



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

**Citation: 2012 TMOB 17**  
**Date of Decision: 2012-01-24**

**IN THE MATTER OF AN  
OPPOSITION by Advance Magazine  
Publishers Inc. to application  
No. 1,133,904 for the trade-mark  
HYSTERIC GLAMOUR in the name  
of Ozone Community Corporation**

FILE RECORD

[1] On March 12, 2002, Ozone Community Corporation (based in Tokyo, Japan) filed an application to register the trade-mark HYSTERIC GLAMOUR for use in association with the wares listed below, based on use and registration of the mark (that is, three registrations for the same mark) in the United States of America:

- (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; hankkerchiefs; 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.

[2] Certified copies of U.S.A. Registration Nos. 2,166,995 for the wares (1), above; 2,544,655 for the wares (3), above ; and 2,788,074 for the wares (2), above, were filed in support of the subject Canadian application. The applicant claims a priority filing date of January 28, 2002 in view of its corresponding application (No. 76/363215) filed in the U.S.A on January 28, 2002 in respect of the wares denoted by (2), above. The applicant also claims the benefit of s.14 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 in respect of the wares denoted by (1), above.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 31, 2004 and was opposed by Advance Magazine Publishers, Inc. on March 28, 2006. The delay in bringing this matter forward for a more timely hearing is largely accounted for by the applicant consenting to the opponent's several requests for extensions of time to file its statement of opposition and subsequent consents by the opponent to the applicant's requests for extensions of time to file its evidence.

[4] The Registrar forwarded a copy of the statement of opposition to the applicant on April 13, 2006 as required by s.38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[5] The opponent's evidence consists of the affidavit of Elenita Anastacio. The applicant's evidence consists of the statutory declaration of Nobuo Saito and the affidavit of Katherine Guilmette. Mr. Saito and Ms. Guilmette were cross-examined on their affidavit testimony, the transcripts thereof forming part of the evidence of record. Mr. Saito's responses to undertakings and questions taken under advisement at his cross-examination were entered into evidence by the applicant pursuant to Rule 44(1) of the *Trade-marks Regulations*: see the Board ruling dated January 19, 2010. Only the applicant submitted a written argument, however, both parties attended at an oral hearing held on January 5, 2012.

[6] Shortly prior to the oral hearing, the applicant filed the list of case law it would rely on at the hearing, including an opposition case involving the parties herein. In response, the opponent filed the parties' pleadings in the aforementioned opposition case. The applicant objected for the reasons that the pleadings "did not form part of the

Applicant's[sic] evidence in the present opposition, are not jurisprudence and are not relevant to the present opposition." I agree with the applicant that the pleadings filed by the opponent are not evidence in this proceeding and I have not had regard to them.

STATEMENT OF OPPOSITION

[7] The opponent pleads that it is the owner of the following registered marks:

Trade-mark / Registration No.	Wares / Services	First Use
GLAMOUR UCA26554	a periodical magazine	December 1938
GLAMOUR TMA531405	interactive CD-roms relating to periodicals and magazines in the fields of fashion, beauty and entertainment . . .	July 2000
GLAMOUR TMA576136	online magazine and publications distributed in electronic format via the internet . . .	July 1997

[8] The opponent pleads that (1) its above listed marks have been used continuously and extensively in Canada since their dates of first use and are very well known in Canada, (2) the public, upon seeing the applicant's mark, would be led to believe that the applicant's wares originate with or were licensed by or authorized by the opponent, (3) the applicant knew or ought to have known of the opponent's use, registration and notoriety of its marks prior to filing the subject application for the mark HYSTERIC GLAMOUR, (4) the applicant has not used the applied for mark HYSTERIC GLAMOUR since the date of first use claimed or at all in the United States, and (5) the applicant did not at the time of filing the subject application have a real and effective industrial or commercial establishment in the United States.

[9] On the basis of the above assertions, the opponent alleges that:

- (i) the applied for mark is not registrable pursuant to s.12(1)(d) of the *Trade-marks Act*,
- (ii) the applicant is not entitled to register the applied for mark pursuant to s.16(2)(a) of the Act,
- (iii) the applied for mark is not distinctive of the applicant's wares,

(iv) the application is contrary to s.30.

OPPONENT'S EVIDENCE

*Elenita Anastacio*

[10] Ms. Anastacio identifies herself as a trade-marks searcher employed by the firm representing the opponent. Her affidavit serves to introduce, by way of exhibits, particulars of the opponent's trade-marks registrations, summarized in paragraph [7] above, as well as particulars for a further application filed by the opponent, No. 1,269,487 for the mark GLAMOUR. The application is based on proposed use in Canada and covers the following wares:

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.

APPLICANT'S EVIDENCE

*Nobuto Saito*

[11] Mr. Saito, of Tokyo, Japan, identifies himself as President of the applicant company. The evidence in his statutory declaration may be summarized as follows. In 1998 the applicant opened a subsidiary company in the United States under the name Hysteric Glamour USA, Inc. The applied for mark has been used in Canada in association with men's and women's clothing and accessories since shortly after filing the subject application. Attached as Exhibit B to his affidavit are invoices from 2002, 2006 and 2007 for sales of the applicant's wares under the applied for mark HYSTERIC GLAMOUR in Canada. Attached as Exhibit C to his affidavit are copies of labels and hang tags bearing the mark HYSTERIC GLAMOUR which appear on the applicant's wares. Retail sales of items sold in Canada under the applicant's mark HYSTERIC GLAMOUR totalled \$30,000 US dollars from 2002 to mid-2008. The applicant sells its wares in Canada via distributors and on-line sales.

[12] At cross-examination Mr. Saito was unable to provide any detailed information concerning the sales of the applicant's wares in Canada, which sales are apparently managed by Hysteric Glamour USA, Inc. Mr. Saito was also unable to provide any

information concerning the existence of a trade-mark licensing agreement between the applicant and Hysteric Glamour USA, Inc. However, Mr. Saito was able to confirm that Hysteric Glamour USA, Inc. is a wholly owned subsidiary of the applicant. I would add that the opponent did not put into issue whether, under United States law, use of a mark by a wholly owned subsidiary, in the absence of a trade-mark licensing agreement, inures to the benefit of the parent company.

*Katherine Guilmette*

[13] Ms. Guilmette identifies herself as a trade-mark agent employed by the firm representing the applicant. She conducted a search of the trade-marks register for marks “containing the element GLAMOUR for use in association with clothing, cosmetics and related items and accessories” and also “in respect of beauty and fashion related services.” The searched revealed 79 marks including, for example, the registered marks GLAMOUR SHOTS ( for cosmetic makeovers); GLAMOUR HOUSE (for bedsheets); GLAMOUR SECRETS (for cosmetic supplies); GLAMOUR (for ladies hosiery); GLAMOUR SHEERS (for hosiery); GLAMOUR GIRLS (for children’s wear); and GLITZ AND GLAMOUR (for sunglasses and gloves). Ms. Guilmette also located thirteen HYSTERIC GLAMOUR items, consisting mostly of clothing, for sale on the website ebay.ca.

LEGAL ONUS AND EVIDENTIAL BURDEN

[14] 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 (F.C.T.D.). 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.

#### FIRST GROUND OF OPPOSITION

[15] The first ground of opposition turns on whether the applied for mark HYSTERICAL GLAMOUR is confusing with the any of the opponent's GLAMOUR marks. The material time with respect to the first ground is the date of decision: see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.). The legal onus is therefore on the applicant to establish, on a balance of probabilities, that at the present time 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 and any of the opponent's registered GLAMOUR marks.

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 . . . sold . . . or performed by the same person, whether or not the wares or services are of the same general class.

[16] 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 of the applicant's wares sold under the mark HYSTERICAL GLAMOUR as being provided by or endorsed by the opponent.

#### *Test for Confusion*

[17] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are "all the surrounding circumstances including" those specifically mentioned in s.6(5)(a) to s.6(5)(e) 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 and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as 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.). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R.(4<sup>th</sup>) 361 (S.C.C.), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion

#### *Consideration of s.6(5) Factors*

[18] The applied for mark HYSTERICAL GLAMOUR possesses some degree of inherent distinctiveness owing mostly to the first component HYSTERICAL which term has no meaning in relation to the wares specified in the subject application. The second component GLAMOUR adds little inherent distinctiveness as it is a laudatory and/or descriptive term suggesting a high degree of attractiveness. The opponent's mark GLAMOUR possesses little inherent distinctiveness owing to its laudatory and/or descriptive meaning. Ms. Guilmette's state of the register evidence underscores the fact that the term is routinely incorporated into trade-marks to suggest the idea of attractiveness. The opponent has not established any reputation for its mark GLAMOUR at any material time while the applicant has established at least some reputation for its mark HYSTERICAL GLAMOUR by the end of the year 2006. Thus, the first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, favours the applicant to some extent.

[19] The opponent's evidence of the particulars of its trade-mark registrations indicates the date of first use of the opponent's marks but it is not evidence of any continuing use of its marks. In other words, the opponent has not evidenced any use of its marks above an inferred minimal use sufficient to have had its marks registered. On the other hand, the applicant has evidenced use of the applied for mark in Canada for the years 2002 – 2006. Thus, the second factor in s.6(5) favours the applicant to some extent.

[20] The natures of the parties' wares, services and businesses are different as the opponent is focused on publishing magazines while the applicant's focus is mainly on clothing. Thus, the third and fourth factors in s.6(5) favour the applicant.

[21] There is necessarily a resemblance between the marks in issue as the applicant has incorporated into its mark the whole of the opponent's GLAMOUR marks. However, the term GLAMOUR is a commonplace descriptive term and the first component of the applied for mark, that is, the term HYSTERICAL, serves to distinguish the applied for mark from the opponent's mark. In this regard, two principles of trade-mark law are relevant namely, (i) the first component of a mark is often considered more important for the purpose of distinction: see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.), and (ii) when marks are inherently weak, comparatively small differences will suffice to distinguish one mark from another: see *GSW Ltd. V. Great west Steel Industries Ltd.* (1975), 22 C.P.R.(2d) 154 (F.C.T.D.). Accordingly, when the marks in issue are viewed in their entireties, they are more different than they are alike. Thus, the last and most important factor in s.6(5) favours the applicant.

[22] In view of the foregoing, 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 any of the opponent's registered marks. The first ground of opposition is therefore rejected.

#### REMAINING GROUNDS OF OPPOSITION

[23] With respect to the second ground of opposition, the opponent is required to show that it had not abandoned its marks as of March 31, 2004, that is, the date of advertisement of the applied for mark: see s.17(1) of the *Trade-marks Act*. As the opponent has not established any continued use of its marks, the second ground is rejected.

[24] With respect to the third ground of opposition, the opponent is required to show at least some reputation for at least one of its marks relied on in the statement of opposition. As the opponent has not established any acquired distinctiveness for any of its marks, the third ground is rejected.

[25] With respect to the fourth ground of opposition, from the pleadings as a whole it appears that the opponent is relying on s.30(d) and s.30(i). However, as the opponent has not supported its allegation that the applicant has not used its mark in the United States,



the ground of opposition pursuant to s.30(d) fails because the opponent has not met its evidential burden to put the ground into issue. With respect to s.30(i), the opponent has not evidenced any fraud on the part of the applicant or violations of specific federal statutory provisions which prevent the registration of the applied for mark: see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 C.P.R. (3d) 221. Again, the opponent has not met its evidential burden to put the s.30(i) ground into issue.

DISPOSITION

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

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Myer Herzig  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office