

Court File No. T-23

FEDERAL COURT

BETWEEN:

Harley-Davidson Motor Company, Inc. (formerly H-D U.S.A., LLC)

Applicant

– and –

Montréal Production Inc.

Respondent

APPLICATION UNDER Section 56(1) and 59 of *The Trademarks Act* R.S.C. 1985, c. T-13 and Rule 300 of the *Federal Courts Rules* as amended

NOTICE OF APPLICATION

TO THE RESPONDENT:

A PROCEEDING HAS BEEN COMMENCED AGAINST YOU by the applicant. The relief claimed by the applicant appears below.

THIS APPLICATION will be heard by the Court at a time and place to be fixed by the Judicial Administrator. Unless the Court orders otherwise, the place of hearing will be as requested by the applicant. The applicant requests that this application be heard at Toronto, Ontario.

IF YOU WISH TO OPPOSE THIS APPLICATION, to receive notice of any step in the application or to be served with any documents in the application, you or a solicitor acting for you must file a notice of appearance in Form 305 prescribed by the [Federal Courts Rules](#) and serve it on the applicant's solicitor or, if the applicant is self-represented, on the applicant, WITHIN 10 DAYS after being served with this notice of application.

Copies of the [Federal Courts Rules](#), information concerning the local offices of the Court and other necessary information may be obtained on request to the Administrator of this Court at Ottawa (telephone 613-992-4238) or at any local office.

IF YOU FAIL TO OPPOSE THIS APPLICATION, JUDGMENT MAY BE GIVEN IN YOUR ABSENCE AND WITHOUT FURTHER NOTICE TO YOU.

Dated: February 20, 2023

Issued by _____
Local Registrar

Address of local office:
180 Queen Street West
Suite 200
Toronto, Ontario
M5V 3L6

TO: **The Administrator**
Federal Court

AND TO: **Montréal Production Inc.**
1436 rue de Montarville
Saint-Bruno-de-Montarville, QC, J3V 3T5

AND TO: **The Registrar of Trademarks**
Canadian Intellectual Property Office
50 Victoria Street, Phase 1, Fourth Floor
Gatineau, QC, K1A 0C9

APPLICATION

This Application is an appeal pursuant to section 56 of the *Trademarks Act* and Rule 300(d) of the *Federal Courts Rules* from a decision of the Registrar of Trademarks (the “Registrar”) issued November 29, 2022 pursuant to Section 45 of the *Trademarks Act* and dispatched to the parties on December 19, 2022 (citation 2022 TMOB 233), amending registration No. TMA649,923 (“the Registration”) for the trademark HARLEY-DAVIDSON (“the Mark”) to delete the following goods listed in the Registration (“the Decision”):

(1) ... bed tents, bed mats ...

(2) ... telephones, sunglasses, eyewear, namely, eyeglasses, sunglasses, safety goggles and goggles for riding motorcycles, protective helmets, magnets, mouse pads, neon signs, vending machines, juke boxes, compasses, motorcycle generators and spare parts for same ... electric signs.

(5) Knives, knife sheaths ... pewter spoons, sport and folding knives and knife cases.

(6)... key chains and rings ... tool boxes of metal, door knockers, safes, vaults ... non-luminous and non-mechanical signs of metal, hooks for hanging articles, tins (boxes made of tin).

(7) ... electric signs.

(10) Knives ...

(13) ... key chains and rings ...

(14) Knife sheaths.

(17) Pewter spoons, sport and folding knives and knife cases.

The Applicant Makes Application For:

1. An Order pursuant to section 56 of the *Trademarks Act* allowing this appeal and setting aside the Decision of the Registrar to the extent that it amended the Registration to delete the following goods:

(1) ... bed tents, bed mats ...

(2) ... telephones, sunglasses, eyewear, namely, eyeglasses, sunglasses, safety goggles and goggles for riding motorcycles, protective helmets, magnets, mouse pads, neon signs, vending machines, juke boxes, compasses, motorcycle generators and spare parts for same ... electric signs.

(5) Knives, knife sheaths... pewter spoons, sport and folding knives and knife cases.

(6)... key chains and rings ... tool boxes of metal, door knockers, safes, vaults ... non-luminous and non-mechanical signs of metal, hooks for hanging articles, tins (boxes made of tin).

(7) ... electric signs.

(10) Knives ...

(13) ... key chains and rings ...

(14) Knife sheaths.

(17) Pewter spoons, sport and folding knives and knife cases.

2. Costs of this appeal in favour of the Applicant; and
3. Such further and other relief as this Honourable Court may permit.

The Grounds of the Application are as Follows:

1. The Registrar issued a notice pursuant to section 45 of the *Trademarks Act* in respect of the Registration on July 7, 2020 (the "Section 45 Notice").
2. Pursuant to the Section 45 Notice, the Applicant had to show use of the Mark in Canada in association with the goods and services listed in the Registration in the three year period immediately preceding the date of the Section 45 Notice.
3. The Applicant filed as its evidence in support of the Registration the Affidavit of Adraea Brown.
4. The Applicant and Respondent both filed written submissions in support of their respective positions. Only the Applicant was represented at the oral hearing held on July 7, 2022.
5. On November 29, 2022, the Registrar issued the Decision, which was dispatched to the Applicant and the Respondent on December 19, 2022, in which the Registration was amended such that it was restricted to the following goods and services:

Goods

(1) Motorcycles, motorcycle parts-namely, starter motor brushes, starter motors, horns and starters, cylinders, cylinder heads, valves, rocker arms, flywheel shafts, sprocket shafts, gear shafts, rocker arm covers, transmission shafts, push rod covers, crankcase gear covers, crankcase covers, oil pump covers, air cleaner covers, coil covers, ignition system covers, starter motor covers, cable covers, transmission covers, master cylinder covers, front fork covers, side frame covers, shock absorber covers, shock absorber stud covers, clutch covers, chain housing covers, engine instrument covers, solenoid switch covers, valve collars, valve keys, crank pin rollers, lock rings, bearings, bear rollers and bearing retainers used in starters, transmissions, clutches, wheels, forks and chain housings, flywheels, flywheel lock plates, sprockets, gear shaft lock plates, starter housing pins, crankcase bearings, bearing rollers and bearing retainers, crank case plugs, oil plugs, oil pump plugs, engine bearing shims, cams, cam followers, shifter adjusting screws, starter levers, pivot pins, gear shifter roll pins, clutch control pivot pins and cable anchor pins, and push rod pins, brake control lever pivot pins, brake caliper guide pins, frame and fork pins, chain housing pins, starter pins and roll pins, crank pins, shift lever pivot pin plugs, transmission plugs, handle bar, and throttle control plugs, headlamp bracket plugs, chain cover plugs, oil tank plugs, engine instrument plugs, brake mounting plates, sissy bar mounting plates, foot rest mounting plates, rocker arm assembly caps, fork caps, axle caps, frame and fork end caps, transmission gears, motorcycle engine drive gears, starter gears, exhaust pipes, oil separator deflectors, oil pumps, wheel weights, shift levers, carburetor housings, starter shaft housings, transmission housings, headlamp housings, chain housings, handle bar switch housings, shifter collars, shifter forks, pawls for gear shifters, clutch hubs, sprockets, clutch releasing discs, clutch drive plates, adjusting screws for cables, clutch cable straps, oil lines sleeves, wheel bearing sleeves, starter gear shift levers, choke lever, drive chains, chain links, wheels, axles, brake discs, brake pads, brake calipers, devises, brake master cylinders, hydraulic fluid line connectors-namely, tees, brake pedals, axle caps, fork stems, forks, foot rests, frames, stands, bumpers, seats, shock absorbers, handle bars, handle bar grips, clutch cables, throttle cables, windshields, fairings, mirrors, fenders, chain guards, gas tanks, oil, air and fuel filters, seat grab straps, cable straps, hose straps, mufflers, exhaust pipes, mud flaps, highway pegs, luggage carriers, air scopps, air cleaners, body trim, wind deflectors, oil coolers, backrests, luggage attachment cords and motorcycles, rear forks, belts, sprockets, connecting rods, transmission cases, engine assemblies, oil pump assemblies, drive belts, cam gears, turn signals, crank cases, transmission assemblies, transmission covers and gears, pivot shafts, footboards, gas tank medallions and fairings, bicycles, trucks, mud flaps, sun shades, cargo shade, front end cover, tonneau covers, power sliding rear window, hood deflectors, plate box, utility mats, license plate frames, seatbelt shoulder pads, hitch covers, splash guards, spare tire covers, floor mats, steering wheel and truck covers, rear forks, belts, sprockets, connecting rods, transmission cases, engine assemblies, oil pump assemblies, drive belts, cam gears, turn signals, crank cases, transmission assemblies, transmission covers and gears, pivot shafts, footboards, gas tank medallions and fairings.

(2) Paint for manufacture and repair of motorcycles; motorcycle cleaners and polish, synthetic enamels, and liquid polish and cleaner for use on motorcycles,

polishing cloths, washing preparations, namely wheel and tire cleaners, bug remover, soaps for cleaning motorcycles, windshield cleaning liquids, leather dressing, chrome polish and cleaner; motorcycle electrical parts, namely, spark plugs; ignition wires; breaker points; condensers; coils; ignition switches; motorcycle parts-namely, piston pins, piston rings, carburetor float pins, carburetor jet plugs and carburetor adjusting screws, screw drivers, wrenches, ignition sensors, ignition modules, carburetors and parts therefor, motorcycle engine gauges, speedometers, thermometers, thermostats, 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; motorcycle parts-namely, reflectors and instrument panels brake control stoplight switches thereto, oil tank gages and cruise control components, namely servo controls, cruise control switches, cruise control modules, cable assemblies, control levers, battery chargers, magnets, MP3 players, GPS systems, wiring and wiring harnesses for motorcycles, switches, switch panels and spare parts for same, electric lamps and spare parts for same, electric lamp mountings and spare parts for same, storage batteries and spare parts for same, spark plugs.

(3) Motorcycle parts, made of metal-namely, crankcase dowel pins, oil pump dowel pins, cotter pins, clevis pins, hose clamps, clutch cable clamps, brake line clamps, master cylinder clamps, handle bar clamps, license plate bracket clamps, exhaust system clamps, cable couplings, metallic nuts, bolts, screws, brackets, studs, spacers, washers for motorcycle parts, bushings, o-rings, and brake hose seats and spring clips.

(4) Motorcycle brake fluid and engine treatment additives.

(5) multi-function hand tools.

(6) Metal articles, namely, key fobs, and license plate holders, pad locks.

(7) Motorcycle generators and spare parts for same, wiring and wiring harnesses for motorcycles, switches, switch panels and spare parts for same, electric lamps and spare parts for same, electric lamp mountings and spare parts for same, storage batteries and spare parts for same, spark plugs.

(8) Chrome polish and cleaner.

(9) Synthetic enamels, and liquid polish and cleaner for use on motorcycles.

(10) screw drivers, wrenches.

(11) Motorcycle brake fluid and engine treatment additives; paint for manufacture and repair of motorcycles; motorcycle cleaners and polish.

(12) Motorcycle parts, made of metal-namely, crankcase dowel pins, oil pump dowel pins, cotter pins, clevis pins, hose clamps, clutch cable damp, brake line clamps, master cylinder clamps, handle bar clamps, license plate bracket clamps,

exhaust system clamps, cable couplings, metallic nuts, bolts, screws, brackets, studs, spacers, washers for motorcycle parts, bushings, o-rings, and brake hose seats and spring clips; motorcycle electrical parts-namely, spark plugs; ignition wires; breaker points; condensers; coils; ignition switches; motorcycle parts-namely, piston pins, piston rings, carburetor float pins, carburetor jet plugs and carburetor adjusting screws; motorcycle engine gauges, speedometers, thermometers, thermostats, 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; motorcycle parts-namely, reflectors and instrument panels brake control stoplight switches thereto; motorcycles, motorcycle parts-namely, starter motor brushes, starter motors, horns and starters, cylinders, cylinder heads, valves, rocker arms, flywheel shafts, sprocket shafts, gear shafts, rocker arm covers, transmission shafts, push rod covers, crankcase gear covers, crankcase covers, oil pump covers, air cleaner covers, coil covers, ignition system covers, starter motor covers, cable covers, transmission covers, master cylinder covers, front fork covers, side frame covers, shock absorber covers, shock absorber stud covers, clutch covers, chain housing covers, engine instrument covers, solenoid switch covers, valve collars, valve keys, crank pin rollers, lock rings, bearings, bearing rollers and bearing retainers used in starters, transmissions, clutches, wheels, forks and chain housings, flywheels, flywheel lock plates, sprockets, gear shaft lock plates, starter housing pins, crankcase bearings, bearing rollers and bearing retainers, crank case plugs, oil plugs, oil pump plugs, engine bearing shims, cams, cam followers, shifter adjusting screws, starter levers, pivot pins, gear shifter roll pins, clutch control pivot pins and cable anchor pins, and push rod pins, brake control

lever pivot pins, brake caliper guide pins, frame and fork pins, chain housing pins, starter pins and roll pins, crank pins, shift lever pivot pin plugs, transmission plugs, handle bar, and throttle control plugs, headlamp bracket plugs, chain cover plugs, oil tank plugs, engine instrument plugs, brake mounting plates, sissy bar mounting plates, foot rest mounting plates, rocker arm assembly caps, fork caps, axle caps, frame and fork end caps, transmission gears, motorcycle engine drive gears, starter gears, exhaust pipes, oil separator deflectors, oil pumps, wheel weights, shift levers, carburetor housings, starter shaft housings, transmission housings, headlamp housings, chain housings, handle bar switch housings, shifter collars, shifter forks, pawls for gear shifters, clutch hubs, sprockets, clutch releasing discs, clutch drive plates, adjusting screws for cables, clutch cable straps, oil lines sleeves, wheel bearing sleeves, starter gear shift levers, choke lever, drive chains, chain links, wheels, axles, brake discs, brake pads, brake calipers, devices, brake master cylinders, hydraulic fluid line connectors-namely, tees, brake pedals, axle caps, fork stems, forks, foot rests, frames, stands, bumpers, seats, shock absorbers, handle bars, handle bar grips, clutch cables, throttle cables, windshields, fairings, mirrors, fenders, chain guards, gas tanks, oil, air and fuel filters, seat grab straps, cable straps, hose straps, mufflers, exhaust pipes, mud flaps, highway pegs, luggage carriers, air scoops, air cleaners, body trim, wind deflectors, oil coolers, backrests, luggage attachment cords and motorcycles.

(13) Metal articles, namely, key fobs, and license plate holders.

(15) Motorcycle parts, namely ignition sensors, ignition modules, carburetors and parts therefor; motorcycle parts, namely oil tank gages and cruise control components, namely servo controls, cruise control switches, cruise control modules, cable assemblies, control levers and parts therefor; motorcycle parts, namely rear forks, belts, sprockets, connecting rods, transmission cases, engine assemblies, oil pump assemblies, drive belts, cam gears, turn signals, crank cases, transmission assemblies, transmission covers and gears, pivot shafts, footboards, gas tank medallions and fairings.

(16) Locks and keyfobs.

Services

(1) Repair and servicing of motorcycles.

6. The Register held that the Applicant had shown use of the Mark with the registered services, motorcycles and motorcycle parts.

7. In the Decision, the Registrar amended the Registration to delete the below goods (“Miscellaneous Goods”):

(1) ... bed tents, bed mats ...

(2) ... telephones, sunglasses, eyewear, namely, eyeglasses, sunglasses, safety goggles and goggles for riding motorcycles, protective helmets, magnets, mouse pads, neon signs, vending machines, juke boxes, compasses, motorcycle generators and spare parts for same ... electric signs.

(5) Knives, knife sheaths... pewter spoons, sport and folding knives and knife cases.

(6)... key chains and rings ... tool boxes of metal, door knockers, safes, vaults ... non-luminous and non-mechanical signs of metal, hooks for hanging articles, tins (boxes made of tin).

(7) ... electric signs.

(10) Knives ...

(13) ... key chains and rings ...

(14) Knife sheaths.

(17) Pewter spoons, sport and folding knives and knife cases.

8. The Registrar erred in amending the Registration in part pursuant to section 45 of the *Trademarks Act*. In particular, the Registrar erred:

- a. in holding that the Applicant did not demonstrate use of the Mark in Canada in the three year period immediately preceding the date of the Section 45 Notice in association with the Miscellaneous Goods; and,
 - b. in amending the Registration under Section 45 of the Act to delete the Miscellaneous Goods.
9. Furthermore, the Register erred in finding that “motorcycle generators and spare parts for same” were not motorcycle parts.
10. In any event, the Application will be supported by additional evidence that fills the perceived gap in the evidentiary record. As such, the Registration should be maintained for the Miscellaneous Goods.
11. On December 31, 2022, H-D U.S.A., LLC merged with and into Harley-Davidson Motor Company, Inc.. Harley-Davidson Motor Company, Inc. is the current owner of the Mark.

The Application Will Be Supported By The Following Material:


1. A certified copy of the file for trademark registration no. TMA649,923 maintained by the Registrar in respect of the Mark, including the Section 45 proceeding and all evidence filed by the Applicant in such file;
2. Such further and other supporting affidavits and exhibits as the Applicant may serve and file pursuant to Rule 306 and 309 of the *Federal Courts Rules* and this Honourable Court permits; and
3. Such further and other documents as this Applicant may tender and the Court may permit.

Request for Material in the Possession of Tribunal:

The Applicant hereby requests, pursuant to s. 60(1) of the *Trademarks Act* and Rules 317 and 318 of the *Federal Courts Rules*, that the Registrar send a certified copy of the following material that is not in the possession of the Applicant but is in the possession of the Registrar to the Registry and the Applicant:

1. The files for trademark registration no. TMA649,923 maintained by the Registrar in respect of the Mark, including the Section 45 proceeding and all evidence filed by the Applicant in such file.

Date: February 20, 2023



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