



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

**Citation: 2010 TMOB 130**  
**Date of Decision: 2010-08-19**

**IN THE MATTER OF AN OPPOSITION  
by Advance Magazine Publishers, Inc. to  
application No. 1,273,185 and application  
No. 1,273,186 for the trade-mark  
G.L.A.M./GROUPE LES AILES DE LA  
MODE Design in the name of Les Ailes  
De La Mode Incorporées**

[1] On September 23, 2005, Les Ailes De La Mode Incorporées (the Applicant) filed two applications to register G.L.A.M./GROUPE LES AILES DE LA MODE Design (the Mark), which is shown below.



[2] One application was assigned serial number 1,273,185 and the other was assigned serial number 1,273,186. Both applications are based upon proposed use of the Mark in Canada. The statement of services in application No. 1,273,185 reads, “retail clothing store services; retail department store services”. The statement of wares in application No. 1,273,186 reads, “ladies’, men’s and children’s clothing, namely, suits, jackets, skirts, pants, dresses, coats, blouses, t-shirts, halter tops, tank tops, sweaters, sweater jackets, pullovers, cardigans, sweatsuits, swimwear, jeans; intimate apparel, namely, lingerie, pantyhose, hosiery, sleepwear, nightgowns, pajamas, robes, underwear, foundations, bras, camisoles; ladies’ accessories, namely, hats,

gloves, jewellery, socks, hair clips, scarves, handbags, belts; small leather goods, namely, wallets, purses, key chains, briefcases and eyeglass cases; housewares, namely, flatware, cookware, glassware, giftware and table top items, namely: dinnerware made of porcelain, fine or bone china, pottery or stoneware, coffee mugs, café au lait cups, espresso cups, beverage glassware, wine glasses, martini glasses, serving plates and platters, vegetable bowls, salad bowls, butter dishes, cream and sugar sets, sugar bowls, gravy boats, salt and pepper shakers, egg cups, ice cream dishes, onion soup bowls, pitchers, hors d'oeuvre plates, butter warmers, butter cups, tea and coffee pots, eating utensils (namely forks, knives, spoons, chop sticks, seafood forks, lobster tongs, cocktail forks, butter knives), cooking pots, stock pots, pans, skillets, roasting pans, crock pots, casserole dishes, woks, rice cookers, baking sheets, baking pans, muffin tins, pie plates and servers, quiche dishes, soufflé dishes, waffle irons, fondue sets, fondue plates, fondue forks, burners and ignition fuel in liquid or solid form for fondues, ramekins, tureens, colanders, rolling pins, cake plates and servers, milk frothers, paper towel holders, utensil holders, spoon rests, trivets, tongs, peelers, rotary cheese graters, rolling mincers, food slicers, graters, corers, zesters, pizza wheels, spaghetti measurers, cheese plates, grapefruit trimmers, lemon squeeze, pie servers, jar openers, ice cream scoops, kitchen knives, bottle openers, can openers, scissors, candy thermometers, oven thermometers, garlic presses, turners, spatulas, cooking spoons, cooking forks, ladles, spoon rests, skimmers, strainers, corkscrews, spaghetti servers, potato mashers, whisks, measuring cups, measuring spoons, spice racks, canister sets, cookie jars, bread boxes, cutlery trays, jam jars, coaster sets, cheese boards, cutting boards, carving boards, lazy Susans, condiment sets, cookbooks, cookbook holders, wine racks, kitchen clocks, napkin holders, knife blocks, banana holders, nut crackers with picks, salad sets, chip and dip sets, dish racks, fruit bowls; home furnishings, namely: furniture for the kitchen, bedroom, bathroom, living room, dining room, rec room, office and outdoors, bedding, sheets, pillow cases, duvet covers, comforter covers, bed skirts, bedspreads, afghans, decorative pillow covers, pillow shams, pillows, mattress pads, mattress covers, quilts, quilt covers, duvets, hand and bath towels, wash cloths, bath mats and window treatments”.

[3] The Applicant has disclaimed the right to the exclusive use of the word MODE apart from the Mark in both applications.

[4] Both applications were advertised for opposition purposes in the *Trade-marks Journal* of September 13, 2006.

[5] On February 13, 2007, Advance Magazine Publishers, Inc. (the Opponent) filed a statement of opposition against each application. The statements of opposition plead identical grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), namely:

- 1) s. 12(1)(d) – the Mark is not registrable in that it is confusing with the trade-mark GLAMOUR registered by the Opponent under Nos. UCA26,554, TMA531,405 and TMA576,136;
- 2) s. 16(3)(a) – the Applicant is not the person entitled to register the Mark because the Mark is confusing with the trade-mark GLAMOUR previously used in Canada by the Opponent;
- 3) s. 30(e) – at the date of application, the Applicant had no intention to use the Mark in Canada;
- 4) s. 30(i) – the Applicant could not have been satisfied of its entitlement to use the Mark at the date of application because the Applicant knew or ought to have known of the prior use, registration and notoriety of the Opponent’s trade-mark;
- 5) s. 2 – the Mark is not distinctive and is incapable of becoming distinctive because the public, upon seeing the Applicant’s Mark, would be led to believe that the wares/services originate with or were licensed or authorized by the Opponent.

[6] The Applicant filed and served a counter statement with respect to each application in which it denied the Opponent’s allegations.

[7] In support of both oppositions, the Opponent filed the same evidence, namely an affidavit of Elenita Anastacio, which simply provides details of the Opponent’s three pleaded trade-mark registrations, plus details of the Opponent’s trade-mark application No. 1,269,487. I note that allegations of use contained in an opponent’s registration are insufficient to support an opponent's evidential burden with respect to grounds of opposition based on non-entitlement or

non-distinctiveness [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[8] In support of each application, the Applicant filed a certified copy of the application.

[9] Only the Applicant filed written arguments, but both parties were represented at an oral hearing.

#### Onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

#### Section 30 Grounds

[11] I agree with the Applicant that the Opponent has not met its initial burden in support of either s. 30 ground. They are accordingly dismissed.

#### Section 16(3)(a) Grounds

[12] The Opponent has also not met its initial burden in support of its s. 16 grounds as there is no evidence of the prior use of the Opponent's GLAMOUR mark. They are accordingly dismissed.

#### Distinctiveness Grounds

[13] The Opponent has not shown that its mark was known to any extent as of the filing of the oppositions [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. Accordingly the Opponent has not met its initial burden in support of its distinctiveness grounds and they too are dismissed.

## Section 12(1)(d) Grounds

[14] The Opponent has met its initial burden with respect to its s. 12(1)(d) grounds of opposition because the pleaded trade-mark registrations are extant.

[15] The pleaded registrations cover the following wares:

- UCA26,554: a periodical magazine
- TMA531,405: interactive CD-roms relating to periodicals and magazines in the fields of fashion, beauty and entertainment; pre-recorded compact discs, namely games and catalogues of magazines in the fields of fashion, beauty and entertainment; pre-recorded audio and video cassettes, electronic publications, namely magazines and searchable computer software relating to periodicals and magazines in the fields of fashion, beauty and entertainment
- TMA576,136: online magazine and publications distributed in electronic format via the internet; operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet.

[16] 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.

[17] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

[18] The material date for assessing confusion under s. 12(1)(d) is today's date. [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]

[19] I consider the ground of opposition that is based on registration No. TMA531,405 to present the Opponent's strongest position since only that registration identifies the subject matter of the Opponent's magazines, namely fashion, beauty and entertainment. Accordingly, I will focus my discussion on that registration.

[20] The word GLAMOUR is an ordinary dictionary word that aptly relates to fashion; *Oxford Canadian Dictionary* defines "glamour" as 1. physical attractiveness, esp. when achieved by make-up, elegant clothing, etc. 2. an attractive or exciting quality, esp. one which is inaccessible to the average person. Accordingly, the Opponent's GLAMOUR mark is suggestive and inherently weak.

[21] The Applicant's Mark is not inherently strong, since the dominate portion of the Mark, the acronym G.L.A.M., can be interpreted as "glam", which is informal for glamorous [*Oxford Canadian Dictionary*]. The Opponent's agent has also directed me to definitions for "glam" from the 1989 *Oxford English Dictionary*, which include "Colloq. abbrev. of *glamorous*, *glamorize*, and *glamour*".

[22] Overall, I find that the Mark has a greater degree of inherent distinctiveness than does the Opponent's mark, due largely to its inclusion of the words GROUPE LES AILES.

[23] There is no evidence that either party's trade-mark has acquired any distinctiveness through use or promotion.

[24] The particulars of the Opponent's registration, as provided by Ms. Anastacio, indicate that a declaration of use was filed on July 5, 2000. However, in the absence of evidence of continuing use by the Opponent of its mark, the length of time the marks have been in use in Canada is not a material circumstance in this case.

[25] From the statements of wares and services, it appears that the Applicant is in the business of operating stores that sell both clothing and various wares for the home while the Opponent is in the business of selling magazines and the like concerning fashion, beauty and entertainment, in print or electronic form. Although both parties' activities are somehow related to fashion, the nature of their wares/services is intrinsically different and there is no evidence that their channels of trade overlap or are closely related.

[26] Although marks are to be considered in their entirety, the first component of a mark is often considered more important for the purpose of distinction. However, when the first component is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[27] The first portion of the Mark may be perceived as an abbreviation of the Opponent's mark. However, the remainder of the Mark makes it clear that G.L.A.M. is an acronym for **Groupe Les Ailes de la Mode**. Thus, while there is a degree of resemblance between the marks when viewed, they differ significantly both aurally and in ideas suggested.

[28] Overall, I find that there is not a reasonable likelihood of confusion between the parties' marks, due to the differences between the marks, their associated wares, services and channels of trade, and the lack of any evidence that the Opponent's suggestive mark has acquired any significant reputation. The evidence before me does not demonstrate that the Opponent's suggestive mark should be entitled to an expanded scope of protection.

### Disposition

[29] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject both oppositions pursuant to s. 38(8) of the Act.

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Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office