



SEP 02 1997

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T-1301-96

BETWEEN:

BRÛLERIE DES MONTS INC.,

Applicant,

- and -

3002462 CANADA INC.,

Respondent.

REASONS FOR ORDER

NADON J.:

In its originating notice of motion under subsection 57(1) of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (the "Act"), the applicant, Brûlerie des Monts Inc., is seeking an order declaring registration number TMA 308,213, dated November 15, 1985, for the trade-mark *La Brûlerie* (the "trade-mark") to be invalid and striking it from the Canadian register of trade-marks.

Notwithstanding the fact that the originating notice of motion was properly served on the respondent, the owner of the trade-mark, the respondent failed to reply, and accordingly the applicant's application was not contested.

The relevant facts may be summarized as follows. The applicant carries on a business located at 197 rue Principale in Saint-Sauveur, Quebec. The applicant operates a restaurant at that location, and a place where coffee beans are sold and roasted for consumption outside the premises of the business.

In July 1982, Orient Express Café Ltée ("Orient Express") filed an application to register the trade-mark in association with a system for roasting coffee directly at points of sale. In October 1985, Orient Express assigned the trade-mark to Pierre and Nicole DeRuelle, who had the trade-mark registered on November 15, 1985, as number TMA 308,213, in association with a system for roasting coffee directly at points of sale.

In March 1995, Mr. and Mrs. DeRuelle assigned their rights in the trade-mark to A L Van Houtte Ltée. In May 1995, A L Van Houtte Ltée assigned its rights, title and interest in the trade-mark, including the goodwill associated therewith. In early August 1995, the respondent filed an application to extend the trade-mark to restaurant operations with the Registrar of Trade-Marks in Ottawa.

By letter dated June 5, 1995, the respondent sent a demand to Brûlerie Mille et Un Cafés of Laval, Quebec, directing it to cease using the word "*brûlerie*" in connection with its business, a restaurant and the sale of coffee for consumption inside and outside the restaurant premises.

On July 6, 1995, the respondent commenced legal proceedings in the Superior Court of Quebec, District of Montréal, seeking a permanent injunction against Brûlerie Mille et Un Cafés and its owners prohibiting them from using the word "*brûlerie*" directly or indirectly in connection with their commercial operations. On November 8, 1995, the Honourable Pierre Viau, a judge of the Superior Court, dismissed an application for an interlocutory injunction filed by the respondent against Brûlerie Mille et Un Cafés. In dismissing the respondent's application for an interlocutory injunction on the ground that it had not succeeded in demonstrating that it would suffer irreparable harm if the injunction were not granted, Viau J. seemed to have doubts about the respondent's rights in connection with the trade-mark.

On April 9, 1996, the applicant, which has used the trade-mark *Brûlerie des Monts* in association with its restaurant and also in association with the place where it roasts and sells coffee beans for consumption outside the premises of its business since June 30, 1995, filed an application with the Registrar of Trade-Marks for registration of the design of its trade-mark *Brûlerie des Monts* in association with its restaurant and the place where it roasts coffee beans for consumption outside the premises of the business.

This is the context in which the applicant filed its originating notice of motion in this Court, in May 1996, under subsection 57(1) of the Act.

The applicable legislation

In support of the applicant's motion, Ms. Tremblay, for the applicant, cited sections 2, 12 and 18 of the Act. The relevant provisions read as follows:

"person interested" includes any person who is affected or reasonably apprehends that he may be affected by any entry in the register, or by any act or omission or contemplated act or omission under or contrary to this Act, and includes the Attorney General of Canada;

12.(1) Subject to subsection 13, a trade-mark is registrable if it is not

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French languages of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

(c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used;

18.(1) The registration of a trade-mark is invalid if

(a) the trade-mark was not registrable at the date of registration;

(b) the trade-mark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced; or

(c) the trade-mark has been abandoned,

...

Analysis

For the following reasons, I am of the opinion that the applicant's application must be allowed.

The applicant's first argument is that the trade-mark was not registrable on November 15, 1985. In support of that argument, the applicant cited paragraphs 12(1)(b) and (c) of the Act. According to the applicant, there can be no doubt that the trade-mark is merely descriptive of the services in association with which it is used. In other words, the name "La Brûlerie", in French, is merely a description of the service in connection with which it is used.

The applicant also submits that the trade-mark is invalid on the ground that it is not distinctive in terms of the wares or services in association with which it is used by the respondent.

In support of its arguments, the applicant referred me to passages taken from French language dictionaries. The definition of the word "*brûlerie*" most often found in such dictionaries is that a "*brûlerie*" is the place where coffee is roasted. This is not a recent definition of the word "*brûlerie*", since the 1962 edition of the *Dictionnaire usuel Quillet Flammarion par le texte et par l'image rédigé sous la direction de Pierre Gioan*, published by Quillet-Flammarion, defines the word "*brûlerie*" as follows:

[TRANSLATION]

Place where wine is distilled, where coffee is roasted.

Accordingly, I cannot do otherwise than agree with Ms. Tremblay's submission that the expression "*brûlerie*" is a generic expression, which is known to Canadians and Quebecers and is used in the coffee roasting business. In fact, on September 10,

1982, Claude Cyr, an employee in the Office of the Registrar of Trade-Marks in Ottawa, noted on the file, in respect of the application for registration of the mark filed by Orient Express, that he had done research concerning the meaning of the word "*brûlerie*", and that according to that research the word "*brûlerie*" was defined as an industrial facility for roasting coffee beans. Thus in September 1982 the Office of the Registrar of Trade-Marks was aware of the meaning of the expression "La Brûlerie".

The applicant also put in evidence the fact that at present there are at least nine businesses operating in Quebec that use the word "*brûlerie*" to describe one of their principal activities, coffee roasting. The applicant further submits that the respondent cannot claim to have removed the word "*brûlerie*", a common, generic word that exists in the French language to describe an establishment where coffee is roasted, from the public domain so that it can appropriate it for its exclusive use. Lastly, the applicant submits that the respondent has abandoned its exclusive right to the trade-mark, in any event, by failing to maintain its opposition to the trade-mark *Brûlerie St. Denis*.

On December 17, 1985, Maison du café (St. Denis) Inc. ("Maison du café") filed an application for registration of that trade-mark with the Registrar of Trade-Marks in Ottawa. On September 11, 1986, the Office of the Registrar wrote to counsel for Maison du café to draw to their attention that they had to disclaim the exclusive use of the word "*brûlerie*" in order to comply with paragraph 12(1)(c) of the Act. Accordingly, Maison du café filed an amended application for registration on September 22, 1986, in which it stated the following, *inter alia*:

2. The trade mark is the words "BRULERIE ST. DENIS".
3. The trade mark has been used in Canada by the Applicant since at least May 15, 1985, in association with the operation of a retail establishment which is both a restaurant and which also roasts coffee beans and sells roasted coffee beans for consumption outside the premises and requests registration of the trade mark in respect of such services.
5. The Applicant disclaims the right to the exclusive use of the word "BRULERIE" apart from the trade mark.

On January 20, 1987, Orient Express filed a notice of opposition to the application for registration of the trade-mark *Brûlerie St. Denis*. In short, the opponent stated in its notice of opposition that it was the owner of the trade-mark *La Brûlerie* and that the trade-mark that the applicant was seeking to register would create sound and visual confusion with the trade-mark *La Brûlerie*.

On June 6, 1989, counsel for Orient Express informed the Office of the Registrar that their client no longer wanted to pursue the opposition proceedings. Based on that evidence, the applicant submits that the respondent has abandoned its right to the exclusive use of the trade-mark.

Since the word "*brûlerie*" is merely the name, in French, of the service in connection with which the trade-mark is used, and further, since it is not distinctive in terms of the goods or services in association with which it is used, when the trade-mark was registered on November 15, 1985, it was not registrable within the meaning of paragraphs 12(1)(b) and (c) of the Act. Accordingly, in my opinion, the trade-mark *La Brûlerie* is invalid.

Before concluding, I would like to note that the applicant is beyond any doubt a person interested, within the meaning of section 2 of the Act.

The applicant's motion will therefore be allowed and the registration of the word "*brûlerie*" will be declared to be void and invalid. Registration TMA 308,213, dated November 15, 1985, will be struck from the register of trade-marks and the Registrar of Trade-Marks will be ordered to make the appropriate entries in the register.

The applicant will be entitled to its costs, including the fees for the expert opinions provided by Lisa Corbeil, analyst and researcher, and by Marthe Faribeault, a professor in the linguistics and translation department of the Université de Montréal.

OTTAWA, Ontario
February 20, 1997

"MARC NADON"
JUDGE

Certified true translation



C. Delon, LL.L.

FEDERAL COURT OF CANADA
TRIAL DIVISION

NAMES OF COUNSEL AND SOLICITORS OF RECORD

COURT FILE NO: T-1301-96

STYLE OF CAUSE: BRÛLERIE DES MONTS INC. v. 3002462 CANADA INC.

PLACE OF HEARING: MONTRÉAL, QUEBEC

DATE OF HEARING: FEBRUARY 14, 1997

REASONS FOR ORDER OF THE HONOURABLE MR. JUSTICE NADON

DATED FEBRUARY 20, 1997

APPEARANCES:

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FOR THE APPLICANT

NO ONE APPEARING

FOR THE RESPONDENT

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FOR THE RESPONDENT

**THE FEDERAL COURT
OF CANADA**

**LA COUR FÉDÉRALE
DU CANADA**

Court No.: T-1301-96

No. de la cause:

Let the attached certified translation of the following document in this cause be utilized to comply with Section 20 of the Official Languages Act.

Je requiers que la traduction ci-annexée du document suivant telle que certifiée par le traducteur soit utilisée pour satisfaire aux exigences de l'article 20 de la Loi sur les langues officielles.

Reasons for Order

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Form T-4F

Marc Nadon

J.F.C.C.

J.C.F.C.

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