



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 210

**Date of Decision:** 2023-12-11

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Montréal Production Inc.

**Registered Owner:** Harley-Davidson Motor Company, Inc.

**Registration:** TMA324,987 for HARLEY-DAVIDSON MOTOR  
COMPANY & DESIGN

### **INTRODUCTION**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA324,987 for the trademark HARLEY-DAVIDSON MOTOR COMPANY & DESIGN, reproduced below (the Trademark), currently owned by Harley-Davidson Motor Company, Inc. (the Owner).



[2] The Trademark is registered for use in association with numerous motorcycle parts. The statement of goods is reproduced in its entirety in Schedule A to this decision.

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

### **THE RECORD**

[4] On January 6, 2022, 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 previous owner of the subject registration. On May 5, 2023, the Registrar recorded a change in title from this entity to the Owner, due to a merger effective December 31, 2022. I am satisfied that this change in title is not at issue in this proceeding and, for simplicity, will refer to both the Owner and its predecessor-in-title as “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.

[6] The relevant definition of “use” in this case 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.

[7] The relevant period for showing use is between January 6, 2019, and January 6, 2022.

[8] In response to the Registrar's notice, the Owner submitted the affidavit of Adraea M. Brown, Vice President and Assistant General Counsel for the Owner, sworn on July 19, 2022, together with Exhibits AB-1 to AB-16.

[9] Only the Owner filed written representations and was represented at an oral hearing. The hearing in this proceeding was held concurrently with hearings in summary expungement proceedings with respect to the registered trademarks H-D (TMA665,101) and HARLEY-DAVIDSON MOTORCYCLES & DESIGN (TMA980,318). Separate decisions will issue for those registrations.

### **EVIDENCE**

[10] In her affidavit, 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 "range of products and services ancillary to motorcycling such as motorcycle parts, clothing, jewelry, toys, finance and insurance, touring and servicing" [para 9].

[11] Ms. Brown defines the registered goods, collectively, 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 [para 23].

[12] Ms. Brown explains that the Goods are sold by the Owner as well as its authorized licensees. She further states that the Owner exercised, and continues to exercise, direct or indirect control over the character and quality of the Goods sold by its licensees. Having regard to the evidence as a whole in light of this statement, I am satisfied that use of the Trademark evidenced in the Brown affidavit accrues to the Owner's benefit pursuant to section 50 of the Act [per *Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102 at para 84, aff'd 2011 FCA 340].

[13] Ms. Brown also states that, during the relevant period, the Trademark was displayed on the Goods themselves, on their packaging, on invoices accompanying the Goods, and on signage at dealerships selling the Goods. As examples showing how the Trademark was displayed in association with the Goods, Ms. Brown attaches the following exhibits to her affidavit:

- webpage captures from the websites of the Clare’s HARLEY-DAVIDSON of Niagara and The Rock HARLEY-DAVIDSON dealerships, both licensees of the Owner, and captures of social media pages for those dealerships [Exhibit AB-1 and Exhibit AB-2];
- a 2020 HARLEY-DAVIDSON® GENUINE MOTOR PARTS & ACCESSORIES catalogue to which Ms. Brown refers as the “2020 Big Book” [Exhibit AB-3]; and
- webpage printouts from “the Canadian page of the Harley-Davidson, Inc. website (<https://www.harley-davidson.com/>)” [Exhibit AB-4]. Ms. Brown states that Harley-Davidson, Inc. is the Owner’s licensee.

[14] Ms. Brown states that the 2020 Big Book “was used during the Relevant Period to indicate the parts and accessories available and was also used to select and order those motorcycle parts in Canada” [para 18]. The almost 900-page catalogue depicts and describes a wide variety of motorcycle parts. The table of contents lists, for example, windshields, seating, backrests and racks, foot controls, hand controls, engine guards, chassis trim, auxiliary power and charging, transmissions, mirrors, handlebars, cables, gauges, caps and medallions, oil change accessories, oil, lubes and sealants, surface care products, paints, GPS navigation, motorcycle covers, batteries, tools, air filters, security locks & systems, spark plugs, brake pads, headlamps and auxiliary lighting, just to name a few.

[15] As for the website and social media page captures and printouts, Ms. Brown states that while these were collected in July 2022, the pages were accessible and accessed by Canadians during the relevant period. The Exhibit AB-4 printouts of the Harley-Davidson, Inc. website depict various motorcycle parts such as transmission and oil dipsticks, covers and trim, hand grips, foot pegs, voltage regulators, temperature gauges, speedometers, spark plug wires, mounting kits, conversion kits and lighting kits.

[16] Although the resolution of many images is fairly low, the Trademark *per se* does not appear to be displayed in the above-described exhibited material. Instead, the

materials display the design mark reproduced below (the Cycles Logo), which is similar to the Trademark albeit with the word CYCLES replacing the word COMPANY.



[17] I note, for example, that the Cycles Logo is displayed on packaging for “Empire™ Collection – Footboards”, and in the banner at the top of the Clare’s HARLEY-DAVIDSON of Niagara dealership webpage.

[18] Ms. Brown does not provide specific references to products depicted in the exhibits and their correlation to registered goods. However, her affidavit includes a “non-exhaustive list of references to Goods as located in Exhibits AB-3 and AB-4” [para 20]. The list correlates many of the registered goods with exhibit numbers and pages.

[19] As for evidence of transfers, Ms. Brown provides figures for the Owner’s retail sales in Canada. The sales figures are provided as cumulative sales over the entire relevant period; the figures are broken down by categories identified by Ms. Brown as:

- Audio & Instrumentation
- Backrest & Racks
- Bags, Luggage & Travel
- Bearings, Seals and Hardware
- Braking and Suspension
- Buell Parts/Miscellaneous
- Chassis & Components
- Decorative & Trim
- Electrical
- Engine, Transmission & Primary
- Foot Controls
- Hand Controls & Mirrors

- Handlebars, Cables & Lines
- Intake, Exhaust & Fuel Management
- Lighting
- Maintenance & Tools
- Oil & Fluids
- Paint & Body Work
- Seats, Backrests & Luggage Racks
- Security & Storage
- Tires
- Wheels, Sprockets & Rotors
- Windshields & Air Deflectors

[20] The sales range between approximately \$25,000 for the “Backrests & Racks” category, to multi-million dollar sales for many other categories including “Bearings, Seals and Hardware”, “Braking and Suspension” and “Engine, Transmission & Primary”. The combined sales for all of the categories total more than \$170 million.

[21] In terms of direct evidence of transfers, Ms. Brown provides representative invoices for various motorcycle parts sold during the relevant period to the Owner’s licensed dealers in Canada [Exhibit AB-5]. Ms. Brown does not provide correlations between the invoiced products and the Goods. However, she attests that invoices like these ones accompanied Goods delivered in Canada. The Trademark is displayed in the upper left corner of each invoice.

### **REASONS**

[22] At the hearing, the Owner conceded that it did not furnish samples of trademark use and invoices for each of the Goods sold during the relevant period, but, relying on *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD), argued that it was not required to do so.

[23] I agree with the Owner that there is no requirement that either direct or documentary proof be furnished with respect to each and every good listed in a registration. The evidence in a section 45 proceeding need not be perfect and it is well

established that a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [per *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 9]. However, sufficient evidence must still be provided to permit the Registrar to form an opinion or logically infer use within the meaning of section 4 of the Act in association with each of the goods at issue [see *Guido Berlucchi & C Srl v Brouillette Kosie Prince*, 2007 FC 245 at para 18]. Accordingly, whether the principle from *Saks* is applicable to a particular case depends on the degree of detail that the registered owner provides and the clarity with which it explains the representative evidence.

[24] In this case, I find that the Owner has provided sufficiently clear and detailed evidence to allow me to conclude that each of the Goods were sold in the normal course of trade during the relevant period. Aside from Ms. Brown's clear assertions, the sales figures provided by the Owner are substantial, and broken down by Ms. Brown into well-identified product categories that span the range of motorcycle parts listed in the registration. The breadth of goods sold by the Owner is also represented in the exhibited materials, such as the 2020 Big Book and the website printouts.

[25] The remaining issue to be decided is therefore whether the Trademark was associated with each of the Goods within the meaning of the Act. On that point, it is not clear that the Trademark was displayed directly on the evidenced motorcycle parts. Indeed, despite Ms. Brown's references to "Goods bearing the Trademark" in her affidavit, no such goods are depicted in the evidence. Moreover, the examples of goods, packaging and signage submitted by the Owner show the Cycles Logo, rather than the Trademark [Owner's written representations at paragraph 18].

[26] When I questioned the Owner on this point at the hearing, the Owner confirmed its position that the Cycles Logo is a minor variation of the Trademark such that display of that logo constitutes display of the Trademark. That being said, the Owner also directed my attention to the Exhibit AB-5 invoices, which display the Trademark *per se*.

[27] Display of a trademark at the top of an invoice that accompanies goods at the time of transfer in the normal course of trade may, in some circumstances, provide the

requisite notice of association between that trademark and the goods listed in the invoice [see *Hortilux Schreder BV v Iwasaki Electric Co*, 2012 FCA 321]. Relevant factors to consider in assessing whether use of a trademark at the top of the invoice establishes use in association with listed goods include whether the trademark is distinguishable from other matter in the invoice, whether goods of more than one manufacturer are listed in the invoice and whether other trademarks appear on the invoice.

[28] In the present case, the Trademark appears prominently in the top left corner of the exhibited invoices, separate from the corporate address. The Trademark stands out from the rest of the document and no other trademarks are displayed on the invoice. As a result, I find that the notice of association between the Trademark and the invoiced products, rather than merely the business, is clear.

[29] As the invoices accompanied the goods at the time of their transfer, I am satisfied that the Owner has met its *prima facie* burden to demonstrate use of the Trademark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

[30] Finally, I note that given my conclusion above, I do not find it necessary to address the question of deviation as it pertains to the Cycles Logo.

#### **DISPOSITION**

[31] 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



## **SCHEDULE A**

### Goods

(1) Motorcycle gauges and electric and ignition parts, motorcycle tune-up kits, motorcycle decorative parts, parts for motorcycle engines, frames, transmissions, cooling systems, exhaust systems, starters, stands, foot rests, and brakes.

(2) Motorcycle parts, made of metal - namely dowel pins, cotter pins, clamps, nuts, bolts, screws, brackets, studs, spacers, washers, studs, lock washers, retainers, springs, mounting plates, and bushings; motorcycle electrical parts, namely spark plug, ignition wires, breaker points, condensers, spark generators, coils and ignition switches; motorcycle engine gauges, speedometers, thermometers, thermostats, radios, motorcycle electrical parts, namely batteries, electrical wires and wiring harnesses, battery chargers, electrical wire terminals, battery and grounding cables, lenses, magnets, armatures, circuit breakers, switches, turn signals and indicators, connectors, voltage regulators, ignition system pin plugs, socket terminal pins, single socket pins, ignition system clamps, and grounding straps, and motorcycle parts, namely reflectors and instrument panels, brake control stoplight switches; motorcycle parts, namely starter motor brushes, starter motors, horns and starters, cylinders, cylinder heads, valves, tappets, rods, rocker arms, flywheels, sprockets, sprocket shafts, gear shafts, rocker arm covers, transmission shafts, push rod covers, crankcase gear covers, crankcase covers, oil pump covers, coil covers, starter motor covers, cable covers, master cylinder covers, side frame covers, shock absorbers, engine instrument covers, solenoid switches, valve spring retainers and collars, crank pin rollers, lock rings, bearings, transmissions, clutches, wheels, forks, flywheels, flywheel crank pins, gear shaft lock plates, bearing rollers and bearing retainers, crank case plugs, oil plugs, oil pump plugs, engine bearing shims, cams, cam followers, brake control levers, brake calipers, starter pins and roll pins, crank pins, shift lever pivot pin plugs, engine instrument plugs, sissy bar mounting plates, foot rest mounting plates, axle caps, oil filler caps, gas filler caps, transmission gears, motorcycle engine drive gears, starter gears, exhaust pipes, pumps, wheel weights, shift levers, starter shaft housings, transmission housings, headlamp housings, chain housings, pawls for gear shifters, clutch hubs, clutch drive plates, wheel bearings, starter gear shift levers, transmission shift levers, shifter levers, choke levers, chain links, axles, brake discs, brake pads, brake calipers, brake master cylinders, hydraulic fluid line connectors, brake pedals, axle caps, form stems, foot rests, frames, stands, seats, shock absorbers, handle bars, handle bar grips, clutch cables, throttle cables, windshields, fairings, mirrors, fenders, chain guards, gas tanks, oil and air filters, seat grab straps, mufflers, exhaust pipe, mud flaps, highway pegs, luggage carriers, air cleaners, body trim, wind deflectors, oil coolers, backrests, and luggage attachment cords.

# Appearances and Agents of Record

**HEARING DATE:** October 19, 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