



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2014 TMOB 25**  
**Date of Decision: 2014-02-06**

**IN THE MATTER OF AN OPPOSITION  
by Cache, Inc to application No. 1,455,624  
for the trade-mark CACHE CACHE in  
the name of CACHE-CACHE, société  
anonyme**

Introduction

[1] This opposition relates to an application filed on October 16, 2009 by CACHE-CACHE, société anonyme (the Applicant) to register the trade-mark CACHE CACHE (the Mark). The application was filed on the basis of proposed use in Canada and also on the basis of foreign use and registration in France.

[2] The wares in association with which the application was advertised were:

precious metals and their alloys except for dental use; horological and chronometric instruments, namely, clocks, watches, watch cases, watch bracelets, alarm clocks; precious stones; jewellery, costume jewellery; rings (jewellery), bands (jewellery), earrings, bracelets, broaches (jewellery), necklaces, charms; ties clips, ties bars; boxes of precious metals, jewel caskets (made of precious metals), cases for jewellery of precious metals, cigarette cases made of precious metals, purses of precious metals; statues made of precious metals; leather and imitation of leather, goods made of these materials (leather and imitation leather) that are not included in other classes, namely: trunks, travel bags and travelling sets; bags, namely, handbags, beach-bags, shopping bags, school book bags, bags on wheels, duffel bags that are not specifically adapted to the items they are to carry, backpacks; briefcases, suitcases, attaché cases, overnight cases, boxes designed to carry toiletries such as vanity cases, toiletry (vanity) cases, garment carriers (for travel), travel toiletry cases; key cases (leather goods); mobile phone case (leather goods); eyeglass cases (leather goods); wallets and purses (not made of precious materials), portfolios, pouches, purses of precious materials; card case (wallet); boxes made of leather or imitation leather; umbrellas,

parasols and canes; whips and saddlery; leather goods made of leather or imitation leather (except cases adapted to the items they are designed to carry, gloves and belts), namely, handbags, school book bags, wallets, purses, portfolios, pouches, suitcases, attaché cases, overnight cases, travel toiletry cases; leather or imitation leather lanyards; straps made of leather or imitation leather or leather board, namely, shoulder bag straps, handbags straps, luggage straps; animal collars made of leather or imitation leather; animal clothes; leashes; muzzle; animal hides; clothing, namely; overcoats, parkas, furs, gabardine, waistcoat, raincoats, cardigans, coats, jackets, pea jackets, suits, body suits, trousers, dresses, skirts, jumper, smocks, t-shirts, shirts, short-sleeved shirt, pullovers, sweaters, tank tops, crop tops, singlets, jerseys, pyjamas, dressing gowns; underwear, undergarments, undershirts, slips (underwear), underpants, boxer shorts, bra, petticoats; sportswear, biker shorts, bath caps, bathing-trunks, swimsuits, swimming costumes; bath-robos, bathing sandals, bathing shoes; belts (clothing), suspenders, scarves, mittens, muffs, gloves (clothing); shoes, footwear, namely, boots, slippers, espadrilles, sandals sports shoes; socks, tights, collar protector; headgear, namely, hats, ear muffs, caps, headbands (clothing), berets, bonnets, hoods, visors (hats); boiler suits (combination - clothing), combination (clothing); clothing made of leather or imitation leather, namely, overcoats, jackets, trousers, dresses, skirts, tops; baby linens (clothing); Eiderdowns (duvet quilts) (collectively referred as the Wares).

[3] The application was advertised on July 13, 2011 in the *Trade-marks Journal*. Cache Inc, (the Opponent) filed a statement of opposition on September 13, 2011.

[4] The grounds of opposition raised by the Opponent are based on sections 12(1)(d), 16(3)(a), (b) and (c) and section 2 (distinctiveness) of the *Trade-marks Act* RSC 1985, c T-13 (the Act). The specific grounds of opposition are detailed in Schedule A annexed to this decision. The Applicant denied all grounds of opposition in a counterstatement filed on December 2, 2011.

[5] The Opponent filed as its evidence the affidavits of Fatima Da Ponte, Margaret Vandermeulen and Margaret Feeney. The Applicant filed the affidavit of Eleonora Eusepi and certified copies of registrations TMA535,972 for the trade-mark CACHE CREEK; TMA370,596 for the trade-mark CACHE POCKET; TMA349,959 for the trade-mark LA CACHE ; and TMA339,381 for the trade-mark LA CACHE. Both parties filed written argument and were represented at the hearing.

[6] The first issue is to determine if the Opponent has furnished sufficient evidence to support its grounds of opposition. If so, then I must decide if they are well founded.

[7] For the reasons detailed hereinafter, I conclude that the Opponent has not met its initial burden with respect to the grounds of opposition based on sections 16(3)(a) and (c) as well on section 2 (distinctiveness). I conclude that the Mark is not confusing with any of the Opponent's trade-marks subject of applications cited under its ground of opposition based on section 16(3)(b) of the Act. However I conclude that the Mark is confusing with the Opponent's registered trade-mark CACHÉ, registration TMA759,605 in so far the Overlapping wares (as defined hereinafter) are concerned.

#### Legal Onus and Burden of Proof

[8] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. This means that if a determinate conclusion cannot be reached in favour of the Applicant once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Joseph E Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA) and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

#### The Relevant Dates

[9] The following are the applicable relevant dates to the grounds of opposition pleaded:

- i) Grounds of opposition based on section 16(3) of the Act: the filing date of the application (October 16, 2009) [see section 16(3) of the Act];
- ii) Ground of opposition based on section 12(1)(d): the date of the Registrar's decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];

iii) Grounds of opposition based on lack of distinctiveness of the Mark: the filing date of the statement of opposition (September 13, 2011) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)].

### Preliminary Remark

[10] In coming to my decision I have considered all of the evidence and submissions made by the parties; however, only the portions of the evidence and submissions which are directly relevant to my findings will be discussed in the body of my decision. As an example, the evidence contained in Ms. Vandermeulen's affidavit to support any alleged use of the Opponent's trade-marks in Canada is evidence postdating any of the relevant dates, except for the registrability issue.

### Grounds of Opposition where Prior Use of the Opponent's Marks or Trade Name Needs to be Established

[11] To support its grounds of opposition based on sections 16(3)(a) and (c) as well as lack of distinctiveness of the Mark (section 2) the Opponent must establish prior use of its trade-marks or trade-name in Canada. I note that the ground of opposition based on section 16(3)(a) of the Act as pleaded does not include an allegation of 'making known in Canada' of the Opponent's trade-marks. Also, under that ground of opposition, the Opponent is relying only on its prior use in Canada of its registered trade-marks in association with the wares and services for which they are registered.

[12] The following are the Opponent's registrations and the wares and services covered by those registrations:

- CACHÉ, certificate of registration TMA759,605 in association with jewellery, purses, clutch purses, handbags and satchels;
- CACHÉ & Design, certificate of registration TMA 759,901 in association with jewellery, purses, clutch purses, handbags and satchels;

- CACHÉ ACCENTS, certificate of registration TMA 795,697 in association with retail store services featuring women's clothing and fashion clothing accessories; operation of an incentive award and loyalty program for customers (collectively referred to as the Registered Marks).

A certified copy of each of these registrations is attached to Ms. Da Ponte's affidavit, a legal assistant at the Opponent's agent firm.

[13] Ms. Vandermeulen was an articling student at the Opponent's agent firm at the time of execution of her affidavit. She attended a local newspaper store in Toronto and purchased *Vogue*, *InStyle*, *People Style Watch* and *W* magazines all dated April 2012. *InStyle*, *PeopleStyle Watch* and *W* magazines contain advertisements for CACHÉ products. However they all issued after the relevant dates applicable to the grounds of opposition based on sections 16(3)(a) and (c) ;and section 2 of the Act.

[14] As for Ms. Vandermeulen's search conducted using the Google search engine for the word 'cache', it was performed on March 29, 2012 and thus also after the relevant dates associated with those grounds of opposition.

[15] Ms. Feeney has been the Opponent's Executive Vice President and Chief Financial Officer. She provides a brief history of the Opponent that goes back to 1975 in Florida. It started as a couture boutique selling ladies clothing and accessories. In 1986 the Opponent became a mall based specialty retail chain. The Opponent grew from 29 stores in 1986 to 183 stores at the end of 1999.

[16] Ms. Feeney alleges that in 2000 the Opponent 'began to focus on developing a sportswear customer along with the special occasion customer'. She states that the Opponent is currently located in most of the best malls in the United States. At year end 2011 the Opponent operated 279 locations. I note that there is no allegation yet on Canadian business activities and/or use of any of the Opponent's registered trade-marks in Canada.

[17] Ms. Feeney refers to the Opponent's website located at <http://www.cache.com> which allows customers to search for CACHE store locations and purchase merchandise online. She

alleges that the Opponent sells and advertises on this website a wide variety of merchandise namely women's clothing and accessories such as jewellery, belts, bags, scarves and legwear. She asserts that approximately ten percent of the website visits are from international customers, including Canadians. She provides the website sales figures for the Opponent's fiscal years 2009 and 2011. However there is no allegation of a single sale through its website to a Canadian customer of merchandise bearing anyone of the Opponent's Registered Marks prior to the relevant dates. In fact she alleges that only in the beginning of the Fall 2012 the Opponent would be able to distribute its merchandise to international customers, suggesting that sales to Canadian customers were not possible via the website prior to that time.

[18] Ms. Feeney then provides the annual net sales of the Opponent for each of the fiscal years 2006 to 2010. She attached to her affidavit a copy of an article from the *New York Times* dated January 12, 2012 discussing 'the 2011 financials and remarking that in 2012 Cache will be expanding its brand internationally'. Again this article postdates the material dates associated with the grounds of opposition presently under review.

[19] Finally Ms. Feeney attached to her affidavit various advertisements published in the magazines *People StyleWatch*, *InStyle*, *W*, *Vogue* and *Latina*. They consist of 8 advertisements in total published in those magazines between November 2011 and April 2012, thus outside any of the material dates associated with the grounds of opposition under review. Finally none of these advertisements makes reference to the trade-mark CACHÉ ACCENTS.

[20] From all this evidence I conclude that the Opponent failed to establish use in Canada of any of its Registered Marks in association with any of the wares associated with these registrations prior to the filing date of the present application. Moreover there has been no evidence of use of the Opponent's trade name in Canada at any relevant time.

[21] As for the ground of opposition based on lack of distinctiveness of the Mark, the Opponent had to establish that at least one of its Registered Marks was sufficiently known in Canada at the filing date of its statement of opposition (September 21, 2011) to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)].

[22] None of the advertisements described above predates the material date. There is no evidence of sales of products bearing the trade-mark CACHÉ in Canada prior to the material date and there is no evidence of use of the trade-mark CACHÉ ACCENTS in Canada in association with any of the services covered by the certificate of registration of that mark.

[23] For all these reasons I conclude that the Opponent failed to meet its initial burden in so far as the grounds of opposition under sections 16(3)(a) and (c) and section 2 are concerned. Therefore they are all dismissed.

#### Ground of Opposition based on Section 16(b) of the Act

[24] The Opponent has filed, through the affidavit of Ms. Da Ponte a Certificate of Authenticity for the following applications:

- CACHÉ, application 1364149 for magnetic encoded credit cards and the services of promoting the sale of credit card accounts through the administration of incentive award programs; promoting the sale of goods and services of others by awarding purchase points for credit card use; credit card registration; credit card services;
- CACHÉ & Design, application 1364150 for the same wares and services covered by application 1364149;
- CACHÉ TEE'Z & Design, application 1395746 for shirts and retail clothing store services;
- CACHÉ CONTOUR COLLECTION, application 1377691 for clothing, namely tops, bottoms, jackets and dresses;
- CACHÉ CONTOUR COLLECTION & Design, application 1377690 for the same wares covered by application 1377691.

[25] I exercised the Registrar's discretion and checked the register. I confirm that all these applications were still pending at the advertisement date of the present application [see section

16(4) of the Act and *Royal Appliance Mfg Co v Iona Appliances Inc* (1990), 32 CPR (3d) 525 (TMOB)].

[26] Consequently the Opponent has met its initial burden under this ground of opposition. I must now determine if there is a likelihood of confusion between the Mark and any of the Opponent's marks covered by these applications.

[27] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks or trade-names in appearance, or sound or in the ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight but the most important factor is often the degree of resemblance between the marks [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC), *Mattel Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC)].

[28] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether a consumer who sees the Applicant's Wares bearing the Mark, would think they emanate from or sponsored by or approved by the Opponent.

[29] Under this ground of opposition I do not need to do an exhaustive analysis of the relevant criteria listed under section 6(5) of the Act. In so far as applications 1364149 (CACHÉ) and 1364150 (CACHÉ & Design) are concerned, there is no evidence of use of any of these trade-marks which could have made those marks known in Canada to some extent. I am of the opinion that the difference in the parties' wares and services, namely precious metals, horlogical instruments, jewellery, leather goods, bags, cases, clothing, footwear etc... versus credit cards and credit card services and the like, is sufficient to conclude, on the balance of probabilities,



that there is no likelihood of confusion between the Mark and the marks covered by those applications.

[30] As for applications 1395746 (CACHÉ TEE'Z), 1377691 (CACHÉ CONTOUR COLLECTION) and 1377690 (CACHÉ CONTOUR COLLECTION & Design) there is an overlap between some of the parties' wares, namely the clothing products listed in the present application. However I am of the opinion that the degree of resemblance between those marks and the Mark is the determining factor.

[31] Most of the parties' arguments with respect to this issue dealt with the difference in the meanings of the word 'cache cache' and 'cache' or 'caché'.

[32] Ms. Eusepi, a student working for the Applicant's agent, has provided us with some English and French definitions, taken from various dictionaries, for the words 'cache' and 'caché'. The *Merriam-Webster Dictionary* defines the English word 'cache' as 'a hiding place especially for concealing and preserving provisions and implements'. *Le Petit Robert* defines the word 'caché' in French as an adjective or a past participle for the action of hiding. It also defines the French word 'cache-cache' (note the presence of a hyphen) as a child game where one player must find the other players that are hidden. Finally *Le Petit Robert* defines the noun 'cache' as 'lieu secret propre à cacher, à se cacher'. I consider such definition to be similar to the definition of the word 'cache' in English.

[33] In so far as the trade-mark CACHÉ TEE'Z is concerned I am of the view that the Mark does not resemble to that mark in sound, in appearance, or in the ideas suggested. Phonetically TEE'Z is similar to "tease" and as such the trade-mark CACHÉ TEE'Z sounds different. The combination of CACHÉ and TEE'Z suggest the idea of a teasing hiding place. Finally in appearance CACHÉ TEE'Z and CACHE CACHE look different.

[34] As for the likelihood of confusion between the trade-marks CACHÉ CONTOUR COLLECTION, CACHÉ CONTOUR COLLECTION & Design and the Mark, on a balance of probabilities I do not think that there is a likelihood of confusion between them. As a whole, those marks look different, sound different and the ideas suggested by them are also different. The Opponent's marks when used in association with clothing, suggest that the articles of

clothing are part of a collection where the contour of the person wearing them would be hidden. These differences in assessing the degree of resemblance outweigh the similarities in some of the parties' wares.

[35] For all these reasons I dismiss the ground of opposition based on section 16(3)(b) of the Act.

#### Ground of Opposition based on Section 12(1)(d) of the Act

[36] Under this ground of opposition, the Opponent pleads that the Mark is not registrable because it is confusing with the Opponent's registered trade-marks.

[37] As already mentioned above, the Opponent filed a Certificate of Authenticity for each of the registrations alleged in its statement of opposition. I checked the register [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)] and they are extant. Consequently the Opponent has met its initial burden.

[38] I propose to compare the Mark to the Opponent's trade-mark CACHÉ, certificate of registration TMA759,605 as I consider this mark to be the best case scenario for the Opponent. The presence of a design feature in CACHÉ & Design, certificate of registration TMA 759,901 and the addition of the word ACCENTS in registration TMA795,697 would add to the argument that the marks do not resemble one to another. If the Opponent is not successful under this ground of opposition in assessing the likelihood of confusion between the Mark and its registered trade-mark CACHÉ, it would not succeed when doing a similar analysis using its other two registered trade-marks.

[39] The Opponent's trade-mark CACHÉ is registered in association with jewellery, purses, clutch purses, handbags and satchels.

#### *Inherent distinctiveness of the trade-marks and the extent to which they have become known*

[40] The parties' trade-marks are dictionary words as detailed above. Both marks do not have any meaning related to the parties' respective wares and services. Consequently I conclude that the degree of inherent distinctiveness is the same for each of these marks.

[41] Any mark may acquire distinctiveness through extensive use or advertisement in Canada. There is no evidence of use of the Mark in Canada in association with any of the Wares. The Opponent argues that its CACHÉ trade-mark has become known in association with the Opponent. It supports its contention by referring to the evidence of use and advertisement over 35 years; sales averaging about 250 million dollars in the years 2006-2010; Canadians have access to its website; and finally CACHÉ brand is advertised in magazines available in Canada.

[42] There is no evidence of use of the CACHÉ trade-mark in Canada in association with wares. As for the advertisement of that mark in Canada as discussed previously, the Opponent filed 5 different advertisements published in 8 issues of 5 different magazines in total, namely *People Style Watch*, *InStyle*, *Vogue*, *W* and *Latina*. I am referring to paragraphs 12 to 16 inclusive to Ms. Feeney's affidavit. The advertisements referred to in Ms. Vandermeulen's affidavit are included in Ms. Feeney's affidavit. However Ms. Vandermeulen's evidence shows that, except for *Latina*, those magazines circulate in Canada as she bought them in a Toronto store. On the other hand we have no circulation figures for any of those magazines. With respect to the Opponent's website, we have no information on the number of Canadian visitors.

[43] Overall I conclude that the Opponent's trade-mark CACHÉ is known in Canada but to a very limited extent. Consequently this factor slightly favours the Opponent but will not be a determining factor in the outcome of my decision.

*The nature of the wares, services, or business; the nature of the trade*

[44] As for the Applicant's nature of the trade, we have no evidence. I must compare the Wares as described in the application with the wares and services covered by the Opponent's registrations [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 at 10-11 (FCA); *Henkel Kommanditgesellschaft v Super Dragon* (1986), 12 CPR (3d) 110 at 112 (FCA); *Miss Universe Inc v Dale Bohna* (1994), 58 CPR (3d) 381 at 390-392 (FCA)]. However, those statements must be read with a view to determine the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the description of the wares and services [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[45] The Applicant admits at paragraph 36 of its written argument that there is an overlap in so far as jewellery, purses and handbags. I consider the overlapping wares to be:

watch bracelets; precious stones; jewellery, costume jewellery; rings (jewellery), bands (jewellery), earrings, bracelets, broaches (jewellery), necklaces, charms; ties clips, ties bars; boxes of precious metals, jewel caskets (made of precious metals), cases for jewellery of precious metals, cigarette cases made of precious metals, purses of precious metals; statues made of precious metals; goods made of these materials (leather and imitation leather) that are not included in other classes, namely: trunks, travel bags and travelling sets; bags, namely, handbags, beach-bags, shopping bags, school book bags, bags on wheels, duffel bags that are not specifically adapted to the items they are to carry, backpacks; briefcases, suitcases, attaché cases, overnight cases; wallets and purses (not made of precious materials), portfolios, pouches, purses of precious materials; card case (wallet); boxes made of leather or imitation leather; leather goods made of leather or imitation leather (except cases adapted to the items they are designed to carry, gloves and belts), namely, handbags, school book bags, wallets, purses, portfolios, pouches, suitcases, attaché cases, overnight cases, travel toiletry cases; leather or imitation leather lanyards; straps made of leather or imitation leather or leather board, namely, shoulder bag straps, handbags straps, luggage straps; (the Overlapping wares)

[46] Thus this factor favours the Opponent in so far the Overlapping wares are concerned. I am fully aware that registration TMA795,697 for the trade-mark CACHÉ ACCENTS covers retail store services featuring women's clothing and fashion clothing accessories but, as mentioned before, the Mark as a whole does not resemble CACHÉ ACCENTS. Thus there would be no likelihood of confusion between CACHE CACHE and CACHÉ ACCENTS despite some overlap between the Applicant's clothing and the Opponent's retail store services featuring women's clothing.

[47] I agree with the Opponent that it is reasonable to assume that given their nature, the Overlapping wares are likely to be sold in similar channels of trade of those used by the Opponent. However, the Applicant argues that the Opponent's wares are sold in the United States in its own retail stores.

[48] There is no restriction in the Canadian registration limiting the sale of the Opponent's wares to its own retail stores. They could very well be sold in third party retail stores and so could it be for the Wares [see *CD Services Inc v Dominion Fittings Manufacturing Ltd* (1989), 22 CPR (3d) 433 (TMOB)]. This factor also favours the Opponent.

*The degree of resemblance*

[49] As stated earlier, in its judgment in *Masterpiece* the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks. The appropriate test is not a side by side comparison but the imperfect recollection in the mind of a Canadian consumer of the Opponent's marks.

[50] At the hearing the Applicant quoted the following extract in *Mattel, supra* to argue that the appropriate average Canadian consumer would be a bilingual person:

58. A consumer does not of course approach every purchasing decision with the same attention, or lack of it. When buying a car or a refrigerator, more care will naturally be taken than when buying a doll or a mid-priced meal: *General Motors Corp. v. Bellows*, [1949] S.C.R. 678 (S.C.C.). In the case of buying ordinary run-of-the-mill consumer wares and services, this mythical consumer, though of average intelligence, is generally running behind schedule and has more money to spend than time to pay a lot of attention to details. In appropriate markets, such a person is assumed to be functionally bilingual: *Four Seasons Hotels Ltd. v. Réseau de télévision Quatre Saisons Inc./Four Seasons Television Network Inc.* (1992), 43 C.P.R. (3d) 139 (T.M. Opp. Bd.). To those mythical consumers, the existence of trade-marks or brands make shopping decisions faster and easier. The law recognizes that at the time the new trade-mark catches their eye, they will have only a general and not very precise recollection of the earlier trade-mark, famous though it may be or, as stated in *Pepsi-Cola Co. v. Coca-Cola Co.*, [1942] 2 D.L.R. 657 (Canada P.C.), "as it would be remembered by persons possessed of an average memory with its usual imperfections" (p. 661). The standard is not that of people "who never notice anything" but of persons who take no more than "ordinary care to observe that which is staring them in the face": *Coombe v. Mendit Ltd.* (1913), 30 R.P.C. 709 (Eng. Ch. Div.), at 717. However, if ordinary casual consumers somewhat in a hurry are likely to be deceived about the origin of the wares or services, then the statutory test is met. (my underlines)

[51] The quoted paragraph was a synopsis of what could be the average Canadian consumer. I do not think that it was the intention of the Supreme Court of Canada to modify the applicable test under the degree of resemblance between two trade-marks. The Registrar in *Four Seasons Hotel Ltd.* applied what used to be the test at that time (in 1992), namely the average bilingual Canadian consumer. However in 2001 that test was the subject of a detailed analysis by the Federal Court in *Smithkline Beecham Corporation v Pierre Fabre Médicament*, (2001) 11 CPR (4th) 1(FCTD). The Court made the following analysis:

10. With respect, I think the *Registrar*, in *Les Vins La Salle Inc.*, misread what Joyal and Strayer JJ. were saying. They were simply observing that in the Canadian linguistic context the perception of the Francophone consumers warranted just as much attention as that of the Anglophone consumers, and once there was a reasonable probability of confusion among *either* of them, the mark could not be registered. Both judges added, in an effort to adequately cover all the bases in light of the special features of the cases before them, that neither the average French-speaking consumer nor the average English-speaking consumer might be confused but the average bilingual consumer might be, in which case this risk of confusion sufficed by itself to rule out the registration. Nowhere was there any suggestion of a test that would consider only the perception of the average bilingual consumer as opposed to the perceptions of the average French-speaking and English-speaking consumers.  
(...)

13. The approach adopted by the Court is easily comprehensible. French and English are of equal value in Canada. The *Trade-marks* Act applies throughout Canada. Section 6 states that confusion may result from the use of a trade-mark in only one area of Canada. Paragraph 12(1)(b) provides that a trade-mark is not registrable if it is "either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services ...". A trade-mark may be used anywhere in Canada (see, for example, section 16) and its registration, according to section 19, gives the owner "the exclusive right to the use throughout Canada of the trade-mark", subject to the cited exceptions.

14. It follows that once there is a risk of confusion in either of the country's two official languages, a trade-mark cannot be registered. The particular problem with which Joyal and Strayer JJ. were confronted was the possibility that a trade-mark that does not create any confusion in a Francophone or in an Anglophone might create confusion in a bilingual person through the use of usual, distinct words in French and in English but, to someone who knew what it meant in both languages, referring to the same reality. For example, in *Les Produits Freddy Inc.*, the word "noixelle" might mean nothing to an English-speaking person, and the word "nutella" might be meaningless to a French-speaking person, but it was not excluded that the use of either of these words would confuse a bilingual person who knew the meaning in both languages. It was solely to guard against this possibility that the test was extended to the average bilingual consumer.

[52] There is no indication in *Mattel* that the Supreme Court intended to go back to the single test of the average bilingual Canadian consumer. In fact the Court used the qualifying terms 'In appropriate markets'. Therefore I shall use the three prong test as outlined in *Pierre Fabre Médicament* that has been applied since then by the Registrar. In any event the Applicant has not elaborated on the concept of 'appropriate market' and why I should infer that the Wares would be sold in an appropriate market that justifies the use of the Canadian bilingual consumer test.

[53] According to the definitions cited above, the Mark may have a different meaning than ‘CACHÉ’ to a Francophone or a bilingual person but to a unilingual Anglophone I have no evidence that he would know the specific meaning of the French word ‘cache-cache’. For that person, the Mark is simply the repetition of the word ‘cache’.

[54] Visually even though the marks may look different in that the Opponent’s trade-mark has an accent on the vowel ‘e’ at the end and that the Mark is technically composed of two words (as in French the word cache-cache is written with a hyphen), I still believe that there is some visual resemblance.

[55] Phonetically, I am aware that a Francophone or a bilingual person would pronounce differently the words ‘cache’ and ‘caché’ but I have no evidence that such conclusion would also apply to a unilingual Anglophone. Therefore the Applicant failed to establish that the degree of resemblance of the marks in sound would be a factor in its favour.

[56] As for the ideas suggested by the parties’ trade-marks, they both suggest the idea of hiding or hidden, no matter if we look at them in a French or English perspective. I do not consider being a significant factor the fact that the Mark has a specific meaning in French when the words ‘cache cache’ are separate by a hyphen. I assume that a unilingual Anglophone would not know the definition of the word ‘cache-cache’.

[57] Overall I conclude that this factor favours the Opponent.

*Additional surrounding circumstances*

[58] The Applicant filed certificates of authenticity for the registered trade-marks CACHE CREEK, CACHE POCKET, LA CACHE and LA CACHE. At the hearing the Opponent drew my attention to the fact that the trade-mark CACHE CREEK has since been expunged. I checked the register, using my discretion, and confirm such fact. Therefore there are only 3 registrations on the register owned by two different entities which contain the word ‘cache’.

[59] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences

about the state of the marketplace can only be drawn from state of the register evidence where large number of relevant registrations are located [see *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)]. The number of relevant citations does not enable me to infer that consumers are accustomed to see the term ‘cache’ as part of trade-marks in association with either clothing, handbags or jewellery such that they can distinguish them.

### *Conclusion*

[60] I conclude, with respect to section 12(1)(d) ground of opposition, that the Applicant has not discharged its burden to prove, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent’s registered trade-mark CACHÉ, certificate of registration TMA759,605 in so far the Overlapping wares are concerned.

[61] I reach this conclusion based on the fact that the Overlapping wares overlap the wares covered by that registration. Also the Mark does resemble the CACHÉ trade-mark both visually and in the ideas suggested by them.

[62] Consequently the ground of opposition based on section 12(1)(d) is maintained in part for the Overlapping wares in so far as registration TMA759,605 for the trade-mark CACHÉ is concerned.

### Disposition

[63] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition in so far as the following wares are concerned:

precious metals and their alloys except for dental use; horological and chronometric instruments, namely, clocks, watches, watch cases, alarm clocks; leather and imitation of leather; boxes designed to carry toiletries such as vanity cases, toiletry (vanity) cases, garment carriers (for travel), travel toiletry cases; key cases (leather goods); mobile phone case (leather goods); eyeglass cases (leather goods); umbrellas, parasols and canes; whips and saddlery; animal collars made of leather or imitation leather; animal clothes; leashes; muzzle; animal hides; clothing, namely; overcoats, parkas, furs, gabardine, waistcoat, raincoats, cardigans, coats, jackets, pea jackets, suits, body suits, trousers, dresses, skirts, jumper, smocks, t-shirts, shirts, short-sleeved shirt, pullovers, sweaters, tank tops, crop tops, singlets, jerseys, pyjamas, dressing gowns; underwear, undergarments, undershirts, slippers (underwear), underpants, boxer shorts, bra, petticoats; sportswear, biker shorts, bath caps, bathing-trunks, swimsuits, swimming costumes;



bath-robos, bathing sandals, bathing shoes; belts (clothing), suspenders, scarves, mittens, muffs, gloves (clothing); shoes, footwear, namely, boots, slippers, espadrilles, sandals sports shoes; socks, tights, collar protector; headgear, namely, hats, ear muffs, caps, headbands (clothing), berets, bonnets, hoods, visors (hats); boiler suits (combination - clothing), combination (clothing); clothing made of leather or imitation leather, namely, overcoats, jackets, trousers, dresses, skirts, tops; baby linens (clothing); Eiderdowns (duvet quilts)

but refuse the application for:

watch bracelets; precious stones; jewellery, costume jewellery; rings (jewellery), bands (jewellery), earrings, bracelets, broaches (jewellery), necklaces, charms; ties clips, ties bars; boxes of precious metals, jewel caskets (made of precious metals), cases for jewellery of precious metals, cigarette cases made of precious metals, purses of precious metals; statues made of precious metals; goods made of these materials (leather and imitation leather) that are not included in other classes, namely: trunks, travel bags and travelling sets; bags, namely, handbags, beach-bags, shopping bags, school book bags, bags on wheels, duffel bags that are not specifically adapted to the items they are to carry, backpacks; briefcases, suitcases, attaché cases, overnight cases; wallets and purses (not made of precious materials), portfolios, pouches, purses of precious materials; card case (wallet); boxes made of leather or imitation leather; leather goods made of leather or imitation leather (except cases adapted to the items they are designed to carry, gloves and belts), namely, handbags, school book bags, wallets, purses, portfolios, pouches, suitcases, attaché cases, overnight cases, travel toiletry cases; leather or imitation leather lanyards; straps made of leather or imitation leather or leather board, namely, shoulder bag straps, handbags straps, luggage straps.

pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

## Schedule A

The grounds of opposition now pleaded can be summarized as follow:

1. The Mark is not registrable in view of section 12(1)(d) of the Act since the Mark is confusing with the Opponent's registered trade-marks;
  - CACHÉ, certificate of registration TMA759,605 owned by the Opponent in association with jewellery, purses, clutch purses, handbags and satchels;
  - CACHÉ & Design, certificate of registration TMA 759,901 owned by the Opponent in association with jewellery, purses, clutch purses, handbags and satchels;
  - CACHÉ ACCENTS, certificate of registration TMA 795,697 owned by the Opponent in association with retail store services featuring women's clothing and fashion clothing accessories; operation of an incentive award and loyalty program for customers.
2. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(a) of the Act in that at the filing date of the application the Mark was confusing with the Opponent's registered trade-marks mentioned above that had been previously used in Canada in association with the wares and services for which they are registered;
3. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(b) of the Act in that at the filing date of the application the Mark was confusing with the Opponent's trade-marks herein listed:

CACHÉ, application 1364149

CACHÉ & Design, application 1364150

CACHÉ TEE'Z & Design, application 1395746

CACHÉ CONTOUR COLLECTION, application 1377691

CACHÉ CONTOUR COLLECTION & Design, application 1377690

for which applications had been previously filed;

4. The Applicant is not the person entitled to the registration of the Mark pursuant to section 16(3)(c) of the Act in that the Mark was confusing with the Opponent's trade-name Cache, Inc. which had been previously used in Canada;
5. Pursuant to section 38(2)(d) of the Act, the Mark is not distinctive of the wares or services of the Applicant since the Mark does not actually distinguish and is not adapted to distinguish the wares in association with which it is proposed to be used by the Applicant in Canada from the wares or services of the Opponent;