



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

**Citation: 2013 T.M.O.B. 230**  
**Date of Decision: 2013-12-23**

**TRANSLATION**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Sim & McBurney against registration No.  
TMA394,413 for the trade-mark LES RÔTISSERIES  
BENNY & Design in the name of Les Placements 1360  
Inc.**

[1] This decision pertains to a summary expungement proceeding requested against registration No. TMA394,413 for the trade-mark LES RÔTISSERIES BENNY EXPRESS & Design (the Mark) reproduced below:



[2] The Wares and Services covered by the registration are:

Wares: chickens, salads, pastries, fries, poutines, non-alcoholic beverages [sic], sandwiches, breads, sauces (the Wares).

Services: restaurant operation services and delivery of prepared foods (the Services).

[TRANSLATION]

[3] For the following reasons, I conclude in favour of maintenance of the registration.

The proceeding

[4] On April 28, 2011, the Registrar addressed a notice under section 45 of the *Trade-Marks Act*, RSC (1985), c. T-13 (the Act) to Les Placements 1360 Inc. (Placements), registered owner of registration No. TMA394,413. This notice was addressed at the request of Sim & McBurney (the Requesting Party).

[5] The Registrar's notice enjoined Placements to prove the use of the Mark in Canada, at some time between April 28, 2008 and April 28, 2011, in association with each of the wares and each of the services specified in the registration. In the absence of use, the Registrar's notice enjoined Placements to prove the date when the Mark was used for the last time and the reason for its absence of use since that date.

[6] It is well established that the purpose and the scope of section 45 of the Act are to provide for a simple, summary and expeditious procedure for removing "deadwood" from the register. The criterion for establishing use is not demanding and an overabundance of evidence is unnecessary. However, sufficient facts must be presented to allow the Registrar to conclude that the trade-mark was used in association with each of the wares or services mentioned in the registration during the relevant period [see *Uvex Toko Canada Ltd. v. Performance Apparel Corp.* (2004), 31 C.P.R. (4th) 270 (F.C.)]. Bare allegations of use are insufficient to prove the use of the Mark [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)].

[7] In response to the Registrar, Placements filed a statutory declaration by its president, Pierre Benny, made on July 18, 2011.

[8] Only Placements filed written representations.

[9] The Requesting Party and Placements were both represented at the hearing held on August 27, 2013 jointly with the hearing concerning the summary expungement proceeding regarding registration No. TMA444,852 for the trade-mark LES RÔTISSERIES BENNY EXPRESS Design. The latter proceeding is the subject of a separate decision.

[10] On August 21, 2013, less than one week before the hearing, Placements requested a retroactive extension of time for filing an additional statutory declaration by Pierre Benny, in order to complete his evidence in response to the Registrar's notice. Before proceeding any further, I will rule officially on this request, which I rejected at the beginning of the hearing.

Request for retroactive extension of time

[11] Below, I reproduce the second paragraph and part of the third paragraph of the letter of August 21, 2013, which essentially state the reasons invoked by Placements in support of its request for retroactive extension of time.

A rereading of the affidavit [sic] of Mr. Pierre Benny, initially submitted, shows that certain additional information would specify the use made of the Mark, adequately complete the evidence and dispel any ambiguity in this regard. We understand, given the fact that Mr. Pierre Benny cannot be cross-examined [sic] on his affidavit [sic], and even though the section 45 proceeding is one that need not be excessively technical, that the concept of use nonetheless must be adequately "proved".

We are well aware of the fact that this request is made very late in the process; we respectfully submit, however, that the purpose of this additional declaration is only to complete the evidence already submitted, and that the necessity of these clarifications appeared useful or necessary only upon rereading the status of the file in anticipation of the next hearing. [...]

[TRANSLATION]

[12] For the following reasons, Placements' representations did not convince me that its failure to file the proposed evidence within the time limit, namely on or before July 28, 2011, was not reasonably avoidable, as required by section 47(2) of the Act.

[13] There was no representation by Placements allowing a conclusion that the proposed evidence was unavailable at the time of preparation of Mr. Benny's first statutory declaration. Moreover, the fact that Placements realized the necessity for clarifications only upon rereading the file in anticipation of the hearing is not clearly a fact that existed on or before July 28, 2011.

[14] Therefore, I will disregard Mr. Benny's additional statutory declaration in considering the evidence in the file of this proceeding.

### Summary of the representations of the Requesting Party

[15] At the hearing, the Requesting Party first submitted that the right of use granted to Placements' franchisees concerns the word mark LES RÔTISSERIES BENNY, instead of the Mark, and is limited to the operation of a restaurant, especially a rotisserie. Subject to its position regarding the right of use granted to the franchisees, the Requesting Party made additional representations on the evidence.

[16] In general, these additional representations on the evidence introduced regarding the Wares are to the effect that:

- a) the evidence does not prove the use of the Mark within the meaning of section 4(1) of the Act, applicable in the case at bar;
- b) the evidence does not prove the use of the Mark during the relevant period;
- c) the evidence does not prove the use of the Mark in association with each of the Wares; and
- d) the Mark as used is not the Mark as registered.

[17] Concerning the Services, the Requesting Party agrees that the evidence is sufficient to conclude the Services were performed during the relevant period. However, it submits that the Mark as used, within the meaning of section 4(2) of the Act, is not the Mark as registered.

[18] Before examining the questions raised by the representations of the Requesting Party, I will review the evidence provided by Pierre Benny in his statutory declaration of July 18, 2011, including his Exhibits P-1 to P-10.

### The evidence

[19] In addition to providing corporate information concerning Placements, Mr. Benny refers to the constitution in 2008 of the three companies identified below, which are franchisees of Placements in Québec.

1. LES RÔTISSERIES 3066 INC., operating at 2800 Chemin Chambly, Longueuil.

2. BENNY BBQ LONGUEUIL INC., operating at 1360 Boulevard Ste-Foy, Longueuil.
  3. BENNY BBQ ST-HUBERT INC., operating at 5500 Grande-Allée, St-Hubert.
- (hereinafter sometimes collectively called “the franchisees”)

[20] I note in passing that the Requesting Party rightly mentions that the certificates of constitution of the three corporations show they were constituted before 2008, contrary to Mr. Benny’s assertion [Exhibit P-2 of the statutory declaration]. However, the Requesting Party acknowledges that this contradiction in the evidence is inconsequential in the case at bar.

[21] Since the Requesting Party’s representations regarding the rights granted to the franchisees are based on paragraph 4 of Mr. Benny’s statutory declaration, I consider it useful to reproduce it below. I note that the Requesting Party accepts that the term “Opponent” in the paragraph in question refers to Placements.

Each of these corporations signed, as franchisee [sic], a franchise agreement with the Opponent, as franchisor, dated November 1, 2008, April 1, 2008 and April 1, 2008 respectively, granting them a licence to use the Mark, and giving them each the right to operate a fast food establishment under the mark “Les Rôtisseries Benny”. Copies of the three franchise agreements are attached [sic] hereto as Exhibit P-3.

[TRANSLATION]

[22] According to Mr. Benny’s assertions, Placements [TRANSLATION] “has used and uses the Mark, directly or through its duly authorized franchisees, in association with each of the classes of wares and services” identified as follows in its declaration [para. 5 and 7 of the statutory declaration]:

<u>Wares</u>	<u>Identifier of classes of wares/services</u>
Chickens	M1
Salads	M2
Pastries	M3
Fries	M4
Poutines	M5
Non-alcoholic beverages	M6
Sandwiches	M7

Breads	M8
Sauces	M9
<u>Services</u>	
Restaurant operation services and delivery of prepared foods	S1

[23] According to Mr. Benny’s assertions, Exhibits P-5 to P-10 prove the use of the Mark at a given time during the relevant period in association with [TRANSLATION] “the class of wares or services, identified by the identifier of classes of wares or services indicated in the foregoing table” [para. 8 of the statutory declaration].

[24] Exhibits P-5 to P-10 are described in a table presented based on Mr. Benny’s statutory declaration. This table is essentially reproduced below.

Exhibit	Description	Identifier of Wares /Services
P-5	Sample of foldable delivery box intended [sic] to contain the edible goods ordered, on which the Mark appears	M1, M2, M4, M6, M8, M9, S1
P-6	Exterior photographs of the Licensee’s restaurants, on which a sign bearing the Mark has been erected for several years	S1
P-7	Photographs of the vehicles, on which [sic] the sign bearing the Mark appears	S1
P-8	Sample of a menu from 1360 Ste-Foy, Longueuil, on which the drawing of a vehicle bearing the Mark appears, as well as a copy of the menu accessible on the website [sic] [of Placements] (address: <a href="http://www.bennybarbq.com">www.bennybarbq.com</a> )	M1, M2, M3, M4, M5, M6, M7, M8, M9, S1
P-9	Copies of invoices, dated from 2010, concerning the manufacturing of delivery boxes, a sample of which is provided as Exhibit P-5	
P-10	Stationery, including envelope, business card, fax form, personnel hiring forms, notepad sheets	S1

[25] Finally, to facilitate understanding of my future discussion of the representations of the parties concerning the Mark as used in relation to the Mark as registered, the specimens of use

attached as Exhibits P-5 to P-8 are reproduced in whole or in part in Appendices A to D of my decision.

Examination of the questions in the case at bar

[26] I recall that the Requesting Party does not challenge that the evidence allows it to be concluded that the Services were performed during the relevant period. However, the Requesting Party submits that the Mark, as used in association with the Services, is not the Mark as registered.

[27] Therefore, the questions raised by the representations of the Requesting Party are as follows:

1. Does the right of use granted under the terms of the franchise agreement concern the Mark and, if applicable, is it limited to “restaurant operation services”?
2. Does the evidence prove the use of the Mark within the meaning of section 4(1) of the Act, during the relevant period, in association with each of the Wares?
3. Is the Mark as used in association with the Wares and Services the Mark as registered?

[28] I will examine these questions in turn.

Does the right of use granted under the terms of the franchise agreement concern the Mark and, if applicable, is it limited to “restaurant operation services”?

[29] I will mention from the outset that the Requesting Party accepts that the evidence submitted by Placements is sufficient to prove that the use of any trade-mark covered by the franchise agreements meets the requirements of section 50(1) of the Act for the purposes of this procedure. Section 50(1) of the Act stipulates that the owner of a trade-mark must have direct or indirect control of the character or quality of the wares or services to benefit from the use of his trade-mark by an entity licensed by the owner.

[30] The Requesting Party’s representations are to the effect that the right of use granted to the franchisees concerns the word mark LES RÔTISSERIES BENNY, instead of the Mark, and is limited to the operation of a restaurant, more specifically a rotisserie.



[31] With all due respect for the Requesting Party, it is raising a false line of reasoning, in my opinion. Therefore, I will not engage in a long discussion of its arguments. I am ruling in favour of Placements on the first question for the following reasons.

[32] On the one hand, I consider it is highly technical for the Requesting Party to support its position based on Mr. Benny's assertion that the licence to use gives [TRANSLATION] "the right to operate a fast food establishment under the mark "Les Rôtisseries Benny" [para. 4 of the statutory declaration]. In my opinion, this assertion is inconsequential. First of all, I consider that the use of the Mark is equivalent to the use of the word mark LES RÔTISSERIES BENNY. Moreover, the assertion raised by the Requesting Party is preceded by the assertion that each franchise agreement grants [TRANSLATION] "a licence to use the Mark".

[33] On the other hand, even though the Requesting Party rightly submits that clause 6.1 of each franchise agreement concedes a right of use limited to the operation of a rotisserie, it does not convince me to conclude that the right of use is limited to the "restaurant operation services" set out in the registration.

[34] Instead, I fully subscribe to Placements' oral representations that it is reasonable to conclude in the case at bar that the right to use the Mark implicitly covers the Wares and the "delivery of prepared foods" services set out in the registration. Indeed, common sense leads me to conclude that the operation of a rotisserie involves the sale of chicken and other foods that may correspond to the Wares. Finally, the evidence clearly shows that "delivery of prepared foods" services are inherent in the performance of "restaurant operation services".

Does the evidence prove the use of the Mark within the meaning of section 4(1) of the Act, during the relevant period, in association with each of the Wares?

[35] For the following reasons, it is my opinion that Placements has presented sufficient evidence to allow me to rule in its favour on this question.

[36] In view of the Requesting Party's representations, I am going to consider the use of the Mark in association with the Wares in three parts, namely:

- a) use within the meaning of section 4(1) of the Act;

- b) use during the relevant period; and
- c) use in association with each of the Wares.

*Use of the Mark within the meaning of section 4(1) of the Act*

[37] I recognize from the outset that Mr. Benny's bare assertion concerning the use of the Mark in association with each of the Wares set out in the registration does not constitute a proof of use of the Mark within the meaning of section 4(1) of the Act [para. 7 of the statutory declaration]. This section, which defines the use of a trade-mark in association with wares, states the following:

A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[38] I begin my discussion by addressing the Requesting Party's representations to the effect that the application of the Mark on the menus is not a use in association with the Wares.

[39] I note that the Requesting Party did not cite any decision regarding the use of a mark on menus as such to support its argument. This having been said, it cited the decision 88766 *Canada Inc. v. Monte Carlo Restaurant Ltd* (2007), 63 C.P.R. (4th) 391 (F.C.) (*Monte Carlo*) concerning a trade-marks registered, inter alia, in association with wares, namely "pizza and spaghetti", and used in *circulars*.

[40] Although the Court in *Monte Carlo* overturned the Registrar's decision to maintain the registration for the wares, it seems to me that the Court did not exclude the possibility that the use of the mark in circulars may constitute a use in association with wares within the meaning of section 4(1) of the Act. To this effect, I note the following comment of the Court in paragraph 14 of the decision: "Here, the Registrar did not conduct an analysis to determine whether the customers used the circulars at the time of the transfer of the property in or possession of the wares in question. There was no evidence on this point."

[41] In the present context, I am prepared to accept that the application of the Mark to the menus is sufficient to give notice of association between the Mark and the Wares ordered at the counter from the menus. It is manifest that the Mark is unlikely to be affixed to the Wares themselves. The consumers order the Wares at the restaurants where they are prepared. Exhibits P-6 and P-7 prove that the Mark also appears on the restaurants' outdoor signs, including a sign above the entrance door. [By analogy, see *Oyen Wiggs Green & Muala v. Aimers* (1998), 86 C.P.R. (3d) 1998; also see *Cassels, Brock & Blackwell v. Western Pizza & Bar-B-Q-Chicken (1979) Ltd.* (1995), 59 C.P.R. (3d) 567 in which the Hearing Officer comments on his decision in *Western Pizza Bar B-Q Chicken (1979) Ltd.* (May 20, 1994), Doc. Registration 292,655 (T.M.O.B.), indicating: "In my decision regarding that matter, I was 'prepared to conclude in view of the fact that the registered trade mark appears on the registrant's menu that for any wares prepared and/or cooked on the registrant's premises, ... notice of the association between the registrant's trade mark and such wares would have been given when the customers ordered the food items from the menu'".]

[42] Concerning the application of the Mark on the delivery box, the Requesting Party accepted at the hearing that such application corresponds to the application of the Mark on the packages in which the Wares would have been distributed.

[43] I will now address the Requesting Party's representations to the effect that Mr. Benny's statutory declaration does not prove the use of the Mark in the *normal course of trade*, as required by section 4(1) of the Act.

[44] More specifically, the Requesting Party submits that due to the absence of precise allegation of sales, as such, of Wares or documentary evidence proving sales of the Wares, such as invoices, it is impossible to conclude that there were business transactions resulting in a transfer of property or possession of the Wares. I disagree.

[45] The jurisprudence clearly indicates that there is no specific type of evidence to provide in response to a notice stipulated in section 45 of the Act [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483 (F.C.T.D.) p 486]. I agree with Placements that a reasonable reading of Mr. Benny's statutory declaration allows me to conclude that there were business transactions involving the Wares.

[46] To this effect, as I commented at the hearing, Exhibit P-9, composed of three invoices, one issued in the name of each franchisee, proves that a total of 25,600 delivery boxes were manufactured during the months of October and November 2010. With respect for the Requesting Party, I believe that common sense leads to the conclusion that the boxes ordered by the franchisees were used to contain one or more of the Wares sold in the restaurants.

[47] Ultimately, I consider that Mr. Benny's statutory declaration presents enough evidence to allow me to conclude that the Mark was used within the meaning of section 4(1) of the Act.

*Use during the relevant period*

[48] The second part of the question under consideration arises from the Requesting Party's representations, calling into question the period of use of the delivery box [Exhibit P-5].

[49] The Requesting Party submits that the delivery box cannot have been used between April 28, 2008 and April 28, 2011. The Requesting Party claims that the delivery box was in use before 2007, because the 450 area code is not included in the two telephone number identified on the box [see Appendix A]. In support of its claim, the Requesting Party argues that since 2007, every telephone number must include the area code. The Requesting Party adds that the copyright notice "© 2007 Les Rôtisseries Benny Inc. tous droits réservés" ("© 2007 Les Rôtisseries Benny Inc. all rights reserved") found on the first page of the website confirms its position; the telephone numbers provided on the website include the 450 area code [Exhibit P-8 of the statutory declaration].

[50] I mention in passing that the Requesting Party submitted that the copyright notice on the website suggests that an entity other than Placements and the franchisees used the Mark during the relevant period. Placements responded to these representations by submitting at the hearing that the reference to "Les Rôtisseries Benny Inc." is inconsequential in this proceeding, because the evidence proves that this is the previous legal name of Placements [para. 2 and Exhibit P-1 of the statutory declaration]. Although the evidence proves that the change of legal name dates back to October 1985, I agree with Placements that the reference to Les Rôtisseries Benny Inc. in the copyright notice is inherently inconsequential in this proceeding.

[51] Returning to the Requesting Party's argument based on the absence or an area code in the telephone numbers, I consider, on the one hand, that once again this is a highly technical argument. On the other hand, I see no reason to call into question Mr. Benny's assertion that the 2010 invoices concern the manufacturing of delivery boxes, a sample of which is introduced under Exhibit P-5 [Exhibit P-9 of the statutory declaration]. Whatever the case may be, a reasonable reading of Mr. Benny's statutory declaration leads me to conclude that the delivery box introduced in evidence is representative of the delivery boxes used during the relevant period.

*Use in association with each of the Wares*

[52] On the one hand, the Requesting Party submits that the terms [TRANSLATION] "edible goods" found in the description of Exhibit P-5 create an ambiguity regarding the contents of the boxes [see paragraph 24 of my decision]. I do not subscribe to the Requesting Party's representations. Indeed, it seems obvious to me that the "edible goods" in question are specified by the identifiers M1, M2, M4, M6, M8 and M9.

[53] On the other hand, the Requesting Party submits that the evidence is insufficient to allow me to conclude that the Mark was used in association with the wares "pastries" and "breads". More specifically, the Requesting Party submits that the menus do not prove the independent sale of "pastries" and "breads". Moreover, to the extent that the menus prove the independent sale of "pie" or "pieces of pie", the Requesting Party submits that pies are not pastries.

[54] Despite the Requesting Party's position, I note that the first meaning of the word "tarte" (pie) found in the *Le Petit Robert* dictionary is: [TRANSLATION] "pastry formed of a dough shell surrounded by an edge and filled (with jam, fruit, cream)". Accordingly, I consider it justified to conclude that independent sales of "pies" or "pieces of pie" are "pastry" sales.

[55] Concerning "breads", Placements admitted during the hearing that they are not sold separately. However, Placements submitted that its evidence allows the conclusion that the Mark is used in association with brands in the normal course of trade. More specifically, it submits that in the normal course of trade, of the franchisees' restaurants, the chicken dishes are sold with a

side of bread. To this effect, Placements referred me to the photographs found in the menus and to the pictures on the cover of the delivery box.

[56] I accept to infer from the evidence that the chicken dishes are sold with a side of bread. Moreover, I believe it is reasonable to conclude that a customer attaches value to the brand that accompanies his chicken dish.

[57] Accordingly, I conclude that in the normal course of trade of the franchisees' restaurants, the bread accompanying a chicken dish has added value and can be perceived as a separate ware. Thus, I believe it is appropriate to make an analogy with the decision *Doctor's Associates Inc. v. American Multi-Cinema, Inc.*, 2012 T.M.O.B. 77 (CanLII). In this decision, which concerns an opposition to registration of the mark KIDSPACK & Design, my colleague Andrea Flewelling concluded that the mark was used in association with cardboard and paper food containers for containers for movie theatres, despite the fact that the containers were not sold separately from the combination meals. Ms. Flewelling considered that the evidence in the file allowed her to conclude that the container had "value added such that it can be perceived as a component of the combination meal separate and apart from the food products" [see *Doctor's Associates Inc.*, *supra*, para. 30].

[58] Ultimately, a reasonable reading of Mr. Benny's statutory declaration as a whole leads me to conclude that the Mark was used in association with each of the Wares.

Is the Mark as used in association with the Wares and Services the Mark as registered?

[59] The Requesting Party's position regarding material differences between the Mark as used and the Mark as registered is essentially based on its claim that the Mark includes a "black rectangle" that is a dominant feature of the Mark. Accordingly, the Requesting Party claims that the absence of the black rectangle in the Mark as used cannot constitute a use of the Mark as registered.

[60] In view of its position, the Requesting Party submits that the Mark as used on the delivery box and on the vehicle is not a use of the Mark as registered [see Appendices A and C].

[61] The Requesting Party acknowledges the presence of a rectangle in the Mark as used on the restaurant signs [see Appendix B]. However, it maintains that these signs do not prove the use of the Mark as registered, particularly due to the illustration of a chicken found in the rectangle. The Requesting Party also points out that the first of the two signs shows a white rectangle, while the second sign shows a black rectangle which does not have the same dimensions as the rectangle of the Mark as registered, in that the sign is widened upward.

[62] In support of its position to the effect that the black rectangle is a dominant feature of the Mark, the Requesting Party points out that the code for the rectangle is one of the Vienna Codes used by the Canadian Intellectual Property Office (CIPO) to classify the Mark. The Requesting Party also points out that the Court, in the decision *Guido Berlucchi & C Srl v. Brouillette Kosie Prince* (2007) F.C. 245, considered that “the general shape of the label” was one of the dominant features of the mark in question. (The decision mentioned by the Requesting Party is one of those cited by Placements but in another context than that of the question under consideration.)

[63] Regardless of whether the Requesting Party is right or wrong in submitting that one of the portions of the design mark is a “black rectangle”, its representations based on the materiality of the “black rectangle” have not convinced me to rule in its favour on this question. Instead, I consider that the question of the Mark as used in relation to the Mark as registered must be resolved in favour of Placements for the following reasons.

[64] The Requesting Party’s representations have not convinced me that the rectangle is a dominant and essential portion of the Mark. On the one hand, I do not believe it is appropriate to consider the Vienna Codes used by the CIPO to determine the dominant features of a trade-mark. On the other hand part, apart from the fact that it is well established that each case must be judged according to its surrounding circumstances, the mark involved in *Guido Berlucchi, supra*, has nothing in common with the Mark.

[65] I would add that if I had to consider other precedents in determining this question, I would tend to conclude that the case at bar is more similar to the case in *Novopharm Ltd. v. Novo Nordisk A/S* (2005) 43 C.P.R. (4th) 305 (T.M.O.B.), in which the Hearing Officer concluded that minor differences existed between the mark as registered and the mark as used – the proof of use did not use the colours claimed in the registration – reproduced below:



Mark registered



Mark used

[66] In the present case, I consider that “BENNY” is the dominant portion of the Mark. I also consider that “BENNY”, displayed predominantly and in combination with “LES RÔTISSERIES”, are essential features of the Mark. Accordingly, I conclude that the Mark used on the delivery box and on the vehicle retains its essential features. Concerning the delivery box, I subscribe to Placements’ representations to the effect that the positioning of “BENNY” to the right of “LES RÔTISSERIES”, instead of below it, is inconsequential because “BENNY” predominates over “Les RÔTISSERIES”.

[67] Concerning the signs, I do not believe it is reasonable for the Requesting Party to base its position on the colour or dimensions of the rectangle to claim that there are significant differences between the Mark as used and the Mark as registered. Moreover, despite the Requesting Party’s insistence in invoking the *black* rectangle, no colour is claimed as a feature of the Mark.

[68] Finally, in my opinion, the illustration of a chicken near “LES RÔTISSERIES BENNY” can be perceived as a trade-mark distinct from the Mark. Accordingly, the addition of the illustration of a chicken on the delivery box or on the signs is not likely to mislead, deceive or injure the public in any way [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)].

[69] Ultimately, I conclude that the evidence proves the use of the Mark as registered; the Mark has not lost its identity and has remained recognizable [*Canada (Registrar of Trade-marks) v. Compagnie Internationale pour l’informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 (F.C.A.); and *Promafil Canada Ltd. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.)].



## Decision

[70] In view of the foregoing, I conclude that the evidence proves the use by Placements of the Mark in Canada in association with each of the Wares and each of the Services, within the meaning of sections 4 and 45 of the Act.

[71] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, I decide that registration I decide that registration No. TMA394,413 will be maintained pursuant to section 45 of the Act.

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Céline Tremblay  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Traduction certifiée conforme  
Arnold Bennett, trad.

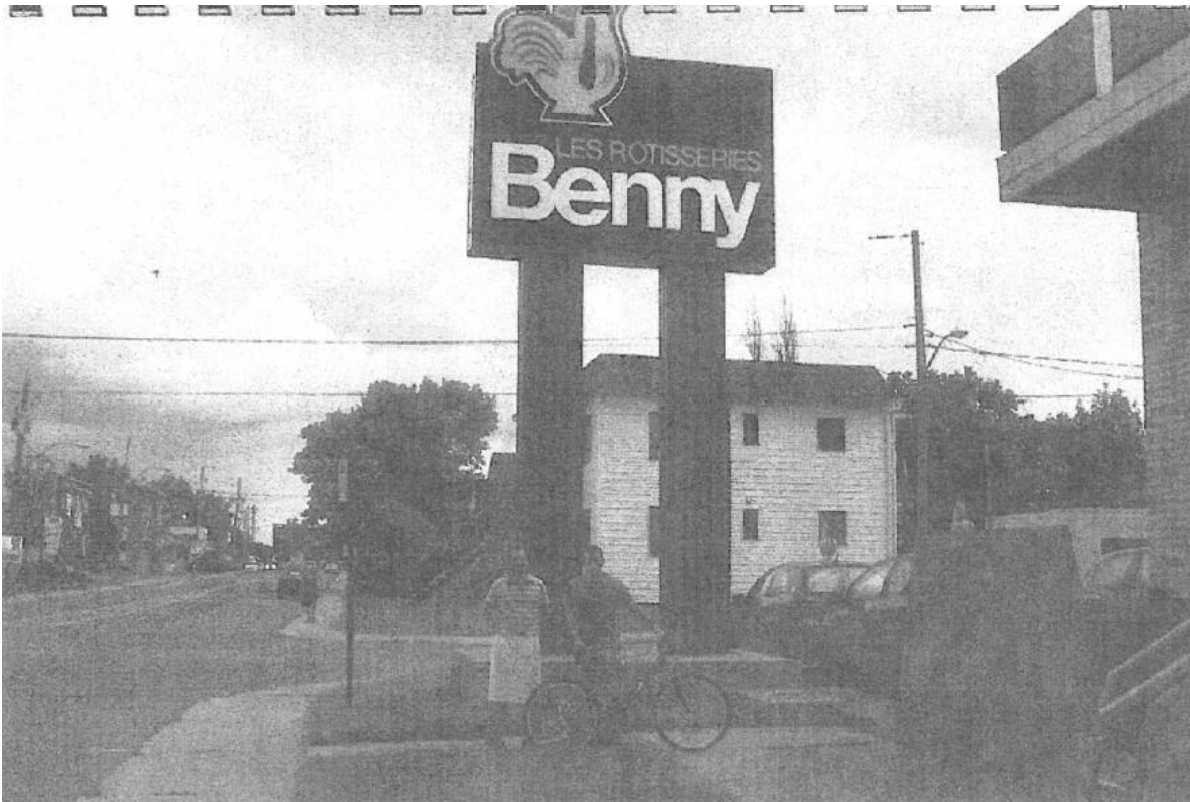
Appendix A

Right and left sides of the foldable delivery box – In colour in Exhibit P-5



Appendix B

Exterior photographs of the restaurants – In colour in Exhibit P-6



Appendix C

Photograph of a vehicle – In colour in Exhibit P-7



Appendix D

Cover page of the sample of the delivery menu – In colour in Exhibit P-8



Logo in the top left-hand corner of the menus on the Internet – In colour in Exhibit P-8

