

OPIC  CIPO

LE REGISTRAIRE DES MARQUES DE COMMERCE

THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 56

Date of Decision: 2017-05-17

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF AN OPPOSITION

J. Benny Inc. and 88766 Canada Inc.

Opponent

and

Les Placements 1360 Inc.

Applicant

1,500,513 for BENNY EXPRESS

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 EXPRESS trade-mark (the MARK), which is the object of application No. 1,500,513, in the name of Les Placements 1360 Inc. (the Applicant), for the goods and services described as follows:

[TRANSLATION] chickens, salads, pastries, fries, poutines, sandwiches, breads, spaghetti, pizzas, hamburgers, steaks, eggs, ice cream, dairy bar, coffee, tea, chocolate, soft drinks, mineral waters, beer, wine, wine aperitif (hereinafter collectively referred to as the "Goods"); and

[TRANSLATION] restaurant operation services and delivery of prepared foods (the "Services").

[2] The application, filed on October 20, 2010, is based on a use in Canada since February 1989 in association with the Goods and Services.

[3] The Opponent bases its opposition on the non-compliance of the registration application (sections 30(a) and (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 March 2, 2015. On May 12, 2015, 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:

- a statutory declaration of Nicolas Filiatrault dated September 4, 2015, to which are attached Exhibits NF-1 to NF-202;
- a true copy of this registration application;
- a true copy of a letter dated May 18, 1990 from the Bélanger Sauvé firm to the Trade-marks Registrar, filed in registration file TMA444,852 concerning the LES RÔTISSERIES BENNY EXPRESS & DESIGN trade-mark;
- a true copy of the Registrar's notice of April 28, 2011 in accordance with section 45 concerning registration TMA444,852;
- a true copy of the Registrar's decision dated December 23, 2013 related to the proceedings under section 45 concerning registration TMA444,852;
- a true copy of registration TMA444,852, expunged on April 10, 2014;
- certificates of compliance relating to 9061-9966 Québec Inc., 9153-3661 Québec Inc., 9241-3178 Québec Inc., and 9278-3638 Québec Inc.

[7] The Applicant filed no evidence.

[8] Only the Opponent filed a written argument and participated in the hearing held in this file.

PRELIMINARY COMMENTS

[9] In view of the absence of evidence and written arguments of the Applicant and its absence from the hearing, I deduce a lack of interest on its part. Thus, I will analyze only a single ground of opposition, because this will be sufficient to dispose of this case.

[10] Regarding the voluminous evidence filed by Mr. Filiatrault, Vice-President, Finance and Administration of BENNY & FRÈRES INC. (Benny et Frères), it is primarily related to the ground of opposition based on the non-distinctiveness of the Mark, in view of the use by third parties of the word BENNY as a component of different trade names. Since I have no intention to analyze this ground of opposition, it is useless, for the purposes of my decision, to produce a detailed summary of this evidence. Moreover, during the hearing, the Opponent's agent made no representation concerning this ground of opposition. He only referred to Exhibit NF-202, which I will describe more fully below.

[11] It is sufficient to mention at this stage that Mr. Filiatrault represents he was employed by the Opponent J. Benny between May 2010 and December 31, 2010. Since January 1, 2011, he has been employed by Benny et Frères. He affirms that Benny et Frères and J. Benny both have their place of business at the same location and that he is aware of J. Benny's business. Finally, he represents he has access to all the documents and information concerning J. Benny and he has full authority to represent Benny & Frères and J. Benny in this opposition.

[12] Finally, concerning the certificates of compliance relating to 9061-9966 Québec Inc., 9153-3661 Québec Inc., 9241-3178 Québec Inc., and 9278-3638 Québec Inc., this evidence is irrelevant for the purposes of analysis of the ground of opposition that will dispose of this opposition.

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

[13] The Opponent argues, among others, five different points based on section 30(b) of the Act, namely that:

- the Applicant did not use, as is stated in the application under opposition, the Mark in association with each of the Goods or each of the Services;

- the date of first use claimed is erroneous;
- the Applicant omitted to designate a predecessor in title;
- the alleged use of the Mark in association with each of the Goods and each of the Services is discontinued or even absent, for all or part of the Goods or Services;
- any alleged use of the Mark was made by the Applicant or did not profit or benefit the Applicant in accordance with the relevant provisions of the Act in this regard.

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].

[16] Moreover, section 30(b) requires that the use of the trade-marks be continuous in the normal course of trade from the date of first use claimed to the date of filing of the registration application [see *Benson & Hedges Canada Ltd v Labatt Brewing Co* (1996), 67 CPR (3d) 258 (FCTD)].

[17] The Opponent submits that, under the ground of opposition based on section 30(b) of the Act, it only has to present evidence that "*put[s] into issue*" the validity of the date of first use of the Mark alleged in this registration application [see *Friedman and Soliman Entreprises (sic), LLC v Hunky Haulers Inc*, 2017 TMOB 11].

Relevant Date

[18] The relevant date to analyze this ground of opposition is the filing date of the application (October 20, 2010) [see *Georgia-Pacific Corp v Scott Paper Ltd*, 3 CPR (1984), (3d) 469 (TMOB)]. One of the Opponent's claims is that, according to the evidence of record, there was an absence of use of the Mark by the Applicant between February 1989 and October 20, 2010.

Opponent's Arguments

Applicant's Identity

[19] This registration application was filed by Les Placements 1360 Inc. This is a holding company, as indicated in the slip obtained from the Enterprise Registrar concerning this company, filed as Exhibit NF-202 in support of Mr. Filiatrault's affidavit. There is no mention on this slip that the Applicant would be or would have been involved in the restaurant field. Thus, in the first place, a serious doubt would exact regarding the veracity of the Applicant's declaration in its registration application to the effect that it had used the Mark since February 1989, given that it is a holding company.

[20] During the hearing, the Opponent conceded it would have been possible for the Applicant to file a registration application based on a use of the mark by a predecessor in title and/or a licensee or licensees. However, on this point, the Opponent presented the evidence described hereinafter.

Decision rendered under section 45 of the Act

[21] The Opponent filed a true copy of the decision of the Registrar dated December 23, 2013 relating to a notice issued under section 45 in registration file TMA444,852 concerning the trade-mark LES RÔTISSERIES BENNY EXPRESS & DESIGN illustrated hereinafter:



[22] This registration covered the same goods and services as those referred to in this registration application. However, the Registrar expunged registration TMA444,852 from the Register due to the absence of evidence of use of this trade-mark by its owner, which incidentally was the Applicant. Indeed, the Opponent also adduced in evidence, based on certified copies, that registration application No. 633,365, at the origin of this registration, had

been filed initially on May 30, 1989 by Les Rotisseries Benny Inc., and then assigned on May 9, 1990 to the Applicant.

[23] In his decision, the Registrar concluded that the evidence of use of the mark LES RÔTISSERIES BENNY EXPRESS & DESIGN by a third party, which had been filed on the record, could not benefit the Applicant because there was no proof of record that the Applicant had granted this third party a licence to use this mark. The Registrar added that, even if the record had contained evidence of the existence of a licence, in accordance with provisions of the Act governing the use of trade-marks under licence, there was no evidence that the Applicant controlled, directly or indirectly, the characteristics or the quality of goods and services under the terms of this licence [see *Sim & McBurney v Les Placements 1360 Inc*, 2013 TMOB 229, at paragraphs 24 and 28 to 31].

[24] The Opponent also asserted that the Registrar's notice under section 45 in registration file TMA444,852 had been issued on April 28, 2011. Thus, the Applicant had to prove the use of the LES RÔTISSERIES BENNY EXPRESS & DESIGN trade-mark during the period between April 28, 2008 and April 28, 2011, which period overlaps the one relevant in this case, namely February 1989 to October 20, 2010.

[25] The Opponent argues this evidence is sufficient to satisfy its light initial burden. Indeed, according to its claims, the Applicant could not declare on October 20, 2010 that it had used the Mark in association with each of the Goods and Services, because it is a holding company, and thus cannot operate on its own in the restaurant field.

[26] The Opponent adds that the Applicant did not mention, in its registration application, the identity of the predecessor(s) in title or of the licensee(s) who would have used the Mark in Canada since the date of first use alleged in this application, whereas such mention is found in the record concerning registration application No. 633,365, for the similar trade-mark LES RÔTISSERIES BENNY EXPRESS & DESIGN, covering the same goods and services and also based on a use since a similar date (February 1, 1989), having been filed by Les Rotisseries Benny Inc. before being assigned to the Applicant.

[27] Finally, the Opponent claims the decision of the Registrar dated December 23, 2013 concerning the LES RÔTISSERIES BENNY EXPRESS & DESIGN trade-mark would also be sufficient to prove the Applicant had abandoned the use of the Mark during the period from April 28, 2008 to October 20, 2010 and that there would have been, at least, a discontinuous use of the Mark during a period preceding the relevant date.

[28] During the hearing, I asked the Opponent if it could claim to have discharged its light burden, given that it was basing its position, in part, on a decision of the Registrar rendered in the context of proceedings under section 45 of the Act and this decision did not pertain to the Mark but rather to the LES RÔTISSERIES BENNY EXPRESS & DESIGN mark.

[29] The Opponent submits this decision of the Registrar ordering the expungement of the LES RÔTISSERIES BENNY EXPRESS & DESIGN mark was sufficient to satisfy its light burden, because it puts into issue the date of first use alleged in this registration application.

[30] To support this position, the Opponent first drew my attention to the Registrar's decision in *Parfums Christian Dior v Lander Co Canada Ltd* (2000), 6 CPR (4th) 257 (TMOB). In that case, Parfums Christian Dior (Christian Dior) opposed the registration application of Lander Co. Canada Ltd. (Lander) for the FASCINATION mark. Christian Dior claimed Lander had not used the FASCINATION mark since the date of first use alleged in its registration application. Christian Dior had adduced as evidence the expungement of three registrations, in the name of Lander, for the FASCINATION mark following proceedings under section 45. The Registrar expressed his position as follows in this matter:

The evidence relating to the Section 45 proceedings points to the fact that the trade-mark FASCINATION was likely not in use as of the date of the Section 45 notices [June 13, 1995] in relation to the wares covered in registration Nos. 188,736 and 126,745 and was also likely not in use during the two-year period from December 28, 1993 to December 28, 1995 in relation to the wares covered in registration No. 406,275. As Subsection 30(b) of the *Trade-marks Act* requires that there be continuous use of a trade-mark in the normal course of trade [see *Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership*, referred to above], the opponent's evidence meets its evidential burden in respect of the wares covered in the present application which were also covered in the opponent's three expunged registrations.

[31] Thus, according to the Opponent, the Registrar was of the opinion that this evidence of expungement of Lander's registrations for the FASCINATION trade-mark was sufficient to conclude that Christian Dior had discharged its light burden under section 30 (b) of the Act.

[32] Regarding the fact the Mark is not the mark that was the object of the proceedings under section 45, the Opponent refers to the decision of the Registrar in *Georgia-Pacific Corp*, cited above. In this case, the mark that was the object of the opposition was MD, while the mark expunged following proceedings under section 45 was the MD and Design mark. On this question, the Registrar ruled as follows:

In view of the dominance of the letters "MD", the connotation of the letters "MD" in the context of the design mark and the probability that the design mark would be orally identified by the letters "MD", I consider that use of the design mark constitutes use of the word mark MD.

[33] The Opponent argues, and I agree, that the Mark is another trade-mark of the Applicant composed of two dominant elements of the LES RÔTISSERIES BENNY EXPRESS & DESIGN mark, namely the words "BENNY" and "EXPRESS". These two dominant elements constitute the entirety of the Mark.

Conclusion

[34] In light of this evidence and the arguments presented by the Opponent, it is my opinion that the Opponent has discharged its light burden under section 30(b) of the Act. Indeed, the facts enumerated hereinafter, and more fully described previously, seriously put into issue the Applicant's statement contained in its registration application, to the effect it itself had used the Mark in association with each of the Goods and Services, since February 1989:

- the Applicant is a holding company and not a company that works on its own in the restaurant field;
- the Applicant omitted to identify the predecessor(s) in title or licensee(s) who had used the Mark since the date of first use alleged in its registration application;
- The expungement of the LES RÔTISSERIES BENNY EXPRESS & DESIGN mark in the context of the proceedings under section 45 described above, due to the non-use of this mark in association with the same goods and services as those referred to in this application, for at least the period from April 28, 2008 to October 30, 2010.

[35] Consequently, the Applicant had the legal onus of proving it itself had used the Mark, at the date of filing of the application, in association with each of the Goods and Services, continuously since February 1989. Since it filed no evidence, I find it is appropriate to grant the different points of the ground of opposition based on section 30(b) and more fully described in paragraph 13.

DECISION

[36] 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 translation

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2017-04-25

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