submits that where the Act does not authorize the owner to use the mark, it challenges the validity of the entire affidavit. The requesting party submits that the affidavit is

inadmissible considering that it is made by a representative for the holder. In addition, the requesting party submits that under the best evidence rule, evidence of use of the mark, if any, should have been provided by a licensee authorized by the owner.

Contrary to what the requesting party claims, neither the Act nor the case law prohibits the owner of a certification mark to provide evidence of use in the context of proceedings under section 45. In addition, as mentioned in the owner's written submission, the owner licenses others to use the mark in association with services that meet the defined standard and seeing as Mr. Lalbert indicates in paragraph 1 of his affidavit that he is familiar with the facts alleged in his affidavit, either by personal knowledge or after consulting the trade-mark holder's registers, I accept that he is competent to testify as to the use of the certification mark by those licensed by the owner.

Use of the certification mark

Mr. Lalbert clearly states that the owner of the mark does not operate the food stores and convenience stores under the mark (para. 4 of the affidavit) but that on the date of his affidavit it licensed over 145 food stores and convenience stores to operate under the mark in accordance with the defined standards in the province of Quebec. In addition, he claims under oath that each food store and convenience store licensed to operate under the mark signed an agreement which refers to standards defined by the owner. In view of the foregoing, I accept that if the evidence shows the use of the mark during the relevant period by licensed food stores and convenience stores, than the use was by the owner in accordance with subsection 23(2) of the Act.

Therefore, the issue to determine is whether the mark was used by licensed food stores and convenience stores in association with services during the relevant period.

Although Mr. Laliberté claims that the majority of the 145 licensed food stores and convenience stores operated under the mark prior to July 16, 2003, he does not explain what he means by ‘prior to July 16, 2003’ and as mentioned by the requesting party I cannot presume that that coincides with the relevant period. In *Plough Canada Ltd. v. Aerosol Fillers Inc.*, 45 C.P.R. (2d) 194 at pp. 198 and 199 - aff’d 53 C.P.R. (2d) 62, the Court emphasized the following regarding ambiguity in an affidavit: The allegations in an affidavit should be precise. . . . It should not be susceptible of more than one interpretation and if it is then the interpretation adverse to the interest of the party in whose favour the document was made should be adopted. Here, it would have been easy for Mr. Laliberté to be more precise but he chose otherwise.

Furthermore, where Exhibit B is concerned, which Mr. Laliberté describes as a photograph of a food store displaying the mark, seeing as Mr. Laliberté does not confirm that the food store in question existed during the relevant period, I cannot conclude that the photo shows use of the mark during the relevant period.

Moreover, I accept that the flyers (Exhibit C to the affidavit) confirm that food stores and convenience stores operated under the *Marché Extra! & Design* banner during the relevant period as the evidence shows the existence of flyers during the relevant period advertising products sold

in the food stores and convenience stores displaying the mark. I do not believe that flyers advertising prices in effect during the relevant period at Marché Extra! & Design businesses would have been printed if there were no food stores and convenience stores operating under the Marché Extra! & Design banner during the relevant period. Therefore, as raised by the owner, the very existence of these flyers advertising prices in effect particularly for the week of April 21, 2003, to April 27, 2003, the week of June 30 to July 6, 2003, and the week of July 7, 2003, for products sold in the food stores and convenience stores displaying the Marché Extra! & Design mark, is evidence that food stores and convenience stores displaying the mark were operated during the relevant period.

Furthermore, considering the whole of the evidence, I accept that these food stores and convenience stores were part of the 145 food stores and convenience stores licensed by the owner to operate under the mark in accordance with the standard defined by the owner and that, therefore, they operated under the Marché Extra! & Design banner (the mark as registered) during the relevant period. Therefore, since I accept that these businesses operated during the relevant period, I accept that the services were rendered during the relevant period in association with the MARCHÉ EXTRA! & Design trade-mark.

In view of the foregoing, I find that the registration of the mark should remain on the register.

DATED AT GATINEAU, QUEBEC, THIS 21ST DAY OF DECEMBER 2006.

D. Savard
Senior Hearing Officer
Section 45

