

# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 235

**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:** TMA665,193 for HARLEY

### **INTRODUCTION**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA665,193 for the trademark HARLEY (the Trademark).

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

Extension of consumer credit via credit cards, credit card and debit cards, financial services namely issuance of loans and provision of purchase financing, provision of extended service plans and purchase protection plans; commercial insurance, wholesale insurance, retail lending, wholesale lending, insurance brokerage in the field of motorcycles, motorcycle dealerships and special events for motorcycle dealerships and motorcycle clubs.

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

## **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 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 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 3, 2020, the relevant period for showing use in this case is between August 3, 2017 and August 3, 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] In response to the Registrar’s notice, the Owner submitted a first 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 (the First Declaration), as well a second declaration solemnly declared by Ms. Brown on February 5, 2021, together with Exhibits AB-8 and AB-9 (the Second Declaration).

[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, 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] In her declarations, 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 services associated with "the Trademark".

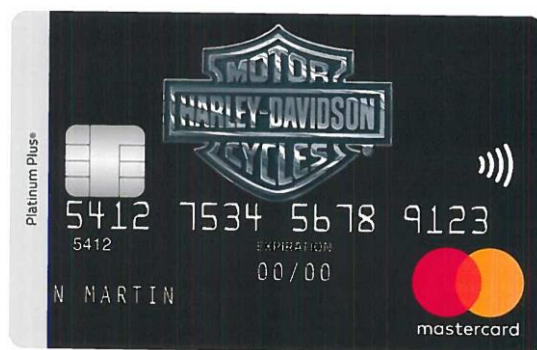
[13] Before proceeding, I note here that Ms. Brown references "the Trademark" throughout her declarations. However, as set out in greater detail below, virtually all of the evidenced materials display variations of the Trademark, rather than HARLEY *per se*. It is therefore clear that Ms. Brown's numerous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

[14] With respect to the registered services "extension of consumer credit via credit cards, credit card and debit cards", 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 [First Declaration, para 10].

[15] In support, she attaches Exhibit AB-2, consisting of webpage printouts from websites operated by the Owner's licensees. The exhibited webpages reference credit cards such as a "Harley-Davidson® Mastercard®" and a "Harley-Davidson® Platinum Plus® credit card", and credit card reward points which can be redeemed for "Harley Chrome® Cash that can be used for MotorClothes® apparel, Genuine Motor accessories, service and more". The webpages also promote a "quarterly contest" to win a motorcycle: "Every three months, you'll have the chance to win\* a Harley-Davidson® motorcycle".

[16] One of the Exhibit AB-2 printouts displays a trademark notice, in small font at the bottom of the page. The notice indicates that trademarks such as "HARLEY-DAVIDSON", "H-D", "the Bar & Shield logo" and "HARLEY" are "among the trademarks of [the Owner]".

[17] As for actual credit cards issued in Canada, Ms. Brown states that, during the relevant period, there were never less than 30,000 credit card holders in Canada and that the Trademark appeared on the credit cards themselves [First Declaration, para 10]. Based on my review of the exhibits, the only credit card shown in evidence is a "Platinum Plus Mastercard" in Exhibit AB-2. As shown below, the Trademark only appears as part of the Harley-Davidson Motor Cycles design mark (the Cycles Logo):



[18] With respect to the registered services "financial services namely issuance of loans and provision of purchase financing" as well as "provision of extended service plans and purchase protection plans", 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 [First Declaration, paras 11 and 12].

[19] In support, she attaches Exhibit AB-3, consisting of webpage printouts and screenshots from websites operated by dealerships licensed by the Owner, as well as a credit application from Harley-Davidson Financial Services Canada, Inc., also the Owner's licensee.

[20] The Cycles Logo is displayed in the upper and lower left hand corner of the first page of the credit application. As for the webpages, these promote "Harley-Davidson® Financing", "Harley-Davidson® Financial Services" and various financing offers, as well as a "Harley-Davidson® Extended Service Plan" and a "Harley-Davidson® Tire + Wheel Protection".

[21] I note that the Trademark *per se* is displayed in this exhibit, though as discussed below, only in reference to motorcycles such as: "protect your new or pre-owned Harley® motorcycle" and "Talk to Trev Deeley Motorcycles about financing your Harley® with credit, and get out on the road today!".

[22] In addition, Ms. Brown attaches Exhibit AB-9 to her Second Declaration, consisting of invoices showing sales of motorcycles between two of the Owner's licensees, namely Harley-Davidson Motor Company and Harley-Davidson Canada LP, together with invoices showing the subsequent sale of those motorcycles by Harley-Davidson Canada LP to various dealers in Canada. The invoices are dated within the relevant period and display the design mark reproduced below (the Company Logo), which is similar to the Trademark albeit with the word COMPANY replacing the word CYCLES:



[23] With respect to the registered services “commercial insurance, wholesale insurance ... [and] insurance brokerage in the field of motorcycles”, Ms. Brown attaches Exhibit AB-4, consisting of a printout from a webpage relating to “Harley-Davidson® Insurance” for “Canadian Harley-Davidson® motorcycle riders” and a screenshot of the website for Prairie Harley-Davidson promoting an “Extended Service Plan”. The webpages promote insurance benefits such as trip interruption coverage, choice of repair shop and genuine replacement parts.

[24] Ms. Brown explains that – due to confidentiality concerns – she cannot disclose documents showing wholesale insurance, but she asserts that those services were offered “under the Trademark” to the Owner’s licensed dealers in Canada during the relevant period [First Declaration, para 14].

[25] In addition, Ms. Brown attaches Exhibit AB-8 to her Second Declaration, consisting of brochures which she explains were issued by Harley-Davidson Financial Services Canada [Second Declaration, para 10]. The brochures advertise various types of insurance as well as protection plans such as the “Harley-Davidson® Extended Service Plan”, the “H-D® Tire & Wheel Protection”, the “Harley-Davidson® Theft Protection” and the “H-D™ Gap Plan”. Trademark notices such as the one referenced above are displayed on these brochures.

[26] In her Second Declaration, Ms. Brown also provides approximate numbers of insurance and protection plans which were in force during the relevant period. For example, she attests that there were at least 30,000 “ESP Extended Protection Plans” 175 “Purchase protection plans”, 2,500 “Theft Insurances” and 3,000 “GAP Insurances” in force in Canada during the relevant period [Second Declaration, para 11].

[27] With respect to the registered “retail lending” and “wholesale lending” services, Ms. Brown states that “lending” is a form of financing or loan and, consequently, that she relies on the Exhibit AB-3 materials in support of the use of the Trademark in association with the registered “retail lending” and “wholesale lending” services [First Declaration, para 14].

[28] Again, Ms. Brown explains that – due to confidentiality concerns – she cannot disclose documents showing wholesale lending, but she asserts that those services were offered under the Trademark to the Owner's licensed dealers in Canada during the relevant period [First Declaration, para 14].

[29] With respect to the registered services, “motorcycle dealerships”, Ms. Brown attests that “at any moment during the Relevant Period, [the Owner] had, in Canada, at least 68 licensed dealers operating under the Trademark” [First Declaration, para 16].

[30] In support, she attaches Exhibit AB-5, which consists of various photographs and documents relating to the Owner's dealer network. In particular, I note photographs depicting the storefront of two licensees of the Owner, namely the Gabriel Harley-Davidson Montreal and the Leo Harley-Davidson Brossard motorcycle dealerships, as well as webpage printouts from the website operated by the latter dealership. Signs displaying the Cycles Logo are visible in both exhibited photographs, along with storefront signs identifying the two dealerships as “HARLEY-DAVIDSON MONTREAL” and “LEO HARLEY-DAVIDSON”, respectively. Although the image quality of the Leo Harley-Davidson webpage printout is poor, I note that the Cycles Logo is displayed, as well as multiple references to Harley-Davidson®.

[31] As Exhibit AB-5, Ms. Brown also attaches documents for prospective dealers and new dealers, namely a webpage printout from *www.harley-davidson.com* providing information on how to “Become a Harley-Davidson® Dealer”, a copy of a “Prospective Dealer Inquiry” form, and a copy of an “Ownership Policy”. These materials display the Company Logo and refer to “Harley-Davidson® Dealers”, “Harley-Davidson® Dealerships” and “Harley-Davidson culture”.

[32] Finally, Ms. Brown attests that “support for special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses” was offered and rendered in Canada during the relevant period and that the Trademark was displayed in the performance and advertising of those services [First Declaration, para 17].

[33] In support, she attaches Exhibit AB-6, consisting of two webpage excerpts. The first is a printout of a post from the “Barrie Harley-Davidson” Facebook page dated August 15, 2019 providing details regarding a “BIKE NIGHT” event hosted by the dealership to be held later that day. Ms. Brown explains that Barrie Harley-Davidson is one of the Owner’s Ontario licensees. The Trademark is shown as part of a series of hashtags in the post: “#harley #hd #motorcycle #event #rain #move #inside #fun #exciting #staydry #august #2019 #summer #instagood”.

[34] The second is a screenshot of a Facebook event page providing details regarding a “Trev Deely’s Fall Open House” event to be held in September 2018. Ms. Brown explains that Trev Deeley Harley-Davidson is one of the Owner’s British Columbia licensees and that this event was an open house showcasing model year motorcycles. The Cycles Logo is displayed on this event page, and the event description references the Trademark: “Come check out some of our new 2019 models, find a clinic to satisfy your thirst for everything Harley... In the afternoon, hop on the jumpstart (11am – 2pm) to feel the thrill of a Harley...”

[35] I note that the First Declaration also attaches Exhibit AB-7, which is not identified or explained by Ms. Brown in her declaration, nor properly endorsed. At the hearing, the Owner confirmed that this exhibit should not have been included in the evidence. Accordingly, this exhibit will be disregarded.

### **ANALYSIS**

[36] 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 Cycles Logo or the Company Logo, constitute display of the Trademark *per se*.



[37] To establish use of the Trademark as registered, the Owner first relies on the display of the Trademark as part of trademark notices in the exhibited materials. The Owner also relies on references to a “Harley” such as “feel[ing] the thrill of a Harley” [Exhibit AB-6], as well as “financing your Harley® with credit” and “protect[ing] your new or pre-owned Harley® motorcycle” [Exhibit AB-3].

[38] The Owner also directed attention to certain instances where the Trademark was displayed together with additional material, such as “Harley Chrome® Cash” [Exhibit AB-2] and the “Harley” hashtag [Exhibit AB-6].

[39] First, I find that the display of Harley *per se* in the exhibited materials is insufficient to establish use of the Trademark in association with any of the registered services. For example, references to “a Harley” and “your Harley” are references to the motorcycles themselves as a product or good, rather than any particular service. Similarly, the association between the Trademark referenced in trademark notice footnotes and any of the services specified in the subject registration is at best unclear [for a similar conclusion in the context of trademarks appearing as part of domain names, see *McMillan LLP v SportsLine.com, Inc*, 2014 TMOB 51].

[40] Second, I do not find that the evidenced display of the Trademark in combination with additional material are minor deviations of the Trademark. Where a trademark is used in combination with additional words or features, use will be considered when the public, as a matter of first impression, would perceive the trademark as being used *per se*. This is a question of fact which is dependent on whether the trademark stands out from additional material, for example, by the use of different lettering, sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)]. Although not necessarily determinative, the placement of trademark or registration symbols may also be a relevant factor to consider [see *Rogers, Bereskin & Parr v Canada (Registrar of Trade Marks)* (1986), 9 CPR (3d) 260 (FCTD)].

[41] Applying the principles set out above, I find that the Trademark displayed as part of the hashtag does not stand out from the additional material. In fact, “#harley” is displayed together with a series of other hashtags such as “#motorcycle”, “#fun” and #summer. The Harley hashtag is not displayed any differently than the other hashtags in that series; each of the hashtags is displayed in the same lettering and sizing, such that none of them stands out from the others.

[42] Similarly, in the case of “Harley Chrome® Cash”, the Trademark is immediately followed by the word “Chrome”, in identical lettering and sizing. As a result, there is nothing to distinguish the additional matter from the Trademark as registered. In fact, the placement of the registered symbol strengthens the perception that the trademark displayed is HARLEY CHROME, rather than the Trademark.

[43] Having said that, even if I were to consider that Harley Chrome® Cash amounts to display of the Trademark *per se*, the association between that trademark and any of the registered services is unclear.

[44] In view of the foregoing, I am not satisfied that the Owner has shown use of the Trademark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

#### **DISPOSITION**

[45] As there is no evidence of special circumstances excusing the absence of use of the Trademark, 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 expunged.

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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