



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

Citation: 2012 TMOB 79
Date of Decision: 2012-04-04

**IN THE MATTER OF AN OPPOSITION
by Advance Magazine Publishers Inc. to
application No. 1,338,305 for the trade-
mark SAFILO GLAMOUR in the name
of Safilo Società Azionaria Fabbrica
Italiana Lavorazione Occhiali SpA**

[1] On March 7, 2007, Safilo Società Azionaria Fabbrica Italiana Lavorazione Occhiali SpA (the Applicant) filed an application to register the trade-mark SAFILO GLAMOUR (the Mark).

[2] The application was based on proposed use of the Mark in Canada, as well as on use and registration of the Mark in the United States of America, in association with the following wares: eyeglasses and sunglasses; eyeglass frames, cases, hinges, temples and lenses for spectacles and sunglasses; parts and accessories thereof. It also claimed a convention priority filing date of December 8, 2006. However, on October 20, 2009 the Applicant deleted the basis of use and registration in the United States of America and on January 13, 2011, the Applicant deleted its convention priority claim. Thus, as of today's date, the application is based solely on proposed use of the Mark in Canada.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 27, 2008.

[4] Advance Magazine Publishers Inc. (the Opponent) filed a statement of opposition against the application for the Mark on January 27, 2009. 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.

[6] In support of its application, the Applicant filed an affidavit of Keith Chung and a certified copy of registration No. TMA166,314 for the trade-mark SAFILO. Mr. Chung was cross-examined and the transcript has been filed.

[7] Only the Applicant filed a written argument. 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(3)(a), the Applicant is not the person entitled to registration of the Mark because the Mark is confusing with the trade-mark GLAMOUR, which the Opponent used in Canada before both the date of filing of the application and the convention priority filing date;
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 trade-mark GLAMOUR by the Opponent;
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 use, registration and notoriety of the Opponent's GLAMOUR mark prior to the filing date of its application;
5. contrary to s. 30(e), at the date of application the Applicant had no intention to use the Mark in Canada or, alternatively, had used the Mark prior to the date of application;
6. contrary to s. 30(d) and 34(1)(b), the Applicant has not used the Mark in the United States at any time nor did it have a real and effective commercial or

industrial establishment in the United States at any time prior to the application date in Canada.

[9] In view of the amendment of the application, the last ground of opposition set out above is no longer relevant. The material dates with respect to the remaining grounds of opposition are as follows:

- s. 12(1)(d) - the date of my decision [*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(3) – 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 [*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].

Grounds to be Dismissed on the Basis that the Opponent has not Met its Initial Burden

[11] The grounds of opposition identified above as 2, 3, 4 and 5 are dismissed on the basis that the Opponent has not met its initial burden in respect thereof, as explained further below.

[12] Regarding the s. 16(3)(a) ground of opposition, the Opponent was obliged to evidence that it had used its mark prior to March 7, 2007 and had not abandoned its mark as of August 27, 2008 [s. 16(5)]. However, the Opponent has not filed evidence showing use of its mark. Moreover, reference to use in registrations owned by the Opponent are not sufficient to satisfy the Opponent's evidential burden [see *Roosx, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.)].

[13] Regarding the distinctiveness ground of opposition, the Opponent was obliged to evidence that its mark was known to some extent at least as of January 27, 2009 to negate the distinctiveness of the Mark [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. However, the Opponent did not file evidence to support such a conclusion. Once again, the Opponent's registrations are insufficient to satisfy the Opponent's evidential burden.

[14] At the oral hearing the Opponent took the position that it had met its initial onus under the entitlement and distinctiveness grounds of opposition based on findings made in *Advance Magazine Publishers Inc. v. Farleyco Marketing Inc.* (2009), 72 C.P.R. (4th) 96 (F.C.), aff'd (2009), 80 C.P.R. (4th) 324 (F.C.A.).

[15] As pointed out by the Applicant, in *Advance Magazine Publishers Inc. v. BeautyBank Inc.* (2010), 89 C.P.R. (4th) 264 (T.M.O.B.), the Opponent also sought to rely on findings made in *Farleyco*. Board Member Sprung dealt with such submissions as follows, at paragraph 12:

[12] The Opponent has not filed any evidence of use of its trade-mark at the filing date of the application; in fact the Opponent has not filed any evidence of use of its trade-mark at all. The Opponent argued that a finding of use of its trade-mark in the *Advance Magazine Publishers Inc. v. Farleyco Marketing Inc.* (2009), 72 C.P.R. (4th) 96 (F.C.) [*Advance Magazine*] (where evidence of use was filed), should apply in this proceeding. No judicial support was provided for this submission, and I do not find this a reasonable approach to take since it greatly prejudices the Applicant who has had no opportunity to respond to such evidence, nor test its veracity.

[16] I agree with Member Sprung that it would not be reasonable to allow the Opponent to rely on findings made in a different decision in which different evidence was of record.

[17] At the oral hearing, the Opponent relied on the decision in *Conde Nast Publications Inc. v. Hanz Schwarzkopf GmbH* (1988), 20 C.P.R. (3d) 176 (T.M.O.B) in support of its submission that I take into account the findings made in *Farleyco*. However, I find that case to be distinguishable and not supportive of the proposition advanced by the Opponent. In *Schwarzkopf*, Member Martin noted that on appeal of another opposition by Conde Nast Publications Inc. against a different party's trade-mark application, the Federal Court stated that the opponent's VOGUE trade-mark had acquired a secondary meaning distinctive of its publication. Mr. Martin reached a similar finding in the proceeding before him, but not based on evidence that was not

before him. Rather, Mr. Martin stated that the conclusion made by the Court applied with equal force in the proceeding before him, noting that the circulation figures for the opponent's VOGUE publication had increased in the interval since the decision by the Federal Court. In other words, there was evidence of the opponent's use of its mark before the Board which enabled Mr. Martin to make a finding similar to that made in another case. Clearly, this is not the situation at hand.

[18] Regarding the s. 30(i) ground of opposition, where an applicant has provided the statement required by s. 30(i), such a ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the required statement and there is no evidence that this is an exceptional case.

[19] Regarding the s. 30(e) ground of opposition, there is no evidence that supports the Opponent's allegation that when the Applicant filed the application it either did not intend to use the Mark in Canada or had already used the Mark in Canada.

Section 12(1)(d) Ground of Opposition

[20] Pursuant to s. 12(1)(d), the Opponent has relied upon three registrations. 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.

[21] 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.

[22] It is noted that none of the Opponent's statements of wares/services refer to eyewear. However, registration No. TMA531,405 does refer to the field of fashion and, as eyewear is arguably a fashion item, I consider that registered mark to present the Opponent's strongest case under s. 12(1)(d). I will therefore focus my discussion on that registration. If confusion is not likely with that registered mark, then it is not likely with any of the pleaded registered marks.

[23] 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.

[24] 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

[25] The Opponent's mark is not inherently strong because it consists of a suggestive/laudatory, ordinary dictionary word. The Mark is more inherently distinctive than the Opponent's mark because the Mark commences with the inherently strong, invented word SAFILO.

the extent to which each mark has become known

[26] 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.)]. As there is also no evidence that the Applicant has used or promoted the Mark, this factor does not favour either party.

the length of time the marks have been in use

[27] The particulars of the Opponent's registration 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. As stated above, at most I may infer only *de minimis* use of the Opponent's mark. (I note that similar logic would apply even if I was considering the Opponent's registration No. UCA26554 which claims a date of first use of December 30, 1938.)

the nature of the wares, services, business and trade

[28] 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.) and *Miss Universe, Inc. v. Dale Bohna* (1984), 58 C.P.R. (3d) 381 (F.C.A.)].

[29] The Opponent's wares 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, let alone any eyewear.

[30] Magazines and periodicals are very different from eyewear and there is no reason to assume that they would travel the same channels of trade. Even if they were sold in the same store, there is no basis for finding that they would be sold in close proximity to each other.

the degree of resemblance between the marks

[31] While trade-marks must be considered in their entirety, there is a 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 (F.C.T.D.) at 188] and it is possible to focus on particular features that may be a determinative influence on the public's perception [see *Pink Panther Beauty Corp. v. United Artists Corp.* (1998), 80 C.P.R. (3d) 247 (F.C.A.) at para. 34]. Thus, although the Applicant's Mark incorporates the Opponent's mark, I find that the unique word SAFILO, which dominates the Applicant's Mark, would be a determinative influence on the public's perception. As a result, there are significant differences between the marks in appearance, sound and ideas suggested.

other surrounding circumstances

[32] The Applicant has introduced evidence of the state of the register and the marketplace with respect to the word GLAMOUR through Mr. Chung. However, I do not intend to discuss that evidence any further for the simple reason that evidence of third party use of GLAMOUR would only serve to strengthen the Applicant's case and, as set out in my conclusion, I am already satisfied that the Applicant has met its legal burden.

[33] The Applicant has also evidenced that it already owns a registration for SAFILO for eyewear. However, that does not give it the automatic right to obtain any further registrations no matter how closely they may be related to the earlier registration [see *American Cyanamid Co. v. Stanley Pharmaceuticals Ltd.* (1996), 74 C.P.R. (3d) 571 (T.M.O.B.) at 576].

[34] At the oral hearing, the Opponent took the position that the Opponent owns a family of GLAMOUR marks which entitles it to a broader scope of protection. However, there is no evidence of a family before me. First of all, all of the registrations relied upon by the Opponent relate to a single mark, GLAMOUR, not to a family of marks that each comprises the common word GLAMOUR in conjunction with some other component. Furthermore, there must be evidence of use of the members of an alleged family of marks in order for the benefits of a family to apply [*MacDonald's Corporation v. Yogi Yogurt Ltd.* (1982), 66 C.P.R. (2d) 101]. The Opponent again stated that it was relying on findings made in *Farleyco* to support its claim of a family. However, for the reasons indicated above, I reject the Opponent's position that it can rely on *Farleyco* in this manner.

conclusion

[35] 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, especially where there is no evidence of acquired distinctiveness. In the present case, I find that the differences between both the parties' marks and the parties' wares/services are more than sufficient to make confusion unlikely.

[36] The s. 12(1)(d) ground is accordingly dismissed in its entirety.

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.

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