



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 230

Date of Decision: 2022-11-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Montréal Production Inc.

Registered Owner: H-D U.S.A., LLC

Registration: TMA294,796 for HARLEY

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA294,796 for the trademark HARLEY.

[2] The subject trademark is registered for use in association with “Motorcycles and parts thereof”.

[3] For the reasons that follow, I conclude that the registration ought to be maintained only in association with motorcycle parts.

THE RECORD

[4] At the request of Montréal Production Inc. (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to H-D U.S.A., LLC (the Owner).

[5] The notice required the Owner to show whether the trademark HARLEY was used in Canada in association with each of the goods specified in 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 such use since that date. Where the Owner has not shown use, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[6] As the notice was sent to the Owner on August 13, 2020, the relevant period for showing use in this case is between August 13, 2017 and August 13, 2020.

[7] The relevant definition of “use” is set out in section 4(1) of the Act as follows:

A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[8] In response to the Registrar’s notice, the Owner submitted the declaration of Adraea Brown, Vice President and Assistant General Counsel for the Owner, solemnly declared on February 8, 2021, together with Exhibits AB-1 to AB-7.

[9] Both parties filed written representations, but only the Owner was represented at an oral hearing. In this respect, while the Requesting Party was scheduled to make representations, the Registrar received an email from the Requesting Party the morning of the hearing indicating that it was unable to attend the hearing due to an emergency. However, as the Requesting Party did not explain the nature of its emergency and neither explicitly requested a rescheduling of the hearing nor attempted to obtain the Owner’s consent to any such rescheduling, the hearing proceeded as scheduled [*per the practice notice Practice in section 45 proceedings*].

[10] The hearing in this proceeding was held concurrently with the hearings in summary expungement proceedings with respect to registration Nos. TMA574,523, TMA649,923, TMA665,193, TMA669,509, TMA671,782, TMA701,942, and TMA975,878 for various other HARLEY-formative trademarks. Separate decisions will issue for those registrations.

SUMMARY OF THE EVIDENCE

[11] Ms. Brown explains that the Owner's main activity is the manufacture and sale of motorcycles, and that the Owner's activities also extend to a "vast area of products and services ancillary to motorcycling such as clothing, jewelry, finance and insurances, touring and servicing."

[12] In her declaration, Ms. Brown identifies and defines the goods listed in the subject registration as follows:

- motorcycles;
- motorcycle parts (hereinafter the "Goods").

As a result, it is unclear whether Ms. Brown's definition of "the Goods" includes motorcycles. That being said, this ambiguity does not materially affect my conclusion.

[13] With respect to sales, Ms. Brown asserts that, during the relevant period, "at least one unit" of each of the Goods bearing "the Trademark" was sold in Canada in the normal course of trade, and that "the Trademark" was associated with the Goods at the time of their transfer.

[14] I note here that Ms. Brown references "the Trademark" throughout her declaration. However, virtually all of the evidenced materials display variations of the subject trademark, such as the word mark HARLEY-DAVIDSON and related design marks, rather than HARLEY *per se*. Furthermore, Ms. Brown misidentifies "the Trademark" in her declaration as being the trademark HARLEY-DAVIDSON, rather than the subject trademark HARLEY. It is therefore clear that Ms. Brown's numerous references to "the Trademark" do not necessarily refer to the trademark HARLEY *per*

se. Consequently, and for greater clarity, references to “the Trademark” in this decision are in quotation marks to indicate that the term is Ms. Brown’s rather than my own.

[15] With respect to licensees, Ms. Brown states that the Owner markets its products and services in Canada under “the Trademark” either directly or through licensees and distributors. She attests that, during the relevant period, the Owner exercised direct or indirect control over the character or quality of the Goods associated with “the Trademark”. Ms. Brown specifically identifies Harley-Davidson Motor Company and Harley-Davidson Canada LP as the Owner’s licensees.

[16] As evidence of transfers, Ms. Brown attaches representative invoices for motorcycles and for motorcycle parts [Exhibits AB-6 and AB-7, respectively].

[17] The Exhibit AB-6 invoices evidence sales of motorcycles between Harley-Davidson Motor Company and Harley-Davidson Canada LP, including during the relevant period. The exhibited invoices also evidence the sale of those motorcycles by Harley-Davidson Canada LP to dealers in Canada. The Exhibit AB-7 invoices evidence sales of motorcycle parts by Harley-Davidson Motor Company to dealers in Canada, including during the relevant period.

[18] The trademark HARLEY is not displayed on the exhibited invoices, except as part of the design mark reproduced below (the Company Logo):



[19] I note that Exhibit AB-7 also includes what appears to be excerpts from internal sales reports. The excerpts are truncated and seemingly disordered; without any reference to them in Ms. Brown’s declaration, their significance is unclear. The subject trademark does not appear to be associated with any goods referenced in the reports.

[20] With respect to the amount of sales, Ms. Brown attests that, in 2018 and in 2019, over 8,000 motorcycles bearing “the Trademark” were sold in Canada. Ms. Brown also provides yearly sales figures for “motorcycle parts constituting the Goods bearing the Trademark”, totaling over \$200 million over the course of the relevant period in Canada.

[21] In addition, Ms. Brown attaches a 2020 HARLEY-DAVIDSON® GENUINE MOTOR PARTS & ACCESSORIES catalogue which she refers as Harley-Davidson Motor Company’s “2020 Big Book” [Exhibit AB-4]. Ms. Brown states that the exhibited catalogue “was used during the Relevant Period to indicate the parts and accessories available and was also used to select and order those motorcycle parts in Canada.”

[22] The almost 900-page catalogue depicts and describes a wide variety of motorcycle parts and accessories. Although the catalogue also includes photographs of motorcycles, there is nothing to suggest that such motorcycles were purchased using the catalogue. Further, none of the depicted motorcycles bear the trademark HARLEY *per se*.

[23] In fact, there are very few instances of display of the trademark HARLEY *per se* in the catalogue. Nevertheless, I note that the catalogue index lists the following items: “Harley® Detailing Kit”, “Harley Hammock Touring Seats”, “Harley Travel Care Kit”, “Harley Wash Bucket” and “Harley Bike Wash Kit” at page 841 of the catalogue. Those items are depicted in the catalogue, however their image quality is poor, and it is not possible to discern whether they bear the trademark HARLEY.

[24] Ms. Brown also attaches a screenshot of a webpage which she identifies as the Owner’s website located at <https://accessories.harley-davidson.ca/products/#/> [Exhibit AB-5], which she states was used to select and order parts constituting the registered goods. The image quality of the exhibited screenshot is very poor and most of the print is illegible; the trademark HARLEY is not visible.

[25] Finally, Ms. Brown attaches a document she describes as “a 2019 catalogue of [the Owner] featuring some of its 2020 motorcycles” [para 11, Exhibit AB-3]. However, this exhibit appears to be comprised of printouts from the Harley-Davidson Accessories

webpage attached as Exhibit AB-5. Indeed, the first page of Exhibit AB-3 appears to correspond to the webpage captured in the Exhibit AB-5 screenshot. The trademark HARLEY appears to be nowhere displayed on the exhibited printouts, nor on the products depicted on the captured webpages.

[26] Although paragraph 10 of Ms. Brown's declaration indicates that there is no Exhibit AB-2, I note that an exhibit identified as Exhibit AB-2 is attached to the declaration. At the hearing the Owner confirmed that the exhibit was attached in error and should be disregarded.

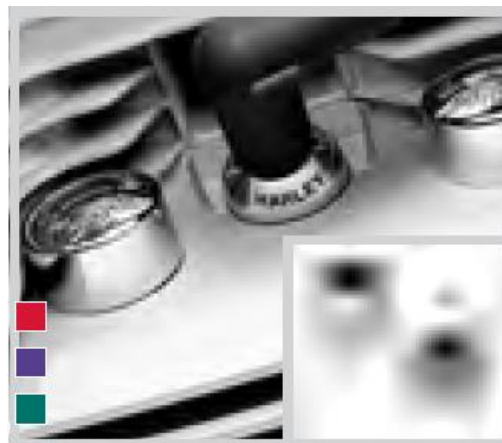
ANALYSIS

[27] There is no dispute that the Owner has sold motorcycles and motorcycle parts during the relevant period. The question to be decided is whether those goods were sold in association with the trademark HARLEY within the meaning of sections 4(1) and 45 of the Act.

[28] In its written representations, the Owner relies on Ms. Brown's "clear and unambiguous" assertions with respect to the "full use" of the subject trademark in Canada. The Owner also cites specific pages of the Exhibit AB-4 catalogue which it argues "illustrate" the way the subject trademark is affixed or otherwise associated to goods. It is unclear whether the cited page numbers refer to the catalogue page or the exhibit page, and the Owner does not explain the relevance of the cited pages.

[29] At the hearing, the Owner confirmed that it only asserts use of HARLEY *per se*. In this respect, the Owner agreed that the trademark HARLEY-DAVIDSON is not a minor deviation of the subject trademark and, therefore, that display of HARLEY-DAVIDSON does not constitute display of the subject trademark as registered. Indeed, in applying the principles set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA*, 1985 CanLII 5537, 4 CPR (3d) 523 (FCA), I find that the display of the HARLEY-DAVIDSON word mark or the Company Logo does not constitute display of HARLEY *per se*.

[30] When asked at the hearing, the Owner confirmed that the trademark HARLEY *per se* is not displayed in the exhibited invoices. The Owner also confirmed that there was no evidence showing products bearing HARLEY *per se*, with the possible exception of one blurry photograph showing part of a spark plug cover at page 542 of the catalogue:



C, SPARK PLUG COVERS
(32745-99 SHOWN)

[31] The particular spark plug cover model shown is identified on the same page as the “H-D Motor Co. Logo” model. Considering the prevalence of the trademark HARLEY-DAVIDSON in the evidenced materials as well as the name of this particular spark plug model, it is reasonable to infer that the depicted spark plug bears the trademark HARLEY-DAVIDSON rather than HARLEY *per se*.

[32] That being said, HARLEY *per se* is displayed as part of the product name for certain motorcycle parts offered in the Exhibit AB-4 catalogue index, namely the “Harley Hammock Touring Seats”. This particular product is displayed at page 167 of the catalogue and I note that it is identified on that page as a “Harley® Hammock” seat.

[33] Display of a trademark in catalogues used for ordering purposes can provide the required notice of association [see, for example, *Dart Industries Inc v Baker & McKenzie LLP*, 2013 FC 97]. Consequently, having regard to the evidence as a whole, including Ms. Brown’s sworn statement that the catalogue was used during the relevant period to order motorcycle parts in Canada, I am prepared to accept that such motorcycle seats

were sold during the relevant period and that at least some of them were purchased by ordering from the catalogue.

[34] In view of the foregoing, I am satisfied that the Owner has shown use of the subject trademark HARLEY within the meaning of sections 4 and 45 of the Act, but only in association with “motorcycle parts”. As there is no evidence of special circumstances which could excuse non-use of the Trademark in association with “motorcycles”, the statement of goods will be amended accordingly.

DISPOSITION

[35] Pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete “Motorcycles” and the remaining statement of goods will be amended to read “Motorcycle parts”.

Eve Heafey
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: July 7, 2022

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Charlotte MacDonald

AGENTS OF RECORD

For the Requesting Party: No agent appointed

For the Registered Owner: Gowling WLG (Canada) LLP