



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

Citation: 2016 TMOB 55
Date of Decision: 2016-04-06
[UNREVISED ENGLISH
CERTIFIED TRANSLATION]

IN THE MATTER OF A SECTION 45 PROCEEDING

De Grandpré Chait

Requesting Party

and

J. Benny Inc.

Registered Owner

CMA783,734 for
MAÎTRES RÔTISSEURS DEPUIS 1960

Registration

[1] On February 17, 2014 at the request of De Grandpré Chait, the Registrar sent the notice stipulated in section 45 of the Trade-marks Act, RSC 1985, c T-13 (the Act) to J. Benny Inc. (the Registered Owner), holder of registration No. TMA783,734 for the MAÎTRES RÔTISSEURS DEPUIS 1960 trade-mark (the Mark).

[2] This notice enjoined the Registered Owner to prove that its Mark was used in Canada at any time between February 17, 2011 and February 17, 2014 (the relevant period), in association with the services specified in the registration, namely [TRANSLATION] "restaurant services including dining room, car order services, takeout of restaurant dishes and home delivery of restaurant dishes" and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[3] 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 goods or services mentioned in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Bare allegations of use are insufficient to prove the use of the Mark [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980) 53 CPR (2d) 62 (FCA)].

[4] Section 4(2) of the Act provides that 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. In the latter case, the use of a trade-mark in the advertising of services in Canada is not sufficient alone to establish use; it is indispensable that the services be offered in Canada and can be performed there [see *Wenward (Canada) Ltd v Dyanaturf Co* (1976), 28 CPR (2d) 20 (RMC); *Porter v Don the Beachcomber* (1966), 48 CPR 280 (Ex Ct); *Bedwell v Mayflower* (1999), 2 CPR (4th) 543 (TMOB); and *Société Nationale des Chemins de Fer Français SNCF v Venice-Simplon-Orient-Express, Inc.* (2000) 9 CPR (4th) 443 (FCTD)].

[5] In reply to the notice, the Registered Owner submitted the affidavit of Jean Benny. Only the Owner filed written representations and was represented at a hearing.

[6] Mr. Benny describes himself as President and Secretary of the Registered Owner since its constitution in 2001. Mr. Benny adds that he is also President of the licensee Benny & Frères Inc. and of several franchisees of the Registered Owner.

[7] Mr. Benny affirms that the Mark was used during the relevant period by Benny & Frères Inc. and franchisees under a franchise program for the purpose of operating rotisserie restaurants under the Benny & Co. banner, in accordance with the control conditions described in the licences and sublicences filed as Exhibits JB-4(a) to JB-4(i). Mr. Benny adds that the Registered Owner always controlled, directly or indirectly, the characteristics and the quality of the Services rendered in association with the Mark during the relevant period.

[8] In the case at bar, Mr. Benny clearly attests that the Registered Owner exercised the control required by section 50(1) of the Act. Therefore, I am convinced that any use of the Mark, according to section 4(2) of the Act, by Benny & Frères Inc. and the franchisees within the context of the Benny & Co. restaurants constitutes a use that can be ascribed to the Registered Owner in accordance with the provisions of section 50(1) of the Act.

[9] Mr. Benny affirms that, during the relevant period, tens of thousands of Canadian consumers benefited from the Services and that the Mark was displayed at the time the Services were performed and within the context of advertising the Services. As documentary evidence of the use of the Mark in association with the Services, Mr. Benny filed the following exhibits:

- a photograph taken during the relevant period, showing the exterior of the Benny & Co. restaurant located in Fabreville. The Mark clearly appears at the bottom of the restaurant sign;
- a copy of a poster stating the restaurant's business hours, and two photographs taken during the relevant period, showing the poster in question on the entrance door of the Benny & Co. restaurant located in Sainte-Thérèse. Mr. Benny explains that the customers must pass through the entrance door to access the dining room and the restaurant takeout counter. The Mark clearly appears at the bottom of the poster;
- a photograph showing a paper place mat, representative of the place mats placed on the tables found in the dining rooms of the Benny & Co. restaurants during the relevant period. The Mark clearly appears at the bottom of the place mat;
- a photograph of the menu available at the takeout counter of the Benny & Co. restaurants during the relevant period. The Mark clearly appears at the top of the menu;
- a photograph of the delivery menu distributed to consumers by mail at home and upon home delivery of restaurant dishes, such as it was during the relevant period. The Mark clearly appears at the top of the menu;

- a photograph of a delivery car used by the franchisees of the Benny & Co. restaurants for the home delivery service for restaurant dishes, such as it was during the relevant period. The Mark clearly appears on the car door; and
- a photograph showing the poster placed at the car order service of the Benny & Co. restaurant located in Saint-Jérôme, such as it was found during the relevant period. The Mark clearly appears on the poster.

[10] In view of the foregoing and in the absence of representations by the Requesting Party, I find that the evidence filed by the Registered Owner establishes the use of the Mark in the performance and advertising of "restaurant services including dining room, car order services, takeout of restaurant dishes and home delivery of restaurant dishes" in Canada during the relevant period, within the meaning of section 4(2) of the Act.

[11] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

Pik-Ki Fung
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 OF RECORD**

HEARING DATE: 2016-03-02

APPEARANCES

Barry Gamache

FOR THE REGISTERED
OWNER

AGENTS OF RECORD

ROBIC

FOR THE REGISTERED
OWNER

De Grandpré Chait

FOR THE REQUESTING
PARTY