



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 232

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: TMA975,878 for HARLEY

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA975,878 for the trademark HARLEY (the Trademark).

[2] The Trademark is registered for use in association with the following goods:

- (1) Jewelry, ankle bracelets, bracelets, earrings, necklaces, tie tacks, ornamental lapel pins, stick pins, clocks, watches, rings, charms, key fobs, watchbands, collar tips, boot chains, pins for hats, figurines of precious metal.
- (2) Watches, rings, bracelets, necklaces, earrings, pins being jewelry; jewelry, namely, wrist cuffs, pendants, charms and ride beads for making jewelry.
- (3) Money clips.
- (4) Pewter plates.
- (5) Belt buckles of precious metal.

[3] For the reasons that follow, I conclude that the registration ought to be amended.

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 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 the Trademark 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 March 3, 2021, together with Exhibits AB-1 to AB-5.

[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. TMA294,796, TMA574,523, TMA649,923, TMA665,193, TMA669,509, TMA671,782, and TMA701,942 for various other HARLEY-formative trademarks. Separate decisions will issue for those registrations.

SUMMARY OF THE EVIDENCE

[11] In her declaration, 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] 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 registered goods associated with the Trademark.

[13] Before proceeding, I note here that Ms. Brown references "the Trademark" throughout her declaration. However, as set out in greater detail below, virtually all of the evidenced materials display variations of the Trademark, rather than HARLEY *per se*. It is therefore clear that Ms. Brown's numerous references to "the Trademark" do not necessarily refer to the Trademark as registered.

[14] Ms. Brown also defines the registered goods as "the Goods" and 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.

[15] With respect to watches, Ms. Brown attaches Spring and Fall 2018 “sell-sheets” for watches [Exhibit AB-2]. Ms. Brown states that the sell-sheets were “available and distributed” in Canada during the relevant period and “used... to indicate some of the watches available under the Trademark and to select and order those watches in Canada”. The sell-sheets prominently display the trademark HARLEY-DAVIDSON® in their headings and depict various models of men’s and ladies’ wristwatches together with product codes and prices.

[16] Ms. Brown asserts that the exhibited sell-sheets are “illustrative of some of the watches sold in Canada under the Trademark”, but she points to no specific examples showing how the Trademark was displayed in association with such watches. Though the image quality of the sell-sheets is somewhat poor, I note that the vast majority of the depicted watches appear to bear the trademark HARLEY-DAVIDSON, or a stylized form thereof, such as the design mark reproduced below (the Cycles Logo):



[17] Regarding the sell-sheets, Ms. Brown explains that “Citizen Watch Canada Ltd. (‘Bulova’)” was one of the Owner’s licensees in Canada during the relevant period with respect to watches, though there seems to be no reference to that company in this exhibit.

[18] With respect to other Goods, Ms. Brown attaches the 2017 and 2020 jewelry catalogues of MOD Jewelry Group, Inc. [Exhibit AB-3]. As for the sell-sheets, Ms. Brown states that the catalogues were “available and distributed” in Canada during the relevant period and “used... to indicate some of the Goods (other than watches) [available] and to select and order those goods in Canada”. She further states that MOD Jewelry Group, Inc. was one of the Owner’s licensees in Canada during the relevant period with respect to Goods other than watches.

[19] Again, Ms. Brown asserts that the catalogues are “illustrative of some of the Goods sold in Canada under the Trademark”, but points to no example of the Trademark displayed in association with such Goods. While it appears that the vast majority of the depicted jewelry items bear the trademark HARLEY-DAVIDSON or a stylized form thereof, it is possible to discern certain jewelry items that are marked with the Trademark as registered. I note one catalogue page for a HARLEY CURSIVE & OLD ENGLISH product line which depicts necklaces, earrings, bracelets and rings, all clearly bearing the trademark HARLEY *per se* in cursive and in old English-style fonts; another catalogue page, for RALLY BRACELETS, depicts a bracelet charm bearing the trademark HARLEY *per se*.

[20] To further “illustrate some of the Goods sold under the Trademark”, Ms. Brown attaches webpage screenshots from websites of the Owner’s licensees and authorized dealers [Exhibit AB-4]. She states that, despite the date when they were captured, the exhibited webpages were “accessible and accessed” and “used to select and order” Goods during the relevant period in Canada. In addition, Ms. Brown asserts that the Trademark was “associated with the Goods when delivered in Canada, either by way of marking on the Goods, their packaging or the accompanying publicity material or invoices, or both”.

[21] As with the previous exhibits, Ms. Brown does not identify any display of the Trademark in the exhibited webpages. The webpages offer various items for sale including watches, jewelry, footwear, accessories such as belts and key chains, clothing, and garden gnome figurines. Though the image quality of the screenshots is poor, the trademark HARLEY *per se* does not appear to be anywhere displayed, whether on the depicted products themselves or the webpages, aside from one belt buckle shown on what appears to be a Wisconsin dealership webpage located at www.wisconsinharley.com.

[22] As evidence of transfers, Ms. Brown attaches invoices issued by the Owner’s licensees Citizen Watch Canada Ltd., MOD Jewelry Group, Inc. and Harley-Davidson Canada LP, to retailers and authorized dealers in Canada [Exhibit AB-5]. Ms. Brown

states that the invoices are representative of sales of Goods made “in Canada, in the normal course of trade, during the Relevant Period in association with the Trademark.” She further states that the invoices accompanied the Goods at the time of transfer. The specific invoiced products will be discussed in greater detail in the analysis below.

[23] According to Ms. Brown, over the course of the entire relevant period, retail sales of the Goods bearing the Trademark were not less than \$1.2 million for watches and watchbands, and \$1.5 million for Goods other than watches and watchbands.

ANALYSIS

[24] 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 Trademark and, therefore, that display of HARLEY-DAVIDSON does not constitute display of the 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 neither the display of the HARLEY-DAVIDSON word mark, nor the evidenced stylized versions thereof such as the Cycles Logo, constitutes display of the Trademark *per se*.

[25] As such, the issue to be decided in this case is whether the Owner has provided sufficient evidence to establish use of the Trademark *as registered* in association with *each* of the goods listed in the registration.

[26] With respect to use in association with “watches and watchbands”, the Owner points to the invoices issued by Citizen Watch Canada Ltd. Those invoices show sales of “Bulova” items further identified with a product code and product description, sometimes including the Trademark, such as HARLEY M W BR SL, HARLEY M W ST PE and HARLEY M W BR BK. The product codes match the code format associated with watches in the Exhibit AB-2 sell-sheets. For instance, a watch described as HARLEY M W ST BK CAL and identified with code 76B178 in one invoice is also depicted in the Spring 2018 sell-sheet.

[27] In light of Ms. Brown's statement that the invoices accompanied the Goods, I accept that the requisite notice of association between the Trademark and the invoiced watches was given at the time of transfer [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321; and *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD)] for the principle that display a trademark on an invoice that accompanies the goods at the time of transfer may satisfy the requirements of section 4(1) of the Act].

[28] The Citizen Watch Canada Ltd. invoices also list products identified with the terms "strap" and "bracel", such as STRAP M W ST BK and BRACEL M W BR BL. Even if I were to accept that they correspond to "watchbands", the Trademark is not associated with these invoiced products nor does the evidence show any watchbands bearing the Trademark. Moreover, considering that Ms. Brown's references to the Trademark are at best vague and may refer to other trademarks, Ms. Brown's statements regarding sales of Goods in association with the Trademark are on their own insufficient to establish that the requisite notice of association was given with respect to any Goods.

[29] At the hearing, the Owner argued that it also sold watchbands as a component of watches. Generally, use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA); for similar conclusions regarding components or ingredients, see *McMillan LLP v Orange Brand Services Ltd*, 2016 TMOB 111 at paras 72-73; *Vermillion Intellectual Property Corp v Vermillion Energy Inc*, 2017 TMOB 24 at para 69]. For the Owner to maintain its registration for the goods "watchbands", it had to show transfer and sales of such goods otherwise than as components of "watches".

[30] With respect to use in association with "jewelry (and all the goods except watches and watchbands)", the Owner points to certain MOD Jewelry Group, Inc. invoices showing sales of various types of jewelry. Based on my review of invoices

identified by the Owner in its submissions, I note invoiced products described as “Cursive Harley Bangle Bracelet”, “Rose Gold Cursive Harley Necklace” and “Old English Harley Necklace” which plainly correspond to the registered goods “bracelets” and “necklaces”.

[31] I also note an invoiced product described as a “Harley Engine Ride Bell”. Having regard to the various “ride bells” depicted in the exhibited jewelry catalogue, I am prepared to accept that the invoiced bells correspond to the registered goods “jewelry”.

[32] There is very limited evidence of transfers of the remaining registered goods. On this point, I am not prepared to accept Ms. Brown’s statement that “at least one unit” of each of the Goods was sold during the relevant period, as sufficient evidence of transfers of Goods. Indeed, although this statement is accompanied by an aggregated sales figure for Goods other than watches and watchbands, the figure is not broken down by item and could therefore be associated to sales of only, for example, bracelets and necklaces.

[33] Further, while the exhibited MOD Jewelry Group, Inc. invoices show sales of “earrings”, “rings” and “charms”, and of one “ride bead”, there is no indication that these products belong to the HARLEY CURSIVE & OLD ENGLISH product line depicted in the catalogue, or that the Trademark was otherwise associated with any of them. In fact, their product descriptions suggest that they were instead associated with variations of the Trademark shown in the jewelry catalogues such as H-D, HARLEY-DAVIDSON, the Cycles Logo and other stylized versions of those marks.

[34] Consequently, there is no evidence establishing transfers of any the remaining registered goods in association with the Trademark, during the relevant period or otherwise.

[35] Having regard to all of the above, I am satisfied that the Owner has shown use of the Trademark within the meaning of sections 4 and 45 of the Act, but only in association with “watches”, “bracelets”, “necklaces” and “jewelry”. As there is no

evidence of special circumstances which could excuse the absence of use, the registration will be amended accordingly.

[36] Before concluding, I note that the registration includes a number of duplicated goods; however, I am satisfied that such duplication is not at issue in this proceeding.

DISPOSITION

[37] 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 the following goods:

- (1) ... ankle bracelets, ... earrings, ... tie tacks, ornamental lapel pins, stick pins, clocks, ... rings, charms, key fobs, watchbands, collar tips, boot chains, pins for hats, figurines of precious metal.
- (2) ... rings, ... earrings, pins being jewelry; jewelry, namely, wrist cuffs, pendants, charms and ride beads for making jewelry.
- (3) Money clips.
- (4) Pewter plates.
- (5) Belt buckles of precious metal.

[38] The statement of goods will now read as follows:

- (1) Jewelry, bracelets, necklaces, watches.
- (2) Watches, bracelets, necklaces.

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