

Federal Court



Cour fédérale

Date: 20240913

Docket: T-654-22

Citation: 2024 FC 1441

[ENGLISH TRANSLATION]

Ottawa, Ontario, September 13, 2024

PRESENT: Madam Justice St-Louis

BETWEEN:

GIUSEPPE DE LUCA

Applicant

and

GEOX S.P.A.

Respondent

JUDGMENT AND REASONS

I. Introduction

[1] Giuseppe De Luca, the applicant, is the owner of the ANFIBIO & DESSIN trademark, illustrated below, registered on November 16, 1990, under the number TMA375888 [ANFIBIO Mark].



[2] The use of the ANFIBIO Mark is governed by an agreement signed between Mr. De Luca and the company Chaussures De Luca Montréal Inc. [Company].

[3] The respondent, Geox SPA [Geox], a business incorporated in Italy, holds the AMPHIBIOX/AMPHIBIOX trademark, which was registered on March 31, 2017, under the number TMA967206 [AMPHIBIOX Mark]. In 2010, at the time of the application to register the AMPHIBIOX Mark, no statement of opposition was filed.

[4] Geox operates in Canada through its subsidiary Geox Canada Inc. [Geox Canada], which is authorized to use the AMPHIBIOX Mark in Canada under a licensing agreement signed in 2004 and amended in 2022.

[5] This is not the first dispute between the parties. In fact, in 2015, at the request of Geox, the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 [Act], requiring Mr. De Luca to furnish an affidavit or a statutory declaration showing that his ANFIBIO Mark was in use in Canada between April 14, 2012, and April 14, 2015.

[6] On September 19, 2017, the Registrar of Trademarks amended the registration for the ANFIBIO Mark to expunge the word *souliers* (shoes). However, the Registrar considered that Mr. De Luca had provided sufficient evidence to prove that the ANFIBIO Mark was used in association with *bottes* (boots) in the three years immediately preceding the date of the notice under section 45 of the Act and maintained the rest of the registration (*Geox SPA v Giuseppe De Luca*, 2017 TMOB 124). On August 24, 2018, the Federal Court dismissed Geox's appeal (*Geox*

SPA v De Luca, 2018 FC 855); on September 13, 2021, the Federal Court of Appeal did the same (*Geox SPA v De Luca*, 2021 FCA 178); and finally, on March 24, 2022, the Supreme Court of Canada dismissed the application for leave presented by Geox (*Geox SPA v Giuseppe De Luca*, 2022 CanLII 21678 (SCC)).

[7] As part of these proceedings, Mr. De Luca submitted an application under sections 55 and 57 of the Act and has requested that the Court order the AMPHIBIOX Mark, held by Geox, to be expunged from the Trademark Registry. In short, and as he confirmed during the hearing, Mr. De Luca cites paragraph 18(1)(b) of the Act and argues that the registration of the AMPHIBIOX Mark is invalid because it was not distinctive at the time his application was commenced, on March 28, 2022.

[8] For the following reasons, Mr. De Luca's application is dismissed. In short, he has not discharged his burden of establishing, as required by paragraph 18(1)(b) of the Act, that the AMPHIBIOX Mark belonging to Geox was not distinctive on March 28, 2022.

II. Positions of the parties and evidence

[9] On March 28, 2022, Mr. De Luca submitted his notice of application. He cited subsections 16(3), 18(1) and 30(1), as well as, more specifically, paragraph 18(1)(b) of the Act.

[10] In the memorandum of fact and law that he filed with his Applicant's Record, Mr. De Luca adds subsection 6(5) of the Act and reviews the circumstances listed in it to determine whether trademarks create confusion.

[11] During the hearing, Mr. De Luca was unfortunately unable to explain how or why he, the applicant, cited subsection 16(3) of the Act. Mr. De Luca then stated that his objective, in citing subsection 16(3) of the Act, was to argue that the ANFIBIO Mark was never abandoned. Considering these explanations, the Court is inclined to accept, without deciding, that the ANFIBIO Mark was not abandoned. This is not at issue in these proceedings.

[12] Thus, considering the applicant's explanations during the hearing, his only remedy before the Court is the one under paragraph 18(1)(b) of the Act. He argues that the AMPHIBIOX Mark is invalid because it was not distinctive at the time proceedings bringing the validity of the registration into question were commenced, that being on March 28, 2022. Mr. De Luca specifies that, as part of the remedy under paragraph 18(1)(b) of the Act, the Court must examine whether there is confusion between his ANFIBIO Mark and the AMPHIBIOX Mark based on the circumstances set out at subsection 6(5) of the Act. Mr. De Luca thus argues that there is confusion between the two marks under subsection 6(5) of the Act, which warrants the AMPHIBIOX Mark being expunged from the Registry.

[13] In terms of evidence, Mr. De Luca submitted (1) his own affidavit, sworn on May 12, 2022, which entered 10 exhibits into evidence; and (2) the affidavit of Franco Rota, the treasurer, controller and one of the directors of the Company, sworn on May 30, 2022, which entered one exhibit into evidence, that being the Agreement between Mr. De Luca and the Company. Mr. De Luca and Mr. Rota were not cross-examined.

[14] Geox first opposes the admissibility of certain paragraphs of the affidavits from Mr. De Luca and Mr. Rota. It alleges that these paragraphs contain either legal conclusions or speculative statements that are not within the deponent's personal knowledge.

[15] With respect to the merits, Geox essentially responds that Mr. De Luca did not discharge his burden of demonstrating that the AMPHIBIOX Mark was not distinctive on March 28, 2022. Geox specifies that Mr. De Luca did not submit any evidence of the ANFIBIO Mark's use or promotion and did not submit any evidence showing that the ANFIBIO Mark is known in Canada to some extent. Thus, Geox argues that Mr. De Luca has not established that the ANFIBIO Mark's reputation in Canada is either substantial, significant or sufficient in order to negate the distinctiveness of the AMPHIBIOX Mark on March 28, 2022.

[16] In terms of evidence, Geox submits the affidavits of (1) Pierluigi Ferro, senior counsel for Geox since 2010, entering 15 exhibits into evidence; (2) Gino Stinziani, director of Geox Canada since at least 2003, except for a period from October 2016 to May 2019, entering 10 exhibits into evidence; and (3) Juliana Laboucane, an employee of the law firm of Ridout & Maybee LLP, which represented Geox in the previous legal proceedings, sworn on October 11, 2022, and entering one exhibit into evidence, that being the AMPHIBIOX Mark's registration application file produced by the Canadian Intellectual Property Office on August 9, 2022. Mr. Stinziani and Mr. Ferro were cross-examined on April 18 and 21, 2023, respectively.

III. Issues

[17] Considering the arguments raised, as confirmed during the hearing, the Court must determine whether (1) certain paragraphs in the affidavits from Mr. De Luca and Mr. Rota must be struck; and (2) whether Mr. De Luca has established that the AMPHIBIOX Mark was not distinctive on March 28, 2022, and is therefore invalid under paragraph 18(1)(b) of the Act.

IV. Discussion

A. *Certain paragraphs in the affidavits from Mr. De Luca and Mr. Rota will be struck*

[18] Geox argues that the statements found in paragraphs 12, 16, 24, 27 and 30 of Mr. De Luca's affidavit are legal conclusions and that the statements found in paragraphs 17, 18 and 25 are not within his personal knowledge. Geox argues that the Court should therefore assign them little or no weight.

[19] Geox also argues that the statement in paragraph 8 of Mr. Rota's affidavit is a legal conclusion and that, as a result, the Court should assign it little or no weight.

[20] At the hearing, Mr. De Luca rejected Geox's objections and contended that, on the contrary, the statements in question were admissible. Regarding the objection involving statements that are not within his personal knowledge, Mr. De Luca essentially replied that in 2010, the ANFIBIO Mark had already been in use for 20 years and that Mr. Stinziani had stated on cross-examination that he knew the ANFIBIO name. Mr. De Luca stressed that he was of the view that his statements were appropriate since Mr. Stinziani had been working in the footwear industry for many years and would therefore know the other players in the business.

[21] Regarding the objection involving legal conclusions, Mr. De Luca essentially replied that these were opinions drawn from facts of which he had personal knowledge. As for the objection regarding paragraph 8 in Mr. Rota's affidavit, Mr. De Luca argued that this was not a legal conclusion but was instead the opinion of a person from the footwear industry who knew the impacts of a trademark.

[22] As highlighted by Justice Denis Gascon in *SSE Holdings, LLC v Le Chic Shack Inc*, 2020 FC 983 [*SSE Holdings*], the affidavits of ordinary witnesses such as those of Mr. De Luca and Mr. Rota must be confined to facts within their personal knowledge, in accordance with Rule 81 of the *Federal Courts Rules*, SOR/98-106. In addition, these affidavits cannot include opinions or legal conclusions; the Court may strike or disregard all or parts of affidavits where they are abusive or clearly irrelevant, or where they contain opinions, arguments or legal conclusions (*SSE Holdings* at para 49, citing *Canada (Attorney General) v Quadrini*, 2010 FCA 47 at para 18; *Cadostin v Canada (Attorney General)*, 2020 FCA 183 at para 36; *White Burgess Langille Inman v Abbott and Haliburton Co*, 2015 SCC 23 at para 14; *Toronto Real Estate Board v Canada (Commissioner of Competition)*, 2017 FCA 236 at para 78).

[23] The Court considered Mr. De Luca's explanations and arguments in response. However, the Court is satisfied that paragraphs 12, 16, 24, 27 and 30 of Mr. De Luca's affidavit and paragraph 8 of Mr. Rota's affidavit include either opinions or legal conclusions and that they are inadmissible. Said paragraphs will consequently be struck. The Court is also satisfied that paragraphs 17, 18 and 25 of Mr. De Luca's affidavit are not within his personal knowledge, and they will therefore be struck.

[24] Moreover, and given the reasons detailed above, even if the paragraphs at issue were not struck, the result of this decision would remain unchanged.

B. *Mr. De Luca has not established that the AMPHIBIOX Mark was not distinctive on March 28, 2022, as required by paragraph 18(1)(b) of the Act*

[25] Paragraph 18(1)(b) of the Act provides that the registration of a trademark is invalid when “the trademark is not distinctive at the time proceedings bringing the validity of the registration into question are commenced”. Indeed, the distinctiveness of a mark is confirmed as of the date of commencement of the application for expungement; thus, a mark that was not distinctive at registration may have become distinctive in the meantime through the nature of its use by its owner (*Tommy Hilfiger Licensing Inc v Produits de Qualité IMD*, 2005 FC 10 at paras 54–57 [*Tommy Hilfiger*]). As highlighted by Justice Michel Beaudry at paragraph 53 of his decision in *Tommy Hilfiger*, there are two types of distinctiveness: inherent distinctiveness and acquired distinctiveness.

[26] In the case at hand, the relevant date for assessing the distinctiveness of the AMPHIBIOX Mark is March 28, 2022, the day Mr. De Luca filed his notice of application with this Court.

[27] The registration of a mark is presumed to be valid, and any doubts must be resolved in favour of its validity. However, this is a rather weak presumption that requires evidence to be presented that the Court will need to weigh (*Bedessee Imports Ltd v GlaxoSmithKline Consumer Healthcare (UK) IP Limited*, 2019 FC 206 at paras 13–14 [*Bedessee*], aff. 2020 FCA 94 [*Bedessee FCA*], citing *Mr. P’s Mastertune Ignition Services Ltd v Tune Master Inc*,

[1984] 82 CPR (2d) 128 (FC) at p 134; *Cheaptickets and travel Inc v Emall Inc*, 2008 FCA 50 at paras 10–12; *Ottawa Athletic Club Inc (Ottawa Athletic Club) v Athletic Club Group Inc*, 2014 FC 672 at paras 120–22).

[28] Section 2 of the Act defines the term “distinctive” as follows:

Definitions

distinctive, in relation to a trademark, describes a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or that is adapted so to distinguish them; (*distinctive*)

Définitions

distinctive Se dit de la marque de commerce qui distingue véritablement les produits ou services en liaison avec lesquels elle est employée par son propriétaire de ceux d’autres personnes, ou qui est adaptée à les distinguer ainsi. (*distinctive*)

[29] For a trademark to be distinctive of a person, the message to the public must be that such person is the source of the goods bearing the trademark (*White Consolidated Industries Inc v Beam of Canada Inc*, (1991), 39 CPR (3d) 94, 1991 CarswellNat 214 at paras 59, 69 (FC)). In other words, a mark is distinctive when it does not include elements that are likely to direct consumers to a multitude of sources.

[30] In his decision in *Naked Whey Inc O/A Naked Nutrition v N8ked Brands Inc*, 2023 FC 1079 [*N8ked Brands*], Justice Michael Manson noted that, in order to be distinctive, a mark must meet the following three conditions: (1) the mark and the product must be associated; (2) the owner of the mark uses this association between the mark and its product and is manufacturing and selling; and (3) this association enables the owner to distinguish its product from that of others (*N8ked Brands* at para 51, citing *Labatt Brewing Co v Molson Breweries, a Partnership*,

[1992] FCJ No 523 (FCTD); *Bodum USA, Inc v Meyer Housewares Canada Inc*, 2013 FCA 240 at para 5, aff'ing 2012 FC 1450 at para 14).

[31] Justice Manson added that, as with the other claims of invalidity, it is the plaintiff's burden, as part of a remedy under paragraph 18(1)(b) of the Act, to show a lack of distinctiveness (*N8ked Brands* at para 53). In the case at hand, the burden of establishing, on a balance of probabilities, that the AMPHIBIOX Mark is invalid because it was not distinctive on March 18, 2022, rested with Mr. De Luca (*Bedessee* at para 15, citing *Uniwel Corp v Uniwel North America Inc*, [1996] 109 FTR 81 (FC) at para 6). Distinctiveness must be determined on the basis of the particular circumstances of the case (*Bedessee FCA* at para 23, citing *Molson Breweries v John Labatt Ltd*, 2000 CanLII 17105 (FCA), [2000] 3 FC 145 at para 70).

[32] Moreover, an applicant may allege that the reputation of its mark negates the distinctiveness of another mark (*Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 [*Bojangles*]). In that regard, when the issue is proving that a trademark (in this case, the ANFIBIO Mark) is sufficiently well known so as to negate another mark's distinctiveness (in this case, the AMPHIBIOX Mark), the first mark "must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient" (*Sadhu Singh Hamdard Trust v Navsun Holdings Ltd*, 2019 FCA 10 at para 4, citing *Bojangles* at para 34; *1648074 Ontario Inc v Akbar Brothers (pvt) Ltd*, 2019 FC 1305 at paras 31–32).

[33] At paragraphs 13 and 16 of his Memorandum of Fact and Law, and as part of the analysis that he presents regarding the likelihood of confusion between the ANFIBIO and AMPHIBIOX marks, Mr. De Luca deals with the inherent distinctiveness of the marks and the extent to which they have become known, in relation to paragraph 6(5)(a) of the Act. Mr. De Luca then refers to his own affidavit, to the one signed by Mr. Rota and to paragraphs 33 and following of the abovementioned Registrar's decision (Exhibit 7 of Mr. De Luca's affidavit) as evidence.

[34] It is not entirely clear whether Mr. De Luca alleges that the reputation of his ANFIBIO Mark is such that it negates the distinctiveness of the AMPHIBIOX Mark. However, if such is the case, he clearly did not submit the necessary evidence. As Geox emphasizes, none of the evidence submitted by Mr. De Luca demonstrates the use of the mark or sales or promotion of the ANFIBIO Mark in Canada on March 28, 2022, and Mr. De Luca therefore has certainly not demonstrated that the ANFIBIO Mark was known to some extent or that its reputation in Canada was substantial, significant or sufficient on March 28, 2022, as required by the case law cited above. In his affidavit, Mr. De Luca does not deal with the distinctiveness of his ANFIBIO Mark on March 28, 2022; he does not mention the reputation of his mark or the extent to which it was known on the relevant date. In fact, in his affidavit, Mr. De Luca deals only with the likelihood of confusion at the time the AMPHIBIOX Mark was registered, in 2010, and the dispute between the parties up until March 24, 2022, that is, before the date of March 28, 2022. Mr. Rota also does not state anything in this regard.

[35] During the hearing, Mr. De Luca argued that the various procedures related to section 45 of the Act, mentioned above, are relevant for showing that the ANFIBIO Mark was used from

2015 to 2022. Mr. De Luca also argued that his motivation to defend the Registrar's decision showed, to some extent, that his mark was used. Specifically, Mr. De Luca invited the Court to accept the Registrar's conclusions as evidence in these proceedings.

[36] In response, Geox objected to Mr. De Luca's arguments on this topic, stressing that the evidence that was before the Registrar is not evidence in this case. Geox also stressed that it would be contrary to the case law to consider the Registrar's conclusions as evidence in these proceedings.

[37] The Court agrees with Geox's position. First, the evidence that was before the Registrar is not before the Court. Second, the conclusions that the Registrar draws from the evidence before him or her cannot be used as evidence in proceedings before the Court. In any event, in the dispute under section 45 of the Act, the Registrar had to examine whether the mark had been used during the period from April 2012 to April 2015 and not on March 28, 2022. The fact that the Registrar's decision has been subject to appeals and legal decisions up to March 2022 does not change this finding in any way.

[38] At the end of the hearing, in reply, Mr. De Luca applied to this Court for leave to perfect his evidentiary record in order to produce documents that demonstrate use of the ANFIBIO Mark and show that it was known on March 28, 2022. Geox objected to this application, stressing that Mr. De Luca had for a long time known the arguments raised by Geox regarding the insufficiency of the evidence. Geox specified that it served and filed its Respondent's Record on

December 23, 2023, and that Mr. De Luca had not initiated anything in this regard before the end of the hearing, in June 2024. The Court dismissed Mr. De Luca's application from the bench.

[39] The evidence before the Court does not establish, on a balance of probabilities, that the ANFIBIO Mark has any sort of notoriety or reputation in Canada, in association with boots, on March 28, 2022, so as to negate the distinctiveness of the AMPHIBIOX Mark.

[40] Moreover, Mr. De Luca also did not submit any evidence to demonstrate that the AMPHIBIOX Mark was not distinctive on March 28, 2022, according to other means. Specifically, Mr. De Luca did not establish that any of the conditions that determine the distinctiveness of the AMPHIBIOX Mark was not fulfilled, either that:

- (a) the AMPHIBIOX Mark was not associated with Geox boots;
- (b) Geox does not use this association, that is, it neither manufactures nor sells boots bearing the AMPHIBIOX Mark; or
- (c) the association between the AMPHIBIOX Mark and its boots does not enable Geox to distinguish its products from those of other owners, namely Mr. De Luca.

[41] Geox argues that, since Mr. De Luca has not discharged his burden of proof to challenge the validity of the AMPHIBIOX Mark's registration under paragraph 18(1)(b) of the Act, the Court can dismiss Mr. De Luca's application to expunge without determining whether a mark created confusion. The Court agrees.

[42] The Court adds, moreover, that the parties were not able to explain why the Court should examine whether a mark creates confusion based on the circumstances of subsection 6(5) of the Act and as part of a remedy under paragraph 18(1)(b) of the Act. However, it is not necessary to deal with this concern in the circumstances of this case.

[43] In addition, the Court notes that Geox submitted an extensive evidentiary record that demonstrates the use, significant sales and promotion of the AMPHIBIOX Mark, namely in association with boots, across Canada from 2010 to 2022. The evidence attached to Mr. Ferro's and Mr. Stinziani's affidavits demonstrates that the AMPHIBIOX Mark had become very well known even before March 28, 2022, and that it was so on March 28, 2022, in association with boots. The evidence also shows that, on the relevant date, Geox used this association and that the association between the AMPHIBIOX Mark and its boots enables Geox to distinguish its products from those of other owners, which demonstrates the distinctiveness of the AMPHIBIOX Mark on March 28, 2022.

V. Conclusion

[44] Mr. De Luca has not established, on a balance of probabilities, that the AMPHIBIOX Mark was not distinctive on March 28, 2022, the date he filed his application with this Court. Consequently, his remedy under paragraph 18(1)(b) of the Act cannot be granted.

[45] Geox requests that costs be awarded in accordance with the middle of Column III of the table to Tariff B. Mr. De Luca did not make any representations as to costs and did not challenge

Geox's representations on this matter. Given the result of the application, costs will be awarded to Geox, in accordance with the middle of Column III of the table to Tariff B.

JUDGMENT in T-654-22

THIS COURT'S JUDGMENT is as follows:

1. The application to expunge the AMPHIBIOX Mark is dismissed.
2. Costs are awarded to Geox S.P.A. according to the middle of Column III of the table to Tariff B.

“Martine St-Louis”

Judge

Certified true translation
Michael Palles

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-654-22

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