

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

Citation: 2015 TMOB 204
Date of Decision: 2015-11-17

IN THE MATTER OF AN OPPOSITION

JEJE Importing Inc.

Opponent

and

Glama Gals Franchising Ltd.

Applicant

**1,568,677 for Glama Gals Tween Spa.
1,568,678 for Glama Gals Tween Spa &
Design**

Applications

[1] On March 9, 2012, Glama Gals Franchising Ltd. (the Applicant) filed application Nos. 1,568,677 and 1,568,678 for the trade-marks Glama Gals Tween Spa. (the Mark) and Glama Gals Tween Spa & Design (the Design Mark) respectively. Both applications are based on the Applicant's use of the trade-marks in Canada since September 2006 with the following Goods and Services:

Cosmetics

Spa services, salon services namely, make up application services and hair styling services and event hosting services namely, birthday parties, summer camp programs and after school programs.

[2] The Design Mark is shown below.



[3] JEJE Importing Inc. (the Opponent) opposed both applications on the basis that the Applicant did not use the applied-for marks as of September 2006, that the applied-for marks are clearly descriptive or deceptively misdescriptive, are confusing with one or more registered trade-marks and are not distinctive. The Opponent did not file any evidence or written arguments in support of its oppositions. The Applicant filed an affidavit of Laura Cannone, its president, and submitted a written argument. Neither party requested a hearing.

[4] For the reasons that follow, I find that both applications should be refused as the Applicant has not shown that it had used either of the trade-marks in Canada as of the date claimed. In this regard, section 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) requires an applicant, who has used the applied-for mark in Canada, to provide the date from which it or its named predecessors have used it. In its applications for the Mark and the Design Mark, the Applicant states that it has used each of these trade-marks with the Goods and Services since September 2006. The Opponent alleges in its statement of opposition that the applications do not conform with section 30(b) of the Act since the Applicant has not used either trade-mark since this date. As Ms. Cannone's evidence is that in September 2006, the Mark and the Design Mark were owned by a "related corporation" who subsequently transferred the trade-marks to the Applicant, I do not find that the Applicant has proven that it has used its trade-marks since the date claimed and the ground of opposition based on section 30(b) is successful in each case.

Appl. No. for 1,568,677 for Glama Gals Tween Spa.

[5] The Mark was advertised for opposition purposes in the *Trade-marks Journal* dated April 10, 2013. On September 10, 2013, the Opponent filed a statement of opposition to oppose the application for the Mark. The grounds of opposition are based upon sections 30(b); 12(1)(b); 12(1)(d); and 2 of the Act. The Opponent alleges that the application should be refused since the Mark has not been used since September 2006 by the Applicant; is clearly descriptive or deceptively misdescriptive because the Goods and Services are for or inherently relate to spa products and services for glamorous girls in the tween age bracket; is confusing with the registered trade-mark GAL (registration No. TMA233,281); and is not distinctive on the basis that (i) the Mark is confusing with the Opponent's JEJE trade-mark and trade-name and (ii) that it is not adapted to distinguish the Goods and Services from those of others.

Material Dates

[6] The material dates with respect to the grounds of opposition are as follows:

- section 38(2)(a)/30 - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(b) – the filing date of the application [see *General Housewares Corp v Fiesta Barbeques Ltd* (2003), 28 CPR (4th) 60 (FC)];
- section 38(2)(b)/12(1)(d) of the Act - the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]; and
- section 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Onus

[7] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Section 30(b) Ground of Opposition

[8] Section 30(b) requires an applicant to provide the date from which it or its named predecessors have so used the trade-mark in association with each of the general classes of goods or services described in the application. The Opponent alleges in its statement of opposition that:

The Application does not conform to the requirements of s. 30(b), in that the trade-mark applied for has not been used in Canada by the Applicant in association with each of the [goods] and services described in the Application from the date claimed in the application, namely since at least as early as September 2006.

[9] An opponent's evidential burden when alleging non-compliance with section 30(b) of the Act has been characterized as a light one. Moreover, an opponent can rely on the evidence filed by the Applicant itself [see *York Barbell Holdings Ltd v ICON Health & Fitness, Inc.* (2001), 13 CPR (4th) 156 (TMOB)]. Such evidence must be clearly inconsistent with and raise serious doubts about the accuracy of the statements made by the Applicant in its application [see *Tune Masters v Mr. P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB); *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 28-38]. Further, an applicant ought to be aware that if it is unable to prove its date of first use, it may be advantageous to claim a later, provable date, rather than risk having its application refused under section 30(b) [*Guevin v Tall Dark & Handy Handyman Services Ltd* (2011), 97 CPR (4th) 444 at para 19 (TMOB)].

[10] The evidence of Ms. Cannone, the president of the Applicant, sets out that the Mark "has been in use since no later than September, 2006" and that "I was carrying on business on that date and confirm that I used the proposed trade-mark in connection therewith" (Cannone affidavit, para 2). Ms. Cannone further sets out that in September 2006 the trade-mark was owned by a "related corporation" who subsequently transferred the trade-mark to the Applicant (Cannone affidavit, para 3).

[11] Given Ms. Cannone's statement that the trade-mark was owned by a related corporation in September 2006, the Opponent has met its evidential burden since the evidence is that the

Mark was owned by another entity at the date of first use claimed in the application. I consider this to raise a serious doubt as to whether the Applicant was using the Mark as of September 2006 as claimed in the application. The Applicant's evidence is equivocal on this point and there is no documentation that has been provided showing that it has used the Mark in association with the Goods and Services since September, 2006. As such, the Applicant has not met its legal onus and this ground of opposition is successful.

Section 12(1)(b) Ground of Opposition

[12] The Opponent alleges that the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Goods and Services in that it clearly describes that they are for or inherently relate to spa products and services for glamorous girls or “glama gals” in the tween age bracket.

[13] Section 12(1)(b) of the Act states

Subject to section 13, a trademark is registrable if it is not whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin....

[14] In determining whether the trade-mark GLAMA GALS TWEEN SPA. is clearly descriptive or deceptively misdescriptive of the character or quality of the Goods and Services, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression from the point of view of the average user of the goods and services [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-28; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186; *Ontario Teachers' Pension Plan Board v Canada* (2012), 99 CPR (4th) 213 (FCA) at para 29]. The word “character” in section 12(1)(b) has been held to mean a feature, trait or characteristic of the product or service and the word “clearly” has been held to mean “easy to understand, self-evident or plain” [*Drackett Co of*

Canada Ltd v American Home Products Corp (1968), 55 CPR 29 (Ex Ct) at 34]. Finally, I note a suggestive trade-mark, or even a descriptive trade-mark is registrable.

[15] While I find that the trade-mark GLAMA GALS TWEEN SPA. is a descriptive or laudatory trade-mark which suggests a character of the Goods or Services, I do not find it to be clearly descriptive or deceptively misdescriptive. While the Mark consists of ordinary English words (with the word GLAMA being an obvious misspelling of GLAMOUR), the Mark cannot be said to be self-evident of any of the Goods or Services. The Mark does not describe something that goes to the material composition or that refers to an obvious intrinsic quality of the Applicant's goods and services. At best, the Mark evokes the idea that the applied-for goods and services will make tween girls, the target customers of the Applicant, feel or look glamorous. However, the Mark does not describe the character or quality of the cosmetics or the spa, salon or event hosting services listed in the application. The public would likely regard the meaning conveyed by the Mark to be mere puffery. As such, this ground of opposition is rejected.

Section 12(1)(d) Ground of Opposition

[16] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the registered trade-mark GAL (registration No. TMA233,281) for use in association with the following goods: Eau de cologne, soap, talcum powder, bath gel, shaving lotion.

[17] Having exercised the Registrar's discretion, I confirm that this registration is extant and the Opponent has met its initial evidentiary burden. I must now consider whether the Applicant has met the legal onus upon it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the trade-mark GAL.

[18] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[19] In applying the test for confusion, the Registrar must have regard to all of the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. The resemblance between the marks will often have the greatest effect on the confusion analysis [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

the inherent distinctiveness of the trade-marks

[20] The GAL trade-mark is highly suggestive of the likely consumer of its registered goods which may all relate to girls and women. Likewise, the Mark is highly suggestive of the Goods and Services which may make tween girls appear or feel glamorous.

length of time in use, extent known

[21] There is no evidence that either the trade-mark GAL or the Mark has been used in Canada. With respect to the trade-mark GAL, the Opponent has not filed any evidence of use of this trade-mark. With respect to the Mark, while the Applicant has filed evidence of an email chain with a client for a GLAMA GALS party which Ms. Cannone says “evidences use of the trade-mark in 2007” there is no evidence that the Mark was used in the advertising or offering of the goods or services as it does not appear in the email.

nature of the goods, services, trade and business

[22] This factor favours the Opponent as the nature of each parties’ goods and services overlaps and, in the absence of evidence showing otherwise, may target the same consumers (young women or girls).

the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[23] In considering the degree of resemblance, the Supreme Court of Canada in *Masterpiece, supra* sets out that resemblance is defined as the quality of being either like or similar (para 62) and that the approach to assessing resemblance should involve a consideration of whether there is an aspect of a trade-mark that is particularly striking or unique (para 64). In this case, there is nothing striking or unique about the word GAL given that the registered goods may conceivably be directed to girls and women.

[24] While the parties' trade-marks resemble each other to a limited extent in appearance and as sounded since the Mark incorporates the GAL trade-mark, they suggest completely different ideas. The Mark suggests products and services targeted to young girls to make them look and feel glamorous. In contrast, the trade-mark GAL suggests products for women.

surrounding circumstance: jurisprudence concerning weak trade-marks

[25] The jurisprudence on weak trade-marks supports the Applicant's position. It is well accepted that comparatively small differences will suffice to distinguish between weak marks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. explained:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...

[26] A party adopting a weak trade-mark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115-116 (SCC)]. While it is possible for the degree of distinctiveness attributed to a weak trade-mark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at para 6 (FCTD)], there is no such evidence that the trade-mark GAL has been in use in Canada.

conclusion

[27] Considering the factors in section 6(5), and taking into account that the trade-mark GAL is a weak mark and the evidence is insufficient to accord it a greater scope of protection, I conclude on a balance of probabilities that there is no reasonable likelihood of confusion between the trade-marks. Accordingly, the section 12(1)(d) ground of opposition is rejected.

Section 2 Ground of Opposition Alleging Confusion with JEJE

[28] This ground of opposition is set out below:

The trade-mark applied for is not distinctive, in that it cannot actually distinguish the [goods] and services of the Applicant in association with which it is alleged to have been used from the [importation, distribution and sale of cosmetics and other related skin care and beauty products] associated with the Opponent's JEJE trade-mark and JEJE trade-name, nor is it adapted to distinguish them.

[29] The ground of opposition alleging that the Glama Gals Tween Spa. trade-mark is not distinctive as a result of the Opponent's use of its JEJE trade-mark and trade-name is rejected because the Opponent has not met its initial burden. The Opponent has not evidenced that its trade-mark or trade-name was used or known in Canada as of the material date.

Section 2 Ground of Opposition Alleging Glama Gals Tween Spa. trade-mark is not distinctive from the Goods and Services of Others

[30] This ground of opposition is set out below:

The trade-mark applied for is not distinctive, in that it cannot actually distinguish the [goods] and services of the Applicant in association with which it is alleged to have been used from the [goods] and services of others, nor is it adapted to distinguish them.


[31] This ground of opposition does not itself set out sufficiently specific reasons in support of the Opponent's allegation that the Mark is not distinctive. However, when it is read as part of the

statement of opposition as whole, it is apparent that the Opponent is submitting that the Mark is not distinctive on two basis. The first is because it is clearly descriptive or deceptively misdescriptive; my comments concerning the section 12(1)(b) ground apply thereto. The second is that it is used by others, but that basis cannot succeed because there is no evidence before me of others using similar marks or terminology as of this ground's material date, namely September 10, 2013. As such, this ground of opposition is rejected.

Application No. 1,568,678 for Glama Gals Tween Spa & Design

[32] On September 10, 2013, the Opponent filed a statement of opposition to oppose the application for the Design Mark. With the exception of the section 12(1)(d) ground of opposition which in addition to alleging confusion with the trade-mark GAL (registration No. TMA233,281) also alleges confusion with the trade-mark G SPA & Design (registration No. TMA783,678), the issues for decision, material dates and the evidence of record are essentially the same as in the opposition to application no. 1,568,677 and the same results follow. That is the ground of opposition with respect to section 30(b) is successful for the same reasons set out with respect to application No. 1,568,677. With respect to the section 12(1)(b) and section 2 grounds of opposition, these grounds are rejected for the same reasons set out with respect to application No. 1,568,677.

[33] With respect to the section 12(1)(d) ground of opposition, the Opponent has relied on two trade-mark registrations. With respect to registration No. TMA233,281 for GAL, I find that there is no reasonable likelihood of confusion for the reasons set out with respect to application No. 1, 568,677. I will now consider whether there is a reasonable likelihood of confusion with respect to registration No. TMA783,678 the particulars of which are set out below:

| | | |
|---------------------------|---|---|
| <p>G SPA & Design</p> |  | <p>(1) Retail store services featuring hair and skin care preparations, cosmetics, cosmetic applicators, fragrances, hair accessories, hair combs and brushes, toiletry and cosmetic bags sold empty, jewelry, clothing, shoes, bags and fashion accessories; hair salon and beauty spa services.</p> |
|---------------------------|---|---|

the inherent distinctiveness of the trade-marks

[34] Letters per se are not inherently distinctive and are not entitled to a wide ambit of protection [*GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FC)]. Although the stylization of each trade-mark adds some inherent distinctiveness, overall the trade-marks are not particularly inherently distinctive in view of the fact that they primarily consist of a letter of the alphabet and descriptive words. I find that the Design Mark possesses a higher degree of inherent distinctiveness than the trade-mark G SPA & Design due to its more elaborate stylization.

length of time in use, extent known

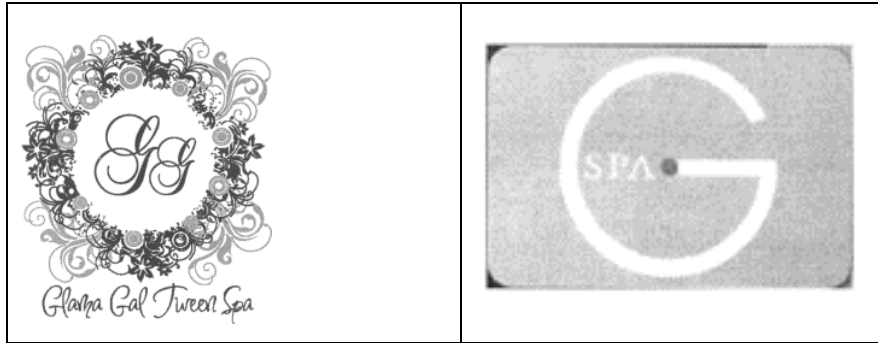
[35] There is no evidence that either the trade-mark G SPA & Design or the Design Mark has been used in Canada.

nature of the goods, services, trade and business

[36] This factor favours the Opponent as the nature of each parties' services overlaps and, in the absence of evidence showing otherwise, it is possible that the goods and services of each party target the same consumers (young women and girls).

the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them

[37] For ease of reference, I have reproduced the parties' marks below. However, I note that it is not correct to lay trade-marks side by side to compare and observe the similarities or differences between them, as the test for confusion is one of first impression and imperfect recollection.



[38] In the present case, the trade-marks of the parties do not resemble each other in appearance, as sounded or in idea suggested. The combination of the words “Glama Gals Tween Spa.” and the design features of the Design Mark including the elaborate flower design create significant differences in the appearance of the trade-marks. The words “Glama Gals Tween Spa.” and use of the repeating G also create a very different sounding trade-mark. Further, the Design Mark and the G SPA & Design trade-mark suggest different ideas. The Design Mark suggests a spa for young girls whereas the G SPA & Design trade-mark has no such connotation.

conclusion

[39] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the G SPA & Design trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, (2006), 49 CPR (4th) 401 at para 20]. I conclude that, on a balance of probabilities, there is no reasonable likelihood of confusion between the G SPA & Design trade-mark and the Design Mark given the differences between the parties’ marks

[40] As I have concluded that there is no reasonable likelihood of confusion between the Design Mark and either of the trade-marks GAL or G SPA & Design set out in the statement of opposition, the section 12(1)(d) ground of opposition is rejected.

Disposition

[41] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the applications.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

No Hearing held

Agents of Record

No Agent Appointed

For the Opponent

Garfinkle Biderman LLP

For the Applicant