

Federal Court



Cour fédérale

Date: 20231220

**Dockets: T-348-23
T-349-23**

Citation: 2023 FC 1727

Ottawa, Ontario, December 20, 2023

PRESENT: The Honourable Madam Justice Tsimberis

BETWEEN:

**HARLEY-DAVIDSON MOTOR COMPANY,
INC. (FORMERLY H-D U.S.A., LLC)**

Applicant

and

MONTRÉAL PRODUCTION INC.

Respondent

JUDGMENT AND REASONS

I. Overview

[1] These are only two of a number of Section 45 proceedings the parties have before both the Trademarks Opposition Board [TMOB] and the Federal Court regarding various HARLEY and HARLEY-formative trademarks. The hearings in these two proceedings were held concurrently.

[2] In the T-348-23 proceeding, the Applicant Harley-Davidson Motor Company, Inc. [HDMC] (formerly H-D U.S.A., LLC) appeals the Registrar of Trademarks' [Registrar] decision dated November 29, 2022 [H-D Decision] rendered under section 45 of the *Trademarks Act*, RSC 1985 c T-13 [Act], to amend the registration TMA649,923 [H-D Registration] for the HARLEY-DAVIDSON trademark.

[3] In the T-349-23 proceeding, HDMC appeals the Registrar's decision dated November 29, 2022 [H Decision] rendered under section 45 of the Act, to amend the registration TMA294,796 [H Registration] for the HARLEY trademark.

[4] The Respondent, Montréal Production Inc. [MP], initiated the summary cancellation proceedings before the Registrar and participated in those proceedings.

[5] Having considered HDMC's new and material evidence and its arguments before this Court, I allow the appeal in T-348-23 in part, for most of the goods ordered stricken by the Registrar, and I allow the appeal in T-349-23 in whole. The Registrar's H-D Decision to amend the H-D Registration for the HARLEY-DAVIDSON mark is set aside and the H-D Registration is maintained, but amended, for the reasons and on the terms provided below. The Registrar's H Decision to amend the H Registration for the HARLEY mark is set aside and the H Registration is maintained for all registered goods.

II. Background

[6] On September 7, 1984, the H Registration for HARLEY was issued to the Applicant's predecessor-in-title and was registered for use in association with motorcycles and parts thereof.

[7] On October 6, 2005, the H-D Registration for HARLEY-DAVIDSON was issued to the Applicant's predecessor-in-title and was registered for use in association with various goods, including motorcycles, various motorcycle parts and accessories, as well as other miscellaneous goods, and with the service of "repair and servicing of motorcycles".

[8] On July 7, 2020, at the request of MP, the Registrar issued a notice pursuant to section 45 of the Act requiring that the owner show whether the HARLEY-DAVIDSON mark [H-D Notice] was used in Canada in association with each of the goods and services specified in the registration at any time within the three-year period immediately preceding the date of the H-D Notice (between July 7, 2017 and July 7, 2020 [H-D Relevant Period]) and, if not, the date when the mark was last in use and the reason for the absence of such use since that date. At all times during the H-D Relevant Period, the HARLEY-DAVIDSON mark was owned by H-D USA, LLC.

[9] On August 13, 2020, the Registrar issued a similar notice at MP's request with respect to the HARLEY mark [H Notice], such that the relevant period to show use of the HARLEY mark was between August 13, 2017 to August 13, 2020 [H Relevant Period]. At all times during the H Relevant Period, the HARLEY mark was owned by H-D USA, LLC.

[10] In response to the H-D Notice, HDMC filed a sworn declaration dated February 8, 2021 from Adraea Brown, Vice President and Assistant General Counsel for H-D USA, LLC, together with Exhibits AB-1 to AB-7 [2021 H-D Brown Affidavit]. In response to the H Notice, HDMC filed a sworn declaration from Ms. Brown dated February 8, 2021 together with Exhibits AB-1 to AB-7 [2021 H Brown Affidavit].

[11] Before the TMOB, both HDMC and MP filed written representations, but only HDMC was represented at the oral hearing.

[12] The Registrar issued its H-D Decision concluding, *inter alia*, that “it was not satisfied that use of the Trademark has been shown in association with those miscellaneous goods identified by the Owner, that do not correspond to motorcycle parts and are not included in the catalogue” HDMC’s 2020 Big Book (Exhibit AB-4) and that the H-D Registration for HARLEY-DAVIDSON would be amended to delete the goods indicated in “~~strikethrough~~” in Schedule B to its H-D Decision.

[13] The Registrar issued its H Decision deciding that the use of the HARLEY-DAVIDSON word mark or the COMPANY LOGO (reproduced below) does not constitute use of the HARLEY mark and concluding that there was insufficient evidence to demonstrate the HARLEY mark was used in association with motorcycles sold in Canada during the H Relevant Period. The Registrar concluded that the H Registration for HARLEY would be amended to delete motorcycles from the list of registered goods.



[14] In the T-348-23 proceeding, the Applicant seeks an order allowing the appeal of, and setting aside, the H-D Decision to the extent that it amended the H-D Registration to delete the following goods:

- motorcycle generators and spare parts for same;
- protective helmets;
- sunglasses, eyewear, namely, eyeglasses, sunglasses, safety goggles and goggles for riding motorcycles;
- bed tents, bed mats;
- neon signs, electric signs, non-luminous and non-mechanical signs of metal;
- door knockers;
- hooks for hanging articles;
- safes, vaults;
- juke boxes;
- tins (boxes made of tin);
- mouse pads;
- key chains and rings; and
- knives, knife sheaths, sport and folding knives and knife cases.

(the “Miscellaneous Goods”)

[15] In the T-349-23 proceeding, the Applicant seeks an order allowing the appeal of, and setting aside, the H Decision to the extent that it amended the H Registration to delete the “motorcycles” goods.

[16] The Respondent did not file any cross-appeals. The Respondent filed a Notice of Appearance in both proceedings, but did not file any Responding Record or make any submissions to the Court.

III. Issue

[17] The issue in these appeals is whether the Applicant has filed sufficient evidence demonstrating use, as defined by sections 2 and 4 of the *Trademarks Act*, within the relevant period, to maintain the H-D Registration for the HARLEY-DAVIDSON trademark in association with the Miscellaneous Goods ordered stricken by the Registrar and to maintain the H Registration for the HARLEY trademark in association with motorcycles ordered stricken by the Registrar.

IV. Analysis

[18] The Applicant has filed new evidence in both appeals. In support of the appeal of the H-D Decision, Ms. Brown has sworn an additional affidavit dated April 19, 2023 [2023 H-D Brown Affidavit] attaching Exhibits 1 to 12. In support of the appeal of the H Decision, Ms. Brown has sworn an additional affidavit dated April 19, 2023 [2023 H Brown Affidavit] attaching Exhibits 1 and 2.

[19] Section 56(5) of the Act provides that, on an appeal from a decision of the Registrar, the Court may consider additional evidence that was not adduced before the Registrar and the Court may exercise any discretion vested in the Registrar. In the context of a section 45 proceeding,

when additional evidence is filed, the Court will reach its own conclusion if the new evidence could have materially affected the Registrar's findings, considering all the evidence before it (*The Clorox Company of Canada, Ltd. v Chloretec SEC*, 2020 FCA 76 at para 21 [*Clorox*]).

[20] Whether new evidence is “material” means it must be “sufficiently substantial and significant” and of “probative value” (*Clorox* at para 21, citing *Vivat Holdings Ltd v Levi Strauss & Co*, 2005 FC 707 at para 27 and *Tradition Fine Foods Ltd v Groupe Tradition'l Inc*, 2006 FC 858 at para 58). New evidence is particularly relevant when addressing concerns identified by the Registrar (*Kabushiki Kaisha Mitsukan Group Honsha v Sakura-Nakaya Alimentos Ltda*, 2016 FC 20 at para 20, citing *Producteurs Laitiers du Canada v Cyprus (Commerce and Industry)*, 2010 FC 719 at para 28 and *Molson Breweries v John Labatt Ltd*, 2000 CanLII 17105 (FCA), [2000] 3 FC 145 (CA), at para 51).

[21] The 2023 H-D Brown Affidavit and its supporting Exhibits 1 to 12 are more comprehensive than the 2021 H-D Brown Affidavit and, when taken in conjunction with some of the Exhibits from the 2021 H-D Brown Affidavit (particularly Exhibits AB-6 and AB-7), help to provide a clearer picture of the use of the HARLEY-DAVIDSON mark in association with several of the Miscellaneous Goods in the normal course of trade during the H-D Relevant Period. I am satisfied that this new evidence as a whole, and save for those exceptions detailed below, has probative significance and would have materially affected the Registrar's findings on several of the Miscellaneous Goods ordered by the Registrar to be stricken out in the H-D Decision.

[22] Similarly, the 2023 H Brown Affidavit and its supporting Exhibits 1 and 2 are more comprehensive than the 2021 H Brown Affidavit, and when taken in conjunction with Exhibits AB-6 and AB-7 of the 2021 HD Brown Affidavit, help to provide a clearer picture of the use of the HARLEY mark in association with motorcycles in the normal course of trade during the H Relevant Period. I am satisfied that this new evidence as a whole has probative significance and would have materially affected the Registrar's findings on the motorcycles ordered by the Registrar to be stricken out in the H Decision.

[23] Accordingly, the Court will decide both matters under appeal on a *de novo* basis.



[24] In an appeal under section 45, the evidentiary burden on the owner of a registered trademark is not a heavy one, and an over-abundance of evidence of the trademark's use is not necessary (*Spirits International BV v BCF SENCRL*, 2012 FCA 131 [*Spirits International*] at para 8, citing *Eclipse International Fashions Canada Inc v Shapiro Cohen*, 2005 FCA 64 at para 6, *Vêtement Multi-Wear Inc. v Riches, McKenzie & Herbert LLP*, 2008 FC 1237 at para 20).

[25] As is made clear by the statute and by the Federal Court of Appeal, in order to maintain its Canadian trademark registration, a trademark owner must make assertions of fact showing use, as opposed to mere or bald assertions of use (section 45(1) of the Act; *Plough (Canada) Ltd. v. Aerosol Fillers Inc.*, 1980 CanLII 2739 (FCA), [1981] 1 FC 679 [*Plough*]):

Section 45(1) of the Act	FCA in <i>Plough</i>
<p>(...) <u>requiring</u> the registered owner to furnish within three months an affidavit or a statutory declaration <u>showing, with respect to all the goods or services specified in the registration or to those goods or services specified in the registration or to those that may be specified in the registration or to those that may be specified in the notice, whether the trademark was in use in Canada</u> at any time during the three-year period (...)</p>	<p>[10] What subsection 44(1) requires is an affidavit or statutory declaration <u>not merely stating but "showing"</u>, that is to say, describing the use being made of the trade mark within the meaning of the definition of "trade mark" in section 2 and of "use" in section 4 of the Act. (...)</p> <p>[12] (...) <u>Neither the Court nor the Registrar, however, is bound by or interested in the deponent's opinion or conclusion that what is going on is use of the trade mark within the meaning of the statute. The statute requires the facts to be shown and when that has been done the Registrar, and the Court in its turn, will determine whether the facts stated show use.</u></p>

A. ***HARLEY-DAVIDSON Appeal T-348-23***

[26] The trademark subject of the H-D Registration is the word mark HARLEY-DAVIDSON. The owner of a word mark is entitled to use those words in any size and with any style of lettering, colour or design (*Master Saddles Inc v Moffat & Co*, 2023 FC 179 at para 20, citing *FFAUF SA v Industria di Diseno Textil, SA*, 2020 FC 521 at paras 54, 57, 60). In the Registrar's view, the HARLEY-DAVIDSON mark displayed prominently at the center of the CYCLES LOGO and of the COMPANY LOGO Design marks reproduced below, stands out from the additional material such that the public as a matter of first impression would perceive the HARLEY-DAVIDSON mark *per se* as being used (H-D Decision, para. 32, citing *Nightingale Interloc Ltd. v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)). I agree with the Registrar that the display by the Applicant of the CYCLES LOGO and of the COMPANY LOGO both constitute display of the HARLEY-DAVIDSON word mark.

CYCLES LOGO	COMPANY LOGO
	

[27] The 2023 H-D Brown Affidavit shows use of either the CYCLES LOGO, the COMPANY LOGO and/or the HARLEY-DAVIDSON trademarks (collectively referred to as the HARLEY-DAVIDSON Mark) in association with a number of goods included in the Miscellaneous Goods. Exhibits 2 through 10 provide images of several of the Miscellaneous Goods bearing the HARLEY-DAVIDSON Mark. Exhibit 11 is an HDMC licensee royalty report for Q3 2017, Q4 2017, and 2018 from HDMC's business records generated from a program used to track sales by licensees. The Exhibit 11 table provides details of Canadian sales (volume and amount) of several of Miscellaneous Goods bearing the HARLEY-DAVIDSON Mark by the identified licensee of HDMC in question, including royalties, currency of sale, identified channel (e.g. Canadian Harley-Davidson dealerships, franchisees, and licensees), and territory for relevant quarters. Exhibit 12 includes screenshots from HDMC's sales information tracking system (SAP) relating to motorcycle helmets.

[28] Having reviewed the 2023 H-D Brown Affidavit, the Exhibits 11 and 12 to the 2023 H-D Brown Affidavit, the 2021 H-D Brown Affidavit, and the Exhibits AB-6 and AB-7 to the 2021 Brown H-D Affidavit, I am satisfied that there is sufficient evidence to demonstrate that motorcycle generators and spare parts for same, protective helmets, sunglasses, eyewear (namely, eyeglasses, sunglasses, safety goggles and goggles for riding motorcycles), neon signs,

electric signs, non-luminous and non-mechanical signs of metal, door knockers, hooks for hanging articles, juke boxes, tins (boxes made of tin), mouse pads, key chains and rings, knives, knife sheaths, sport and folding knives, and knife cases bearing the HARLEY-DAVIDSON Mark (either on the goods themselves or on the packages in which they were distributed) were sold to Canadian Harley-Davidson dealerships in Canada during the H-D Relevant Period. For the reasons mentioned below, this constitutes use of the HARLEY-DAVIDSON mark in association with these goods during the H-D Relevant Period.

(1) **motorcycle generators and spare parts for same**

[29] Below are images of a motorcycle generator and parts with its packaging bearing the CYCLES LOGO mark, identified as “Stator Assembly, AC Generator (Part No. 30734-01K)”:



[30] In the 2021 H-D Brown Affidavit’s Exhibit AB-7, HDMC provided an invoice showing the sale of “stator ass’y part 29965-81C” from Harley-Davidson Canada LP, a licensee of the

owner HD USA, LCC, to authorised dealer “Barnes Harley-Davidson Kamloops” dated July 4, 2017. Sales of goods bearing the trademark by its owner or a licensee to a distributor or retailer as an intermediary constitutes use of the HARLEY-DAVIDSON mark in the normal course of trade within meaning of s. 4 of the Act, and in association with motorcycle generators (*Manhattan Industries Inc v Princeton Manufacturing Ltd*, (1971), 4 CPR (2d) 6 (FCTD) [*Manhattan*] at paras 39-43). While the July 4, 2017 invoice date does not fall within the H-D Relevant Period, it is just three days short of the H-D Relevant Period, the 2023 H-D Brown Affidavit clearly states the invoices provided are merely representative of invoices accompanying sales, and further, the affiant reviewed the sales data directly and swore that at least sixty (60) motorcycle generators and spare parts were sold during the H-D Relevant Period. This evidence was not challenged or cross-examined by the Respondent. I am prepared to accept that, between the sworn evidence of sales of motorcycle generators and spare parts during the H-D Relevant Period and the above-identified invoice showing the sale of “stator ass’y part 29965-81C” being just days away from that period, HDMC has met its burden of demonstrating use of the HARLEY-DAVIDSON mark in association with motorcycle generators and parts for same during the H-D Relevant Period.

(2) **protective helmets**

[31] The 2023 Brown H-D Affidavit provides website captures from the Canadian page of the HDMC website depicting representative examples of motorcycle helmets, including the Overdrive Low Profile Half Helmet (Part No. 98335-15VM) depicted below bearing the HARLEY-DAVIDSON mark. The 2023 H-D Brown Affidavit provided screenshots from the SAP database showing that an order was placed for the Overdrive Low Profile Half Helmet (Part

No. 98335-15VM) by Premont Harley-Davidson Laval with an Order Date of June 5, 2020 and the invoice was dated June 19, 2020. The 2023 H-D Brown Affidavit indicates Canadian sales of helmets were greater than 25,000 helmets totalling over \$4,000,000 in sales during the H-D Relevant Period. This constitutes use of the HARLEY-DAVIDSON mark in association with protective helmets during the H-D Relevant Period.



(3) **sunglasses, eyewear, namely, eyeglasses, sunglasses, safety goggles, and goggles for riding motorcycles**

[32] The 2023 H-D Brown Affidavit shows sunglasses and goggles bearing the HARLEY-DAVIDSON Mark during the H-D Relevant Period and identifies Wiley X, Inc. [Wiley] as the licensee that offered the sunglasses and goggles in Canada during the H-D Relevant Period. Given Wiley only sells sunglasses and goggles (see Exhibit 3), I am prepared to draw a reasonable inference that the non-goggle eyewear referenced in Exhibit 11 of the 2023 H-D Brown Affidavit under the Wiley licensee are indeed sunglasses (*Spirits International* at para 8). More specifically, three hundred and twenty-nine (329) Standard Frame-No Foam men's eyewear sunglasses bearing the HARLEY-DAVIDSON Mark were sold in Canada by the licensee Wiley during Q3 217 quarter to Canadian Harley-Davidson dealerships. Based on the

evidence, I am satisfied that the sales made and use of the HARLEY-DAVIDSON Mark in Canada during the H-D Relevant Period in association with sunglasses and eyewear by Wiley inure to the owner H-D USA, LLC.



- (4) **neon signs, electric signs, non-luminous and non-mechanical signs of metal, door knockers, hooks for hanging articles, juke boxes, tins (boxes made of tin)**

[33] The 2023 H-D Brown Affidavit shows neon signs bearing the HARLEY-DAVIDSON Mark, electric signs and non-luminous and non-mechanical signs of metal bearing the CYCLES LOGO trademark, door knockers bearing the HARLEY-DAVIDSON Mark, hooks for hanging articles bearing the CYCLES LOGO mark, juke boxes, and tins (boxes made of tin) bearing the HARLEY-DAVIDSON Mark during the H-D Relevant Period and identifies Ace Product Management Group [ACE] as the licensee that offered the aforementioned goods in Canada during the H-D Relevant Period. The 2023 H-D Brown Affidavit's Exhibit 11 provides one hundred and fifty-seven (157) pub signs, eighty-seven (87) metal signs, fifteen (15) neon signs, two hundred and ninety-seven (297) tin signs, twenty-six (26) door knockers, two hundred and eighty-three (283) coat hooks, one juke box, and one hundred and sixty-three (163) storage boxes

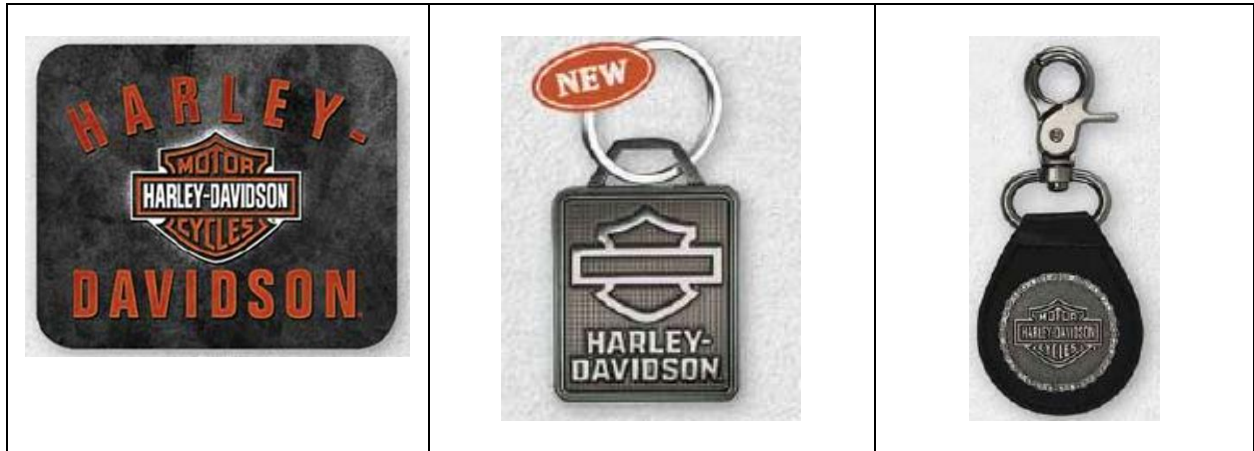
(which I am prepared to reasonably infer from the evidence that these are made of tin) were sold in Canada during the H-D Relevant Period. Exhibit 11 shows these various numbers of each of these goods were sold in Canada by the licensee ACE during various quarters of the H-D Relevant Period to Canadian Harley-Davidson dealerships, gift stores, billiard/game stores, and distributors. Based on the evidence, I am satisfied that the sales made and use of the HARLEY-DAVIDSON Mark in Canada during the H-D Relevant Period in association with neon signs, electric signs, and non-luminous and non-mechanical signs of metal, door knockers, hooks for hanging articles, juke boxes, and tins (boxes made of tin) by ACE inure to the owner H-D USA, LLC.



(5) **Mouse pads, key chains and rings**

[34] The 2023 H-D Brown Affidavit shows mouse pads, key chains and rings bearing the HARLEY-DAVIDSON and CYCLES LOGO marks in Exhibit 9 during the H-D Relevant Period, and identifies “Global” as the licensee that offered the aforementioned goods in Canada during the H-D Relevant Period in Exhibit 11. The 2023 H-D Brown Affidavit’s Exhibit 11 provides four hundred and sixty-two (462) mouse pads and one thousand three hundred and forty-one (1,341) key chains and rings were sold in Canada during the H-D Relevant Period. Exhibit 11 shows these various numbers of each of these goods were sold in Canada by the licensee Global during various quarters of the H-D Relevant Period to Canadian Harley-Davidson dealerships. Based on the evidence, I am satisfied that the sales made and use of the HARLEY-DAVIDSON Mark in Canada during the H-D Relevant Period in association with mouse pads, key chains and key rings by Global Products Inc. inure to the owner H-D USA, LLC.

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(6) **Knives, knife sheaths, sport and folding knives, and knife cases**

[35] The 2023 H-D Brown Affidavit shows knives, knife sheaths, sport and folding knives, and knife cases bearing the HARLEY-DAVIDSON Mark in Exhibit 10 during the H-D Relevant Period, and identifies “W.R. Case & Sons Cutlery Company” [W.R. Case] as the licensee that offered the aforementioned goods in Canada during the H-D Relevant Period in Exhibit 11. The 2023 H-D Brown Affidavit’s Exhibit 11 provides forty (40) fixed blade knives, six hundred and sixty-eight (668) folding knives, four (4) knife gift sets, twenty-one (21) knife sheaths, one (1) multi-tool knife, and nine (9) pocket knives were sold in Canada during the H-D Relevant Period. Exhibit 11 shows these various numbers of each of these goods were sold in Canada by the licensee W.R. Case during various during quarters during the H-D Relevant Period to Canadian Harley-Davidson dealerships and W.R. Case Dealers. Based on the evidence, I am satisfied that the sales and use of the HARLEY-DAVIDSON Mark in Canada during the H-D Relevant Period in association with knives, knife sheaths, sport and folding knives, and knife cases by W.R. Case inure to the owner H-D USA, LLC.





(7) **bed tents, bed mats**

[36] The 2023 H-D Brown Affidavit declares that bed tents and bed mats bearing the Trademark were sold in Canada by HDMC directly or through its licensee ACE during the H-D Relevant Period and that the use of the Trademark in association with bed tents and bed mats is demonstrated in Exhibits 5 and 6. However, the only evidence before the Court is that camping tents and sleeping bags bearing the HARLEY-DAVIDSON Mark were sold by ACE as a licensee of HDMC during the H-D Relevant Period. There was no evidence put forth by the Applicant that bed tents are camping tents and that bed mats are sleeping bags. My understanding of a bed tent is a tent that either sits upon or attaches to a bed or mattress, and a bed mat is something that prevents objects from sliding around in the bed and/or protects the bed or underlying surface from any spills.

[37] Counsel for the Applicant argued at the hearing that, when interpreting a statement of goods, the Court must not be “astutely meticulous”, citing *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654 [*Levi Strauss*] at paragraph 17. The Court in *Levi Strauss* made this statement with a qualification, suggesting for instance that the determination of whether a tomato is a fruit need not be resolved at a trademark level, use of a trademark on tomatoes can sustain a

registration for fruit. This is not the sort of ambiguity arising in this product category. The respective products do not serve the same purpose. The tent proffered by HDMC is a camping tent, which is a wholly different type of product than something that would sit upon or attach to your bed. Likewise, a sleeping bag is not something that prevents slips or spills on your bed.

[38] In the absence of evidence showing a transfer of bed tents or bed mats bearing the HARLEY-DAVIDSON Mark in the normal course of trade during the H-D Relevant Period, I am not satisfied that there is use of the HARLEY-DAVIDSON Mark in association with “bed tents, bed mats” during the H-D Relevant Period and these goods should be stricken from the H-D Registration.

(8) **safes, vaults**

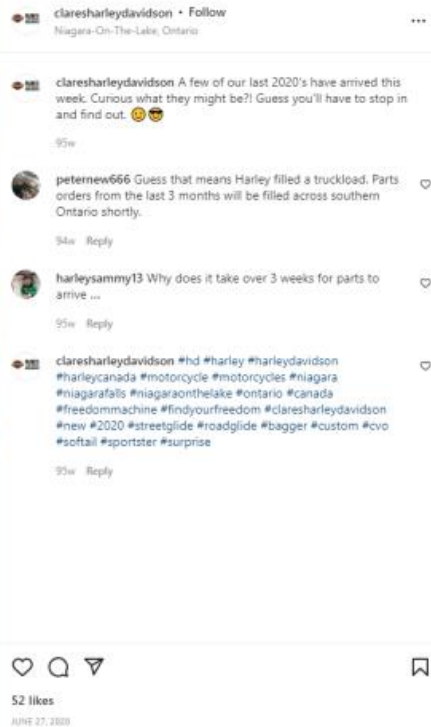
[39] In relation to “safes, vaults”, the 2023 H-D Brown Affidavit declares that a review of the sales and business records of HDMC confirms that “at least one safe/vault bearing the Trademark was sold in Canada during the Relevant Period”, and “invoices that are representative of the invoices that would have accompanied the safes and vaults are attached”. However, Ms. Brown’s statements are unclear as to which of the two (safe or vault) was sold, and there is no evidence before the Court showing any safe or vault bearing the HARLEY-DAVIDSON Mark, or any transfer of either a HARLEY-DAVIDSON safe or vault, in the normal course of trade in Canada during the H-D Relevant Period. The Applicant directed the Court’s attention to a “metal storage unit” in HDMC’s product catalogue at Exhibit 5 of the 2023 H-D Brown Affidavit, which is a storage locker without a built-in locking mechanism akin to a grade school locker for

students. My understanding of safes and vaults is that they are secure because they comprise a built-in locking mechanism.

[40] There was no evidence put forth by the Applicant that storage lockers with no built-in locking mechanism qualify as a safe or vault. In the absence of evidence showing a transfer of safes and vaults bearing the HARLEY-DAVIDSON Mark in the normal course of trade during the H-D Relevant Period, I am not satisfied that there is use of the HARLEY-DAVIDSON Mark in association with either of the goods “safes, vaults” during the H-D Relevant Period and “safes, vaults” should be stricken from the H-D Registration.

B. *HARLEY Appeal T-349-23*

[41] The 2023 H Brown Affidavit shows that during the Relevant Period, the HARLEY trademark was used on the packaging (shipping crates depicted below) of motorcycles sold in Canada in the normal course of trade. Exhibit 2 of the 2023 H Brown Affidavit includes reproductions of Instagram posts showing that the HARLEY trademark was marked on the motorcycle shipping crates delivered to Canadian dealerships during the H Relevant Period. These Instagram posts show that the HARLEY marked shipping crates were used to promote the sale of motorcycles at the Clare’s Harley-Davidson dealership in Niagara-on-the-Lake, Ontario on June 27, 2020. The 2021 H Brown Affidavit declares that more than 19,000 motorcycles were sold during the Relevant Period in Canada and Exhibit AB-6 to the 2021 H Brown Affidavit includes invoices evidencing sales of motorcycles between HDMC and Harley-Davidson Canada LP and between Harley-Davidson Canada LP and dealerships in Canada during the H Relevant Period.



[42] Having reviewed this new evidence, I am satisfied that there is sufficient evidence to demonstrate that motorcycles bearing the HARLEY mark on the packaging in which they were sold to Canadian Harley-Davidson dealerships in Canada during the H Relevant Period. This constitutes use of the HARLEY mark in association with motorcycles during the H Relevant Period and motorcycles should be maintained in the H Registration.

C. *Costs and Disbursements*

[43] The Applicant seeks costs in the amount of \$4,800.81 for the T-348-23 HARLEY-DAVIDSON appeal and in the amount of \$3,610.81 for the T-349-23 HARLEY appeal calculated at mid-column III of Tariff B plus its disbursements as particularized in its respective Bills of Costs.

[44] The Respondent's attempt to be self-represented in these proceedings does not shield it from a costs award. As a corporation, the Respondent must be represented by a solicitor unless leave of the Court is granted under Rule 120 of the *Federal Courts Rules*. No such leave was sought by the Respondent. Even if the Respondent is a self-represented litigant, costs awards may be made against them at the discretion of the Court. As the Federal Court of Appeal has held, self-represented litigants and litigants represented by counsel should receive the same treatment relative to entitlement to litigation costs (*Latham v R.*, 2007 FCA 179 at para 8).

[45] The Applicant was more successful than not in demonstrating use of the HARLEY-DAVIDSON mark in association with the various Miscellaneous Goods and was successful in demonstrating use of the HARLEY mark in association with motorcycles. The Applicant shall be awarded costs in both proceedings. In the circumstances and given my discretion, I award the Applicant \$3,300 in T-348-23 and \$2,700 in T-349-23 as lump costs awards.

[46] Lastly, this appeal was heard by Zoom on November 28, 2023 with simultaneous translation available in English and French, as had been requested by the parties in the Requisition for Hearing. The Requisition for Hearing indicates and the evidence filed by the Applicant confirms that Mr. Richard Gref of MP wished to attend the hearing, make representations in French, and benefit from the services of an interpreter for the parts of the hearings that would be held in English. However, the Respondent MP did not attend the hearing, did not provide notice that they would not attend the hearing, and did not respond to a number of correspondence sent by the Registry prior to the hearing. As such, the interpreters hired by the Court for the benefit of the parties went unused and the Court's fees associated thereto amounted

to a little over \$2,000 for the hearing of both T-348-23 and T-349-23. At the hearing, counsel for the Applicant indicated that it was not made aware that the Respondent would not be attending the hearing and as such, any costs related to the interpretation services should be born solely by the Respondent. I agree.

V. **Conclusion**

[47] In light of my findings above, I am satisfied that the T-348-23 appeal should be granted in part and that the H-D Registration for the HARLEY-DAVIDSON mark should be amended as requested by the Applicant, other than as it relates to bed tents, bed mats, safes, vaults for which no evidence of use has been shown. I am also satisfied that the T-349-23 appeal should be granted in whole.

JUDGMENT in T-348-23 and T-349-23

THIS COURT'S JUDGMENT is that:

1. The Applicant's appeal in T-348-23 is granted in part and its appeal in T-349-23 is granted in whole.
2. The decisions of the Registrar of Trademarks dated November 29, 2022 are set aside to the extent that it amended the registration No. TMA294,796 to delete motorcycles and to the extent that it amended the registration No. TMA649,923 to delete the following goods under appeal: motorcycle generators and spare parts for same, protective helmets, sunglasses, eyewear, namely, eyeglasses, sunglasses, safety goggles and goggles for riding motorcycles, neon signs, electric signs, non-luminous and non-mechanical signs of metal, door knockers, hooks for hanging articles, juke boxes, tins (boxes made of tin), mouse pads, key chains and rings, knives, knife sheaths, sport and folding knives and knife cases.
3. Directing the Registrar of Trademarks to amend the statement of goods for trademark registration No. TMA649,923 to delete the following goods: bed tents, bed mats, safes, vaults, telephones, vending machines, compasses, pewter spoons, tool boxes of metal.
4. Costs shall be awarded to the Applicant in the amount of \$6,000 to be paid forthwith by the Respondent.

5. Respondent to pay the Court the amount of \$2000 in reimbursement of the translation services engaged for the hearing but not used, the full amount to be deposited with the Registry at the latest by January 31, 2024.

"Ekaterina Tsimberis"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKETS: T-348-23 AND T-349-23

STYLE OF CAUSE: HARLEY-DAVIDSON MOTOR COMPANY, INC.
(FORMERLY H-D U.S.A., LLC) v MONTRÉAL
PRODUCTION INC.

PLACE OF HEARING: HELD BY VIDEOCONFERENCE

DATE OF HEARING: NOVEMBER 28, 2023

JUDGMENT AND REASONS: TSIMBERIS J.

DATED: DECEMBER 20, 2023

APPEARANCES:

CHARLOTTE MCDONALD	FOR THE APPLICANT
FAILURE TO APPEAR	FOR THE RESPONDENT, SELF-REPRESENTED

SOLICITORS OF RECORD:

GOWLING WLG (CANADA) LLP TORONTO, ONTARIO	FOR THE APPLICANT
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