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TRANSLATION
THE REGISTRAR OF TRADE-MARKS

Citation: 2017 TMOB 124

Date of Decision: 2017-09-19

**[UNREVISED ENGLISH
CERTIFIED TRANSLATION]**

IN THE MATTER OF A SECTION 45 PROCEEDING

Geox S.p.A.

Requesting Party

and

Giuseppe De Luca

Registered Owner

LMC375,888 for ANIFIBIO & Dessin

Registration

THE RECORD

[1] On April 14, 2015, at the request of Geox S.p.A. (the Applicant), the Registrar sent the notice stipulated in section 45 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act) to Giuseppe De Luca (the Owner), holder of registration No. TMA385,888 for the ANFIBIO & Dessin trade-mark reproduced hereinafter (the Mark).



[2] This notice enjoined the Owner to provide an affidavit or a statutory declaration that its Mark was used in Canada at any time between April 14, 2012, and April 14, 2015 (the relevant period), in association with the goods specified in the registration, i.e. “chaussures, nommément : bottes et souliers” (footwear, namely boots and shoes) and, in the negative, the date when the Mark was used for the last time and the reason for its failure to use it since that date.

[3] In response to the Registrar’s notice, the Owner filed two affidavits, one subscribed by him personally on August 11, 2015, and one subscribed on November 13, 2015, by Franco Rota, Treasurer, Controller, and one of the directors of Chaussures De Luca Montréal Inc.

[4] The two parties filed written representations and participated in a hearing.

ANALYSIS

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register; this is why the applicable test is not very stringent. As stated by Judge Russell in *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC), at page 282:

We know that the purpose of s. 45 proceedings is to clean up the “deadwood” on the register. We know that the mere assertion by the owner that his trade-mark is in use is not sufficient and that the owner must “show” how, when and where it is being used. We need sufficient evidence to be able to form an opinion under s. 45 and apply that provision. At the same time, we need to maintain a sense of proportion and avoid evidentiary overkill. We also know that the type of evidence required will vary somewhat from case to case, depending upon a range of factors such as the trade-mark owner’s business and merchandising practices.

[6] In the present case, section 4(1) of the Act defines use in association with goods as follows:

A trade-mark 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] This leads me to review the evidence filed by the Owner.

Giuseppe De Luca's affidavit

[8] Mr. De Luca affirms he has a great knowledge of the footwear industry. He explains he was trained as a shoemaker and founded a footwear factory in Montreal in 1968. He affirms he was personally involved in the creation and marketing of boots and shoes bearing the Mark from the beginning. He hereby affirms he has a good knowledge of what makes the quality of a boot or a shoe. He also explains he is the founder of Chaussures De Luca and sold it in 1991 while retaining ownership of the Mark.

[9] Mr. De Luca affirms that, during the relevant period, the Mark was used under licence by Chaussures De Luca with all the goods described in the registration. He refers collectively to them as the "Goods" and affirms that [TRANSLATION] "these are essentially winter boots and shoes".

[10] Mr. De Luca affirms that the licence granted to Chaussures De Luca contains a clause to the effect that the Goods must be of quality. He affirms he controls, directly or indirectly, the quality and features of the Goods that bear the Mark, by his regular visits to different footwear stores in Montreal, including visits during the relevant period. He affirms he is thus able to see the Goods bearing the Mark and verify, at random, the quality and features of the Goods bearing the Mark.

[11] Mr. De Luca affirms that the Mark has been modified slightly to update it. He affirms that the essential elements of the Mark, as registered, have been retained, namely the design of a penguin to the left of the word ANFIBIO in uppercase letters, and that the other elements of the updated mark are only to inform consumers that these are waterproof boots.

Franco Rota's affidavit

[12] Mr. Rota affirms that the use of the Mark by Chaussures De Luca has been governed by an exclusive use agreement since June 1, 1991, in association with boots and shoes. He refers collectively to these goods as the "Goods", and affirms they are leather boots and shoes waterproofed for winter. He affirms that the owner of the Mark is Mr. De Luca, whom he knows personally, and he filed as Exhibit 1 in support of his affidavit a copy of the [TRANSLATION] "*Agreement for use of the 'ANFIBIO' trade-mark and the 'GRASSO 1 DE LUCA' trade name*", which took effect on June 1, 1991, between the Owner and Chaussures De Luca (the "Licence").

[13] Mr. Rota refers to certain provisions of the Licence and affirms, in particular, that as specified in clause 6.4 of the Licence, Chaussures De Luca must ensure the quality of the Goods, improve the Goods and develop new Goods with features similar to those of the Goods already manufactured. He affirms that not doing so would constitute a default according to the Licence and that the Owner may terminate the Licence by giving written notice to Chaussures De Luca. He also affirms that under the Licence, Chaussures De Luca pays the Owner annual royalties based on the sales of the Goods.

[14] Mr. Rota affirms that Chaussures De Luca used the Mark in association with the Goods, in Canada, during the relevant period. He specifies that Chaussures De Luca sells to footwear retailers and also sells directly to consumers via the website *www.bottesanfibia.com*.

[15] Mr. Rota affirms that the Goods are entirely manufactured in Canada and that Chaussures De Luca has a workshop located in Montréal-Nord for these purposes. He affirms that the goal of Chaussures De Luca is to produce the warmest and most luxurious boots possible. He explains that the leather used is certified as waterproof, having undergone a treatment that seals the chemicals permanently in the leather. Moreover, all the stitches are sealed to prevent any water infiltration. He affirms that the Goods are very high quality and correspond to the Owner's requirements. He adds in this regard that Chaussures De Luca has never received a notice of default from the Owner concerning the quality of the Goods.

[16] In support of his affirmations of use of the Mark by Chaussures De Luca during the relevant period, Mr. Rota filed the following exhibits:

- Exhibit 2, jointly containing
 - a photo of a label. Mr. Rota explains that such a label is attached to the Goods and represents the way Chaussures De Luca used the Mark during the relevant period. He points out that the mention can be seen, on one of the sides of the label, that the Goods are manufactured by Chaussures De Luca, as well as the address of the website *www.bottesanfibo.com*. I reproduce the front and back of the label in Appendix A of my decision;
 - a photo of a box in which the Goods are packaged, bearing the Mark, as illustrated on the label reproduced in Appendix A. Mr. Rota explains that such a box represents the way Chaussures De Luca used the Mark during the relevant period; and
 - [TRANSLATION] “copies of screenshots of the website of [Chaussures De Luca] archived by Wayback Machine on January 28, 2012, November 18, 2012, and February 17, 2014, as well as an excerpt from the website of [Chaussures De Luca] dated August 11, 2015.” Mr. Rota explains that the excerpts from Wayback Machine and the current website of Chaussures De Luca show that the Mark appearing on the label and the box has been identical since at least January 28, 2012.
- Exhibit 3: copies of invoices issued by Chaussures De Luca between August 27, 2012, and December 9, 2014. Mr. Rota explains that the word ANFIBIO is written on the invoices, with the style number and the mention “botte” (boot). He affirms these are invoices for the sale of Goods bearing the Mark, to different footwear stores in Canada and that the retailers received the Goods in boxes identical to those appearing in the photo filed as Exhibit 2.

The position of the Requesting Party

[17] The Requesting Party essentially makes four arguments:

- i. That there is an absence of evidence of any use of the Mark in association with the goods described in the registration as “souliers” (shoes).
- ii. That the proven use does not pertain to the Mark as registered, but to another mark.

- iii. That such use does not show how the Mark is associated with the goods described in the registration as “bottes” (boots) at the time of the transfer of ownership.
- iv. That such use does not benefit the Owner within the meaning of section 50 of the Act.

[18] I will examine each of these arguments in turn.

Absence of evidence of use of the Mark in association with “shoes”

[19] As rightly noted by the Requesting Party, none of the exhibits provided in support of Mr. Rota’s affidavit shows the Mark used in association with “shoes”.

[20] Although Messrs. De Luca and Rota both affirm that the goods associated with the Mark consist of winter boots and shoes, such a general affirmation of use is not supported by evidence of record – the descriptions and photographs of goods under Exhibits 2 and 3 refer only to “boots”. More specifically:

- Both the Mark, as used, and the goods description found on the label, refer only to “boots”.
- The excerpts from the website *www.bottesanfibio.com* describe “BOTTES D’HIVER HOMME” (winter boots for men), or “BOTTES D’HIVER FEMMES” (winter boots for women), or boast of the Canadian manufacturing of “bottes Anfibio et Contoura” (Anfibio and Contoura boots).
- The invoices only refer to “bottes hautes” (high boots) and “bottes basses” (low boots) for men or women.

[21] During the hearing, the Owner argued that one of the boot models reproduced in the Internet excerpts under Exhibit 2, namely the “JOELLE” model for women, could be likened to a winter shoe, because it is a low boot. I disagree.

[22] Not only is such a position not supported by the description of the goods appearing under Exhibits 2 and 3, but having established a distinction between “boots” and “shoes” by the fact of specifying these goods separately in the registration, the Owner had to provide some evidence of use related to each of these goods [see *John Labatt Ltd v Rainer Brewing Co* (1984), 80 CPR (2d) 228 (FCA); and *Sharp Kabushiki Kaisha c 88766 Canada Inc* (1997), 1997 CanLII 16206

(FC), 72 CPR (3d) 195 (FCTD]. Thus, to be able to maintain its registration regarding “shoes”, the Owner had to prove there were sales and transfers otherwise than in reference to the “boots” presented in evidence.

[23] Consequently, I am not convinced that the Owner proved the use of the Mark in association with the goods described in the registration as “souliers” (shoes) within the meaning of sections 4 and 45 of the Act.

[24] Given that the Owner did not provide any evidence of special circumstances justifying the failure to use the Mark in association with these goods, they will be deleted from the registration.

Use of the Mark as registered

[25] As explained by Mr. De Luca in his affidavit, the Mark as used [TRANSLATION] “has been slightly modified to update it”. The changes described by Mr. De Luca consist of those illustrated in Appendix A hereof.

[26] Establishing a parallel between this case and the decision rendered by the Federal Court of Appeal in *Canada (Registrar of Trade-marks v Compagnie Internationale pour l'Informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523, the Requesting Party submits that the Mark is not used as it is registered.

[27] The test in matters of variation, as stated by the Court in *CII Honeywell Bull, supra*, is as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade-mark as it is registered with the trade-mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin. [at p 525]

[28] As the Court pointed out:

That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the difference between the form in which it was registered and the form in which it was used. [at p. 525]

[29] To settle this question, we must ask ourselves whether the “dominant features” of the trade-mark were preserved [see *Promafil Canada Ltd v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[30] In the case at bar, I agree with the Owner that the dominant features of the Mark, as registered, are the penguin design and the word ANFIBIO, and that these features were preserved in the Mark as used.

[31] As observed by the Owner, both in the Mark as used and in the registered Mark, the penguin is bigger than the letters of the word ANFIBIO written to the right of the penguin in uppercase letters. Moreover, the penguin is designed in almost the same way, with the black and white in the same places, the two wings pointed downward and the gaze turned to the right. The disappearance of the ellipse replaced by a straight line below the design is fairly minor, all in all. The addition of the descriptive words “Bottes imperméables / *Waterproof Boots*” does not compromise the use of the Mark *per se*.

[32] Consequently, I am convinced the Mark was used in such a way that it did not lose its identity and remained recognizable despite the differences existing between the form in which it was registered and the form in which it was used.

How the Mark was associated with “boots” at the time of the transfer of ownership

[33] The Requesting Party submits that the evidence does not prove how the Mark was used in association with the boots described in the registration, at the time of the transfer of ownership, in the normal practice of the trade, during the relevant period. The Requesting Party essentially submits that the label and box photos in Exhibit 2 do not show the boots in question, and that the Internet excerpts in Exhibit 2 suggest that no other entity uses the Mark, given that the copyright notice “©” affixed at the bottom of the screen of the website *www.bottesanfibio.com* refers to “Arteca Design Inc.” (Wayback Machine excerpts), and to “Bottes imperméables Anfibio / Anfibio Weatherproof Boots” (excerpts from the current website).

[34] I disagree with the Requesting Party’s approach.

[35] Mr. Rota's affidavit must be read in its entirety. It is not because the label and box photos do not show the label attached to a real pair of boots, or do not include a photo of the open box showing a real pair of boots inside, that Mr. Rota's affidavit does not prove satisfactorily how the Mark was used in association with the boots described in the registration, at the time of the transfer of ownership, in the normal practice of the trade. It clearly emerges from Mr. Rota's affidavit that such a label is attached to the boots in question, and that they are packaged in such a box and were sold by Chaussures De Luca to various retailers in Canada during the relevant period, as proved by the invoices in Exhibit 3.

[36] Moreover, the fact that a copyright notice possibly referring to an entity other than the Owner or Chaussures De Luca appears at the bottom of the screen of the website *www.bottesanfibio.com* does not change anything in the way these labels and this box give notice of the connection between the Mark and the boots in question to the person to whom ownership or possession is transferred.

How the use of the Mark benefits the Owner within the meaning of section 50 of the Act

[37] The Requesting Party submits that the use of the Mark does not benefit the Owner within the meaning of section 50 of the Act for various reasons.

[38] I find it is unnecessary to set them out in detail, for the following reasons.

[39] Section 50 of the Act governs the question of the use of a trade-mark under licence. The relevant paragraph for the purposes of my analysis is as follows:

50(1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

[40] In the case at bar, Messrs. De Luca and Rota both mention the existence of a licence for use of the Mark.

[41] Apart from the fact that a copy of this licence referring expressly to this trade-mark registration and containing the usual clauses, such as those confirming the ownership of the Mark (clauses 1.2 and 1.5), those concerning the quality of the goods (clauses 3.1 and 6.4), those allowing the Owner to terminate the Licence (clauses 8.1, 8.2 and 9.2), etc., is filed under Exhibit 1 of Mr. Rota's affidavit, I find that Mr. De Luca's affirmations are sufficient in themselves to establish his direct or indirect control of the features or the quality of the goods sold under licence by Chaussures De Luca.

[42] As mentioned by the Owner, a licence to use does not need to be written.

[43] In the case at bar, the Owner signed a Licence in which it is indicated, in particular, that the goods manufactured under the Mark must be of the same quality as those manufactured at the time the Licence is signed. I agree with the Owner that there are enough criteria here to allow the Owner to control adequately the quality and the features of the Goods bearing the Mark. The Owner, during the relevant period, controlled the quality of the goods bearing the Mark by visiting different footwear stores in Montreal, and by using these visits as an opportunity to verify at random the quality of the goods bearing the Mark.

[44] The fact that no clause of the Licence expressly authorizes the Owner to visit a factory is not inherently fatal. As mentioned by the Owner, the Act does not dictate any criterion regarding the nature or the intensity of control of the quality and features of goods bearing a trade-mark. In the case at bar, the Owner performed random controls by going directly to the retailers selling the goods bearing the Mark during the relevant period.

[45] That fact that no clause of the Licence provides expressly for the use of a variant of the Mark as registered is also not inherently fatal. Such as it emerges from my foregoing analysis, the update of the Mark retains the fundamental elements of the registered Mark. In fact, this is still the same trade-mark, as indicated above.

[46] Finally, the fact that a copyright notice possibly referring to an entity other than the Owner or Chaussures De Luca appears at the bottom of the screen of the website *www.bottesanfibio.com*, cannot be enough to call into question the evidence of use of the Mark by Chaussures de Luca, for the benefit of the Owner, in association with boots, as proved by the

label and boot photos in Exhibit 2 and the invoices in Exhibit 3. Even if it were presumed from such a copyright notice that the Mark was used by a thirty party outside the framework established in section 50 of the Act, this could not annihilate the stream of evidence proved by the label and boot photos in Exhibit 2 and the invoices in Exhibit 3.

DECISION

[47] In exercising the authority delegated to me pursuant to the provisions of section 63(3) of the Act, the registration will be amended to expunge the following goods: “...et souliers” (and shoes), according to the provisions of section 45 of the Act.

[48] The amended statement of goods will be worded as follows: “Chaussures : nommément bottes” (Footwear: namely boots).

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified translation
Arnold Bennett

APPENDIX A

Front and back of the label reproduced in Exhibit 2 of Mr. Rota's affidavit



**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

DATE OF HEARING 2017-07-19

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