



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 234

**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:** TMA574,523 for HARLEY-DAVIDSON

### **INTRODUCTION**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA574,523 for the trademark HARLEY-DAVIDSON (the Trademark).

[2] The Trademark is registered for use in association with the services “Arranging motorcycle tours, transport, storage and rental of motorcycles”.

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

## **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 registered trademark was used in Canada in association with each of the services 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 mark was last in use and the reason for the absence of such use since that date.

[6] As the notice was sent to the Owner on July 8, 2020, the relevant period for showing use in this case is between July 8, 2017 and July 8, 2020.

[7] The relevant definition of “use” is set out in section 4(2) of the Act as follows:

A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[8] Use of a trademark in association with services can therefore be shown through advertisement, rather than performance. As such, evidence of actual transactions is not required for a trademark owner to satisfy the requirements of section 4(2) of the Act. Indeed, the display of the trademark in the advertisement of the services is sufficient to show use of that trademark within the meaning of the Act, provided the owner was willing and able to perform the services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[9] 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 1, 2021, together with Exhibits AB-1 to AB-4.

[10] 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*].

[11] The hearing in this proceeding was held concurrently with the hearings in summary expungement proceedings with respect to registration Nos. TMA294,796, 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**

[12] According to Ms. Brown, the Owner's main activity is the manufacture and sale of motorcycles, and 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."

[13] 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 services associated with the Trademark.

[14] In her declaration, Ms. Brown asserts that, during the relevant period, the Owner displayed the Trademark in the performance or advertising of the registered services in Canada. In support, she attaches to her declaration printouts and screenshots from websites of the Owner's licensees and authorized dealers. For each of the exhibits, she provides a statement that, despite the date when they were captured, the exhibited webpages "were accessible and accessed in Canada during the Relevant Period".

[15] The evidence specifically relating to each of the registered services will be discussed in greater detail in the analysis section below.

## **ANALYSIS**

### ***Arranging motorcycle tours***

[16] With respect to the registered services “arranging motorcycle tours”, Ms. Brown attests that such services were offered and rendered in Canada during the relevant period and that the Trademark was displayed in the performance and advertising of those services.

[17] As Exhibit AB-2 to her declaration, she attaches “extracts” from two websites operated by the Owner’s licensees, namely H-C Travel (trading as Orange & Black), and Harley-Davidson International. The exhibited Orange & Black webpages promote “USA and Canada Tours”, including a “Guided Canadian Rockies and Rivers motorcycle tour” package, which includes a “Harley-Davidson® rental motorcycle”. The exhibited Harley-Davidson International webpages advertise “Harley-Davidson® Authorized Tours” throughout the world, including the Orange & Black tours in Canada.

[18] The Requesting Party submits that arranging motorcycles tours is a purely promotional activity and therefore cannot support use of the Trademark “in the normal course of trade”. However, whereas use in the normal course of trade is an element of section 4(1) of the Act in relation to goods, section 4(2) of the Act does not incorporate the requirement that use with respect to services be “in the normal course of trade” *per se*. As long as some members of the public, consumers or purchasers, receive a benefit from the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), *aff’d* 2002 FCA 11; *Live! Holdings LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042, *aff’d* 2020 FCA 120].

[19] Considering the evidenced display of the Trademark on the exhibited webpages promoting motorcycle tours in Canada, I am satisfied that the Owner has shown use of the Trademark in association with “arranging motorcycles tours” within the meaning of sections 4(2) and 45 of the Act.

### ***Arranging transport, storage and rental of motorcycles***

[20] With respect to the registered services “arranging storage of motorcycles”, Ms. Brown attests that such services were offered and rendered in Canada during the relevant period and that the Trademark was displayed in the performance and advertising of those services.

[21] As Exhibit AB-3 to her declaration, she attaches “documents and website extracts from some of [the Owner’s] Ontario licensees (Fox, Clare and MacKie), a [sic] BC licensees (Mountainview and gasoline alley) and a Quebec licensee (Gabriel Harley-Davidson Montreal)”.

[22] The exhibited dealership webpages display the Trademark along with various winter storage offers. For instance, the exhibited webpage for “Clare’s Harley-Davidson® of Niagara” advertises different levels of “Winter Storage Packages”, such as “Silver”, “Gold” and “Platinum” packages, together with the following banner:



[23] Another exhibited webpage, for Fox Harley-Davidson in Owen Sound, Ontario, displays an image of a motorcycle and a price list for “2019-2020 Winter Storage”. The price list indicates that storage is “offered in heated/secured building”.

[24] With respect to the registered services “arranging transport of motorcycles”, Ms. Brown states that, during the relevant period, the Owner’s licensees offered the transport of motorcycles. In support, she refers to Exhibit AB-3 referenced above and she explains that this exhibit deals with not only storage of motorcycles, but also advertises the transportation of motorcycles. Indeed, I note that an exhibited webpage for the Mackie Harley-Davidson dealership indicates that “Mackie Harley-Davidson® offers pick up and delivery services at an additional fee. Rates are calculated based on customer location.”

[25] Finally, with respect to the registered services “arranging rental of motorcycles”, Ms. Brown attests that such services were offered and rendered in Canada during the relevant period and that the Trademark was displayed in the performance and advertising of those services.

[26] As Exhibit AB-4 to her declaration, she attaches “extracts from documents and websites operated by [the Owner’s licensees]”. I note a webpage printout for Harley-Davidson Canada providing information regarding Harley-Davidson motorcycle rentals and a search tool to “find a rental location”. Similarly, webpage screenshots and printouts for Canadian Harley-Davidson dealerships provide information and pricing for Harley-Davidson motorcycle rentals.

[27] Having regard to the above, I am satisfied that the Owner has shown use of the Trademark in association with “[arranging] transport, storage and rental of motorcycles” within the meaning of sections 4(2) and 45 of the Act.

**DISPOSITION**

[28] 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 maintained.

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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