

Federal Court



Cour fédérale

Date: 20090512

Docket: T-151-09

Citation: 2009 FC 492

Ottawa, Ontario, May 12, 2009

PRESENT: The Honourable Mr. Justice Shore

BETWEEN:

**ABERCROMBIE & FITCH CO.  
ABERCROMBIE & FITCH TRADING CO.  
and AFH CANADA STORES CO.**

**Plaintiffs/Respondents**

and

**GIANT TIGER STORES LIMITED, G.T. WHOLESALE LIMITED,  
TORA NEWMARKET LIMITED (doing business as Giant Tiger Store 146),  
TORA MISSISSAUGA LIMITED (doing business as Giant Tiger Store 152),  
JOHN DOE and all others operating or supplying giant tiger stores who have  
sold, offered for sale, advertised or distributed products  
in association with the trade-marks of the Plaintiffs**

**Defendants/Appellants**

**REASONS FOR ORDER AND ORDER**

I. Overview

[1] 6. The ambit of questions on discovery must be restricted to unadmitted allegations of fact in the pleadings, and fishing expeditions by way of a vague, far-reaching or an irrelevant line of questioning are to be discouraged: *Carnation Foods Co. Ltd. v. Amfac Foods Inc.* (1982), 63 C.P.R. (2d) 203 (F.C.A.); and *Beloit Ltee/Ltd. v. Valmet Oy* (1981), 60 C.P.R. (2d) 145 (F.C.T.D.). (*Reading & Bates Construction Co. v. Baker Energy Resources Corp.* (1988), 25 F.T.R. 226,

[1988] F.C.J. No. 1025 (QL) (F.C.T.D.);

[2] [3] ... But, before the filing of the defence, the right of a defendant to be furnished particulars is not so broad, since it does not have the same basis and serves a different purpose. A defendant should not be allowed to use a request for particulars as a means to pry into the brief of his opponent with a view to finding out about the scope of the evidence that might be produced against him at trial, nor should he be allowed to use such a request as a means to go on a sort of fishing expedition in order to discover some grounds of defence still unknown to him. At that early stage, a defendant is entitled to be furnished all particulars which will enable him to better understand the position of the plaintiff, see the basis of the case made against him and appreciate the facts on which it is founded so that he may reply intelligently to the statement of claim and state properly the grounds of defence on which he himself relies, but he is not entitled to go any further and require more than that.

*(Embee Electronic Agencies v. Agence Sherwood Agencies Inc. (1979), 43 C.P.R. (2d) 285,*

*[1979] F.C.J. No. 1131 (QL) (F.C.T.D.)).*

## II. Background

[3] This action is for trade-mark infringement and passing off relating to the sale of counterfeit copies of the Respondents' clothing products by the Appellants in Canada.

[4] A list of particulars of the allegations contained in a Statement of Claim was requested by the Appellants and the Respondents did provide a detailed response to the request (Affidavit of Kathy Paterson, Exhibits "B" to "F", Appellants' Motion Record, dated April 6, 2009, Tab 2B to 2F).

[5] The Appellants subsequently brought a motion which resulted in the Order of Prothonotary Roza Aronovitch that is the subject of this appeal. On the motion, the Appellants sought, *inter alia*, particulars "identifying the manufacturers" referred to in paragraph 11 of the Statement of Claim, which provides:

11. All garments to which the A & F Trade-marks are applied are manufactured by or for Abercrombie & Fitch under licence from Abercrombie & Fitch Trading

Co. and Abercrombie & Fitch Trading Co. controls the character and quality of said garments under said licence.

[6] The Appellants filed an affidavit attaching as exhibits the Statement of Claim and correspondence between counsel. As such, the Record before Prothonotary Aronovitch is devoid of any evidence that the particulars requested were necessary for the Appellants to plead and not within the knowledge of the Appellants (Affidavit of Kathy Paterson, Appellants' Motion Record, dated April 6, 2009, Tab 2).

[7] Prothonotary Aronovitch dismissed the Appellants' motion for the particulars that are the subject of this appeal (Order of Prothonotary Roza Aronovitch, dated April 24, 2009).

### III. Analysis

[8] The onus is on the Appellants to establish that the Prothonotary's decision was clearly wrong in the sense that the exercise of discretion was based upon a wrong principle or a misapprehension of the facts. The Appellants have not met this onus (*Canada v. Aqua-Gem Investments Ltd.*, [1993] 2 F.C. 425, 39 A.C.W.S. (3d) 59 at 454 & 463 (C.A.)).

[9] Although the Prothonotary did not provide reasons for her decision, absent the Appellants establishing that the Prothonotary's decision was clearly wrong, the Court must not exercise its discretion *de novo* (*Pharmaceutical Partners of Canada Inc. v. Faulding (Canada) Inc.*, 2002 FCT 1010, 117 A.C.W.S. (3d) 221 at para. 9).

[10] Overall, the essence of the Appellants' argument is that without the particulars, "the Appellants are being asked to plead in the dark".

[11] The Appellants did not adduce any evidence to support the need for the requested particulars on the motion before Prothonotary Aronovitch. It is axiomatic that the onus on a motion for particulars is on the moving party and particulars will only be granted where the moving party establishes that the particulars are both necessary for pleading and not within its knowledge. As no evidence was adduced in this regard, the Prothonotary's decision cannot be "clearly wrong" (38867227 *Canada Inc. v. Eagle Pack Pet Foods Inc.*, 2006 FC 1095, 151 A.C.W.S. (3d) 811 at para. 7).

[12] The Respondents have pleaded as a material fact that the products in issue were not authorized for manufacture. The identity of the Respondents' authorized manufacturers is not an issue in the action unless and until the Appellants plead material facts supporting that the impugned products are authorized. To the extent that the Appellants believe that the products sold were authorized, they are in a position to plead material facts supporting that allegation by identifying the alleged authorized manufacturer(s). A request for particulars is not a means for Appellants to go on a "fishing expedition" to discover grounds of defence unknown to them (*Reading*, above; *Embee Electronic Agencies*, above).

[13] The *Nav Canada v. Adacel Technologies Ltd.* case referenced in the Appellants' pleadings does not stand for the broad principle asserted and is distinguishable on its facts. In that case, there was a vague allegation that the copyright asserted by the Plaintiff was transferred. The specific mode of transfer was material to the Plaintiff's claim since the *Copyright Act*, R.S., 1985, c. C-42, specifically provides that an assignment of copyright must be in writing and at law a plaintiff is bound to plead its chain of title and the failure to do so can be fatal to the claim. Also, the mode of transfer is the type of information that would be within the knowledge of the

Plaintiff, not the Defendant (*Nav Canada v. Adacel Technologies Ltd.*, 2006 FCA 227, 351 N.R. 184 at paras. 7-12).

[14] The Appellants' request for particulars must also be considered in the context of this action. The infringement allegations in this proceeding pertain to imported counterfeit wares. The identification of all authorized manufacturers may prejudice the Respondents due to the very nature of such information.

[15] In light of the foregoing, the Appellants' appeal is dismissed.

#### Costs

[16] The issue of costs is brought forward clearly in the affidavit of Ms. Donna Stackaruk.

[17] The Appellants have not provided details in regard to sales of such garments made in Canada or to provide undertakings in respect of having them permanently cease selling counterfeit copies of the Respondents' garments.

[18] The Record shows that the Appellants have taken steps which delay the providing of the above-specified information and undertakings which cause an increase to the costs of this litigation (Affidavit of Kathy Paterson, Appellants' Motion Record, dated April 6, 2009; Affidavit of Donna Stackaruk, Respondent's Motion Record, dated April 20, 2009; Affidavit of

Donna Stackaruk, Respondents' Motion Record, Tab 1; *J2 Global Communications Inc. v.*

*Protus IP Solutions Inc.*, 2008 FC 298, 65 C.P.R. (4th) 181 at para. 15).

[19] In the circumstances, a specific costs award is warranted. Accordingly, payment of the Respondent's costs of this appeal is calculated on the highest scale under Column IV of Tariff B of the *Federal Courts Rules* payable forthwith by the Appellants.

**ORDER**

**THIS COURT ORDERS that**

- (1) the appeal be dismissed with costs.
- (2) the payment of the Respondent's costs of this appeal be calculated on the highest scale under Column IV of Tariff B of the *Federal Courts Rules* payable forthwith by the Appellants.

“Michel M.J. Shore”

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Judge

**FEDERAL COURT**

**SOLICITORS OF RECORD**

**DOCKET:** T-151-09

**STYLE OF CAUSE:** ABERCROMBIE & FITCH CO.  
ABERCROMBIE & FITCH TRADING CO.  
and AFH CANADA STORES CO.  
v.  
GIANT TIGER STORES LIMITED, G.T.  
WHOLESALE LIMITED, TORA NEWMARKET  
LIMITED (doing business as Giant Tiger Store  
146), TORA MISSISSAUGA LIMITED (doing  
business as Giant Tiger Store 152),  
JOHN DOE and all others operating or supplying  
giant tiger stores who have sold, offered for sale,  
advertised or distributed products in association  
with the trade-marks of the Plaintiffs

**PLACE OF HEARING:** Ottawa, Ontario

**DATE OF HEARING:** May 12, 2009

**REASONS FOR ORDER  
AND ORDER:** SHORE J.

**DATED:** May 12, 2009

**APPEARANCES:**

Mr. Brian P. Isaac FOR THE PLAINTIFFS/RESPONDENTS  
Mr. Kevin K. Graham  
Mr. Kevin L. LaRoche FOR THE DEFENDANTS/APPELLANTS  
Ms. Kathleen Lemieux

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