



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 039

Date of Decision: 2023-02-28

IN THE MATTER OF AN OPPOSITION

Opponent: Advance Magazine Publishers Inc.

Applicant: Pawandeep Dhunna

Application: 1,820,091 for G & G GOLD & GLAMOUR MAGAZINE

INTRODUCTION

[1] Advance Magazine Publishers Inc. (the Opponent) opposes registration of the trademark G & G GOLD & GLAMOUR MAGAZINE (the Mark) filed by Pawandeep Dhunna (the Applicant).

[2] Filed on January 26, 2017, the application claims proposed use of the Mark, in association with the following Goods and Services in Nice Classes 9, 16, 35 and 41:

Class	Goods and Services
9	(1) Downloadable electronic publications in the nature of magazines in the field of lifestyle, health and fitness, beauty, travel, leisure, fashion, decorating, entertainment and sports
16	(2) Print magazines, namely, magazines in the field of lifestyle, health and fitness, beauty, travel, leisure, fashion, decorating, entertainment and sports
35	(1) Advertising the goods and services of others; providing advertising space in periodicals and magazines
41	(2) Publication of online and print magazines

[3] The Opponent opposes the application on several grounds. The Opponent has pleaded non-compliance with section 30(2)(a) of the *Trademarks Act*, RSC 1985, c T-13 which requires that the application contain the Goods and Services in ordinary commercial terms. The remaining grounds largely turn on the determination of the likelihood of confusion between the Opponent's use and registrations for the trademarks GLAMOUR, GLAMOUR EDITOR'S CHOICE, GLAMOUR EDITOR'S PICKS and GLAMOUR ESSENTIALS and the Mark and are based on sections 12(1)(d), 16, 2 and 38(2)(f) of the Act.

THE RECORD

[4] The application was advertised on February 26, 2020. The Opponent filed its statement of opposition on July 17, 2020. The Applicant denied all of the grounds of opposition in its counter statement.

[5] In support of its opposition, the Opponent submitted certified copies of the following registrations:

Trademark
GLAMOUR

Reg'n No.:
UCA26554

GLAMOUR	TMA576136
GLAMOUR	TMA816771
GLAMOUR	TMA531405
GLAMOUR EDITOR'S CHOICE	TMA1071209
GLAMOUR EDITOR'S PICKS	TMA1046353
GLAMOUR	TMA1000092
GLAMOUR	TMA1070841
ESSENTIALS	

[6] The Applicant did not submit any evidence in support of its application. Neither party submitted written representations. The Opponent alone attended a hearing.

PRELIMINARY ISSUE: SERVICE OF THE COUNTER STATEMENT

[7] At the hearing, the Opponent submitted that it did not have a record of being served with the counter statement. On this basis, the Opponent asked that the Registrar deem the application abandoned pursuant to section 38(11) of the Act:

(11) The application is deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (7) or if, in the prescribed circumstances, the applicant does not submit and serve either evidence under subsection (8) or a statement that the applicant does not wish to submit evidence.

[8] This issue was not raised before the hearing. A review of the counter statement shows that the Applicant indicated that it had served the counter statement by email on consent. In the circumstances, where the Applicant has confirmed service, the Opponent timely filed its evidence in response, and did not raise the issue of lack of service prior to the hearing, I find that service was effected as set out in the Applicant's counter statement.

EACH PARTY'S RESPECTIVE BURDEN OR ONUS

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the 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 [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS

[10] I will now consider each of the grounds of opposition beginning with the section 12(1)(d) ground of opposition.

Section 12(1)(d) Ground of Opposition Succeeds

[11] In its statement of opposition, the Opponent alleges that the Mark is not registrable pursuant to section 12(1)(d) of the Act on the ground that it is confusing with the Opponent's registered trademarks consisting of or including GLAMOUR, the particulars of which are reproduced at Schedule "A" to this decision.

[12] The material date for considering this issue is 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)].

[13] An opponent's initial onus is met with respect to a section 12(1)(d) ground of opposition if one of the registrations relied upon by an opponent are in good standing. Having exercised the Registrar's discretion to check the register, I confirm each of the registrations relied on by the Opponent are in good standing [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[14] Since the Opponent has satisfied its initial evidential burden for this ground of opposition, the issue becomes whether the Applicant has met its legal onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's registered trademarks. The Opponent's best chance of success is its registrations for the trademark GLAMOUR under registration Nos. TMA1000092; UCA26554; TMA576136; TMA816771; and TMA531405.

[15] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or in the same Nice Class.

[16] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

[17] I will now turn to the assessment of the section 6(5) factors.

the inherent distinctiveness of the trademarks and the extent to which they have become known

[18] The inherent distinctiveness of a trademark has to be assessed in the context of the goods and services in question [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at para 35].

[19] The Mark is a combination of the letter G and the ordinary dictionary words GOLD and GLAMOUR. The definitions of GOLD and GLAMOUR from *dictionary.com* are below [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 at para 29 which provides that the Registrar can take judicial notice of dictionary definitions].

GOLD	a precious yellow metallic element, highly malleable and ductile, and not subject to oxidation or corrosion. Symbol: Au; atomic
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	<p>weight: 196.967; atomic number: 79; specific gravity: 19.3 at 20°C.</p> <p>a quantity of gold coins:...</p> <p>a monetary standard based on this metal; gold standard.</p>
GLAMOUR	<p>the quality of fascinating, alluring, or attracting, especially by a combination of charm and good looks.</p> <p>excitement, adventure, and unusual activity: the glamour of being an explorer.</p> <p>magic or enchantment; spell; witchery.</p> <p>suggestive or full of glamour; glamorous: ...</p>

[20] When considered overall, I find that the Mark possesses a limited degree of inherent distinctiveness as it suggests that the subject of the Applicant's Goods and Services are glamorous and relating to wealth and riches or target people interested in goods and services with these attributes. That being said the alliteration and G&G elements in the Mark do add a measure of inherent distinctiveness.

[21] The Opponent's trademark GLAMOUR is even less inherently distinctive than the Applicant's Mark as it is entirely suggestive of the Opponent's goods and services, as it suggests that they relate to glamour or are glamorous or target people wishing to learn about glamorous goods and services.

[22] The strength of a trademark may be increased by means of it becoming known in Canada through promotion or use. However, neither party filed any evidence of promotion or use of its trademark. While in the past the Registrar has taken judicial notice of the circulation of the GLAMOUR magazine [see, for example, *Maurices Incorporated v Dollarama LP* 2014 TMOB 129 at para 37], doing so would not allow me to determine the extent known of the trademark.

[23] Under these circumstances, this factor favours the Applicant.

the length of time the trademarks have been in use

[24] The section 6(5)(b) factor does not favour either party. There is no evidence that either party has used their trademarks. As such, I am unable to make any assessment regarding the length of time the marks have been in use within the meaning of the Act [*Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2018 FC 951 at para 37].

the nature of the goods, services, business and trade

[25] These factors favour the Opponent to a significant extent. The statement of goods and services are very similar. Given the lack of evidence, I conclude that there is potential for overlap between the parties' channels of trade.

the degree of resemblance between the trademarks

[26] When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. While it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks, it is nevertheless possible to focus on particular features that may have a determinative influence on the public's perception [*United Artists Corp v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 at 263 (FCA)].

[27] While the first portion of a mark will in some cases be the most significant when assessing a likelihood of confusion [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)], resemblance must be assessed with a consideration of whether there is an aspect of the mark that is particularly striking or unique [*Masterpiece* at para 64]. In the case of the Mark, I consider its most unique feature to be the combination of the letters G & G and GOLD & GLAMOUR.

[28] When the parties' trademarks are considered in their entirety, there is a fair degree of resemblance between them in appearance and sound given that the Mark encompasses the entirety of the Opponent's word mark GLAMOUR. Likewise, in terms of ideas suggested, I find that both the trademarks suggest glamour and richness.

Importantly, I must also consider how the marks could be presented, as explained in *Arterra Wines Canada, Inc v Diageo North America, Inc*, 2020 FC 508 at para 62

... possible future presentations of a trademark available to a registered trademark owner and an applied for trademark owner must be considered in respect of word marks: *Masterpiece*, above at paras 55-56, 85; *Cheah v McDonald's Corporation*, 2013 FC 774 at paras 3-4; *Pizzaiole*, above at para 24.

In this case, the Mark could be presented in a way that would result in an increased likelihood of confusion, in particular, if the GLAMOUR component was emphasized within it.

[29] As such, this factor favours the Opponent.

Conclusion on the likelihood of confusion

[30] The test to be applied is a matter of first impression in the mind of an average consumer somewhat in a hurry who sees the trademark G & G GOLD & GLAMOUR MAGAZINE with the Goods and Services at a time when he or she has no more than an imperfect recollection of the Opponent's trademark GLAMOUR, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve, supra* at para 20].

[31] I find that the Applicant has failed to establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's trademark GLAMOUR as of the material date (and in particular the trademark GLAMOUR registered under registration Nos. UCA26554; TMA576136; TMA816771; TMA531405; and TMA1000092). I reach this conclusion considering the significant degree of potential resemblance between the marks and the overlap in the parties' goods and services. In reaching my finding, I have also considered that only a narrow scope of protection can be attributed to the Opponent's trademark, as it is a weak mark. However, the Mark falls within this narrow scope.

[32] Accordingly, this ground of opposition is successful.

Section 16(1)(a) Ground is Rejected

[33] In its statement of opposition, the Opponent alleges that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act, on the grounds that it is confusing with the Opponent's GLAMOUR trademarks which have been previously used in Canada.

[34] The Opponent has the initial burden of proving that one or more of its trademarks were used in Canada prior to January 26, 2017, the filing date of the application, and had not been abandoned at the date of advertisement of the application for the Mark [see section 16 of the Act].

[35] Since there is no evidence of prior use of any of the Opponent's trademarks, the ground of opposition based on section 16(1)(a) of the Act is summarily rejected for the Opponent's failure to meet its initial evidential burden.

Section 2 Ground is Rejected

[36] In its statement of opposition, the Opponent alleges that the Mark is not distinctive and is incapable of becoming distinctive within the meaning of section 38(2)(d) of the Act having regard to the Opponent's GLAMOUR trademarks.

[37] The material date for assessing distinctiveness is the date of filing of the opposition, which is July 17, 2020 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185 (FCTD)].

[38] In order to meet its initial evidential burden with respect to the non-distinctiveness ground of opposition, the Opponent is required to show that at least one of its trademarks, had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[39] There is no evidence that demonstrates the extent to which any of the Opponent's trademarks has become known in Canada. Therefore, the section 2 ground is rejected for the Opponent's failure to satisfy its initial evidential burden.

Section 30(2)(a) Ground is Rejected

[40] The Opponent alleges that the application does not conform to section 30(2)(a) of the Act, as the application does not contain a statement in ordinary commercial terms of the goods and services in association with which the trademark is used or proposed to be used. This ground of opposition is rejected for the Opponent's failure to meet its evidential burden. The Opponent did not file any evidence in support of this ground of opposition, nor make any submissions.

Section 38(2)(f) Ground Succeeds

[41] Section 38(2)(f) of the Act states that a statement of opposition may be based on the following ground:

that, at the filing date of the application in Canada, determined without taking into account subsection 34(1), the applicant was not entitled to use the trademark in Canada in association with those goods or services.

[42] With respect to this ground of opposition, the Opponent has made three separate allegations:

i), ... the Applicant was well aware or is deemed to have been aware of the [Opponent's GLAMOUR registrations] previously used and registered in Canada in association with the Opponent's goods and services;

ii) The Applicant was not entitled to use the [Mark] as set out in the Application in Canada in association with the goods and services in light of the allegations set out above;

iii) The Applicant was not entitled to use the [Mark] set out in the Application in Canada in association with the goods and services listed in the application of Schedule "A" since to do so would be contrary to the passing off provisions set out in s. 7 of the Act.

[43] With respect to allegations (i) and (iii), the Opponent did not file any evidence in support of these allegations and as such it fails to meet its evidential burden as it has

provided no evidence that the Applicant was aware of the Opponent's GLAMOUR registrations or that the Opponent's trademarks have any goodwill in Canada to support the passing off claim.

[44] With respect to allegation (ii), as of the filing date, the Applicant was not entitled to use the Mark with the Goods or Services, I find that the Opponent has met its initial evidential burden as its registration Nos. UCA26554; TMA576136; TMA816771; and TMA531405 were in force at the application filing date.

[45] Registration of a trademark under the Act gives the owner the exclusive right to use the trademark throughout Canada in respect of the goods and services in the registration [Act, section 19]. This right is deemed to be infringed by the sale, distribution, or advertisement of goods or services in association with a confusing trademark [Act, section 20(1)(a)]. None of my findings with respect to the section 6(5) factors are impacted by the earlier material date, therefore, I find that the Opponent has met its initial evidential burden with respect to its allegation that the Applicant was not entitled to use the Mark as of the filing date.

[46] In the absence of submissions from the Applicant, I find therefore, that the Applicant has not met its legal onus of proving that as of the date of filing it was entitled to use the Mark and this ground of opposition succeeds.

[47] In so finding, I note that while section 38(2)(f) of the Act appears on its face to be similar to section 30(i) of the Act (as it was prior to June 17, 2019), there is a significant difference as section 30(i) (as it was) required that an applicant include in the application a statement that "he is satisfied that he is entitled to use the trademark in Canada in association with the goods or services". No such focus on whether the applicant himself is satisfied that he is entitled to use the applied-for trademark exists in section 38(2)(f) of the Act. As such, I do not find the case law that exists under (the previous) section 30(i) whereby the Registrar enquired whether it was reasonable for the applicant to be satisfied that it was so entitled [*Lifestyles Improvement Centers, LLP v. Chorney* (2007), 63 CPR (4th) 261 at para 35; *Biker Rights Organization (Ontario) Inc*

v Sarnia-Lambton Bikers Rights Organization Incorporated, 2012 TMOB 189 at para 12] to be instructive.

DISPOSITION

[48] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Opponent's Registrations

Trademark	Reg'n No.:	Goods and Services
GLAMOUR	UCA26554	(1) A periodical magazine.
GLAMOUR	TMA576136	(1) 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.
GLAMOUR	TMA816771	(1) 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.
GLAMOUR	TMA531405	(1) 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.
GLAMOUR EDITOR'S CHOICE	TMA1071209	(1) Jewelry, watches, clocks and chronometers, and parts thereof
GLAMOUR EDITOR'S PICKS	TMA1046353	(1) Sunglasses, eyeglasses, lenses for eyeglasses, eyeglasses frames, cases for eyeglasses
GLAMOUR ESSENTIALS	TMA1070841	(1) Sunglasses, eyeglasses, lenses for eyeglasses, eyeglasses frames, cases for eyeglasses (2) Jewelry, watches, clocks and chronometers, and parts thereof
GLAMOUR	TMA1000092	(1) A Periodical magazine.

		<p>(2) Online magazine and periodical 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. ...</p> <p>(1) 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.</p> <p>...</p> <p>(12) Disseminating a wide range of information all relating to fashion, health, dating, relationships, advice, beauty and entertainment by means of computer databases available via a global computer network, wireless, satellite, and other communication media; transmitting and broadcasting live action entertainment services all relating to fashion, beauty and entertainment by means of computer databases available via a global computer network, wireless broadcast, satellite, internet, CD-ROMs, electronic publications and multimedia interactive software, telephonic and cable; operating online retail services featuring clothing accessories, beauty products, fashion namely, clothing and entertainment namely, pre-recorded CDs, pre-recorded DVDs; operating interactive forums and chatrooms all relating to fashion, beauty and entertainment; computer services, namely providing fashion, health, dating, relationships, advice, beauty and entertainment information and instruction over the internet.</p> <p>(13) Operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet.</p> <p>(14) Advertising the wares and services others; placement of ads for others; creating custom promotional campaigns for others;</p>
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Appearances and Agents of Record

HEARING DATE: 2022-11-03

APPEARANCES

For the Opponent: Kenneth D McKay

For the Applicant: No one appearing

AGENTS OF RECORD

For the Opponent: Marks & Clerk

For the Applicant: Yunwei (Edmund) Xie