

SECTION 45 PROCEEDINGS
TRADE-MARK: ROTEL
REGISTRATION NO: TMA 416,585

At the request of Goodmans LLP (the “requesting party”) the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on May 25, 2005 to Rotel AG, the registered owner of the above-referenced trade-mark.

The trade-mark ROTEL is registered in association with:

Household apparatus, their parts and accessories, namely kneading apparatus, stirring apparatus, kneading arms, mixers, immersion mixers, vegetable cutters, meat choppers, juicers, lemon juicers, apparatus for making sorbets, coffee mills, coffee machines, toasters, grills, waffle irons, immersion heaters, cooking pots, heating plates, hot plates, irons, laundry presses, ventilators, heat radiators, wall heaters, humidifiers, washing machines, tumblers, apparatus for maintenance and cleaning floors and carpets, namely vacuum cleaners, wax-polishing machines, floor polishing machines, shampooers; electric apparatus for hygiene and cosmetic purposes, namely electric razors, hair dryers, apparatus for waving hairs, massage apparatus, electric toothbrushes; small electric motors.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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. In this case, the relevant period for showing use is any time between May 25, 2002 and May 25, 2005.

What qualifies as use of the trade-mark is defined in s. 4 of the Act, which states:

4. (1) 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.

(2) 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.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In response to the Registrar's notice, the Registrant furnished the affidavit of Werner Egloff, the Chairman of the Board and President of Rotel AG. Only the requesting party filed a written argument. An oral hearing was not conducted.

The affidavit of Werner Egloff makes no assertion that the subject trade-mark was or is in use in Canada with respect to wares other than that which are described as "*grills*".

The relevant portions of Mr. Egloff's evidence are summarized as follows:

- In paragraph 3 of the affidavit, it is submitted that Rotel AG's grill products are distributed through its Swiss subsidiary Thielmann Rotel Know-how AG, and the Registrant has direct control over the character and quality of the wares of this subsidiary. Further to this, a sampling of invoices marked Exhibit "A" has been attached, evidencing sales of ROTEL grills by the above-mentioned subsidiary to a Canadian distributor. Three of the seven invoices are dated within the relevant period and in the body of the invoices the trade-mark ROTEL appears in association with the product.
- Paragraph 5 of the affidavit refers to Exhibit "C", which consists of a photograph of the packaging for the wares. Mr. Egloff clearly states that such packaging was used during the relevant time period. **The mark ROTEL can be clearly seen on the packaging.**

The requesting party's argument was brief, stating, "We have reviewed the evidence filed and submit that it appears to be insufficient to maintain the registration or, at the very most, the registration should be limited to "domestic grills".

Having considered the evidence, I am satisfied that it shows use of the trade-mark ROTEL during the relevant period in association with "household apparatus namely grills" in the manner required by the Act.

The three invoices that are dated within the relevant period clearly confirm that sales of ROTEL grills by the Registrant's subsidiary were made in Canada during the relevant period. Furthermore, I accept that the notice of association required by ss. 4(1) of the Act was given to the purchaser at the time of transfer of the wares as Mr. Egloff has clearly confirmed that the trade-mark appeared on the packaging for the wares in the manner shown by Exhibit C attached to the affidavit.

Concerning the fact that the use was by the registrant's subsidiary, as the affiant has indicated that the registrant has direct control of the character and quality of the wares of the subsidiary, that is sufficient for purposes of s. 45 to permit me to conclude that the use by the subsidiary is use meeting the requirements of ss. 50(1) of the Act (see *Gowling Strathy & Henderson v. Samsonite Corp.*, 66 C.P.R. (3d) 560).

In view of the above, I have concluded that use has been shown of the subject trade-mark for the wares described as "*household apparatus, namely, grills*"; use has not been shown for the remaining wares in the registration and there is no evidence of any special circumstances excusing the absence of use. TMA 416,585 will therefore be amended to delete the wares:

"Household apparatus, their parts and accessories, namely kneading apparatus, stirring apparatus, kneading arms, mixers, immersion mixers, vegetable cutters, meat choppers, juicers, lemon juicers, apparatus for making sorbets, coffee mills, coffee machines, toasters, waffle irons, immersion heaters, cooking pots, heating plates, hot plates, irons, laundry presses, ventilators, heat radiators, wall heaters, humidifiers, washing machines, tumblers, apparatus for maintenance and cleaning floors and carpets, namely vacuum cleaners, wax-polishing machines, floor polishing machines, shampooers; electric apparatus for hygiene and cosmetic purposes, namely electric razors, hair dryers, apparatus for waving hairs, massage apparatus, electric toothbrushes; small electric motors",

in compliance with the provisions of ss. 45(5) of the Act.

DATED IN GATINEAU, QUEBEC THIS 6TH DAY OF DECEMBER 2007.

D. Savard
Senior Hearing Officer
Section 45 Division