COURT FINDS TERM "BAGAGERIE" NOT TO BE AN ACCURATE DESCRIPTION OF RESPONDENT'S BUSINESS

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A recent decision of Canada's Federal Court of Appeal relating to confusion between trade-marks has analyzed what constituted an "accurate description of the character or quality of wares or services". The Court concluded that the use of the term "BAGAGERIE" was not an accurate description of the character or quality of a business specialized in selling and repairing suitcases, travel bags and the like. (*La Bagagerie S.A. v. La Bagagerie Willy Limitée*, No. A-301-87, October 15, 1992).

Appellant La Bagagerie S.A. ("La Bagagerie") applied for damages and a permanent injunction against Respondent La Bagagerie Willy Limitée ("Willy") to stop the use of the words "LA BAGAGERIE" in the latter's commercial name. The trial judge who heard La Bagagerie's application dismissed the suit, holding that there was no confusion possible for members of the public between the Appellant's trade-marks and the Respondent's commercial name (reported at (1987) 17 C.P.R. (3d) 209).

On appeal, the Court reviewed the facts and issues raised by the case: Appellant La Bagagerie, a French corporation, is the owner of three registered trade-marks incorporating the terms "LA BAGAGERIE"; these three trade-marks were registered respectively in 1967, 1971 and 1984 in association with inter alia, suitcases, travel bags, trunks and other travel accessories, on the basis of use of the trade-mark in Canada(for the oldest registration) since September 1964.

Respondent Willy was incorporated under its commercial name in 1979 and, as a retailer, sold various types of suitcases (though not Appellant's suitcases) under different trade-marks; it also provided a suitcase repair service. Appellant's instituted its action on August 31, 1984.

The Federal Court of Appeal reviewed the two means of defence put forward by Respondent Willy.

Willy pleaded that there was no confusion possible between the trade-mark LA BAGAGERIE and the commercial name LA BAGAGERIE WILLY LIMITÉE, in light of the difference in both marks. However, reversing the trial judge, the Court held that there was indeed confusion (or likelihood of confusion) between the trade-marks and commercial name at issue and concluded that the trial judge had erroneously conducted the test of confusion: instead of looking for differences between the trade-marks and commercial name at issue, he should have examined them from the point of view of the average consumer having an imperfect recollection of them. The Court also decided that the parties' wares did not require a substantial investment on the part of consumers, (as opposed to, say, a refrigerator or a car) thus enhancing the risk of confusion between the parties' trade-marks and commercial name.

The second defence relied upon by Respondent Willy rested on Section 20 of the Trade-marks Act R.S.C. 1985 c. T-13 which reads, inter alia: "...No registration of a trade-mark prevents a person from making any bona fide use, other than as a trade-mark, of any accurate description of the character or quality of his wares or services..." Thus, in order to succeed against Appellant's action, Respondent Willy had to establish that the word "BAGAGERIE" in its commercial name constituted an "accurate description" of the wares he offered for sale, that is, suitcases, travel bags, etc.

The Federal Court of Appeal proceeded to review the expert linguistic evidence which had been tendered before the trial judge, and more particularly, the evidence relating to the manner of creation of words in French by the addition of the suffix "erie" (to indicate a place where a type of activity is carried on). The Court concluded that the French word "bagages" meant an item or various items that one brings on a trip; it also meant the sum of suitcases or travel bags which contain these items and not an empty suitcase (as sold by Respondent). The Court concluded that the various definitions submitted all indicated that the French word "bagages" represented not a suitcase but its content. Thus, the Court stated that "bagages" was synonymous with "suitcases containing various items" and noted that the word "bagagerie" was formed with the word "bagages" and the suffix "erie" (suffix which suggested the idea of a business). The Court indicated it was plainly clear that both parties were involved in the sale of suitcases which were evidently empty; thus, it concluded that Respondent Willy was not actually involved in a "bagagerie" business, that is the sale of fully packed suitcases.

Having concluded that the name LA BAGAGERIE did not offer an accurate description of the character or quality of Respondent Willy's wares or services, the Court rejected its second ground of defence. The Federal

Court of Appeal overturned the trial judge's decision and allowed Appellant's action.

Though the Court restated that a judge is not bound by definitions found in dictionaries, these and expert linguistic evidence, as this case illustrates, are nearly always considered to help a judge ascertain the true meaning of a word. As the PIZZA PIZZA case illustrated previously (trade-mark held registrable in *Pizza Pizza Ltd. v. Registrar of Trade-Marks* (1989), 26 C.P.R. (3d) 355 (F.C.A.)), this is another illustration of the clash between law and linguistics and the proper use of expert evidence.

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