



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

**Citation: 2012 TMOB 90**  
**Date of Decision: 2012-05-03**

**IN THE MATTER OF AN OPPOSITION  
by Max Mara Fashion Group S.r.l. to  
application No. 1,401,523 for the trade-  
mark MAXXMAR in the name of  
Maxxmar Inc**

[1] On June 27, 2008, Maxxmar Inc (the Applicant) filed an application to register the trade-mark MAXXMAR (the Mark). The application is based on use of the Mark in Canada since at least as early as January 15, 2008 in association with “hard window coverings; namely shutters and soft window coverings; namely blinds”. The application was advertised for opposition purposes in the *Trade-marks Journal* of April 22, 2009.

[2] On June 19, 2009, Max Mara Fashion Group S.r.l. (the Opponent) filed a statement of opposition against the application. The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The Applicant filed and served a counter statement.

[3] In support of its opposition, the Opponent filed certified copies of seven trade-mark registrations plus affidavits of Luigi Caroggio (Chief Executive Officer of Max Mara U.S.A. Inc. (Canada Branch)), Janet McKenzie (a trade-mark assistant with the Opponent’s agents) and Lynda Palmer (a self-employed trade-mark searcher). In support of its application, the Applicant filed an affidavit of Emilio Carinci (the Applicant’s executive vice-president). No cross-examinations were conducted.

[4] Both parties filed a written argument and participated in an oral hearing.

Preliminary Comment re Evidence

[5] There are some concerns with parts of the Carinci, Caroggio and Palmer affidavits that I will now address.

[6] Paragraphs 7, 8, 10 and 11 of Mr. Carinci's affidavit begin with the phrase, "I am advised and do verily believe that..." Those portions of his evidence are being disregarded on the basis that they are inadmissible hearsay. In addition, I am not according any weight to the opinion expressed in paragraph 19 that he does not believe that there is any likelihood of confusion between the parties' businesses.

[7] In paragraph 12 of his affidavit, Mr. Caroggio provides his opinion as to the likelihood of confusion between the parties' marks; I am not according any weight to his opinion. In addition, he starts paragraph 12 by stating, "By virtue of my extensive experience in the fashion industry, I do verily believe that it is not uncommon for fashion designers to expand the uses of their brands to cover products which reflect a high quality of craftsmanship for which the fashion designers are known, such as perfumery and toiletry products, household furnishings, textile goods such as curtains, blinds, bed and bath linens, paints and other articles of household decoration." However, Mr. Caroggio has not provided any information to support his claim that he has extensive experience in the fashion industry; his affidavit simply informs us that he has been with Max Mara U.S.A. Inc., the authorized distributor of MAX MARA wares in Canada and the U.S., for four years. I am therefore not according significant weight to the sentence reproduced above.

[8] Ms. Palmer states that she carried out a search of the Canadian Trade-mark Office records "to locate active applications and registrations for marks which list, in the description of wares" certain combinations of words, namely a) "clothing" and "blinds" and "shutters" and b) "shirts" and "blinds" and "shutters". As Exhibit A, she provides a compact disk "containing my search results and featuring a summary listing of all located active marks." However, she has not provided a copy of her search parameters and the listing that she has provided includes at least one abandoned application, contrary to her statement that she only searched and reported active

marks. Moreover, in the listing the statements of wares are truncated and so it is not possible to tell from her exhibit whether or not the reported marks actually cover all of the searched for wares. For these reasons, I am according very little weight to Ms. Palmer's evidence.

### Onus

[9] 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].

### Section 38(2)(a)/30(b) Ground of Opposition

[10] The Opponent has pleaded that the application does not comply with section 30(b) of the Act in that the Applicant did not use and has not continuously used the Mark in Canada, as a trade-mark, in association with the applied for wares since the date alleged.

[11] The Opponent's initial evidential burden respecting the issue of the Applicant's non-compliance with section 30(b) can be met by reference not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) (FCTD) 216 at 230]. However, while the Opponent may rely upon the Applicant's evidence to meet its evidential burden, the Opponent must show that the Applicant's evidence is clearly inconsistent with the Applicant's claims as set forth in its application [see *Ivy Lea Shirt Co v. 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), affirmed 11 CPR (4th) 489 (FCTD)]. The material date with respect to section 30 is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[12] The Opponent is relying in part on the Applicant's evidence to meet its initial burden. In its written argument, it points out that Mr. Carinci states that "the company has been selling shutters and blinds in Canada since about January 1, 2008", but he does not identify the trade-mark under which such wares were allegedly sold. In addition, the Opponent points to the

samples of company printed materials provided by Mr. Carinci as Exhibit EC1 and submits that these i) are insufficient to demonstrate use of the Mark in accordance with section 4 of the Act and ii) suggest that any wares sold by the Applicant do not bear the Mark but rather bear other marks such as NEW ERA or SUMMERVIEW.

[13] I have reviewed Mr. Carinci's evidence, in particular his Exhibit EC1 which is comprised of a print ad, a mailing label, and a piece of letterhead. Each of these three items displays the Mark. It is true that the advertisement also displays the marks SUMMERVIEW and NEW ERA but nothing prevents a party from using more than one trade-mark in association with a product. I further note that the mailing label displays only one trade-mark, a design version of the Mark, which would qualify as use of the Mark. Although I agree with the Opponent that Mr. Carinci has not shown use of the Mark pursuant to section 4 of the Act as of the date of first use claimed, he was not obliged to do so until the Opponent had met its initial burden. Moreover, I find that Mr. Carinci's evidence is not clearly inconsistent with the Applicant's use claim, with the result that Mr. Carinci's evidence does not meet the Opponent's initial burden.

[14] However, the Opponent also relies on some of Ms. McKenzie's evidence to meet its initial burden. In particular, the Opponent refers to an Internet search that Ms. McKenzie conducted on January 5, 2010 that located the website *www.maxxmar.com*, which she stated appeared to be the Applicant's company website. Ms. McKenzie provided copies of certain pages from that website as her Exhibit C, which the Opponent submits cast doubt on whether the Mark is used as a trade-mark in association with wares or is only used in association with the services of the manufacture of blinds and shutters. However, I do not intend to address the arguments based on Ms. McKenzie's Exhibit C any further for the simple reason that such evidence is dated January 5, 2010, almost two years after the date relevant under this ground of opposition. In any event, the evidence overall appears to indicate that the Applicant uses the Mark as a house mark for the blinds and shutters that it manufactures, with different blinds/shutters being further identified by secondary marks.

[15] The section 30(b) ground of opposition is dismissed on the basis that the Opponent has not met its initial burden.

### Section 38(2)(a)/30(i) Ground of Opposition

[16] The Opponent has pleaded that the application does not comply with section 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Mark is confusing with the Opponent's MAX MARA trade-name and trade-marks. However, 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, which is not the case here [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR.(2d) 152 (TMOB) at 155]. The section 30(i) ground is accordingly dismissed.

### Section 38(2)(b)/12(1)(d) Grounds of Opposition

[17] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with one or more of the following trade-marks (collectively the MAX MARA Trade-marks) that have been registered by the Opponent:

1. MAX MARA - registration No. TMA496,128

wares: cosmetics, namely bath gel, bath oils, bath powders, bath salts (non-medicated), beauty masks, body creams, body oils, body powders, colognes, compacts, cosmetics pencils, cold creams, eye creams, hair removing creams, hand creams, night creams, skin cleaning creams and lotions, skin creams, skin emollients, skin lighteners, skin soaps, skin toners, toilet soaps, liquid soaps for hand, face and body, deodorant soaps, deodorants for personal use, eye, facial and foundation make-up, eye make-up removers, eye pencils, eye shadows, eyebrow pencils, mascara, hair gel, shaving gel, shower gel, lipsticks, skin, hair, facial and body lotions, massage oils, body oils, essential oils, perfumes, toilet waters, moisturizers, dentifrices.

2. MAX MARA - registration No. TMA559,110

services: the operation of retail fashion clothing and accessories shops, and fashion clothing and accessories departments within retail stores; franchising services, namely providing advice and technical assistance in the establishment and operation of retail fashion clothing and accessories

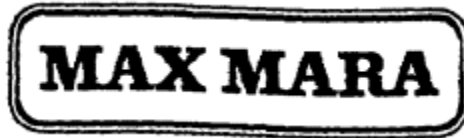
shops and departments.

3. MAX MARA & Design - registration No. TMA276,972



wares: women's clothing, namely, gowns, suits, shirts, dresses, pullovers, jackets, skirts and chemise-gowns.

4. MAX MARA & Design - registration No. TMA348,867



wares: perfume; leather articles, namely, bags, handbags and belts; umbrellas.

5. MAX MARA Design - registration No. TMA501,171

**MaxMara**

wares: spectacles, eyeglasses, sunglasses, lenses, spectacle cases and frames, parts and fittings for all the aforesaid goods; precious metals and their alloys costume jewellery, bracelets, rings, earrings broaches, necklaces all made of precious metals or coated therewith, jewellery, precious stones, clocks and watches.

6. MM BY MAXMARA Design - registration No. TMA477,201



wares: clothing namely, jackets, shirts, dresses, skirts, trousers, shorts, blouses, t-shirts, coats, raincoats, belts, cardigans, pullovers, stockings, tailored clothing, namely, ladies suits and trouser suits, gowns; headgear namely hats, caps, scarves, ear muffs; footwear namely shoes, sandals, boots.

7. WEEKEND BY MAX MARA – registration No. TMA338,395

wares: clothing and articles of clothing, namely, suits, dresses, jackets, blazers, coats, raincoats, shirts, skirts, jumpers, sweaters, vests, pants, slacks, jeans, shorts, dustcoats, trousers, T-shirts, housecoats, dressing gowns, slippers, panties, brassieres, hosiery, shawls, scarves, neckties, bow ties, veils, corsets, camisoles, stockings, hats and caps, bathing suits, bathing caps, slippers, shoes, boots, sandals, belts, suspenders and gloves, fur clothes; accessories, namely, handbags and purses; cosmetics, namely, perfume, eau de cologne, lipsticks, toilet soaps.

[18] The Applicant has pointed out that the Opponent disclaimed the right to the exclusive use of the words MAX MARA apart from the marks registered under Nos. TMA276,972 and TMA338,395.

[19] The material date for assessing a section 12(1)(d) ground of opposition is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)]. As each of the above registrations is extant, the Opponent has met its initial burden under section 12(1)(d).

[20] I consider the Opponent's word mark MAX MARA to most closely resemble the Mark and so I will focus my analysis on the likelihood of confusion between MAXXMAR and MAX MARA, which is the subject of two registrations.

[21] 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. The test for confusion is one of first impression and imperfect recollection.

[22] 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), *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

*inherent distinctiveness of the marks*

[23] Both marks possess some degree of inherent distinctiveness. However, to the extent that the Opponent's mark may be perceived as the name of an individual, the Mark is inherently stronger as it is an invented word.

*the extent to which each mark has become known*

[24] A mark's distinctiveness can be enhanced through use and promotion and I therefore now turn to the evidence regarding use and promotion.

[25] According to Mr. Caroggio, the MAX MARA trade-mark has been extensively used and promoted throughout the world in association with fashion articles, apparel and fashion accessories. He provides "amounts relating to sale proceeds for articles of clothing, footwear, handbags, eyewear and other fashion goods sold in Canada under the MAX MARA trade-mark and trade name" for the years 2003-2009; they exceed \$3 million annually.

[26] Mr. Caroggio informs us that the Opponent's MAX MARA wares are advertised in numerous printed publications, including the Opponent's *MM Magazine*, which is distributed to all of the Opponent's points of sale. In addition, advertisements appear in third party magazines



(such as *Fashion, Flare, FQ, Elle* and *The Look*) and on billboards posted in bus shelters. Details of the number of advertisement placements or circulation figures have not been provided.

[27] Mr. Caroggio attests that the last pages of the *MM Magazine*, which he provides as Exhibit A, “show a list of MAX MARA points of sales worldwide.” The magazine, which is dated 2009, lists ten Canadian locations, six of which are Holt Renfrew stores. However, invoices provided by Mr. Caroggio as Exhibit E show shipments to other locations in Canada.

[28] Mr. Carinci does not provide any information concerning the extent to which the Mark has been used or promoted.

[29] Based on the foregoing summary, I find that the Opponent’s mark is currently more known in Canada than is the Mark. However, it is unclear to what extent the Opponent’s mark is known in association with the wares and services covered by its registrations for the word mark MAX MARA, namely cosmetic products and services related to retail fashion clothing and accessories shops, since Mr. Caroggio’s evidence is not broken down into corresponding categories.

*the length of time the marks have been in use*

[30] The length of time the marks have been in use favours the Opponent. Mr. Caroggio has provided invoices dating back to 1982 that he says relate to the sale of “clothing, namely, skirts, dresses, blouses, jackets, pants, sweaters, gloves, scarves, belts, footwear, handbags and eyeglasses”.

*the nature of the wares, services, business and trade*

[31] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties’ trade-mark application and registration that govern in respect of the issue of confusion arising under s. 12(1)(d) [see *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 58 CPR (3d) 381 (FCA)]. Therefore, in considering the likelihood of confusion between MAX MARA and the Mark, it is the wares/services in the Opponent’s registrations, rather than the wares referred to in Mr. Caroggio’s affidavit, that govern. As set out earlier, one of the Opponent’s registrations for

MAX MARA covers a long list of cosmetic products whereas the other covers services related to retail fashion clothing and accessories shops.

[32] Mr. Caroggio has attested, “The Opponent carries on business in the field of clothing and fashion articles in general.” The *MM Magazine* that he provides is in Italian but it appears to be predominantly promoting women’s clothing, although there are also some purses, eyewear, perfume, footwear and jewelry. A cursory review of the numerous invoices provided reveals that they are predominantly for clothing, with some entries for keyholders, belts, handbags, wallets, and footwear.

[33] Mr. Caroggio has also attested, “The Opponent’s clothing, handbags, eyewear and other related fashion wares are sold in Canada through the authorized MAX MARA retail stores and boutiques as well as in prestige retailers such as Holt Renfrew and La Maison Simons.”

[34] Mr. Carinci has stated that the Applicant “manufactures and sells shutters for windows and doors, and window coverings, including blinds.” The Opponent’s affiant, Ms. McKenzie, has provided us with what appears to be pages from the Applicant’s website dated 2010. The website refers to the Applicant as a manufacturer of various types of hard window coverings, including shutters and blinds, and directs customers to an address in Toronto or to “ask about MAXXMAR products at your local dealer”. It is not clear who the Applicant’s local dealers are but it seems reasonable to conclude that shutters and blinds would not be sold in clothing boutiques and that if they are sold in department stores, they would not likely be sold beside clothing.

[35] To conclude, there appear to be significant differences between the parties’ wares/services and their respective channels of trade.

*the degree of resemblance between the marks*

[36] The marks are very similar in appearance and sound, however they are not identical. There are differences in their spellings and one mark is three syllables divided into two words while the other is two syllables comprised in a single word, resulting in differences both visually and orally.

[37] As alluded to earlier, Max can be interpreted as an individual's first name and the possible name connotation distinguishes the Opponent's mark from the Applicant's Mark insofar as idea suggested is concerned.

[38] The first portion of each mark, MAX(X), can also be interpreted as a laudatory prefix. It is noted that although the first component of a mark is often considered more important for the purpose of distinction, when a word is a common, descriptive word, it is entitled to a narrower range of protection than an invented or unique word [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD) and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[39] Mr. Carinci has attested that the Mark was developed as a combination of the word MAXX and the first three letters of the surname of the Applicant's President (Norbert Marocco). However, as that would not be obvious to the typical purchaser/consumer, it is of no assistance to the Applicant.

[40] Overall, the degree of resemblance between the marks favours the Opponent.

*other surrounding circumstances*

[41] A number of other surrounding circumstances have been raised by the parties.

[42] The Applicant has submitted that the lack of evidence of confusion indicates that confusion is not likely. Although an adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of confusion has been given by the opponent [*Christian Dior SA v Dion Neckwear Ltd* 2002, 20 CPR (4th) 155 (FCA)], in the present case there is no evidence of extensive concurrent use.

[43] The Applicant attempted to introduce state of the register evidence through paragraph 7 of Mr. Carinci's affidavit but as indicated above such evidence is inadmissible. Mr. Carinci did however introduce some evidence of the state of the marketplace. In paragraphs 12-18, he provides some information concerning other parties selling clothing under marks/names that include the formative MAX, for example there are clothing stores in Toronto called MAXIMUM WOMAN, MAXI, MAXINE'S and MAXDONNA. However, Mr. Carinci's evidence is not of

much assistance to the Applicant's case, both because it is limited in volume and because none of the other MAX marks/names evidenced by him are as similar to MAX MARA as is MAXXMAR.

[44] Mr. Caroggio has introduced some evidence concerning the Opponent's mark being extensively used and promoted outside Canada, but that is not relevant in this proceeding. Similarly, his evidence that the MAX MARA mark has been included in lists of famous trademarks in China, Japan, Indonesia and the Philippines is not relevant. It is the mark's reputation in Canada that is relevant.

[45] The Opponent has argued that it is not uncommon for fashion designers to expand the use of their brands to a variety of wares including shutters and blinds. In support of such an argument, its agent had one of its employees, Ms. McKenzie, conduct Internet searches for references to Ralph Lauren, Tommy Hilfiger and Versace, who she refers to as "fashion designers". Ms. McKenzie provides printouts from the Internet that she states include references to "Ralph Lauren window hardware, Tommy Hilfiger curtains and Versace lamps, household linens, furniture and marbles." It is not evident that all of these items can be purchased in/from Canada. More importantly, there is no evidence that any of these names are also associated with clothing.

[46] The McKenzie evidence appears to raise the concerns expressed in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada* (2006), 53 CPR (4th) 286 (FCA), affg (2005), 43 CPR (4th) 21 (FC), but if I nevertheless consider her evidence, I find that it does not assist the Opponent. There is no evidence that the Opponent has any intention to expand the use of its mark beyond clothing and accessories, let alone to wares as remote as window shutters and blinds. Nor does it seem reasonable to conclude that the average Canadian purchaser/consumer would expect it to range so far afield. While it might be true that some famous fashion designers have extended their brands to household wares, the evidence presented on this point is slight at best. Moreover, there is no evidence that there is a famous fashion designer whose name is Max Mara. In the event that I was wrong to not consider Ms. Palmer's evidence, I will note that the first few registrations that she reported for marks that allegedly cover both clothing and window

coverings were SEARS, EATON's, and THE BAY, in other words large department stores (not fashion designers) who are known to sell a wide variety of wares.

[47] Ms. McKenzie also purchased fashion magazines, namely *Vogue*, *In Style*, *Fashion*, *Elle* and *Chatelaine*, from which she provides articles/advertisements pertaining to household furnishings. I do not find this evidence to be significant. I should also mention that Ms. McKenzie provided pages from the website of "the retail store La Maison Simons" advertising home fashions, but window blinds/shades do not appear on these pages.

*conclusion re section 12(1)(d) ground*

[48] Having considered all of the surrounding circumstances, I have concluded that there is not a reasonable probability of confusion between the marks at issue. It is true that the marks are quite similar and that in most instances the degree of resemblance between the trade-marks is the most crucial factor in determining the issue of confusion [*Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70]. However, based on the evidence the Opponent's mark is not famous in Canada; in these circumstances, I cannot conclude that it is entitled to a scope of protection that is broad enough to preclude the registration of the Mark given the distinct differences between their associated wares and services.

[49] The Opponent has correctly pointed out that it is possible for confusion to be likely even when parties' wares are not of the same general class. However, as stated in *Mattel* at paragraph 71, "given the role and function of trade-marks, [a difference in wares] will generally be an important consideration."

[50] In my view, the Opponent has not established a tangible connection between any of its wares and services (including its "clothing and accessories") and the Applicant's "window shutters and blinds". The wide disparity between the parties' wares/services coupled with the slight differences between the two marks suffices to meet the Applicant's legal burden. Prospective consumers will likely *not* infer that whoever owns the MAX MARA clothing trade-mark is associated in some way with the window shutters and blinds identified by the MAXXMAR mark.

[51] For the foregoing reasons, the section 12(1)(d) ground of opposition is dismissed insofar as it relies on registrations No. TMA496,128 and TMA559,110. Moreover, as the Opponent's other registrations do not present it with a stronger case, the section 12(1)(d) ground is dismissed in its entirety.

#### Section 38(2)(c)/16 Grounds of Opposition

[52] The Opponent has pleaded that the Applicant is not entitled to registration of the Mark because at the date of first use claimed in the application, the Mark was confusing with i) one or more of the Opponent's MAX MARA Trade-marks, which have been previously used in Canada by the Opponent, ii) one or more of the Opponent's MAX MARA Trade-marks, for which applications for registration had been previously filed in Canada by the Opponent, and iii) the Opponent's trade-name, Max Mara, which had been previously used in Canada by the Opponent.

[53] The second arm of the pleading fails because not one of the applications for the MAX MARA Trade-marks was pending when the application was advertised, each of such applications having already issued to registration (see section 16(4)).

[54] If the Opponent has met its initial burden with respect to the first and third arms of this ground of opposition, then the ground fails for reasons similar to those set out under the discussion of the section 12(1)(d) ground of opposition. In fact the Opponent's case is weaker under section 16 than it is under section 12(1)(d) to the extent that some of the Opponent's evidence does not predate the Applicant's date of first use.

[55] The section 16 ground is accordingly dismissed in its entirety.

#### Distinctiveness Ground of Opposition

[56] The Opponent has pleaded that the Mark is not distinctive in that it does not distinguish, nor is it adapted to distinguish, the wares of the Applicant from the wares and services of the Opponent because the Mark is confusing with the Opponent's Max Mara trade-name and/or one or more of the Opponent's MAX MARA Trade-marks.

[57] The material date for assessing confusion under this ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. If the Opponent has met its initial burden, then this ground fails for the same reasons that the section 12(1)(d) ground failed. In fact the Opponent's case is weaker under this ground than it is under section 12(1)(d) to the extent that some of the Opponent's evidence does not predate the filing of the statement of opposition.

[58] The distinctiveness ground is accordingly dismissed in its entirety.

#### Disposition

[59] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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