

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 237

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: TMA671,782 for HARLEY-DAVIDSON & DESIGN (4)

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA671,782 for HARLEY-DAVIDSON & DESIGN (4), reproduced below (the Trademark):



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

(1) Promotional support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses; operation of motorcycle dealerships.

(2) Extension of consumer credit via credit cards; issuance of credit cards 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; providing financial support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses.

(3) Lottery games/services.

[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 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 July 3, 2020, the relevant period for showing use in this case is between July 3, 2017 and July 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] 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 a trademark in the advertisement of services is sufficient to show use of that trademark within the meaning of the Act, from the time 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] The purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448]. However, bare statements of use are not sufficient [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (4th) 62 (FCA)] and sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the registered services during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[10] 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 3, 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).

[11] 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*].

[12] 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, TMA701,942, and TMA975,878 for various other HARLEY-formative trademarks. Separate decisions will issue for those registrations.

OVERVIEW OF THE EVIDENCE

[13] 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."

[14] 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.

[15] Ms. Brown concludes both declarations with the general assertion that, during the relevant period, the Owner displayed the Trademark in the performance or advertising of the registered services in Canada.

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

ANALYSIS

[17] With respect to the registered services "operation of motorcycle dealerships" from services (1), 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].

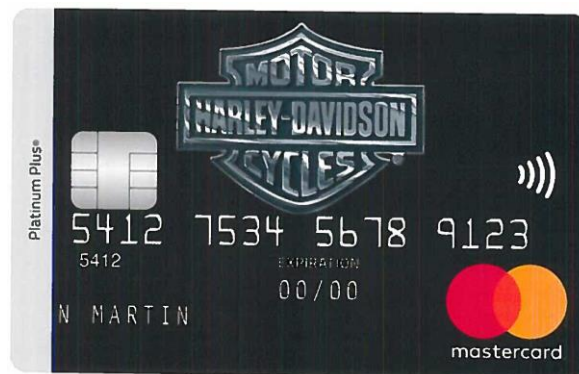
[18] In support, she attaches various photographs and documents relating to the Owner's dealer network [First Declaration, Exhibit AB-5]. In particular, I note photographs depicting the storefront of two licensees of the Owner, namely the Gabriel Harley-Davidson Montreal and the Leo Harley Davidson Brossard motorcycle

dealerships, as well as webpage screenshots from the website operated by the latter dealership. The Trademark is displayed on storefront signs depicted in both photographs, as well as the screenshot of the Leo Harley Davidson Brossard dealership webpage.

[19] Considering the licensed motorcycle dealers in operation in Canada during the relevant period, as well as the evidence showing how the Trademark was displayed in association with the operation of those dealerships, I am satisfied that the Owner has shown use of the Trademark in association with “operation of motorcycle dealerships” within the meaning of sections 4(2) and 45 of the Act.

[20] With respect to the registered services “extension of consumer credit via credit cards” and “issuance of credit cards and debit cards” from services (2), 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. Ms. Brown states that, during the relevant period, there were never less than 30,000 relevant credit card holders in Canada and that the Trademark appeared on the credit cards themselves [First Declaration, para 10].

[21] In support, she attaches webpage printouts from websites operated by the Owner’s licensees [First Declaration, Exhibit AB-2]. The exhibited webpages promote credit cards such as a “Harley-Davidson® Mastercard®” and a “Harley-Davidson® Platinum Plus® credit card”. I note that the Trademark is displayed on a Platinum Plus Mastercard depicted on the webpage printouts:



[22] Considering the evidence showing the Trademark displayed on credit cards, as well as the number of relevant credit card holders during the relevant period in Canada, I am satisfied that the Owner has shown use of the Trademark in association with “extension of consumer credit via credit cards” and “issuance of credit cards” within the meaning of sections 4(2) and 45 of the Act.

[23] However, as pointed out by the Requesting Party, the evidence makes no reference to debit cards, aside from a recitation of registered services and Ms. Brown’s assertion that “...issuance of credit cards and debit cards” were offered and rendered in Canada. Consequently, there is insufficient evidence to support a finding of use in association with the “issuance of... debit cards” within the meaning of the Act. As there is no evidence of special circumstances excusing non-use of the Trademark before me, the registration will be amended accordingly.

[24] With respect to “financial services namely issuance of loans and provision of purchase financing” from services (2), 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 11].

[25] In support, she attaches 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. (HDFS Canada), also the Owner’s licensee [First Declaration, Exhibit AB-3]. The webpages promote “Harley-Davidson® Financing”, “Harley-Davidson® Financial Services” and various financing offers. The Trademark is displayed on the exhibited credit application and webpages.

[26] In further support, Ms. Brown attaches invoices showing sales of motorcycles during the relevant period [Second Declaration, Exhibit AB-9]. Ms. Brown states that the invoices were issued by “Harley-Davidson Motor”, one of the Owner’s licensees, to “Harley-Davidson Canada LP”, another one of the Owner’s licensees. She also states that, “as indicated on the second page” of each invoice, the sales were financed by HDFS Canada [Second Declaration, para 12].

[27] Indeed, the exhibited invoices evidence sales of motorcycles between Harley-Davidson Motor Company and Harley-Davidson Canada LP. The Exhibit AB-9 invoices also evidence the subsequent sale of those motorcycles by Harley-Davidson Canada LP to dealers in Canada; the invoices issued to dealers indicate that the sales were “FINANCED BY HDFFS CANADA”. The invoices display the design mark reproduced below (the Company Logo), which is similar to the Trademark albeit with the word COMPANY replacing the word CYCLES:



[28] I note here that the Company Logo displayed on the Exhibit AB-9 invoices is only a minor deviation of the Trademark such that display of that logo amounts to display of the Trademark. Indeed, I find that the Trademark remains recognizable despite the change of the word CYCLES to the word COMPANY at the bottom of the design. In coming to this conclusion, I have considered the dominant features of the Trademark, namely the bar and shield design together with the term HARLEY-DAVIDSON displayed in the center of the bar, which are preserved in the Company Logo [see *Promafil Canada Ltée v Munsingwear Inc*, 1992 CanLII 12831, 44 CPR (3d) 59 (FCA); *Registrar of Trade-marks v Cie internationale pour l'informatique CII Honeywell Bull*, 1985 CanLII 5537, 4 CPR (3d) 523 (FCA); and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), for a thorough discussion of the general principles that govern the test for deviation].

[29] With respect to “retail lending” and “wholesale lending” from services (2), Ms. Brown states that “lending” is a form of financing or loan and, consequently, that she relies on the aforementioned Exhibit AB-3 website materials in support of the use of the Trademark in association with the registered “retail lending” and “wholesale lending” services. Ms. Brown asserts that – due to confidentiality concerns – she cannot disclose “documents” showing wholesale lending, but that such services were offered “under the

Trademark” by the Owner to its licensed dealers in Canada during the relevant period [First Declaration, para 14].

[30] Considering the above, including the evidenced display of the Trademark on webpages promoting financing and lending options, and on credit applications for financing motorcycle purchases, as well as the invoices showing that the Owner’s licensee did, in fact, finance such sales during the relevant period in Canada, I am satisfied that the Owner has shown use of the Trademark in association with “financial services namely issuance of loans and provision of purchase financing”, and “retail lending” within the meaning of sections 4(2) and 45 of the Act.

[31] In the absence of submissions from the Requesting Party on this point, at a minimum, I accept that display of the Trademark on the Exhibit AB-9 invoices showing sales of motorcycles financed by HDFFS Canada constitutes use of the Trademark in association with the specific services of “wholesale lending”. As such, I am also satisfied that the Owner has demonstrated use of the Trademark in association with “wholesale lending” within the meaning of sections 4(2) and 45 of the Act.

[32] With respect to “provision of extended service plans and purchase protection plans” from services (2), 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 12].

[33] In support, she again refers to the website materials at Exhibit AB-3 referenced above and, more specifically, to the exhibited dealership webpages displaying the Trademark and promoting service plans and protection plans such as “Harley-Davidson® Extended Service Plan” and a “Harley-Davidson® Tire + Wheel Protection”.

[34] Ms. Brown also attaches a printout from a webpage titled “Harley-Davidson® Insurance Aviva” and a screenshot of the website for Prairie Harley-Davidson promoting an “Extended Service Plan” [First Declaration, Exhibit AB-4]. The exhibited webpages display the Trademark and promote insurance benefits such as trip interruption coverage, choice of repair shop and genuine replacement parts.

[35] As for “commercial insurance, wholesale insurance... [and] insurance brokerage in the field of motorcycles” from services (2), Ms. Brown refers to Exhibit AB-4 referenced above and specifies that Aviva Insurance Company of Canada is one of the Owner’s licensees [First Declaration, para 13]. As she did for wholesale lending services, Ms. Brown asserts that – due to confidentiality concerns – she cannot disclose “documents” showing wholesale insurance, but that such services were offered “under the Trademark” by the Owner to its licensed dealers in Canada during the relevant period [First Declaration, para 13].

[36] In addition, Ms. Brown attaches brochures which she explains were issued by HDFS Canada and were circulated in Canada during the relevant period [Second Declaration, para 10 and Exhibit AB-8]. The exhibited brochures advertise various types of insurance as well as protection plans. The Trademark is displayed on the front cover of the Exhibit AB-8 brochure for “Harley-Davidson® Planned Maintenance”. The Trademark is also displayed on the front cover of the brochure for “H-D® Guaranteed Asset Protection”, as well as on the back cover of that brochure which lists services offered by the “HDFS Canada Family”, namely “Extended Service Plan”, “Guaranteed Asset Protection (GAP) Plan”, “MasterCard” and “Theft Protection Product”.

[37] 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].

[38] Considering the above, including exhibited materials displaying the Trademark and promoting specific insurance and protection plans, along with approximate numbers of insurance and protection plans which were in force during the relevant period, I am satisfied that the Owner has shown use of the Trademark in association with “provision of extended service plans and purchase protection plans; commercial insurance” and “insurance brokerage in the field of motorcycles” within the meaning of sections 4(2) and 45 of the Act.

[39] Furthermore, in the absence of submissions from the Requesting Party on these other “wholesale” services, I accept the licensee Aviva’s website shown at Exhibit AB-4 as displaying the Trademark in association with the advertisement of services that can be characterized as wholesale insurance services. As such, I am also satisfied that the Owner has demonstrated use of the Trademark in association with “wholesale insurance” within the meaning of sections 4(2) and 45 of the Act.

[40] As for the registered services “promotional support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses” from services (1) and “providing financial support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses” from services (2), 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].

[41] In support, she attaches two webpage excerpts [First Declaration, Exhibit AB-6]. The first excerpt is a printout of a post from the “Barrie Harley-Davidson” Facebook page dated August 15, 2019 providing details regarding a “BIKE NIGHT” rally 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 second excerpt is a screenshot of a Facebook event page providing details regarding “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 Trademark is displayed on both exhibited Facebook pages.

[42] The Requesting Party submits that activities related to special events are “purely” promotional 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].

[43] In this case, the exhibited Facebook posts show that rallies and open houses were promoted during the relevant period in Canada and that the Trademark was displayed in association with the promotion of those events. I therefore accept that such Facebook posts, together with Ms. Brown's statement that "support for special events" was offered and rendered, demonstrates use of the Trademark in association with "promotional support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses" from services (1) within the meaning of sections 4(2) and 45 of the Act.

[44] Similarly, I accept that such Facebook posts together with Ms. Brown's statements also demonstrates use of the Trademark in association with "providing financial support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses" from services (2) within the meaning of sections 4(2) and 45 of the Act.

[45] Finally, with respect to services (3), "lottery games/services", Ms. Brown attaches six webpage screenshots [First Declaration, Exhibit AB-7] and refers to the third page of the Exhibit AB-2 webpage printouts promoting credit cards. I note that the third page of those printouts promote a "quarterly contest" to win a motorcycle.

[46] In addition, one of the webpages captured in the Exhibit AB-7 screenshots promotes a bike draw held on June 1, in Red Deer, Alberta. Ms. Brown describes this event as "Special Olympics Bike Draw 2019", and the screenshot as being an "extract from the website of Gasoline Alley Harley-Davidson one of [the Owner's licensees]". The image quality of the screenshot is poor and some of the print is illegible. Nevertheless, it appears that the Trademark is displayed in the upper left hand corner of the exhibited webpage.

[47] Having regard to the aforementioned, and in view of the light evidential burden and purpose of section 45 of the Act, I find that the Owner has shown use of the Trademark in association with “lottery games/services” within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[48] 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 “[issuance of ...] and debit cards” from services (2).

[49] The statement of services will now read as follows:

(1) Promotional support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses; operation of motorcycle dealerships.

(2) Extension of consumer credit via credit cards; issuance of credit 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; providing financial support of special events for motorcycle dealerships and motorcycle clubs, namely rallies and open houses.

(3) Lottery games/services.

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