



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 164

Date of Decision: 2023-09-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Montréal Production Inc.

Registered Owner: Harley-Davidson Motor Company, Inc.

Registration: TMA524,796 for MOTOR CLOTHES & Design

THE RECORD

[1] At the request of Montréal Production Inc. (the Requesting Party), the Registrar of Trademarks issued a notice on November 2, 2021, pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to H-D U.S.A., LLC (the Owner), the registered owner of registration No. TMA524,796 for the trademark MOTOR CLOTHES & Design set out below (the Mark):



Subsequently, the Registrar recorded a merger of the Owner into Harley-Davidson Motor Company, Inc., effective December 31, 2022.

[2] The Mark is registered in association with the following Goods:

(1) Sweaters, suspenders, scarves, bandanas, handkerchiefs, jackets, coats, vests, gloves, jeans, chaps, shirts, shorts, caps, hats, knit hats, rain hats, belts, wristbands, coveralls, hosiery, halter tops, neckties, nightgowns, night shirts, pajamas, pants, rain suits, rain coats, shirts, sweatshirts, sweat pants, tank tops, t-shirts, underwear, suits, head bands, leg warmers, aprons, mittens, lingerie, swimsuits, skirts, bibs; footwear, namely shoes and boots, and parts of footwear, namely boot tips, sole plates, heel guards, and decorative boot straps.

(2) Saddlery, purses, wallets, backpacks, duffle bags, motorcycle saddlebags, key fobs and key holders made of leather, garment bags, key cases, suitcases, tote bags, briefcases, attache cases, checkbook clutches, luggage, travel bags, leather beverage container holders; handbags, hip bags, haversacks, satchels, rucksacks, umbrellas and parasols, valises, trunks, pouches, and note pad holders made of leather.

[3] Section 45 of the Act requires the registered owner of the trademark to show whether the trademark has been 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. In this case, the relevant period for showing use is between November 2, 2018 and November 2, 2021.

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

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.

[5] In response to the Registrar’s notice, the Owner submitted the declaration of Adraea Brown, Vice President and Assistant General Counsel for the Owner.

[6] Only the Owner submitted written representations and was represented at a hearing.

ANALYSIS

Use Shown Enures to the Owner

[7] The evidence is that the use of the Mark shown in the evidence enures to the Owner who exercised direct or indirect control in respect of the character and quality of the Goods sold by its authorized licensees in association with the Mark (para 13).

Use is Shown with Some Goods

[8] During the relevant period and in the normal course of trade, authorized distributors/dealers or direct consumers purchased the Goods in person or ordered the Goods online or through catalogues from the Owner or its licensees (para 11). The display of trademarks in catalogues and on webpages used for ordering purposes as well as in a store can provide the required notice of association [see, for example, *Dart Industries Inc v Baker & McKenzie LLP*, 2013 FC 97; *Mcdowell v Laverana GmbH & Co KG*, 2016 FC 1276; *Fraser Milner Casgrain LLP v LG Electronics Inc*, 2014 TMOB 232] where, as is the case here, proof of transfer of the goods is provided. Ms. Brown's evidence includes pictures of the following goods bearing the Mark or displayed adjacent to the Mark in catalogues, in stores including on hangers and on the Owner's website (pages 6, 9-11, 13-14, 18, 133, 263, 465, 522, 536-537, 575, 587, 598, 604, 632, 648, 655 665, 701, 726, 731, 741, 748, 786, 928, 990, 1017, 1019, 1040, 1102, 1161) and aggregate sales numbers:

(1) Sweaters, suspenders, scarves, bandanas, handkerchiefs, jackets, coats, vests, gloves, jeans, chaps, shirts, shorts, caps, hats, knit hats, rain hats, belts, wristbands, coveralls, hosiery, halter tops, nightgowns, night shirts, pajamas, pants, rain suits, rain coats, shirts, sweatshirts, sweat pants, tank tops, t-shirts, underwear, head bands, lingerie; footwear, namely shoes and boots, and parts of footwear, namely boot tips, sole plates, heel guards, and decorative boot straps.

(2) Saddlery, purses, wallets, backpacks, duffle bags, motorcycle saddlebags, key fobs and key holders made of leather, garment bags, key cases, suitcases, tote bags, briefcases, attache cases, luggage, travel bags; handbags, hip bags, haversacks, satchels, rucksacks, valises, pouches.

[9] In several instances the trademark used is only a minor deviation of the Mark, as shown in the representative examples below this paragraph, such that display of these

trademarks amounts to display of the Mark. The Mark remains recognizable despite the change to the design of the eagle and crest and deletion of the phrase AN AMERICAN LEGEND. In coming to this conclusion, I have considered the dominant features of the Mark, namely the shield, eagle, and HARLEY-DAVIDSON displayed within a bar on the shield are preserved [see *Promafil Canada Ltée v Munsingwear Inc*, 1992 CanLII 12831 (FCA); *Registrar of Trade-marks v Cie internationale pour l'informatique CII Honeywell Bull*, 1985 CanLII 5537 (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].



[10] In view of the foregoing, I am satisfied that the Owner has shown use of the Mark with the following goods:

(1) Sweaters, suspenders, scarves, bandanas, handkerchiefs, jackets, coats, vests, gloves, jeans, chaps, shirts, shorts, caps, hats, knit hats, rain hats, belts, wristbands, coveralls, hosiery, halter tops, nightgowns, night shirts, pajamas, pants, rain suits, rain coats, shirts, sweatshirts, sweat pants, tank tops, t-shirts, underwear, head bands, lingerie; footwear, namely shoes and boots, and parts of footwear, namely boot tips, sole plates, heel guards, and decorative boot straps.

(2) Saddlery, purses, wallets, backpacks, duffle bags, motorcycle saddlebags, key fobs and key holders made of leather, garment bags, key cases, suitcases, tote bags, briefcases, attache cases, luggage, travel bags; handbags, hip bags, haversacks, satchels, rucksacks, valises, pouches.

No Use is Shown with the Following Goods

[11] No use of the Mark is shown with the following goods:

neckties, suits, leg warmers, aprons, mittens, swimsuits, skirts, bibs;

checkbook clutches, leather beverage container holders; umbrellas and parasols, trunks, and note pad holders made of leather.

[12] The sole reference to these goods sold in association with the Mark in the evidence is Ms. Brown's statement that "at least one unit" was sold during the relevant period (para 24). Although there is no requirement that either direct or documentary proof be furnished with respect to every good listed in a registration [*Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)], 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 goods during the relevant period. In the absence of any additional evidence that these types of goods were sold with the Mark during the relevant period, Ms. Brown's statement that "at least one unit" was sold is a bald statement and insufficient for me to infer use of the Mark for these goods. Further, I am not persuaded that these goods are of the same type of goods for which evidence is provided (for example, a swimsuit, leg warmers and aprons are not the same type of clothing goods as those for which use was shown, nor are umbrellas and parasols the same type of good as rain coats). For a similar finding, see for example the related cases *Montréal Production Inc. and H-D U.S.A., LLC*, 2022 TMOB 231 and *Montréal Production Inc. and Harley-Davidson Motor Company, Inc.*, 2023 TMOB 133.

[13] As there is no evidence of special circumstances which could excuse non-use of the Mark in association the above goods, the statement of goods will be amended accordingly.

DISPOSITION

[14] 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 goods below:

(1) neckties, suits, leg warmers, aprons, mittens, swimsuits, skirts, bibs;

(2) checkbook clutches, leather beverage container holders; umbrellas and parasols, trunks, and note pad holders made of leather.

[15] The registration will now read:

(1) Sweaters, suspenders, scarves, bandanas, handkerchiefs, jackets, coats, vests, gloves, jeans, chaps, shirts, shorts, caps, hats, knit hats, rain hats, belts, wristbands, coveralls, hosiery, halter tops, nightgowns, night shirts, pajamas, pants, rain suits, rain coats, shirts, sweatshirts, sweat pants, tank tops, t-shirts, underwear, head bands, lingerie; footwear, namely shoes and boots, and parts of footwear, namely boot tips, sole plates, heel guards, and decorative boot straps.

(2) Saddlery, purses, wallets, backpacks, duffle bags, motorcycle saddlebags, key fobs and key holders made of leather, garment bags, key cases, suitcases, tote bags, briefcases, attache cases, luggage, travel bags; handbags, hip bags, haversacks, satchels, rucksacks, valises, pouches.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: June 13, 2023

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