

SECTION 45 PROCEEDINGS  
TRADE-MARK: COMMANDER  
REGISTRATION NO.: 164,489

On September 13, 2001, at the request of Mr. Paul B. Bélanger, the Registrar forwarded a Section 45 notice to Accuride Corporation, the registered owner of the above-referenced trade-mark registration.

The trade-mark COMMANDER is registered for use in association with the wares “vehicle rims”.

Section 45 of the Trade-marks Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on the registration at any time within the three-year period immediately preceding the date of the notice, and if not, the date when it was last in use and the reason for the absence of use since that date. The relevant period in this case is any time between September 13, 1998 and September 13, 2001.

In response to the notice, the affidavit of William D. Noll together with exhibits has been furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

In his affidavit, Mr. Noll states that the registrant has been for many years and continues to be a

designer, manufacturer and seller of wheels, rims, components thereof and spacer bands for dual rims, for trucks, trailers, buses and other vehicles. He submits that the registrant wholly owns a Canadian subsidiary, Accuride Canada Inc. The registrant sells products in Canada under the trade-mark COMMANDER through catalogues forwarded by the registrant to its subsidiary for distribution in Canada. He specifies that the catalogue is widely distributed and sales of the COMMANDER rims are made in Canada to OEM's, distributors, truck fleets, etc. He adds that the registrant also specifically controls the character and quality of the COMMANDER rims by specifications it provides.

He confirms that the catalogue contains a specific reference to COMMANDER rims or radial COMMANDER rims and that approximately 1500 catalogues are distributed annually in Canada. As Exhibit A he provides copies of the front and back covers and relevant pages of the catalogues that demonstrate use of the mark COMMANDER in association with vehicle rims for the years 1999, 2000 and 2001. He confirms that during the years 1999, 2000, 2001, Accuride Canada Inc. sent the catalogues to OEM's, distributors, truck fleets, etc. and that OEM's and distributors ordered from the catalogue by telephoning, mailing or faxing Accuride Canada Inc. He states that price lists were provided to the OEM's and distributors, and prices were also obtained by calling Accuride Canada. Fleet owners also ordered from the catalogue by calling distributors.

As Exhibit B, he submits copies of representative invoices of COMMANDER vehicle rims sold in Canada through catalogue sales during the relevant period. He provides sales figures for 1999,

2000 and 2001 and he explains that they are broken down by rim base, rim side ring and rim lock ring and that these are all parts for the 5° Radial COMMANDER vehicle rims. The three parts are always invoiced separately, including when the assembly of the three parts is shipped in assembled condition.

The requesting party has raised several arguments concerning the evidence furnished, however, I find none to be successful.

Concerning the source of the wares, Mr. Noll has indicated that the registrant is a designer, manufacturer and seller of rims and that it sells its rims in Canada under the COMMANDER mark through catalogues forwarded by the registrant to its subsidiary in Canada. The catalogues which are distributed in Canada by the registrant's Canadian subsidiary refer to the registrant company under its current address and its previous address. Consequently, from the above, I find it is clear that the source of the wares is the registrant.

Concerning the registrant's Canadian subsidiary, it can be concluded from the statements in the affidavit (paragraphs 4, 7 and 9) that it is merely a conduit from the registered owner of the trademark to the purchaser of the wares (i.e. distributors, truck fleets, etc.). Consequently, I conclude that all sales of the registrant's rims by the Canadian subsidiary amount to use by the registrant (*Manhattan Industries Inc. v. Princeton Manufacturing Ltd.*, 4 C.P.R. (2d) 6).

Concerning sales during the relevant period, the invoices and sales figures together with the

statements contained in paragraph 10 of the affidavit clearly demonstrate that sales of rims were made in Canada during the relevant period.

As for the required notice of association between the trade-mark and the wares at the time of transfer of the wares in the normal course of trade (Section 4(1) of the Act), although it is true that the evidence does not show that the trade-mark appears on the wares or on their packaging, the evidence does show that the trade-mark appears in the registrant's catalogues in association with the wares. Mr. Noll has explained that the wares are sold through catalogues and the catalogues are used by the purchasers to order the vehicle rims. Consequently, as the catalogues are in the hands of the purchasers when they order the wares and when they receive the wares, I accept that the catalogues would provide the required notice of association at the time of transfer of the wares to the purchasers of the wares. Consequently, this satisfies me that the use shown complies with the requirements of Section 4(1) of the Act.

The evidence shows that the trade-mark is being used with additional matter. The trade-mark appears as follows in the catalogues:

As the additional matter is descriptive, I conclude that it would probably be perceived by the public as such and the word COMMANDER “per se” would be perceived as the trade-mark for the wares (*Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535 Principle 1).

Having concluded that the evidence shows use of the registered trade-mark in association with the registered wares by the registered owner, I conclude that the trade-mark registration ought to be maintained.

Registration No. 164,489 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 29<sup>TH</sup> DAY OF JANUARY 2004.

D Savard  
Senior Hearing Officer  
Section 45 Division