

SECTION 45 PROCEEDINGS
TRADE-MARK: FONDAL
REGISTRATION NO.: 281,163

On December 18, 2002, at the request of 88766 Canada Inc., the Registrar forwarded a Section 45 notice to Didier-Werke A.G., the registered owner of the above-referenced trade-mark registration.

The trade-mark FONDAL is registered for use in association with the following wares:
“refractory bricks and special shapes”.

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 December 18, 1999 and December 18, 2002.

In response to the notice the affidavit of Michaela Gruber with exhibits and the affidavit of Brian E. Wood were furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

In her affidavit Ms. Gruber states she is responsible for dealing with invoices of Veitsch-Radex-

Didier Vertriebsgesellschaft m.b.H., being an associated company of the registered owner. She adds that another company associated with the registrant is VRD-Glas GmbH of Germany and that these are all subsidiaries of a holding company called RHI AG. She states that because of her work she has knowledge of the facts set out in her affidavit.

She indicates that one of the functions of Veitsch-Radex-Didier Vertriebsgesellschaft m.b.H. is to sell products of the other members of RHI AG, thus her company sells products manufactured by the registered owner and advertised by VRD-Glas GmbH, to customers in Canada.

She explains that the registered owner manufactures refractory bricks and special shapes under the trade-mark FONDAL. As Exhibit A she attaches a catalogue of VRD-Glas GmbH. On the fifth page of the catalogue, excluding the cover, is a reference to an arch shape (i.e. a special shape made of refractory material) associated with the trade-mark FONDAL. On other pages reference is made to refractory bricks associated with the trade-mark FONDAL. As Exhibit B, she provides an invoice showing a sale from her company to VRD Canada Inc., meanwhile acting as RHI Canada Inc. The invoice is for FONDAL rectangular bricks.

As Exhibit C, is an invoice showing a sale in Canada of special refractory shapes under the trade-mark FONDAL.

She then explains that the trade-mark is not affixed to the wares the reason being that the bricks and special shapes are designed to be used in high temperature environments, so the trade-mark

if affixed thereon would not survive the heat environment. Further, there is no wrapping to which the trade-mark can be affixed. Rather the trade-mark appears in the catalogue and in the invoices.

In his affidavit, Mr. Wood states that he is Vice President and COO of RHI Canada Inc. (previously known as VRD Canada Inc.) who is an associated company of RHI AG. He submits that his company has received FONDAL bricks and special shapes from Veitsch-Radex-Didier Vertriebsgesellschaft m.b.H. and he confirms that these products entered the Canadian territory under the trade-mark FONDAL. He then states that the bricks and special shapes were then sold to Canadian glass manufacturers as they have been received, that is under the trade-mark FONDAL.

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

Concerning the Gruber affidavit, which was sworn in Austria, the requesting party has argued that the notary Dr. Rupert Brix did not sign in his personal capacity, but instead as a representative designated by the public notary Dr. Georg Weissmann. Consequently, it submits that the affidavit is inadmissible. The registrant, on the other hand, submits that it is settled law that an affidavit in Section 45 proceedings, if valid in the country where it is taken, will be valid in Section 45 proceeding. It then states that the affidavit was sworn in Austria and, in fact, is valid in Austria. As stated in *Lubrication Engineers, Inc. v. Canadian Council of Professional*

Engineers, 78 C.P.R. (2d) 179 (reversed on other grounds 1 C.P.R. (3d) 309 and 41 C.P.R. (3d) 243) and *Russell & Dumoulin v. Guangdong Cereals & Oils Import & Export Corporation*, 17 C.P.R. (4th) 283), it is the Registrar's practice to accept, as prima facie admissible, affidavits made in accordance with the rules of the jurisdiction where they were sworn. Based on the submissions provided by the registrant, and bearing in mind the summary nature and purpose of Section 45 proceedings, I accept the affidavit as being admissible.

Concerning the use of the trade-mark, the requesting party has argued that the use shown is not use by the registrant or accruing to the registrant. I am satisfied, having regard to the evidence as a whole, that the use shown is by the registrant. Ms. Gruber has clearly explained that the registered owner is the entity that manufactures the wares. The other entities either sell the registrant's products or advertise the registrant's products. Consequently, it is clear that the registrant is the first link in the chain of transactions and therefore the user of the trade-mark.

Consequently, having regard to the evidence furnished I conclude that the trade-mark registration ought to be maintained.

Registration No. 281,163 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 8TH DAY OF SEPTEMBER 2005.

D. Savard
Senior Hearing Officer
Section 45 Division