

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by Borden Ladner  
Gervais against registration No. TMA 163,123  
for the trade-mark MUELLER 110 in the  
name of Mueller International, Inc. (a  
Delaware corporation)**

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[1] On March 10, 2006, at the request of Borden Ladner Gervais (the Requesting Party), the Registrar forwarded a notice under s.45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Mueller International, Inc. (a Delaware Corporation), the registered owner of the above referenced trade-mark registration (the Registrant). The trade-mark MUELLER 110 (the Mark) is registered in association with the following wares: Compression couplings for use on gas, oil, water, steam and other fluid conducting lines (the Wares).

[2] In response to the notice, the Registrant furnished the affidavit of Leo W. Fleury, sworn June 8, 2006. Both the Registrant and the Requesting Party filed written arguments and an oral hearing was conducted which both parties were ably represented. This case was heard at the same time as Registration No. TMDA 19191, for the trade-mark MUELLER.

[3] Section 45 of the 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. In this case, the relevant period for showing use is any time between March 10, 2003 and March 10, 2006.

[4] Use in association with wares and services is set out in s.4 of the Act:

4(1) A trade-mark is deemed to have been used in association with wares if, at the time of 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.

[5] Mr. Fleury identifies himself as the Operations Manager of Mueller International, Inc., Vice-President, Research and Development of Mueller Co., the United States operating affiliate of the Registrant and Vice President of Mueller Canada Ltd. (Mueller Canada), the Canadian operating affiliate of the Registrant. At paragraph 7 of his affidavit, he states the following:

“Pursuant to written license agreements effective as of September 20, 2001, the Registrant granted to each of Mueller Canada and Mueller Co. (collectively, the “Licensees”) a license to use, among other things, certain patents and trade-marks owned by the Registrant in various countries throughout the world (the “License Agreements”). Specifically, for these purposes, pursuant to the License Agreements, the Registrant licenses the Licensees to use the Trade-mark in Canada in association with the Wares. Pursuant to the License Agreements, the Registrant maintains quality control over the Trade-mark and all use by the Licensees of the Trade-mark insures to the benefit of the Registrant.”

[6] Mr. Fleury goes on to explain that the licensees manufacture and sell a variety of waterworks, plumbing and piping applications and have done so throughout the relevant period. Further, the licensees manufacture all of their products, including the Wares bearing the Mark at their own factories and foundries and have been doing so throughout the relevant period. The ordinary course of the licensees’ trade in Canada involves selling the products at wholesale to unrelated retailers who in turn sell the products to consumers and to industrial plumbing suppliers for installation or sale to the trade.

[7] At paragraph 12 of his affidavit, Mr. Fleury states that although the Mark does not appear on the Wares themselves, it appears on installation instructions and other product literature that accompanies the Wares. Attached as Exhibit A1 to his affidavit is an instruction sheet, upon which the Mark appears, showing how to properly install the Wares. He explains that while the document was created in December of 1994, it was in use in Canada throughout the relevant period in conjunction with the Wares. As Exhibit A-2, he attaches a specification sheet upon which the Mark appears from 2004/2005 produced by one of the Licensees, showing straight three part union and straight conductive compression connections as well as branch connections which are all compression couplings.

[8] Mr. Fleury has provided understated figures for the sales in Canada of compression couplings sold in association with the Mark during the relevant period. The total sales were more than \$5,000,000 during this period.

[9] Mr. Fleury attaches as Exhibit B to his affidavit a representative invoice showing a sale of the Wares to a customer with an address in Canada in association with the Mark during the relevant period. He explains how the item numbers on the invoices correspond to the compression couplings shown in Exhibit A.

[10] In its written argument, the Requesting Party concedes that there is evidence of use that products are sold to plumbing and waterworks distributors and plumbing suppliers. However, the Requesting Party also argues that the nature of the trade referring to “waterworks” is vague and does not provide sufficient detail to determine the specific underlying goods or customers. It is also argued that there are no statements, brochures, price lists or invoices directed to any business in association with “compression couplings for use on gas, oil, steam or other fluid conducting lines”.

[11] In my opinion, the evidence as a whole is sufficient to enable me to conclude that the Mark has been used in Canada in association with the Wares described in the registration during the relevant period. The invoice filed confirms that there were some sales of the Wares during the relevant period. I also conclude that at the time of transfer of the Wares, notice of association between the Mark and the Wares was given to the purchaser in accordance with the provisions of s. 4(1) of the Act. In this regard, I am satisfied that the Mark was drawn to the attention of the purchaser by the instruction sheet showing how to properly install the Wares which Mr. Fleury states accompanied the Wares.

[12] Finally, with respect to the Requesting Party’s argument that use of the Mark has not been shown of the Mark in association with “compression couplings for use on gas, oil, steam and other fluid conducting lines”, in my view the Registrant’s registration is for one ware, namely compression couplings for use with conducting lines, and “gas, oil, water and steam” are examples of the types of conducting lines the Wares could be used with. Further, the evidence

does not show that compression couplings for use on water conducting lines could not be used for other applications, or that compression couplings for use on gas, oil, water and steam are different products. I am therefore satisfied that the Mark has been used with the Wares during the relevant period.

[13] Although I am prepared to conclude that use has been shown of the Mark in association with the Wares during the relevant period, it must still be determined whether the use shown enures to the benefit of the Registrant. In this regard, all the use that has been shown has been by Mueller Canada and Mueller Co., companies which have been identified by Mr. Fleury as licensees of the Registrant.

[14] The only way that third party use of a trade-mark is deemed to be that of the registered trade-mark owner is when s. 50 of the Act is satisfied. Sections 50(1) and 50(2) of the Act are reproduced below:

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

[15] In the present case, copies of the license agreements, from which I may have been able to determine that the Registrant had control over the character and quality of the Wares under the license, have not been submitted into evidence. Further, there has been no assertion as to the requisite control by the registered owner. In this regard, I note that Mr. Fleury states that the Registrant maintains quality control *over the trade-mark*. From the wording of s.50, it is clear that the registered owner must have, under the license, direct or indirect control *of the character or quality of the wares or services*. Finally, the evidence does not reveal that public notice was

given of the fact that the Mark was used under license and of the identity of the Registrant; accordingly, the presumption set out in s. 50(2) of the Act does not arise in this case. I must therefore conclude that any use of the Mark by the licensees does not accrue to the Registrant.

[16] As I have concluded that any use shown by the evidence does not accrue to the Registrant, I have no alternative but to conclude that the Mark MUELLER 110 ought to be expunged. Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be expunged in compliance with the provisions of s. 45 of the Act.

DATED AT Gatineau, THIS 22nd DAY OF December, 2009.

C.R. Folz  
Member,  
Trade-marks Opposition Board