

Date: 20090212

Docket: T-1490-07

Citation: 2009 FC 153

Ottawa, Ontario, February 12, 2009

PRESENT: The Honourable Mr. Justice Russell

BETWEEN:

ADVANCE MAGAZINE PUBLISHERS INC.

Applicant

and

FARLEYCO MARKETING INC.

Respondent

REASONS FOR JUDGMENT AND JUDGMENT

[1] This application is an appeal of a decision of the Registrar of Trade-marks (Registrar) dated June 4, 2007 (Decision), which found that Advance Magazine Publishers Inc. (Advance) had not met the onus required by section 16(3) of the *Trademark Act*, R.S.C. 1985, c. T-13 (Act) for its opposition to the Farleyco Marketing Inc. (Farleyco) Canadian Trade-mark Application 1,199,765 for Ghoulish Glamour..

[2] Advance argues that the Registrar erred in finding:

- 1) That Advance's evidence at the opposition level was insufficient to demonstrate that it was entitled to a broad scope of protection for its GLAMOUR mark;

- 2) That Advance's GLAMOUR mark and Farleyco's subject mark are not confusing;
- 3) That Advance's evidence at the opposition level was not sufficient to meet its onus under paragraph 16(3)(a) of the Act;
- 4) That Advance had not met its onus to establish that Farleyco's mark was not distinctive; and
- 5) That Advance had not filed sufficient evidence to meet its onus under subsection 30(i) of the Act.

BACKGROUND

[3] On December 16, 2003, Farleyco filed an application to register the trade-mark GHOULISH GLAMOUR based upon the proposed use set forth in Application no. 1,119,765. Farleyco was the applicant in the Opposition from which this appeal arises. The wares contained in the application were "Halloween cosmetics and eyelash accessories".

[4] Advance was the opponent in the Opposition of Application no. 1,119,765 for GHOULISH GLAMOUR on July 12, 2004 based on its longstanding trade-marks for GLAMOUR which is registered for use in association with a periodical magazine and a variety of related print and electronic wares and services.

[5] Farleyco filed a Counterstatement to Advance's Statement of Opposition, and Advance filed the Affidavit of Elenita Anastacio to support its claim of use and registration of the GLAMOUR mark.

[6] GHOULISH GLAMOUR has been used in the sale of strip false eyelashes by Farleyco which have been principally sold for Halloween and costume wear since September 2004. They are sold in drug, food and mass merchandize outlets. There have been no instances of confusion of GHOULISH GLAMOUR eyelashes and GLAMOUR magazine that have been reported. Farleyco claims it uses the word GLAMOUR as a descriptive term on other products to indicate the style of the product.

[7] Mr. Reiken, an investigator hired by Farleyco, spent about 10 hours and visited two malls and one other store in Toronto and located 31 "Glamour" products in the field of cosmetics, lingerie, jewellery, children's wear, computer games, music, books and toys.

[8] There are also approximately 22 certified registrations and applications by third parties for trade marks consisting of and/or incorporating the word "Glamour" on the Trade Mark Register in Canada for wares and services in various fields, including cosmetics, fashion and beauty.

DECISION UNDER APPEAL

[9] The Trade-marks Opposition Board rejected Advance's Opposition and provided the following summary:

Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the marks is unlikely. This is primarily because of the inherent weakness of the Opponent's mark and the difference between the parties' marks, wares and channels of trade. The Opponent's evidence falls far short of demonstrating that its GLAMOUR trade-mark is entitled to a scope of protection that is broad enough to render the Applicant's Mark unregistrable.

ISSUES

[10] Advance raises the following issues in this appeal:

- 1) Has Farleyco, the trade-mark applicant, met its legal burden or onus in this opposition, namely to prove to the Court that there is no reasonable likelihood of confusion between Farleyco's trade-mark GHOULISH GLAMOUR and Advance's trade-mark GLAMOUR?
- 2) Is the evidence filed by Advance sufficient to demonstrate that it was entitled to the broad protection of a well-known and famous trade-mark?
- 3) Is Farleyco entitled to the registration of the trade-mark GHOULISH GLAMOUR in association with Halloween cosmetics and eyelashes?

STANDARD OF REVIEW

[11] Advance submits that subsection 56(5) of the Act provides that, on appeal under subsection 56(1) of the Act, evidence in addition to that adduced before the Registrar may be filed with the Federal Court and the Federal Court may exercise any discretion vested in the Registrar.

[12] Advance says that when new evidence is submitted, the Court should, where the evidence is substantial, proceed by way of a fresh hearing on the extended record: *Phillip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 17 C.P.R. (3d) 289 (F.C.A.); *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 at paragraph 35; *Garbo Group Inc. v. Harriet Brown & Co.* (1999), 3 C.P.R. (4th) 224 (F.C.T.D.) at paragraph 24; *Maison Cousin (1980) Inc. v. Cousins Submarines Inc.* (2006), 60 C.P.R. (4th) 369 (F.C.A.) at paragraph 7.

[13] Advance also submits that it has submitted substantive new evidence dealing with the findings of the Registrar and the Court is not obliged to defer to the Opposition Board Decision. The Court must decide the issues for itself. Advance points out that Farleyco has also filed additional evidence for this appeal.

[14] Advance submits that the additional evidence filed is the affidavit of Ms. Susan Goodall, Executive Managing Editor of GLAMOUR magazine, which was sworn on November 2, 2007. Advance says that this evidence significantly and substantially goes beyond the evidence that was before the Registrar and demonstrates that the Court should decide the issues before it on the new record without deference to the Hearing Officer at the Opposition Board.

[15] Farleyco submits that a Trade-mark Opposition Board's decision is subject to a standard of reasonableness on appeal unless there is significant new evidence before the Court that would have materially affected the Opposition Board's decision: *Mattel* at paragraph 37.

[16] Farleyco argues that Advance's additional evidence filed in this appeal would not have materially affected the Board's finding that there was no likelihood of confusion between the marks GLAMOUR and GHOULISH GLAMOUR. Farleyco also says that, to avoid the reasonableness standard, Advance's additional evidence would have to show that the GLAMOUR mark was not inherently weak, or that it has acquired extensive distinctiveness, and that the parties' marks, wares and channels of trade are not different. Advance's additional evidence would also have to show that its GLAMOUR mark was so well-known in Canada that it renders Farleyco's GHOULISH GLAMOUR mark unregistrable.

[17] Farleyco concludes that Advance's additional evidence would not have materially affected the Opposition Board's findings that Advance's GLAMOUR mark is inherently weak, that both marks are different in appearance, and in the sound and ideas suggested, and that the parties' wares are different and are sold in different channels of trade. Therefore, the Court should only overturn the Board's Decision if it is found to be unreasonable.

[18] In the alternative, Farleyco submits that if the Court accepts that Advance's additional evidence would have materially affected the Board's finding in respect to confusion, then the applicable standard of review is correctness. Farleyco submits that the Board's Decision was correct because there is no likelihood of confusion between the GLAMOUR and GHOULISH GLAMOUR marks.

ARGUMENTS

Advance

Evidence Presented

[19] Advance says that Ms. Goodall's evidence is as follows:

- 1) GLAMOUR magazine has been distributed continuously in Canada for 70 years since 1938, and is available in over 200 countries, including Canada and the United States;
- 2) Although initially only used in the publishing business, the GLAMOUR mark has been used in association with all of the following wares and services:
 1. A periodical magazine;
 2. 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;
 3. Online magazines and publications distributed in electronic format via the internet and operating an internet website which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet; and

4. 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.
- 3) GLAMOUR is a monthly magazine and has also been available online since July of 1997. The print version is by subscription and on newsstands and the average yearly circulation is in excess of 2, 000,000 in the United States and 80,000 in Canada;
- 4) Particular excerpts from the Goodall Affidavit show representative magazine and online content over the years. In particular, GLAMOUR magazine and its online equivalent regularly feature articles, columns and advertisements that relate to fashion, cosmetics, make-up, beauty tips, etc.;
- 5) Advance filed its typical Halloween content in GLAMOUR magazine;
- 6) A web capture from GLAMOUR's website shows some typical Halloween promotions in association with the GLAMOUR mark and, in particular, shows that Advance has used the designation GHOULISH GLAMOUR;
- 7) The evidence also shows the ways in which Advance promotes its magazine and related wares in Canada other than through subscriptions or newsstand displays. In particular, Advance conducts TOP TEN COLLEGE WOMEN competitions at over 50 universities from coast to coast across Canada;

- 8) Promotional dollars spent on advertising the GLAMOUR magazine and the GLAMOUR mark in association with its related products and services have been in excess of \$10,000,000 from 1997 to date;
- 9) The popularity of Advance's online services in association with the GLAMOUR mark is shown by the number of Canadians who visit www.glamour.com. With regard to the online version of GLAMOUR, Canadians view over 400,000 pages monthly and have done so since July 1997;
- 10) The GLAMOUR website allows advertisers, particularly cosmetics and make-up companies, to promote their goods. Ms. Goodall opines, based on her experience in the industry, that advertisers participate in the GLAMOUR website because it is seen as an excellent vehicle for the promotion of their products; and
- 11) Annual revenues of Advance associated with its GLAMOUR products and services are well in excess of \$100,000,000 for the period of 1997 to 2007. Canada represents approximately 10 percent of that number in terms of revenue.

[20] Advance submits that Farleyco's evidence, particularly the affidavit of Mr. Edward Reiken sworn November 30, 2007, is of limited value since it reflects a two-day shopping spree conducted on November 12 and 13, 2007. There is no evidence as to how long the products Mr. Reiken located have been in the marketplace or whether they were recently put into commerce or otherwise.

[21] Advance also submits that the affidavit of Ms. Patricia Farley-Pope sworn December 3, 2007 and filed by Farleyco is also of limited probative value for the following reasons:

- 1) Ms. Patricia Farley-Pope was not “sworn” before she signed the Affidavit;
- 2) While the affidavit attests to the use of the GHOULISH GLAMOUR mark, the sales are relatively recent, minimal and seasonal;
- 3) The reference to the existing trade-mark registrations and applications of third parties contains little or no evidence as to any use or promotion of the marks referred to or where use occurred. There is no temporal context to give the evidence any probative value.

[22] Advance also points out that the following admissions were made on cross-examination by Mr. Reiken:

- 1) He was not aware of Farleyco’s GHOULISH GLAMOUR product and did not locate it in his searches;
- 2) He was aware of Advance’s GLAMOUR magazine on magazine racks and his awareness could be for 5-10 years;
- 3) His perception of GLAMOUR magazine was that it related to “fashion, clothing and cosmetics”;
- 4) The magazines are sold and are visible in grocery and food stores, drug stores, Costco’s at the checkouts and on racks. Cosmetics products are also available in these stores;
- 5) In the Farley-Pope affidavit, 22 Canadian trade-mark applications and registrations were listed which include the word GLAMOUR. The list was put to Mr. Reiken and he admitted that he had been unable to find one of them in his 10-12 hours of

searching. He even inquired of store clerks and none of the products could be found;
and

- 6) Mr. Reiken was not aware of how long the products he located on the website or products he found and attached to his affidavit had been in existence or in the marketplace.

[23] Advance also points out that Ms. Farley-Pope made the following admissions:

- 1) She had not been asked to confirm the truth of her affidavit before she signed it;
- 2) That eyelashes are a cosmetic accessory;
- 3) She has seen Advance's GLAMOUR magazine in stores she has visited, which stores also sell Farleyco's GHOULISH GLAMOUR product;
- 4) Advertising and promotion sells cosmetic products and she is familiar with cosmetic advertising in various magazines;
- 5) She has seen Advance's GLAMOUR magazine "for as long as it has been around";
- 6) Magazines and cosmetics are sold in the same stores;
- 7) Farleyco's sales numbers in her affidavit and Exhibit D were not compiled by her. (Advance submits that they are hearsay);
- 8) No written directions or memoranda have been sent out to retailers inquiring as to consumer confusion between Advance's and Farleyco's trade-marks.

Confusion

[24] Advance submits that the Registrar erred in determining that Farleyco's GHOULISH GLAMOUR mark was not confusing with Advance's GLAMOUR marks, particularly in view of the new evidence contained in the Goodall Affidavit and the admissions obtained from Farleyco's witnesses.

[25] Advance says that the question of confusion is a matter of first impression and imperfect recollection as to whether a consumer, knowing of Advance's GLAMOUR marks would, upon seeing the GHOULISH GLAMOUR mark, believe the products come from the same source. Advance points to section 6(2) of the Act for the definition of confusion.

[26] Advance also says that the wares in relation to which Farleyco's GHOULISH GLAMOUR are used, are related to, if not overlapping with, those of Advance's GLAMOUR mark and they are sold through the same channels of trade.

[27] Advance maintains that, when applying the test for confusion, the Court must have regard to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act, namely: the inherent distinctiveness of the trade-marks or trade-names in question and the extent to which they have become known; the length of time each trade-mark has been in use; the nature of the wares, services or businesses; the nature of the trade; the degree of resemblance

between the trade-marks or trade-name in appearance or sound or in the ideas suggested by them. The Courts have determined that these enumerated factors need not be attributed the same weight.

Inherent Distinctiveness of the Trade-marks/Extent to Which Each Trade-mark has Become Known

[28] Advance submits that the Registrar's position was to the effect that no evidence had been filed to enable her to conclude that either party's mark had become known to any significant extent. The Registrar also found that both parties' marks were "suggestive" and that the strength of those marks could be increased through evidence of use and promotion.

[29] Advance points out that legal authors and the Court have made it clear that acquired distinctiveness through use and promotion can warrant a wide scope of protection, even for suggestive or inherently weak marks: Gill, Kelly and R. Scott Joliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed., (Toronto: Carswell, 2002-2007) at section 8.2 (c), pages 8-30 and 8-31.

[30] Advance also cites and relies upon *Bohna v. Miss Universe, Inc.* (1994), 58 C.P.R. (3d) 381 at 389-390 (F.C.A.) at paragraphs 17 and 18:

17 It may have been said, thirty years ago, that there was nothing remarkably distinctive about the word "Miss" or the word "Universe" or the expression "Miss Universe". But as time went by and as the use and promotion of the two words linked together as one expression were reaching global proportion, the expression acquired, to use the very words of the Trial Judge, a "considerable distinctiveness". The name is now a well-known and reputable name.

18 In these circumstances, one would have expected the Trial Judge to examine the facts of this case on the assumption that the appellant's trade mark was to be accorded a particularly wide scope of protection and that the burden imposed on the respondent to dispel any likelihood of confusion was particularly difficult to overcome, even more so in the area of beauty pageants. This, in my view, he has failed to do. His reasons, which I have reproduced earlier, show no such concern. He seems to have ignored the fact that the respondent was a newcomer entering a field already extensively occupied by the appellant and borrowing in so doing the whole of a name already well-established in that very field by the appellant.

[31] Advance maintains that even "clearly descriptive" marks can become very well known through use and promotion. Advance cites and relies upon *Molson Breweries v. Schenley Canada Inc.* (1991), 36 C.P.R. (3d) 543 (T.M.O.B.) (Molson):

8. ...the opponent's trade-mark GOLDEN is clearly descriptive of brewed alcoholic beverages: see the decision in *John Labatt Ltd. v. Molson Cos. Ltd.* (1987), 19 C.P.R. (3d) 88 (F.C.A.). The applicant's mark GOLDEN COOLER is inherently weak since COOLER is the name of the wares and GOLDEN is arguably descriptive of the color of the wares.

9. Since the applicant filed no evidence, I must conclude that its mark had not become known at all in Canada as of the material time. The opponent, on the other hand, has evidenced long and extensive use of its trade-mark GOLDEN in combination with its house mark MOLSON or MOLSON's for brewed alcoholic beverages. In his affidavit, Mr. Moran attests to sales by the opponent of beer bearing labels featuring the mark GOLDEN in excess of \$700 million for the period 1970 to 1986. Advertising expenditures for that same period were greater than \$24 million. Thus, as of the filing of the present application, the opponent's trade-mark GOLDEN had become very well known in Canada.

...

11. ...In view of my conclusions above, and particularly in view of the similarities in the wares, trades and marks of the parties and the extent to which the opponent's mark has become known, I find that the applicant has failed to satisfy the legal burden on it

to show that there is no reasonable likelihood of confusion between its mark GOLDEN COOLER and the opponent's mark GOLDEN...

[32] Advance says that the Goodall Affidavit establishes that Advance's GLAMOUR magazine is well-known, if not famous, as a result of extensive promotion and use in Canada and around the world since the late 1930s. Advance has used the GLAMOUR mark in association with magazines in Canada and the United States since as early as 1938. Advance's magazine and related wares are also available in over 200 countries around the world. In addition, the Goodall affidavit indicates that Advance's GLAMOUR magazine has acquired a significant reputation over almost 70 years of distribution in Canada and that the average yearly circulation is in excess of 2 million copies in the U.S. and in excess of 80,000 copies in Canada per monthly issue. While GHOULISH GLAMOUR is seasonal and has been sold to a certain extent in some geographical regions in Canada since 2004, Mr. Reiken did not know of Farleyco's GHOULISH GLAMOUR mark; nor did he find it in his investigations on the internet or in stores. Advance submits that this factor favours Advance and establishes that its GLAMOUR mark is well-known, which makes it difficult for Farleyco to meet the burden of dispelling any likelihood of confusion.

Length of Time

[33] On this issue Advance submits that the Registrar concluded there was no evidence to the effect that Advance had continuously used its GLAMOUR mark in Canada. The new evidence contained in the Goodall Affidavit, however, establishes substantial and continuous use of GLAMOUR in Canada since as early as December 1938, and continuously to the present. Advance

points out that GLAMOUR magazine has been available on-line continuously since at least July 1997. Sales of GLAMOUR online reflect that Canadians have accessed over 400,000 pages per month in each year since 1997. GHOULISH GLAMOUR, on the other hand, only commenced in Canada in September 2004 and is principally marketed in August, September and October leading up to Halloween. Advance says this factor is clearly in its favour.

Nature of the Wares, Services or Businesses and the Nature of the Trade

[34] Advance submits that while it is clear that a finding of confusion is not dependent on the wares and services in issue not being in the same general class of goods or services, the closer the relationship, the harder it is for Farleyco to meet its burden of establishing that there is no likelihood of confusion: section 6(2) of the Act.

[35] Advance says that the Goodall Affidavit establishes the nature of GLAMOUR magazine and other products distributed by Advance and bearing the trade-mark GLAMOUR. It is “a monthly magazine, devoted to fashion, beauty, entertainment, health and lifestyle which necessarily includes beauty products including cosmetics and make-up and tips and advice related to beauty products.” As well, GLAMOUR “regularly included articles, features and advertisements relating to fashion, cosmetics, make-up, beauty, entertainment, health and lifestyle... .”

[36] Advance takes the position that, while it can be argued that the wares of the respective parties are different, they do belong to the same general class of goods, namely cosmetic, fashion

and beauty. Ms. Farley-Pope admitted that the wares associated with GHOULISH GLAMOUR are a cosmetic accessory and that both parties' products are sold in the same channels of trade at the retail level.

[37] Advance also submits that the Registrar erred when she considered that Halloween cosmetics are less likely to relate to fashion and beauty. There was no evidence upon which to base such an opinion. The Registrar ignored the cosmetic industry. The Goodall affidavit establishes a cross-over and that the trend in cosmetics is that younger lines of makeup increasingly include Halloween products in their mainstream displays year-round.

[38] Advance concludes on this issue by stating that the type of products sold by Farleyco could be featured in Advance's GLAMOUR publication or online magazine. If this were to occur, it is likely that the public would conclude that the use of GHOULISH GLAMOUR by Farleyco has been approved or authorized by Advance, or that there is some kind of business connection between the parties. Advance submits that this factor favours Advance.

Degree of Resemblance Between the Trade-marks in Appearance or Sound or in the Ideas Suggested by Them

[39] Advance points out that the Registrar recognized the fact that Farleyco "has appropriated the Opponent's mark in its entirety and merely inserted a word in front of it." However, the Registrar concluded: "Overall, I find that when considering the two marks as a whole, the degree of resemblance between them is not great in appearance, sound or idea suggested."

[40] Advance says that in reaching this conclusion the Registrar thought the word “GHOULISH” in Farleyco’s mark did not significantly diminish its resemblance with Advance’s mark, especially when the longstanding use of the mark GLAMOUR by Advance, the breadth of the wares and services of Advance which are sold or provided in association with the GLAMOUR mark, and the extent of revenues, advertising, website units and so forth are taken into account. Advance has, throughout its GLAMOUR website, used GHOULISH GLAMOUR along with its GLAMOUR mark.

[41] With use over almost 70 years and the acquired distinctiveness of Advance’s GLAMOUR mark, Advance says it is entitled to a broad scope of protection and this should render Farleyco’s GHOULISH GLAMOUR mark non-registrable in association with Halloween cosmetics and eyelashes.

State of the Register and the Marketplace

[42] Advance says that copies or certified copies of the registrations or applications filed are required in evidence: *Molson* as cited in *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1985), 7 C.P.R. (3d) 520 at paragraph 6. This was not done in the present case. As well, in order to allow for inferences by the Court as to the state of the marketplace, there must be a large number of relevant registrations located: *Perks Coffee Ltd. v. Blue Tree Hotels Investment (Canada), Ltd.* (2006), 51 C.P.R. (4th) 462 (T.M.O.B.) at paragraph 25 and *UFO Contemporary Inc. v. The Polo/Lauren Company, L.P.* (2007), 60 C.P.R. (4th) 262 (T.M.O.B.) at paragraph 34.

[43] Advance says that Farleyco's evidence regarding the state of the Trade-mark Register should be given little weight, if any, as it does not show evidence of use of the registered marks in the marketplace. Mr. Reiken could not locate any of the registrants listed in the State of the Register search in the marketplace: *Del Monte Corp. v Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.) at paragraph 10; Gill, Kelly and R. Scott Joliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed., (Toronto: Carswell, 2002-2007) at section 8.7(k), page 8-76.11; *Conde Nast Publications Inc. v. Hanz Schwarzkopf GmbH* (1988), 20 C.P.R. (3d) 176 (T.M.O.B.); *Kellogg and Advance Magazine Publishers Inc. v. Masco Building Products Corp.* (1999), 86 C.P.R. (3d) 207 (F.C.T.D.).

[44] Advance points out that in assessing the likelihood for confusion, the Registrar considered the GLAMOUR mark in combination with registrations and applications owned by third parties and submitted by Farleyco. The Registrar did not consider whether these third-party GLAMOUR registrations were sufficient to provide any indication as to the state of the marketplace. Farleyco made little or no effort to improve upon that evidence and an adverse inference should be taken of this fact.

[45] Advance points out that Farleyco's evidence disclosed the existence of a few GLAMOUR registrations and applications; however, it did not show that GLAMOUR is commonly used in the marketplace in association with wares related to cosmetics, fashion and beauty. The existence of these registrations and applications without any actual evidence of use is not sufficient to make any conclusive determination as to the state of the marketplace.

[46] Advance reminds the Court that the legal onus on Farleyco with respect to confusion is such that it has to prove that the absence of confusion is more probable than its existence when considering the specific criteria under subsection 6(5) and the surrounding circumstances. Advance says that Farleyco's evidence falls short of demonstrating an absence of confusion with Advance's GLAMOUR mark, or that there is no likelihood of confusion.

[47] Advance submits that if a definitive conclusion cannot be reached by the Court after reviewing the evidence and the law, then this issue must be decided against Farleyco. Farleyco's mark should be refused as the evidence submitted by Farleyco fails to establish that there is no likelihood of confusion between Advance's GLAMOUR mark and Farleyco's GHOULISH GLAMOUR mark.

Ordinary Dictionary Word

[48] Advance points out that the Registrar indicated that Advance's mark "consists solely of the ordinary dictionary word 'glamour,' which is highly suggestive of the subject matter of [Advance's] magazines." The Registrar ignored the other wares and services of Advance which carry the GLAMOUR mark. However, whether the word "glamour" is or is not commonly used in the English language, it is not sufficient to restrict Advance's registered rights. Advance cites and relies upon *Frank T. Ross & Sons (1962) Ltd. v. de Leeuw (1997)*, 77 C.P.R. (3d) 51 (T.M.O.B.):

14 The applicant has argued that as an additional surrounding circumstance I should consider the fact that the word "nature" is a common word in the English language and as such should not be monopolized by anyone. However, the fact that the word may or may

not be commonly used in the English language is not enough to convince me to restrict the opponent's rights. Once a mark is registered it gives the owner the exclusive right to use it in association with the designated wares and services (section 19 of the Act). The only question which the applicant can raise in its defence in a trade-mark opposition is whether the word has come to be commonly used by others in association with similar wares, which is shown by evidence of the state of the register or the state of the marketplace. If the applicant can show that it is so commonly used, then the presumption is that people are used to seeing marks of this sort for wares of this sort and therefore small differences between the marks will serve to distinguish them...

Initial Evidentiary Burden on Advance

[49] The Registrar also considered whether Advance had met its initial evidentiary onus with respect to the grounds of opposition. In order to meet this initial evidentiary burden with respect to section 16(3)(a) of the Act, there must be evidence that Advance used its GLAMOUR mark in Canada prior to the date of Farleyco's application of December 16, 2003.

[50] In view of the new, substantial evidence contained in the Goodall affidavit and exhibits filed by Advance on appeal, which provide evidence of continuous and substantial use and promotion of the GLAMOUR mark since at least as early as December 1938, Advance says that it has more than met its initial evidentiary burden.

[51] Advance says that in order to meet its initial evidentiary burden with respect to distinctiveness, it has to demonstrate that, as of the date of the opposition, its mark had become sufficiently known in Canada to negate the distinctiveness of Farleyco's mark. As a result of the

significant new evidence filed on appeal, Advance submits that it has met its initial evidentiary burden by showing that its registered trade-mark GLAMOUR, at the time of the filing of the Statement of Opposition, had become well-known, if not famous, in Canada, the United States and in several countries around the world.

[52] With respect to subsection 30(i) of the Act, Advance submits that the significant new evidence submitted on appeal shows that Advance's mark had become well-known, if not famous, in Canada in association with magazines which provide information in the fields of fashion, beauty, makeup and cosmetics prior to the filing date of Farleyco's application. Specifically, both Mr. Reiken and Ms. Farley-Pope freely admitted knowledge of Advance's GLAMOUR mark prior to the application date. Farleyco could not have been satisfied that it was entitled to the registration for the mark applied for. Hence, its application was filed contrary to subsection 30(i) of the Act.

Farleyco

[53] Farleyco submits that **GLAMOUR** and **GLAMOR** are descriptive words widely used in the cosmetic and cosmetic accessory industry to describe an attribute of a product which is "an alluring charm or beauty" or a "magic spell or influence."

Statutory Test for Confusion

[54] Farleyco says that, pursuant to section 6(2) of the Act, trade-marks are confusing when the use of both marks in the same area would be likely to lead to the inference that the wares or services associated with those marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are from the same general class: *Mattel* at paragraph 51.

[55] Section 6(5) of the Act contains a list of factors that must be considered when making a determination as to whether trade-marks are confusing. The list is not exhaustive and the factors can be given different weights depending on the context. Additional surrounding circumstances relevant to confusion include the state of the register and marketplace, as well as the absence of evidence of confusion despite the co-existence of the trade-marks in the same geographical area: *Kellogg Salada Canada Inc. c. Canada (Registrar of Trade Marks)* (1992), 43 C.P.R. (3d) 349 at 358-360 (F.C.A.) and *Mattel* at paragraphs 54-55 and 89.

[56] Farleyco points out that Advance bears an initial evidential burden of proving the allegations of fact used to support each ground of opposition, and Farleyco bears the burden of proving, on a balance of probabilities, there is no likelihood of confusion and that its GHOULISH GLAMOUR mark is registerable.

Applying Statutory Test to the Facts of this Case

Inherent Distinctiveness

[57] Farleyco submits that the Opposition Board found that neither GLAMOUR or GHOULISH GLAMOUR was inherently strong, as both marks are suggestive of the associated wares. Marks that are descriptive or that are everyday expressions should not receive the same level of protection as invented or non-descriptive marks. The mark GLAMOUR, in Farleyco's view, is inherently weak because it is highly suggestive of the subject matter of Advance's monthly magazine, particularly as regards topics of fashion, beauty, health and lifestyle. These are all elements that promote a perception of "an alluring charm or beauty."

[58] Farleyco acknowledges that descriptive marks may, depending on the circumstances, acquire distinctiveness through continuous use in the marketplace. To establish acquired distinctiveness, a trade-mark owner must show that the consumer recognizes the mark and associates it with the owner's wares: *Mattel* at paragraph 75 and *Garbo Group Inc. v. Harriet Brown & Co.* (1999), 3 C.P.R. (4th) 224 at 239 (F.C.T.D.). Farleyco points out that the Goodall Affidavit falls short of establishing that the GLAMOUR mark is famous or even well-known, particularly not outside the limited field of monthly periodicals. Farleyco cites and relies upon *Garbo Group* at page 239:

The appellant introduced as evidence of acquired distinctiveness a statement of the expenses that it had incurred for advertising and promotion over the period between 1984 and 1998. However, there was no direct evidence that consumers recognized the mark GARBO and associated it with the wares sold by the appellant.

[59] Farleyco also cites and relies upon paragraph 30 in *Mattel*:

No doubt some famous brands possess protean power (it was submitted, for example, the distinctive red and white “*Virgin*” trade-mark has now been used in connection with such a diversity of wares and services that it knows virtually no bounds), but other famous marks are clearly product specific. “*Apple*” is said to be a well-known trade-mark associated in separate markets simultaneously with computers, a record label and automobile glass. The Board’s conclusion that BARBIE’s fame is limited to dolls and dolls’ accessories does not at all mean that BARBIE’s aura cannot transcend those products, but whether it is likely to do so or not in the context of opposition proceedings in relation to restaurant, catering and banquet services is a question of fact that depends on “all the surrounding circumstances” (s. 6(5))...

[60] Farleyco submits that the Goodall Affidavit shows Advance’s GLAMOUR mark, if known at all, is only known as the name of a magazine that contains information related to fashion, beauty, entertainment, health and lifestyles. Advance has not provided evidence of the use of its mark in association with any other wares, nor any history or pattern of licensing the mark for use in other fields. As well, Advance has not provided any evidence that would suggest that it is commonplace practice for magazine names to be licensed for use as product trade-marks.

[61] Farleyco submits that Advance’s argument of acquired distinctiveness ignores the impact of numerous other users of the mark GLAMOUR in connection with fashion, beauty, entertainment and lifestyle wares. There are many other registered and unregistered GLAMOUR trade-marks for wares in the fields to which Advance claims to have exclusive rights.

[62] Farleyco says that it is well established in trade-mark law that a trader who uses a mark that consists of, or incorporates, an element that is common to the trade and which is highly descriptive

(as is the word GLAMOUR) cannot expect a wide degree of protection: *Molson Cos. v. John Labatt Ltd.* (1994), 58 C.P.R. (3d) 527 at 529 (F.C.A.) and *MonSport Inc. v. Vêtements de Sport Bonnie (1978) Ltée.* (1988), 22 C.P.R. (3d) 356 (F.C.T.D.). Farleyco reminds the Court that trade-mark rights are based on use, and cites and relies upon paragraph 83 of *Mattel*:

The point, I think, is that the law of trade-marks is based on use. In an earlier era it was not possible to register a “proposed” use. Here, expansion of the BARBIE mark is more than just speculation, but if the BARBIE mark is not famous for anything but dolls and doll accessories in the area where both marks are used and there is no evidence that BARBIE’s licensees, whoever they may be, are in the marketplace using the BARBIE mark for “restaurant services, take-out services, catering and banquet services”, it is difficult to see the basis on which the mistaken inference is likely to be drawn.

[63] Farleyco concludes on this point that the scope of protection afforded to Advance’s mark should not be extended beyond the wares for which the mark is actually registered and used in Canada, namely magazines.

Length of Time Marks in Use

[64] Farleyco submits that the length of time a trade-mark has been in use is only important in considering whether a mark has really and truly become distinctive: *Mattel* at paragraph 77. Advance claims to have distributed magazines in Canada since as early as 1938, but the Goodall affidavit only provides numerical figures for distribution and advertising from as early as 1996.

Nature of Wares and Nature of the Trade

[65] On this issue, Farleyco submits that, pursuant to section 6(2) of the Act, trade-marks are confusing when the use of both marks in the same area would be likely to lead to the inference that the wares or services associated with those marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are from the same general class: *The Conde Nast Publications Inc. v. C-T-L Uniforms Ltd.* (1978), 40 C.P.R. (2d) 142 at 143-144 (T.M.O.B.).

[66] Farleyco cites and relies upon *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, [2006] 1 S.C.R. 824 at paragraph 33:

While the halo effect or aura of the VEUVE CLICQUOT mark is not necessarily restricted to champagne and related promotional items and *could* expand more broadly into the luxury goods market, no witness suggested the mark would be associated by ordinary consumers with mid-priced women's clothing. Thus, in considering all of the relevant circumstances, the trial judge was of the opinion "that the key factor is the significant difference between the plaintiff's wares and those of the defendants" and that "[t]he plaintiff's activities and those of the defendants are so different that there is no risk of confusion in consumers' minds" (para. 76). In weighing up the s. 6(5) factors, this was an emphasis she was entitled to place in this particular case. Section 6(2) recognizes that the ordinary somewhat-hurried consumer may be misled into drawing the mistaken inference "whether or not the wares or services are of the same general class", but it is still a question for the court as to whether in all the circumstances such consumers are *likely* to do so in a particular case.

[67] Farleyco submits that consumers are unlikely to be misled into drawing the inference that its GHOULISH GLAMOUR Halloween cosmetics and eyelashes are manufactured, sold, leased or

hired by Advance, and Advance's evidence does not illustrate otherwise. Advance has mischaracterized, or overstated, Ms. Goodall's testimony. Her affidavit and exhibits do not evidence any "trend" in younger lines of makeup, including Halloween products, in Advance's mainstream display.

[68] Farleyco points to the following four different issues of Advance's magazine where the word Halloween has been used:

- 1) The first reference is the statement "Hey, its OK to ask him to wear the French maid costume for Halloween if he loves it so much." This statement is not made in connection with any article or promotion for Halloween costumes or cosmetics;
- 2) The second reference is a caption to five photos of people making faces at a camera, "Glamour Snapshot: It's Halloween. Make your scariest face!" Again, the photos and caption are not made in connection with any article or promotion for Halloween costumes or cosmetics;
- 3) The third reference is an article about how Halloween is one of the most common holidays during which couples break up. This article does not discuss or promote any Halloween costumes or cosmetics;
- 4) The final reference is also a caption for various photos of celebrities: "In honour of Halloween, Glamour declares that all Dont's are Dos for one day, so let's hear it for Tammy Fay's tattooed on makeup look!" Again, contrary to Advance's submission, these photos and caption do not promote any brand or brands of Halloween costumes or cosmetics.

[69] Farleyco notes that the reference to the term “GHOULISH Glamour” in Exhibit D of Goodall Affidavit is a print-out of a UK-based web page advertising Halloween-themed necklaces. The necklaces are advertised in UK currency and there is no indication they are available to Canadian purchasers through Advance or its website. As well, Farleyco points out that Advance has not provided any evidence of the date of the page, or that any Canadians have ever viewed the page. The web page appears to use “GhoulisH Glamour” as a descriptive phrase to identify a third party’s Halloween-themed necklace.

[70] Farleyco takes the position that Exhibit D to the Goodall Affidavit is completely irrelevant to the issues in this Opposition, except to the extent that the phrase “ghoulisH yet stylish” actually supports the Opposition Board’s finding that Farleyco’s mark is an oxymoron and, therefore, distinguishable from Advance’s mark.

[71] Farleyco further submits that Halloween cosmetics and eyelashes and magazines are purchased and used for very different reasons. Farleyco’s Halloween cosmetics and eyelashes are accessories purchased for use as part of a costume. Advance’s magazine is purchased and read for the information contained therein. Farleyco’s cosmetics and eyelashes are seasonal items and sold in retail stores only in the weeks leading up to Halloween, while Advance’s magazine is distributed on a monthly basis, by mail to subscribers and at newsstands for non-subscribers.

[72] Farleyco says that although its Halloween eyelashes and Advance’s magazine may have been sold in some of the same grocery and drug stores, they are consistently physically situated in

different sections of those stores. Farleyco's eyelashes are always displayed in the cosmetics or seasonal Halloween aisles and Advance's magazine, if sold in any of these stores, is displayed on the magazine rack in a different aisle.

[73] Farleyco's wares are advertised in store flyers and at point-of sale on display boards. Its Halloween eyelashes are not advertised on television or in magazines. Advance's magazines are not advertised in store flyers. Due to these differences, Farleyco submits that it is difficult to see how consumers could mistakenly infer that these wares originate from the same source.

Degree of Resemblance between Marks

[74] Farleyco points out that the Registrar found the degree of resemblance between the marks GLAMOUR and GHOULISH GLAMOUR "is not great in appearance, sound or ideas suggested." The Registrar's finding on this factor was based on a consideration of the overall appearance, sound and ideas suggested by the marks, as well as the law that the first word or syllable of a mark is the most important portion: *Conde Nast Publications Inc. v. Union des éditions modernes* (1979), 46 C.P.R. (2d) 183 at 188 (F.C.T.D.). For this reason, any additional evidence attempting to show that Advance's mark has acquired distinctiveness would not have materially affected the Board's findings regarding the lack of resemblance between the trade-marks.

[75] Farleyco concludes that the Board's finding that the degree of resemblance between the marks "is not great in appearance, sound or ideas suggested" is not only reasonable, it is correct.

State of Trade-marks Register and Marketplace

[76] Farleyco's position on this issue is that the presence of a common element in trade-marks has an important bearing on the issue of confusion. Therefore, the state of the register and of the marketplace in respect of common elements are additional circumstances to be considered when determining whether trade-marks are confusing or distinctive: *Kellogg Salada* at pages 358-360; *Kellogg* citing *Pepsi-Cola Co. of Canada v. Coca-Cola Co. of Canada*, [1940] S.C.R. 17; *Advance Magazine Publishers Inc. v. 412233 Ontario Ltd.* (2002), 24 C.P.R. (4th) 96 at paragraphs 104-105 (T.M.O.B.); *Telus Corp. v. Orange Personal Communications Services Ltd.* (2005), 39 C.P.R. (4th) 389 at 402-404 (F.C.T.D.), aff'd at 47 C.P.R. (4th) 249 (F.C.A.); *MEXX International B.V. v. NBC Fourth Realty Corp.* (2003), 33 C.P.R. (4th) 562 at 571 (T.M.O.B.).

[77] Farleyco filed before the Registrar certified copies of twenty-two registrations and applications for trade-marks consisting of, and containing, the word GLAMOUR for a variety of wares and services including women's and children's fashions, jewelry and accessories, and cosmetics and beauty-care products. With few exceptions, a trade-mark can only be registered if in use. Advance would have moved to cancel these registrations if there was any prospect of success.

[78] Where evidence shows the common use of a mark, it may be inferred that consumers are accustomed to make fine distinctions between those marks by paying more attention to the differences: *Kellogg* at page 358-360 and *Telus* at page 404.

[79] Farleyco says that Canadian consumers have clearly been exposed to many GLAMOUR trade-marks on products in the fields of cosmetics, fashion and beauty. Consumers are accustomed to differentiating between marks and their multitude of sources. Canadians are unlikely to infer mistakenly that Farleyco's mark and products are connected with Advance and its magazine.

[80] Evidence of actual confusion is a relevant surrounding circumstance and, when no evidence has been provided despite the marks having been shown to be used concurrently in the same area, the Court can infer that the allegation of confusion is unjustified: *Mattel* at paragraphs 55 and 89; *Veuve Clicquot* at paragraph 37. Advance has not led any evidence of actual confusion. Farleyco, however, says it has shown that its GHOULISH GLAMOUR products have been in the Canadian market for almost four years and there have been no reported instances of confusion with Advance's mark.

Conclusions

[81] Farleyco concludes that it has discharged the burden of proving, on a balance of probabilities, that there is no likelihood of confusion between the marks GLAMOUR and GHOULISH GLAMOUR, and that Advance's allegation of confusion is unjustified. In addition, the two marks are different in overall appearance, sound and ideas suggested. The word GHOULISH serves to distinguish the GHOULISH GLAMOUR mark from Advance's mark.

[82] Farleyco's Halloween eyelashes are different from Advance's magazine, and these products are not supplied from the same source nor advertised through the same means. Advance's mark is inherently weak and consists of a descriptive word that is commonly used in the fashion, beauty and cosmetics industries. Advance's mark has not been shown to have acquired sufficient distinctiveness or a reputation, which is not limited to magazines, so it does not affect the ability of the GHOULISH GLAMOUR trade-mark to distinguish Farleyco's Halloween eyelashes.

[83] Farleyco concludes that the GHOULISH GLAMOUR mark is registerable pursuant to paragraph 12(1)(d) of the Act and that Farleyco is entitled to registration of the mark pursuant to paragraph 16(3)(a). Farleyco is also entitled to use the mark for the purposes of subsection 30(i) of the Act and the GHOULISH GLAMOUR trade-mark is distinctive of, and is capable of distinguishing Farleyco's wares from Advance's wares.

ANALYSIS

The Board Decision

[84] There is nothing in the record to suggest that the Opposition Board Member did not make an appropriate decision on the basis of the evidence before her. The Member correctly reviewed all of the surrounding circumstances in accordance with the governing jurisprudence and concluded as follows:

Having considered all of the surrounding circumstances, I find that the Applicant [Farleyco] has satisfied its onus to show that, on a balance of probabilities, confusion between the marks is unlikely. This is primarily because of the inherent weakness of the Opponent's

[Advance] mark and the difference between the parties' marks, wares and channels of trade. The Opponent's evidence falls far short of demonstrating that its GLAMOUR mark is entitled to a scope of protection that is broad enough to render the Applicant's mark unregistrable.

[85] Notwithstanding the appropriateness of the Member's Decision on the evidence before her, subsection 56(5) of the Act provides that on appeal under subsection 56(1) of the Act, evidence in addition to that adduced before the Registrar may be filed and this Court may exercise any discretion vested in the Registrar.

[86] Advance claims to have submitted substantive new evidence in this appeal and suggests that the factual underpinnings of the Member's Decision have been so changed that the Court should now decide the matter itself without deference to the Member's Decision. Farleyco takes the position that the additional evidence filed would not have materially affected the Opposition Board's findings so that I should merely review the Member's Decision against a standard of reasonableness.

[87] Before the Court can decide whether it should review the whole matter anew or simply review the Member's Decision for reasonableness, the Court must first examine the new evidence that has been brought forward as part of this appeal.

The New Evidence

[88] Advance has filed additional evidence through the affidavit of Ms. Susan Goodall, the Executive Managing Editor of GLAMOUR magazine sworn on November 2, 2007. Advance says that Ms. Goodall's evidence alone significantly and substantially extends beyond the evidence that was before the Registrar. Ms. Goodall was not cross-examined on her affidavit.

[89] Farleyco has also filed new evidence in the form of an affidavit of Mr. Edward M. Reiken, sworn November 30, 2007 and the affidavit of Ms. Patricia Farley-Pope dated December 3, 2007.

[90] Ms. Farley-Pope is the president of Farleyco and Mr. Reiken is the president of Amera International Inc., a private investigation firm. Mr. Reiken was retained by Farleyco's counsel to identify, locate and obtain a variety of products bearing the trade-mark GLAMOUR and he did this by visiting certain stores in the Square One Shopping Centre in Mississauga on November 12, 2007, and the Yorkdale Shopping Centre on November 13, 2007. Advance says, for various reasons I will come to, that Mr. Reiken's evidence is irrelevant to the present appeal.

Ms. Goodall's Evidence

[91] When Ms. Goodall's evidence is examined against the criteria and deficiencies noted in the Member's Decision, the following is revealed:

(A) Section 6(5)(a) – inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known. Section 6(5)(b) – the length of time each trade-mark has been in use.

[92] The Member concluded that neither of the parties' marks is inherently strong since each mark is suggestive of its associated wares. Also, there was no evidence of continuing use of the GLAMOUR mark by Advance.

[93] However, as the Member pointed out, the strength of a trade mark may be increased if it becomes known through promotion or use. At the opposition stage there was no evidence to enable the Member to conclude that either party's mark has become known in Canada to any significant extent.

[94] That deficiency has now been remedied and Ms. Goodall's affidavit makes it clear that:

- a) GLAMOUR magazine has been distributed continuously in Canada since 1938 and is available in over 200 countries, including Canada and the United States;
- b) GLAMOUR has been used:
 - (i) Since December 30, 1938 in association with a periodical magazine;
 - (ii) Since July 5, 2000 in association with: interactive CD-roms relating to periodicals and magazines in the fields of fashion, beauty and entertainment; in association with pre-recorded compact discs, 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 field of fashion, beauty and entertainment;

- (iii) Since July 1997 in association with an on-line magazine and publications distributed in electronic format via the internet; operating an internet web-site which allows consumers to subscribe to consumer magazines and allows advertisers to promote their goods and services via the internet;
- (iv) In accordance with a recent proposed use application, to provide 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.

- c) GLAMOUR magazine is a monthly magazine that has been available online since July, 1997. The print version is available by subscription and on newsstands. The average yearly circulation is in excess of 2,000,000 in the United States and 80,000 in Canada.
- d) The contents of the GLAMOUR magazine (both print and online) reveal regular feature articles, columns and advertisements dealing with fashion, cosmetics, make-up, beauty tips and the like.

[95] Farleyco says that the evidence contained in Ms. Goodall's affidavit falls far short of establishing that the GLAMOUR mark is famous or even well-known, and particularly not outside

the limited field of monthly periodicals. In my view, Ms. Goodall's evidence shows a wide use of the GLAMOUR mark in association with both the print and electronic versions of the magazine as well as other electronic networks that advertise products and provide advice and information to women in the fields of fashion, beauty and entertainment.

[96] However, I cannot find convincing evidence that consumers associate the products featured in the magazine and its various electronic extensions with the GLAMOUR mark. And there is no evidence that Advance has ever licensed the GLAMOUR mark for use in association wares and products.

[97] As Ms. Goodall points out, Advance publishes GLAMOUR magazine, which is devoted to fashion, beauty, entertainment, health and lifestyle, and this means, by necessity, that beauty products such as cosmetics and make-up are advertised and offered for sale in the magazine, and that the magazine offers advice, articles, features and advertisements that relate to fashion, cosmetics, make-up beauty, entertainment, health and lifestyle.

[98] Whether this means that confusion will result if Farleyco is permitted to use GHOULISH GLAMOUR for its Halloween cosmetics and eyelash accessories depends upon all of the circumstances of the case, but I think it is obvious at this point that the evidence before the Court concerning Advance's use of GLAMOUR and the extent to which the mark has become known significantly extends the evidence that was before the Member when she made her Decision, so that I must decide the issues before me anew on the basis of the new evidential record.

(B) Section 6(5)(c) and (d) – the nature of the wares, services or business; the nature of the trade.

[99] As regards Advance’s GLAMOUR mark the Member concluded that the “wares appear to be essentially magazines, in printed or electronic form, in the field of fashion, beauty and entertainment ...” and that “[n]o information has been provided regarding either party’s channels of trade and it is not apparent that the parties’ wares would travel the same channels of trade.” The Member also pointed out that “there is no evidence that the Opponent’s magazines ever dealt with Halloween related cosmetics or eyelash accessories.”

[100] Ms. Goodall’s affidavit brings out the following material evidence for consideration under this heading:

- (a) Besides promoting its magazine and on-line extensions in Canada through subscriptions and newsstand displays, Advance also conducts a TOP TEN COLLEGE WOMEN competition carried out at over 50 universities from coast to coast across Canada;
- (b) Advance has spent in excess of \$10,000,000 since 1997 on advertising GLAMOUR magazine and its extensions, but the Court is not told how this breaks down between Canada, the United States and the rest of the world;
- (c) As regards the online version of GLAMOUR, Canadians have viewed over 400,000 pages monthly since July 1997;
- (d) The GLAMOUR website also allows advertisers, including cosmetics and make-up companies, to promote their goods;

- (e) Annual revenues of Advance associated with its GLAMOUR products and services are well in excess of \$100,000,000 for the period 1997-2007 and Canada represents approximately 10% of that number in terms of revenue;
- (f) Advance does include some specific Halloween content in its GLAMOUR magazine and has, in fact, used the designation GHOULISH GLAMOUR.

[101] Once again, I think the Court has been presented with evidence of the nature of the wares and services, and the channels of trade that goes significantly beyond what was before the Member and which should now be considered afresh as part of the general issues before the Court.

[102] After reviewing this evidence, although Ms. Goodall makes reference to interactive cd-roms, pre-recorded compact discs consisting of games and catalogues, pre-recorded audio and video cassettes and electronic publications in the fields of fashion, cosmetics, make-up, beauty, entertainment, health and lifestyle, it seems to me that the Advance evidence shows that various cosmetic products are featured and advertised in GLAMOUR magazine and its electronic extensions as part of the discussion and advice that Advance provides to its readers. There is no evidence of use in association with the cosmetic products that are featured and advertised. GLAMOUR is used by Advance in association with its magazine and online periodicals and extensions, which are the wares for which the mark is registered in Canada.

[103] As regards Exhibit C-1 to Ms. Goodall's affidavit and the use of the word "Halloween," I can see no use in association with any article or promotion of Halloween costumes or cosmetics.

The references simply refer to Halloween as an occasion. And, as Farleyco points out, the reference to “GHOULISH GLAMOUR” is a print-out from a UK based web site advertising Halloween-themed necklaces. The necklaces are advertised in UK currency, and there is no indication that they are available to Canadian purchasers through Advance or its website. “GHOULISH GLAMOUR” is used as a descriptive phrase to identify a third-party’s Halloween-themed necklace and there is no evidence that Canadians have ever seen it.

Summary

[104] Considering the new evidence put forward by Advance and Farleyco as it relates to section 6(5) of the Act, my conclusions are as follows:

- (a) It is still the case that neither of the parties’ marks is inherently strong because both marks are suggestive of their associative wares;
- (b) Advance has now been able to show that it has continuously used GLAMOUR in Canada since 1938;
- (c) Advance’s GLAMOUR mark is used in association with magazines, in both printed and electronic form, and related wares and services such as cd-roms, pre-recorded compact discs, games, catalogues, pre-recorded audio and video cassettes, electronic publications and searchable computer software, all of which deal with the fields of fashion, beauty and entertainment, and which provide information and advice directed at women about fashion, beauty, style and culture. Advance’s magazine

publications and internet web-site allow consumers to subscribe to its magazines and advertisers to promote their goods and services;

- (d) Advance's wares and services are sold by subscription, on newsstands and are also available online on the internet and are distributed over television, satellite, audio, video, and global computer networks. Farleyco's evidence reveals that its GHOULISH GLAMOUR Halloween eyelashes are sold in drug, food and mass merchandise retail outlets such as Shoppers Drug Mart, WalMart, Loblaw's and Zellers where the GHOULISH GLAMOUR wares are stocked in the cosmetic sections or Halloween specialty sections. There is no evidence to suggest that such wares are displayed near magazines or that anyone, in purchasing GHOULISH GLAMOUR wares, has inferred or might reasonably infer that such wares are manufactured, sold, leased, hired or performed by the same person who manufactures, sells leases, hires or performs wares and services in association with the GLAMOUR mark. The evidence also suggests that Farleyco advertises its GHOULISH GLAMOUR wares in store flyers and on display boards at point-of-sale and not on television or in magazines. Advance's GLAMOUR wares and services, on the other hand, are not advertised in store flyers.
- (e) The degree of resemblance between the trade marks in appearance or sound, or in the ideas suggested by them is, in my view, as described by the Member in her Decision, and the new evidence does not suggest that her conclusions that, taken as a whole, "the degree of resemblance between them is not great in appearance, sound

or idea suggested” was either unreasonable or incorrect. Considering this factor anew, I come to the same conclusions;

- (f) As regards other factors, it is not entirely clear to what extent the other 22 registrations and applications on the request for marks consisting of, or containing, GLAMOUR, amount to in terms of actual market use. But the evidence of Mr. Reiken, as well as Advance’s own evidence, reveals that the word “GLAMOUR” is in commonplace usage in the fashion, beauty and cosmetic fields. As Farleyco points out, this would suggest that Canadian consumers have been exposed to an array of GLAMOUR trade-marks and are accustomed to differentiating between GLAMOUR marks and their multitude of sources. As mentioned earlier, there is no evidence before me of actual confusion between the two marks at issue in this case. GHOULISH GLAMOUR products have been in the Canadian market for approximately four years and there are no reported instances of confusion with Advance’s GLAMOUR. There is also no evidence that anyone in the magazine industry typically licenses the names of their magazine for use in association with cosmetics.

[105] The Member concluded that, considering all of the surrounding circumstances, Farleyco had satisfied its onus to show that, on a balance of probabilities, confusion between the marks was unlikely:

This is primarily because of the inherent weakness of the opponent’s [Advance’s] mark and the differences between the parties’ marks, wares and channels of trade. The opponent’s evidence falls far short of demonstrating that its GLAMOUR mark is entitled to a scope of protection that is broad enough to render the Applicant’s mark unregistrable.

[106] The Member also said that her conclusion would remain the same even if she accepted that “the opponent’s registrations showed *de minimus* use of its mark in Canada since 1938” and whether or not she “treated the number of third party GLAMOUR registrations as sufficient to reach a conclusion concerning the state of the marketplace.”

[107] In considering this matter anew, I still need to assess the extent to which the new evidence brought forward by both sides concerning use demonstrates that Advance’s GLAMOUR mark has an acquired distinctiveness through use and promotion that is sufficient to warrant a wide scope of protection, even for a mark that is suggestive and inherently weak.

[108] Farleyco, I think, correctly points out that its Halloween eyelashes are different from Advance’s magazine wares and services, they are not typically supplied from the same source, and they are advertised and sold through different means and in different retail locations. Just because cosmetic products are advertised, discussed, or otherwise featured in Advance’s magazine and related wares does not mean, in my view, that any acquired distinctiveness in the GLAMOUR mark should extend to cover such products.

[109] However, as Advance points out, section 6(2) of the Act makes it clear that confusion can occur “whether or not the wares or services are of the same general class.”

[110] When applying the test for confusion, it is clear that the Court must have regards to all the surrounding circumstances, including those specifically enumerated in subsection 6(5) of the Act,

and that the enumerated factors need not be attributed the same weight. It is also well established that the test for confusion is one of first impression and imperfect recollection. The Supreme Court of Canada has discussed the appropriate process for assessing all of the surrounding circumstances to be considered in determining whether two trade-marks are confusing in *Mattel* and *Veuve Clicquot*.

Conclusions

[111] In my view, what the evidence establishes (particularly the new evidence put forward by Advance) is that the word “GLAMOUR” is descriptive of a whole industry of cultural and commercial endeavour. Like the words “Fashion” or “Beauty,” GLAMOUR may have a more specialized meaning in particular contexts, but in the context of this dispute Glamour is something that a large segment of the public obviously wishes to acquire, and both Advance and Farleyco are part of an industry that wishes to make money out of supplying Glamour to the public in various forms.

[112] Within this general context, Advance has, through the continuous use of its GLAMOUR mark in association with particular wares and services given its mark a certain distinctiveness. GLAMOUR is distinctive of and associated with a particular magazine as well as with the electronic derivatives of that magazine and related wares and services. GLAMOUR is used by Advance in association with wares and services that, in a general sense, create a culture and a realm of discourse that is connected with, and bleeds off into, other related areas such as fashion, beauty,

health, life-style, entertainment, etc. But I think the evidence is clear that Advance's GLAMOUR mark is not associated with all wares and services that make up the glamour industry and that its distinctiveness lies in products and services that contribute to a culture, an ambience, a forum, a form and mode of discourse that we know generally as the glamour industry. Part of the purpose of the culture and discourse created by GLAMOUR is to allow third parties to advertise and sell their glamour products and so generate revenues for Advance.

[113] In my view, the evidence is clear that, in doing this, Advance does not compete with its own advertisers in, for instance, the manufacture, promotion and sale of cosmetics. There is a clear distinction in the materials between the culture and discourse created by Advance's GLAMOUR products and services and the cosmetic products that come with the promise – express or implied – that they will give, create, induce or bestow glamour upon the purchaser.

[114] This is why, in my view, there is no evidence in the present case of Advance having licensed its GLAMOUR mark to product manufacturers or, indeed, that it is common practice in the industry to do so. It is also why there is no actual evidence of confusion in the present case. Those in pursuit of glamour and the products that will make them glamorous are well-aware of the distinction between the general culture and discourse of glamour within which Advance participates, and the myriad cosmetics and packaged aids to glamour that are advertised in GLAMOUR magazine and its electronic derivatives.

[115] Advance's attempts to establish a "cross-over" between its magazine and related products and Farleyco's Halloween eyelashes suggests that Advance is well aware of the distinctions I have referred to above and is anxious to cite any possible use of "Halloween" that might bridge the gap. But none of the examples given do that.

[116] Even though cosmetics and magazines may be sold in the same stores, the evidence in this case shows that GLAMOUR magazine and Farleyco's products are sold and advertised in very different ways and are purchased and used in very different ways.

[117] Advance argues that, although it might be said that the wares of the respective parties that are at issue in this case are different, they nevertheless belong to the same general class of goods, namely cosmetic, fashion and beauty.

[118] The evidence does not suggest to me that magazines and their electronic derivatives are in the same class of goods as cosmetics. I think what Advance means here is that those who manufacture cosmetics are in the same industry as Advance who publishes a magazine devoted to fashion and beauty that also advertises cosmetics manufactured by third parties. There is no evidence, in my view, to establish the cross-over that Advance wishes to make in order to give its GLAMOUR mark a distinctiveness that would extend to cosmetics of the kind manufactured and sold by Farleyco.

[119] The evidence suggests to me that consumers are repeatedly exposed to many Glamour trade marks and to the constant use of the word “glamour” in the glamour industry and the marketplace it spawns. I think it can be assumed in this context that they have become extremely adept at distinguishing between wares and services sold and associated with the word “Glamour,” either singly, or in combination with other words, and that they are extremely unlikely to associate Farleyco’s Halloween GHOULISH GLAMOUR products with Advance’s GLAMOUR wares and services.

[120] For these reasons, after considering all the factors enumerated in section 6(5) of the Act, and taking into account the principles enunciated in *Mattel, Veuve Clicquot* and all of the surrounding circumstances brought before me in this case, and considering the matter anew, I still believe that Farleyco has discharged its burden of proving, on a balance of probabilities, that confusion between the marks is unlikely.

[121] As regards the section 30(1) grounds, I think the new evidence establishes that Farleyco was aware of Advance’s GLAMOUR mark as of the relevant date, but this is not inconsistent with Farleyco’s position that it was satisfied that it was entitled to use GHOULISH GLAMOUR on the basis that its mark was not confusing with Advance’s mark, and I see no evidence of bad faith on the part of Farleyco.

JUDGMENT

THIS COURT ORDERS AND ADJUDGES that

1. The appeal is dismissed;
2. The decision of the Registrar of Trade-marks dated June 4, 2007, refusing Advance's opposition to Canadian Trade-mark Application No. 1,199,765 is maintained;
3. Farleyco shall have the costs of this appeal.

“James Russell”

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-1490-07

STYLE OF CAUSE: **ADVANCE MAGAZINE PUBLISHERS INC. and
FARLEYCO MARKETING INC.**

PLACE OF HEARING: TORONTO, ONTARIO

DATE OF HEARING: 3-DEC-2008

REASONS FOR : RUSSELL J.

DATED: February 12, 2009

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