



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

Citation: 2011 TMOB 122
Date of Decision: 2011-07-18

**IN THE MATTER OF AN
OPPOSITION by Ozone
Community Corporation to
application No. 1,269,487 for the
trade-mark GLAMOUR in the
name of Advance Magazine
Publishing Inc.**

FILE RECORD

[1] On August 15, 2005, Advance Magazine Publishing Inc. filed an application to register the trade-mark GLAMOUR, based on proposed use in Canada, in association with a wide range of services in the fields of television broadcasting, telecommunications and various related ancillary services. The application was subsequently amended to specify the services as follows:

providing information directed to women about fashion, beauty, style and culture, distributed over television, satellite, audio, video, and global computer networks and providing a wide range of information by means of global computer networks and wireless media.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 26, 2006 and was opposed by Ozone Community Corporation on February 26, 2008. The lengthy time delay between advertisement and

opposition is explained by the opponent obtaining, with the consent of the applicant, several extensions of time to submit its statement of opposition.

[3] The Registrar forwarded a copy of the statement of opposition to the applicant on March 27, 2008, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponent's evidence consists of a certified copy of its trade-mark registration for GLAMOUR & Design. The applicant's evidence consists of the affidavit of Elenita Anastacio, a trade-marks searcher. Neither party submitted a written argument. Only the applicant attended at an oral hearing held on May 26, 2011.

STATEMENT OF OPPOSITION

[5] The first ground of opposition, pursuant to s.30(i) of the *Trade-marks Act*, alleges that the applicant could not have been satisfied as to its entitlement to use the applied for mark in Canada.

[6] The second ground, pursuant to s.12(1)(d) of the *Act*, alleges that the applied for mark GLAMOUR is not registrable because it is confusing with the opponent's registered mark GLAMOUR & Design (see paragraph 11, below) used in association with clothing and related wares as specified in the registration (see paragraph 12, below).

[7] The third ground and fourth ground allege that the applicant is not entitled to register the applied for mark, pursuant to s.16(3)(a) and s.16(3)(b), because it is confusing with the opponent's marks HYSTERIC GLAMOUR (application No. 1,133,904) and GALMOUR & Design, previously applied for and used in Canada by the opponent.

[8] The fifth and final ground, pursuant to s.2 and s.38(2)(d), alleges that the applied for mark is not adapted to distinguish the services of the applicant from the wares of the opponent.

OPPONENT'S EVIDENCE

Application No. 1,133,904

[9] The opponent has not evidenced its application No. 1,133,904 for the mark HYSTERIC GLAMOUR relied on in the statement of opposition. However, I have exercised my discretion to inspect the trade-mark register to confirm the existence of the mark: see *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990), 32 C.P.R.(3d) 525 at 529 (TMOB). In doing so I have noted that the application for HYSTERIC GLAMOUR is based on use and registration in the United States, for the wares shown below, and claims a Canadian priority filing date of January 28, 2002:

(1) necklaces; notebooks and binders; leather tote bags, wallets, waist packs, fanny packs, tote bags, waist packs and fanny packs made of canvas, denim, nylon or vinyl; beverage glassware; hankchiefs; clothing - namely, tops, tank tops, shirts, t-shirts, sweatshirts, cardigans, sweaters, jackets, coats, vests, bottoms, pants, trousers, jeans, sweatpants, leggings, shorts, skorts, rompers, jumpsuits, overalls, skirts, dresses, jumpers, leotards, tights, underwear, sleepwear, sleep shirts, pajamas, robes, nightgowns, shoes, boots, sandals, slippers, slipper socks, socks, hosiery, bandannas, neckerchieves, mufflers, caps and hats, head bands, gloves, belts; cigarette lighters (not of precious metals), (2) optical glasses, records, blank video disk, blank video tape, wet suits, swimming float, slide film, fire extinguisher; furniture namely chairs, mirrors, picture frames; buttons, pins, emblems, ribbons, braids, (3) sporting goods, namely skateboards.

[10] I also note that the application was pending as of July 26, 2006, that is, at the date of advertisement of the applied for mark in the *Trade-marks Journal*.

Registration No.TMA 656,337

[11] The opponent's registered mark GLAMOUR & Design is illustrated below:



It may not be clear from the above illustration that the word HYSTERIC appears in vertical alignment in the vertical left portion of the letter G, above. The opponent's mark is formally designated as HYSTERIC GLAMOUR & Design, however, given the diminutive size and minimal visibility of the component HYSTERIC, I will refer to the opponent's registration merely as GLAMOUR & Design.

[12] The opponent's registration for the mark GLAMOUR & Design is based on use and registration of the mark in the United States of America, in association with the following wares:

- (1) men's, women's, and children's clothing, namely shirts, t-shirts, blouses, pants, shorts, jackets, dresses, suits, halters and skirts, tops, tank tops, sweatshirts, cardigans, sweaters, coats, vests, bottoms, trousers, jeans, sweatpants, leggings, skorts, rompers, jumpsuits, overalls, jumpers, leotards, tights, underwear, sleepwear, sleepshirts, pajamas, robes, nightgowns, shoes, boots, sandals, slippers, slipper socks, socks, hosiery, bandannas, neckerchieves, mufflers, caps and hats, head bands, gloves, belts.
- (2) sporting goods, namely, skateboard.
- (3) necklaces, notebooks and binders, fanny packs made of canvas, denim, nylon or vinyl, leather fanny packs, leather tote bags, leather waist packs, leather wallets, tote bags, waist packs, wallets, blanket covers, drapes, handkerchiefs, pillow cases, shower curtains, cigarette lighters not of precious metals.
- (4) blank video discs, blank video tapes, optical glasses, exposed slide film, furniture, mirrors, picture frames, clothing buttons, ornamental novelty pins for clothing, embroidered emblems, braids, hair ribbons.

[13] The application leading to the registration claimed a priority filing date of January 28, 2002. I note, however, that the application for GLAMOUR & Design was not pending as of July 26, 2006 as the mark became registered on January 11, 2006. Accordingly, the opponent cannot rely on the application for GLAMOUR & Design to support a ground of opposition alleging non-entitlement based on an earlier filed application: see s.16(4) of the *Trade-marks Act*.

APPLICANT'S EVIDENCE

Elenita Anastacio

[14] Ms. Anastacio's affidavit serves to introduce into evidence, by way of exhibits, (1) particulars of three trade-mark registrations for the mark GLAMOUR, owned by the

applicant, respectively covering (i) interactive CD-roms relating to fashion magazines and related wares, (ii) operating an Internet website which allows consumers to subscribe to consumer magazines, and (iii) providing, by various means, information directed to women about fashion and beauty, (2) various third party trade-mark registrations, presented *en liasse*, for marks comprised in whole or in part of the component GLAMOUR or GLAMOR. From my cursory review of the exhibit material, I note about 38 such registrations, standing in the names of various owners and covering a variety of wares including cosmetics and clothing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[15] The legal onus is on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. However, there is also, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

MAIN ISSUES

[16] With respect to the first ground of opposition, an allegation pursuant to s.30(i) applies if fraud is alleged on the part of the applicant or if specific federal statutory provisions prevent the registration of the mark applied for: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221. In the instant case the pleadings do not support a s.30(i) ground of opposition, and it is therefore rejected. With respect to the fifth ground of opposition alleging non-distinctiveness, the opponent has not met its evidential burden to show any reputation for its marks in Canada, and therefore the fifth ground is also rejected.

[17] With respect to the third and fourth grounds of opposition alleging non-entitlement, I have previously mentioned that the opponent cannot rely on its application for the mark GLAMOUR & Design to support its ground of opposition pursuant to s.16(3)(b). Further, as the opponent has not evidenced use or making known of its marks in Canada, neither mark can be relied on to support the ground of opposition pursuant to s.16(3)(a).

[18] The remaining grounds allege (i) non-entitlement, pursuant to s.16(3)(b), which raises the issue of whether the applied for mark is confusing with application No. 1,133,904 for the mark HYSTERIC GLAMOUR and (ii) non-registrability, pursuant to s.12(1)(d), which raises the issue of whether the applied for mark is confusing with the opponent's registered mark GLAMOUR & Design. The material date to assess non-entitlement is the date of filing the application while the material date in respect of non-registrability is the date of my decision: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

Consideration of Confusion

[19] The legal onus on the applicant is to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Act*, shown below, between the applied for mark GLAMOUR and either of the opponent's marks HYSTERIC GLAMOUR and GLAMOUR & Design:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured . . . or performed by the same person, whether or not the wares or services are of the same general class.

Thus, s.6(2) 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 s.6(2) is whether there would be confusion that information about fashion and beauty emanating from the applicant was information being provided by, or endorsed by, the opponent.

Section 6(5) Factors

[20] Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in s.6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

[21] The applied for mark GLAMOUR possesses relatively little inherent distinctiveness as the word “glamour” is an apt laudatory term when used in association with fashion, beauty, style and culture, as underscored by the applicant’s state of the register evidence. Similarly, the opponent’s mark GLAMOUR & Design possesses relatively little inherent distinctiveness when used in association with clothing and fashion accessory items. In this regard, the design feature of the mark adds little to the inherent distinctiveness of the mark as a whole, while the word component HYSTERICAL is a barely perceived tertiary feature of the mark. The opponent’s mark HYSTERICAL GLAMOUR possesses a fair degree of inherent distinctiveness, most of which is attributable to the first component HYSTERICAL. Neither party has established any acquired distinctiveness for its marks at any material time.

[22] The length of time that the marks in issue have been in use is not a relevant factor as neither party has shown use of its marks. Based on the description of the parties’ wares and services as set out in paragraphs 1, 9 and 12 above, and in the absence of evidence to the contrary, it appears that the parties’ wares and services, businesses and the nature of their trades are substantially different. There is however some potential for overlap in the parties’ businesses in that the applicant may possibly provide information about the opponent’s clothing or other wares.

[23] There is necessarily a resemblance between the marks in issue as the applied for mark GLAMOUR in its entirety is comprised of a dominant component of the opponent’s marks. However, the overall visual differences between the marks in issue outweigh their

visual similarities and the overall differences in the ideas suggested by the marks in issue also outweigh their similarities. Possibly the highest aspect of resemblance is in the sounding of the applied for mark and the opponent's mark GLAMOUR & Design, assuming that the tertiary word component HYSTERICAL would not be acknowledged by consumers and assuming that consumers would not sound the design feature of the mark.

DISPOSITION

[24] In view of the above, and keeping in mind in particular that the marks in issue are relatively weak marks, that their differences in resemblance outweigh their similarities, that there is little overlap between the parties' wares and services and that the opponent has not established any reputation for its marks, I find that the applicant has met the legal onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the applied for mark and either of the opponent's marks at any material time.

[25] Accordingly, the opposition is rejected. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig
Member
Trade-marks Opposition Board