



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

**Citation: 2011 TMOB 261**  
**Date of Decision: 2011-12-29**

**IN THE MATTER OF AN OPPOSITION  
by Advance Magazine Publishers Inc. to  
application No. 1,264,689 for the trade-  
mark GLAMOURMOM in the name of  
Glamourmom LLC**

[1] On July 13, 2005, Glamourmom LLC (the Applicant) filed an application to register the trade-mark GLAMOURMOM (the Mark).

[2] The application is based on use of the Mark in Canada since at least as early as June 11, 2001, as well as on use and registration of the Mark in the United States of America, in association with the following wares: women's maternity and nursing garments, namely shirts and tank tops with built-in nursing bras.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 16, 2006.

[4] Advance Magazine Publishers, Inc. (the Opponent) filed a statement of opposition against the application for the Mark on January 15, 2007. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio. Ms. Anastacio was cross-examined on her affidavit and the transcript has been filed.

[6] In support of its application, the Applicant filed affidavits of Robert T. Brockbank and Michael S. Rothman. Both affiants were cross-examined and the transcripts have been filed. By letter dated July 7, 2010, the Applicant filed replies to undertakings and questions taken under advisement with respect to these cross-examinations; however these do not form part of the record as they were returned to the Applicant by letter dated September 8, 2010 as they were not filed by the Opponent in a timely manner, as required.

[7] Only the Applicant filed a written argument but both parties participated in an oral hearing.

#### Summary of Grounds of Opposition and Applicable Material Dates

[8] The grounds of opposition pleaded by the Opponent pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) are summarized below:

1. contrary to s. 12(1)(d), the Mark is not registrable because the Mark is confusing with a registered trade-mark, namely: GLAMOUR - registration No. UCA26554; GLAMOUR - registration No. TMA531,405; and GLAMOUR - registration No. TMA576,136;
2. contrary to s. 16(2)(a), the Applicant is not the person entitled to registration of the Mark because the Mark is confusing with the Opponent's GLAMOUR marks, which were used in Canada before both the date of filing of the application and the Applicant's alleged date of first use;
3. contrary to s. 2, the Mark is not distinctive and is not capable of becoming distinctive of the Applicant in view of the use and registration of the Opponent's GLAMOUR marks;
4. contrary to s. 30(i), the Applicant could not have been satisfied of its entitlement to use the Mark because the Applicant knew or ought to have known of the Opponent's use, registration and notoriety prior to its date of application;
5. contrary to s. 30(b), the Applicant has not used the Mark since the date of first use alleged or at all in Canada or the United States in association with the listed wares; in the alternative, if the Mark was in use in the U.S. or Canada, such use was by a third party and does not comply with s. 50 of the Act.

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

- s. 12(1)(d) - the date of my decision [see *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.);

- s. 16(2) – the date of filing of the application;

- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)];

- s. 30 - the date of filing of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475].

### Onus

[10] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

### Section 12(1)(d) Grounds of Opposition

[11] An opponent's initial burden is met with respect to a s. 12(1)(d) ground of opposition if the registration upon which it relies is extant at the date of my decision. Each of the pleaded registrations is currently extant and so the Opponent has met its initial burden. The Applicant must therefore establish, on a balance of probabilities, that as of today's date there is not a reasonable likelihood of confusion between the Mark and any one of the Opponent's registered GLAMOUR marks.

[12] The Opponent's registrations cover the following wares:

- UCA26554: 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.

[13] It is noted that none of the statements of wares refer to clothing. However, registration No. TMA531,405 does refer to fashion and so I consider that registered mark to present the Opponent's strongest case under s. 12(1)(d).

[14] 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.

[15] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar 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.), *Veuve Cliquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

*the inherent distinctiveness of the marks*

[16] Neither party's mark is inherently strong because they are comprised of suggestive, ordinary dictionary words.

*the extent to which each mark has become known*

[17] A mark's distinctiveness may be increased through use and promotion. Although the Opponent's registration refers to a declaration of use having been filed on July 5, 2000, I will only assume *de minimis* use of the Opponent's trade-mark in the absence of any evidence showing that the Opponent has used or promoted its mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)].

[18] The Applicant has been using the Mark in Canada since 2001 with sales in excess of \$565,000 US. The Applicant spent upwards of \$85,000 US between 2001 and 2008 promoting its GLAMOURMOM wares in Canada. The Applicant's Canadian distributor has also spent over \$20,000 CDN since 2004 promoting the GLAMOURMOM wares by attending trade shows, placing ads in print publications, and through email advertisements. In addition, there have been articles and television segments concerning the Applicant's wares.

[19] Based on the evidence before me, I conclude that the Applicant's Mark has become more known than the Opponent's mark.

*the length of time the marks have been in use*

[20] Based on the date of the declaration of use filed in support of registration No. TMA531,405, it appears that the Opponent only began using its mark about one year prior to the Applicant's first use, i.e. both marks have been in use in Canada for about a decade for their respective wares.

*the nature of the wares, services, business and trade*

[21] When considering the wares and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[22] The Applicant sells clothing through both the Internet and third party stores. The Applicant's clothing is specially designed for use by nursing mothers.

[23] The Opponent's wares all focus on magazines and periodicals. While these wares are identified as "in the fields of fashion, beauty and entertainment", there is no evidence that the Opponent itself sells any items of fashion, etc. Magazines and periodicals are very different from maternity/nursing garments. It is not clear where the Opponent's wares would be sold but it seems unlikely that they would travel the same channels of trade as the Applicant's maternity/nursing garments.

*the degree of resemblance between the marks*

[24] The Supreme Court in *Masterpiece* advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique. In the present case, each of the marks is comprised of ordinary, suggestive words. Therefore I am not sure that there is any aspect of either mark that is particularly striking or unique, but if there is one then it would have to be the word "glamour". Such a conclusion coincides with the well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.)].

[25] I acknowledge that the Applicant has incorporated the Opponent's mark in its entirety into its Mark and merely added a descriptive word "mom" thereto. This results in there being a fair degree of resemblance between the marks in appearance, sound and ideas suggested.

*other surrounding circumstances*

*i) state of the marketplace*

[26] The Applicant has introduced evidence of the state of the marketplace with respect to the word GLAMOUR through Mr. Brockbank. He evidenced that third parties have offered clothing and personal care/beauty care products for sale in Canada in association with marks that include the word GLAMOUR.

*ii) co-existence without confusion*

[27] The Applicant submits that the lack of evidence of confusion is a factor that I should consider. I agree that an adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent [see *Christian Dior S.A. v. Dion Neckwear Ltd.* 2002, 20 C.P.R. (4th) 155 (F.C.A.) at para. 19]. However, in the present case, I am not prepared to draw such an inference because the evidence does not show extensive concurrent use.

*conclusion*

[28] Having considered all of the surrounding circumstances, I find that the Applicant has established, on a balance of probabilities, that confusion is not likely between the marks. The common feature between the marks, the word “glamour”, is an ordinary dictionary word that is suggestive of a characteristic of fashion or clothing. A party ought not to be able to easily monopolize such a word. In the present case, the Opponent has provided no evidence of its use or promotion of its GLAMOUR mark; therefore, despite its registration, I can only conclude that the Opponent’s mark has not acquired any more than a *de minimis* reputation. In view of that conclusion, the Opponent’s registered mark is only entitled to a narrow scope of protection. In these circumstances, I find that the differences between the parties’ wares are sufficient to make confusion unlikely. The fact that the marks are not identical and that the Applicant’s Mark has acquired some reputation reinforces the conclusion that confusion is not likely.

[29] The s. 12(1)(d) ground is accordingly dismissed insofar as it is based on registration No. TMA531,405. In addition, as registration No. TMA531,405 presented the Opponent’s strongest case, the Opponent necessarily also does not succeed under s. 12(1)(d) based on either of the other pleaded registrations.

Remaining Grounds of Opposition

[30] The Applicant has submitted that the remainder of the grounds of opposition should be dismissed. The Opponent made no argument in support of such grounds of opposition at the oral

hearing. When asked to make submissions concerning whether or not it had met its initial burden in respect of the remaining grounds of opposition, it declined.

[31] For the reasons set out below, I am dismissing the outstanding grounds on the basis that the Opponent has not met its initial burden in respect thereof.

[32] In support of its s. 16(2) ground of opposition, the Opponent was required to show that it had used GLAMOUR in Canada prior to July 13, 2005 in order to meet its initial burden; it has not done so.

[33] In support of its distinctiveness ground of opposition, the Opponent was required to show that its GLAMOUR mark was known to some extent at least as of January 15, 2007 in order to meet its initial burden; it has not done so.

[34] I note that the allegations of use in the Opponent's trade-mark registrations are insufficient to meet the initial onus on the Opponent, under the grounds of opposition of entitlement and distinctiveness [see *Roos, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.)].

[35] The Opponent's initial burden with respect to its s. 30(b) ground of opposition can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) (F.C.T.D.) 216 at p. 230]. While it would appear that part of Ms. Anastacio's affidavit was prepared with the goal of meeting the Opponent's initial burden, on cross-examination it was made clear that Ms. Anastacio's evidence is insufficient to satisfy the Opponent's initial burden. Moreover, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claims as set forth in its application, and the Opponent has not shown this. If the Opponent has also pleaded a ground of opposition pursuant to s. 30(d), similar comments would apply.

[36] Finally, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on



the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]; there is no such evidence here.

Disposition

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

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