



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

**Citation: 2013 TMOB 130**  
**Date of Decision: 2013-08-13**

**IN THE MATTER OF AN OPPOSITION  
by MinMaxx Realty Inc. to application  
No. 1,500,283 for the trade-mark MAXIM  
REALTY in the name of Maxim Realty  
Inc.**

I. Background

[1] Maxim Realty Inc. (the Applicant) has applied to register the trade-mark MAXIM REALTY (the Mark), based upon proposed use in Canada in association with various promotional items and printed matter, as well as a range of real estate, property management, land development and construction related services. The statement of wares and services in the application is reproduced in its entirety as Schedule “A” to this decision.

[2] MinMaxx Realty Inc. (the Opponent) has opposed the application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[3] The application has been opposed on the grounds that: (i) it does not conform to the requirements of ss. 30(a),(e) or (i) of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under s. 16 of the Act in view of the Opponent’s prior use of the trade-marks MINMAXX and MINMAXX DESIGN, its prior use of the trade-name MINMAXX and its previously filed applications for MINMAXX and MINMAXX DESIGN, the particulars of which are set out in Schedule “B” to this decision; and (iii) the Mark is not distinctive within the meaning of s. 2 of the Act.

[4] Both of the parties filed evidence and written arguments. No oral hearing was held.

## II. Onus

[5] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

## III. Analysis

### Preliminary Matter

[6] As a preliminary matter, I note that in its written argument, the opponent makes reference to both non-entitlement and non-registrability in its confusion analysis. However, the opponent has not pleaded non-registrability under s. 12(1)(d) in its statement of opposition. In view of this, I will only consider the opponent's submissions regarding confusion to the extent that they relate to the grounds of opposition which are based upon non-entitlement under s.16 of the Act.

### Conformity – Section 30 of the Act

[7] The material date for considering the conformity of the application to the requirements of section 30 of the Act is the filing date of the application, namely October 19, 2010 [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

### Section 30(a)

[8] The Opponent's initial evidential burden under section 30(a) is a light one. In fact, the Opponent may need only present sufficient argument in order to meet its initial burden [see *McDonald's Corporation and McDonald's Restaurants of Canada Ltd v MA*

*Comacho-Saldana International Trading Ltd carrying on business as Macs International* (1984), 1 CPR (3d) 101 at 104 (TMOB)].

[9] In the present case, the Opponent has provided neither evidence nor argument in support of this ground of opposition and as a result, the Opponent has failed to meet its evidential burden. The ground of opposition based on section 30(a) of the Act is therefore dismissed.

Section 30(i)

[10] Where an applicant has provided the statement required by section 30(i), a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is dismissed.

Section 30(e)

[11] The opponent has pleaded that the application does not conform to the requirements of s. 30(e) of the Act, as the applicant, either by itself or through a licensee never intended to use the alleged trade-mark in Canada in association with all of the wares and services set forth in the application.

[12] As the application contains a statement that the “applicant by itself or through a licensee, or by itself and through a licensee” intends to use the Mark, it formally complies with the requirement of s. 30(e) of the Act. The issue therefore becomes whether or not it substantially complied at the filing date of the application, i.e., was the statement true?

[13] Since it is difficult to prove a negative and certainly more so in the case of a proposed use application, the initial burden upon an opponent with respect to a ground of opposition based upon non-compliance with s. 30(e) is a relatively light one [see *Molson Canada v. Anheuser-Busch In.*, 2003 FC 1287 (CanLII); (2003), 29 CPR (4th) 315 (FC)].

[14] An opponent may rely upon the applicant's evidence to meet its initial burden, but the opponent must show that the applicant's evidence is clearly inconsistent with the applicant's claim [see *York Barbell Holdings Ltd v ICON Health & Fitness, In.*, (2001), 13 CPR (4th) 156 (TMOB)].

[15] In this case, the opponent relies solely upon the applicant's evidence (the affidavit of Kenn Mukherjee, sworn January 8, 2012) to meet its initial burden. The opponent takes the position that the Mukherjee affidavit provides evidence that is inconsistent with the applicant's proposed use claim in its application.

[16] With respect to the services, the opponent asserts that the applicant never *intended* to use the Mark, as it was already in use in Canada in association with the services prior to the applicant's October 19, 2010 filing date.

[17] In support of its assertion that the Mark had been used prior to the filing date of the application, the opponent relies upon the following passages from the Mukherjee affidavit:

Para 9: My company provides the above noted real estate services. My Company is not a licensed Relator [sic]. Prior to filing for the registration of my Company's trademark I consulted with the Federal Business Development Corporation and was advised that it was in my best interest to file my application based on Proposed Use of the mark is [sic] respect of all the services as it was believed that stating otherwise might be deemed to be the services of a Relator [sic].

Para 10: In view of the evidence, and the advise [sic] of my trademark agent, I have filed a revised application to reflect the services currently being offered and those proposed to be offered. Attached to this my AFFIDAVIT as Exhibit "A5" is a copy of the application as revised.

[18] In the revised application which is attached as Exhibit "A5" to the Mukherjee affidavit, the applicant had deleted "real estate services", as well as all of the wares. In addition, with the exception of "real estate agencies", the applicant amended the remaining services so as to be based upon use since February 28, 2005, rather than proposed use as

claimed in the application as originally filed. As noted by the opponent, some of the services in the amended application appear in both the proposed use and use claims and additional services which were not in the application as originally filed were also added.

[19] The revised application was rejected by the Registrar of Trade-marks on January 17, 2012, on the basis that amending an application to change the date of first use after advertisement is contrary to r. 32(b) of the *Trade-marks Regulations*. I note that the revised application was also contrary to r. 32(e) of the *Trade-marks Regulations*, since it included services which were not covered by the application as originally filed.

[20] In its written argument, the opponent states that all of the services previously claimed to have not been used by the applicant were amended to claim use by the applicant since February 28, 2005 in the revised application. However, this statement is somewhat inaccurate. As previously noted, the revised application does not, in fact, claim use of the trade-mark in association with “real estate agencies”. Those particular services still appear in the proposed use basis in the revised application.

[21] I note that in paragraph 4 of his affidavit, Mr. Mukherjee clearly states that his company “proposes” to expand its real estate services to further include “real estate agencies/brokerage”. In view of this, I do not find that there is any inconsistency in the applicant’s evidence with respect to the services which are defined in the application as “real estate agencies”.

[22] The opponent has also submitted that because the applicant is not a licensed realtor (see paragraph 9 of the Mukherjee affidavit), it could not have intended to use the trade-mark in association with “real estate agencies” services at the time of filing the application. I disagree. Although the applicant may not have been licensed at the time of filing its application, it would not be precluded from becoming licensed in the future and there is nothing in the evidence to suggest that it had no intention of doing so.

[23] In view of the foregoing, I find that the opponent has not met its initial burden with respect to the services “real estate agencies”. The 30(e) ground is therefore unsuccessful in relation to those particular services.

[24] With respect to the remaining services, I find that the opponent's initial burden has been met, as the revised application, together with some of the statements made in the Mukherjee affidavit are clearly inconsistent with the applicant's intent to use claim in its application.

[25] As noted previously, in paragraph 10 of his affidavit, Mr. Mukherjee states that he filed the revised application which is attached as Exhibit "A5" to "reflect the services currently being offered and those proposed to be offered". In the revised application, the applicant has claimed a February 28, 2005 date of first use for "property management services", "land development; construction of commercial and residential buildings", "consulting services in the fields of purchasing real estate and real estate investment" and "operating a website providing information in the field of real estate, real estate investment, property management and land development". In paragraph 3 of his affidavit, Mr. Mukherjee also states that his company currently offers those particular services. I note that in the application as originally filed, all of the aforementioned services are based upon proposed use. Accordingly, I find that the opponent has met its initial burden with respect to these services, as the evidence suggests that the Mark was, in fact, in use prior to the filing date, which is inconsistent with the proposed use claim in the application as originally filed.

[26] The remaining services, namely, "real estate services" were deleted from the revised application attached as Exhibit "A5". However, in paragraph 2 of his affidavit, Mr. Mukherjee states that his company, which was incorporated in 2003, is in the business of providing "real estate services" and that it has operated under the name Maxim Realty Inc. since inception. Moreover, in paragraph 5, Mr. Mukherjee states that his company "commenced to use the trademark in early 2003 and created and started using the logos and printed materials in 2004". I therefore find it reasonable to conclude that the opponent has met its initial burden with respect to these services as well, since these statements also appear to be inconsistent with the proposed use claim in the application as originally filed.

[27] With respect to the wares, the opponent asserts that the applicant never intended to "use" the trade-mark in association with the wares, within the meaning of s. 4 of the Act,

which requires use in the “normal course of trade”. The opponent relies on the decision in *Cordon Bleu International Ltd v Renaud Cointreau & Cie* (2000), 10 CPR (4<sup>th</sup>) 267 (FCTD) wherein Justice Rouleau stated that the word “trade” in the phrase “normal course of trade” contemplates a type of commercial transaction.

[28] The opponent takes the position that it is clear from the evidence that the applicant is not in the business of printing “printed matter” such as “signs, calendars and directories” or manufacturing “promotional items” such as hats, stickers, key chains, pens, etc. The opponent asserts that the wares of the applicant are simply meant to publicize and advertise its services and that such use would not constitute use in the normal course of trade under s. 4 of the Act. I agree.

[29] Aside from paragraph 5, I note that the Mukherjee affidavit is silent with respect to the use of trade-mark in association with any wares. In paragraph 5, Mr. Mukherjee simply states that his company commenced to use the trademark in early 2003 and created and started using the logos and printed materials in 2004. Attached as exhibit “A2” is an invoice from the graphics firm that Mr. Mukherjee states developed his company’s logo and printed materials. The invoice appears to cover the digitization of the logo and business card design. It does not reference any of the printed matter or promotional materials which are covered in the application. Moreover, I note that in the revised application which was attached as Exhibit “A5” to the Mukherjee affidavit, all of the wares which were in the application as originally filed have been deleted.

[30] In view of the foregoing, I am prepared to conclude that the opponent has also met its initial burden with respect to the wares.

[31] Based on a line of decisions wherein the Registrar of Trade-marks has refused proposed use applications where use of the trade-mark was evidenced prior to the filing date [see *Nabisco Brands Ltd v Cuda Consolidated Inc* (1997), 81 CPR (3d) 537 at 540 (TMOB) and *Canada Post corporation v IBAX Inc* (2001), 12 CPR (4<sup>th</sup>) 562 (TMOB)], the section 30(e) ground succeeds with respect to all of the wares and services, with the exception of “real estate agencies”.

## Section 16 – Entitlement

[32] The opponent has pleaded that the applicant is not the person entitled to registration of the Mark under s. 16 of the Act in view of its prior use of the trade-marks MINMAXX and MINMAXX DESIGN, its prior use of the trade-name MINMAXX and its previously filed applications for MINMAXX and MINMAXX DESIGN, the particulars of which are set out in Schedule “B” to this decision.

[33] The material date for considering the Applicant’s entitlement to registration of the mark under ss. 16(3)(a)-(c) is the filing date of the application, namely, October 19, 2010.

[34] In order to meet its evidential burden for the s. 16(3)(a) ground of opposition, the opponent must establish that its MINMAXX and MINMAXX DESIGN trade-marks were used prior to the filing date for the application for the Mark and had not been abandoned at the date of advertisement of the application for the Mark , namely, April 20, 2011 [see s. 16(5) of the Act].

[35] Based upon the Rizvee affidavit, I am satisfied that the opponent’s trade-marks MINMAXX and MINMAXX DESIGN were in use as of the material date and had not been abandoned as of the date of advertisement of the Mark (see paragraphs 6, 8, 11-14 and Exhibit “B”). The opponent has therefore met its initial burden with respect to the s. 16(3)(a) ground of opposition.

[36] In order to meet its initial evidential burden under s. 16(3)(b) of the Act, the opponent must show that its application was filed prior to the filing date of the applicant’s application and that its application was still pending at the advertisement date, namely, April 20, 2011 [see s. 16(4) of the Act]. I have checked the register and can confirm that this is the case. The opponent has therefore met its initial burden in respect of the s. 16(3)(b) ground of opposition.

[37] In order to meet its evidential burden for the s. 16(3)(c) ground of opposition, the opponent must establish that its MINMAXX trade-name was used prior to the filing date for the application for the Mark and had not been abandoned at the date of advertisement of the application for the Mark , namely, April 20, 2011 [see s. 16(5) of the Act].



[38] I am not satisfied that the Opponent has shown any use of MINMAXX *per se*, as a trade-name. Rather, the evidence shows use of MINMAXX REALTY INC. as a trade-name and in my view, the public would not perceive the applicant's use of MINMAXX REALTY INC. to be use of the trade-name MINMAXX *per se*, as pleaded in the statement of opposition [see *Nightingale Interloc v. Prodesign Ltd.* (1984), 2 CPR(3d) 535 at 538 (TMOB)]. The opponent has therefore not met its initial burden under s. 16(3)(c) of the Act. Accordingly, I am rejecting the s.16(3)(c) ground of opposition.

[39] In view of the foregoing, the only remaining issue to be determined in relation to the applicant's entitlement is whether the applicant has met the legal onus upon it to establish that there is no reasonable likelihood of confusion within the meaning of s. 6(2) of the Act between its trade-mark MAXIM REALTY and the opponent's trade-marks MINMAXX and MINMAXX DESIGN.

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

[41] 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 trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

*Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known*

[42] The opponent's marks MINMAXX and MINMAXX & DESIGN possess a relatively low degree of inherent distinctiveness as the marks are essentially composed of truncations of the words "minimum" and "maximum", which are common dictionary words. The added elements of the MINMAXX DESIGN mark are not particularly distinctive, as the mark simply consists of the word MINMAXX in an oblong border with the additional descriptive matter "realty inc. brokerage". The opponent's marks are therefore somewhat inherently "weak".

[43] Similarly, the applied-for mark MAXIM REALTY is also an inherently "weak" mark as it is also comprised of the ordinary dictionary terms "maxim" and "realty".

[44] I am prepared to infer from Mr. Rizvee's affidavit (sworn December 22, 2011) that the opponent's trade-marks MINMAXX and MINMAXX DESIGN and its trade-name had acquired a fairly significant reputation in Canada, particularly in the Greater Toronto Area (GTA) at all material times.

[45] The applicant's application is based upon proposed use. In view of this, under normal circumstances, one would not expect the applicant to have acquired any reputation in its trade-mark as at the material date. However, as previously discussed, in this particular case, the applicant has alleged use of the Mark in connection with at least some of the services dating back to 2003. Based upon the Mukherjee affidavit, I am prepared to infer that as of the material date, the applicant's trade-mark had become known at least to some extent. However, as the application is based on proposed use, I am not certain that the applicant can claim the benefit of any prior use. In any event, in the absence of any sales or advertising figures or details or samples pertaining to advertisements, I am unable to conclude that the applicant would have acquired any significant reputation in the Mark in Canada as of the filing date of its application.

[46] The first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, therefore favours the opponent owing to the greater acquired distinctiveness of the opponent's marks.

*Section 6(5)(b) – length of time in use*

[47] According to the Mukherjee affidavit, the Mark has been in use in association with “real estate services” since 2003 (see paragraphs 2 and 5) and “real estate property and asset management services” since March 1, 2005 (see paragraph 7, Exhibit “A4”). According to the Rizvee affidavit, the opponent did not change its name to MinMaxx Realty Inc. until September 19, 2005 or commence use of its trade-marks until March 14, 2006. This factor therefore slightly favors the applicant.

*Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade*

[48] To the extent that the services of the parties both relate to real estate, there is clear overlap in the nature of the parties’ wares, services, businesses and trades. These factors therefore favour the opponent.

*Section 6(5)(e) – degree of resemblance between the trade-marks*

[49] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf. 60 CPR (2d) 70 (FCTD)].

[50] In *Masterpiece* the Supreme Court of Canada considered the importance of s. 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5) is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[51] I do not consider there to be a particularly high degree of resemblance between the opponent's trade-marks and the applicant's Mark. The applicant's Mark MAXIM REALTY, differs both visually and phonetically from the opponent's trade-marks MINMAXX and MINMAXX DESIGN. It also differs in connotation.

[52] According to the Rizvee affidavit, the opponent's trade-marks which consist of or incorporate MINMAXX, are intended to convey that the opponent charges a "minimum" commission to produce "maximum" results (see paragraph 16).

[53] By contrast, according to the Mukherjee affidavit, the applicant's trade-mark MAXIM REALTY is intended to suggest "a subjective principle or rule that the will of an individual uses in making a decision as it relates to real estate" (see paragraph 8). Although I query whether consumers would attribute the applicant's intended meaning to its trade-mark, there is no question that the words MAXIM and REALTY are both common dictionary terms with readily recognizable meanings.

[54] Mr. Rizvee states in paragraph 17 of his affidavit that the applicant's trade-mark MAXIM REALTY suggests to consumers that the applicant produces "maximum" results and therefore the trade-marks suggest substantively the same idea to consumers. I disagree. The applicant's trade-mark is MAXIM REALTY, not MAXIMUM and the words MAXIM and MAXIMUM have very distinct and entirely different meanings.

[55] When the marks are considered in their entirety, I find that they are more different than alike in appearance, sound and connotation. This certainly favours the applicant. A principle of trade-mark law that in the circumstances of this case also gives greater favour to the applicant is that when marks are inherently weak, comparatively small differences will suffice to distinguish one mark from another: see *GSW Ltd. V. Great west Steel Industries Ltd.* (1975), 22 CPR(2d) 154 (FCTD). Although the opponent's evidence suggests that its trade-marks have perhaps become somewhat more well known than the applicant's, I am of the view that it still falls short of demonstrating that its trade-marks had, at the material date, become so well known so as to entitle the opponent to a broad scope of protection.

[56] The last and most important factor in s.6(5) therefore favours the applicant.

[57] Considering the factors in s.6(5) as discussed above, and taking into account in particular that the opponent's mark is a weak mark, that differences in the parties' marks are sufficient to distinguish them, and that the opponent's mark is not entitled to a broad scope of protection, I find that at all material times the applicant has met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied-for mark MAXIM REALTY and the opponent's trade-marks MINMAXX and MINMAXX DESIGN.

### Section 2 – Distinctiveness

[58] The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition, namely, June 7, 2011 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185 (CanLII), (2004), 34 CPR (4th) 317 (FCTD)].

[59] This ground of opposition essentially turns on the issue of confusion between the Mark and the Opponent's trade-marks.

[60] The difference in material dates is insignificant and thus for the same reasons as outlined above in the analysis of the section 16 grounds of opposition, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' marks.

[61] Accordingly, the non-distinctiveness ground is also unsuccessful.

### Disposition

[62] In view of the foregoing,

(a) the opposition is rejected in respect of the services "real estate agencies,"

otherwise,

(b) the application is refused.

[63] This decision has been made pursuant to a delegation of authority under section 63(3) of the Act. Authority for a divided decision is found in *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD).

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

## Schedule "A"

### Statement of Wares and Services for Application No. 1,500,283


#### Wares:

(1) Printed matter, namely, signs, calendars and directories, (2) Promotional items, namely, hats, bumper stickers, key chains, novelty flags, banners, party balloons, novelty buttons, greeting cards, writing pencils, pens, coffee mugs, and fridge magnets

#### Services:

(1) Real estate services; Real estate agencies, (2) Property management services, (3) Land development; Construction of commercial and residential buildings, (4) Consulting services in the fields of purchasing real estate and real estate investment, (5) Operating a website providing information in the field of real estate, real estate investment, property management, and land development

Schedule "B"

Trade-mark	Application No./ Filing Date	Services
MINMAXX	1,399,482  2008-06-13	(1) Real estate services. (2) Mortgage brokerage services, mortgage services, educational seminars in the field of real estate, educational seminars in the field of mortgages, conducting courses in the field of real estate, conducting courses in the field of mortgages, conducting seminars in the field of real estate, conducting seminars in the field of mortgages, organizing exhibits and community events for real estate; arranging for and conducting conferences in the field of real estate, arranging for and conducting conferences in the field of mortgages, business information services in the field of real estate, business information services in the field of mortgages, business management services, consulting services in the area of real estate, consulting services in the area of mortgages, management services in the field of real estate, management services in the field of mortgages.
	1,399,483  2008-06-13	(1) Real estate services. (2) Mortgage brokerage services, mortgage services, educational seminars in the field of real estate, educational seminars in the field of mortgages, conducting courses in the field of real estate, conducting courses in the field of mortgages, conducting seminars in the field of real estate, conducting seminars in the field of mortgages, organizing exhibits and community events for real estate; arranging for and conducting conferences in the field of real estate, arranging for and conducting conferences in the field of mortgages, business information services in the field of real estate, business information services in the field of mortgages, business management services, consulting services in the area of real estate, consulting services in the area of mortgages, management services in the field of real estate, management services in the field of mortgages.