

Court File

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 230), amending registration No. TMA294,796 (“the Registration”) for the trademark HARLEY (“the Mark”) to delete the following goods listed in the Registration (“the Decision”):

(1) Motorcycles ...

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: “motorcycles”.
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 August 13, 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 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:
 - (1) Motorcycle parts.
6. The Registrar confirmed in their decision that the Applicant had sold motorcycles during the relevant period. The Registrar erred in finding that the evidence of the Applicant did not demonstrate that motorcycles were sold in association with the Mark during the relevant period.
7. 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 “motorcycles”; and,
 - b. in amending the Registration under Section 45 of the Act to delete “motorcycles”.
8. 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 “motorcycles”.
9. 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. TMA294,796 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. TMA294,796 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



GOWLING WLG (CANADA) LLP

1 First Canadian Place
100 King Street West, Suite 1600
Toronto, Ontario
M5X 1G5

Kevin Sartorio
Charlotte McDonald

Tel: 416.862.4492 / 416.369.7328
Fax: 416.863.3536

Solicitors for the Applicant