

**IN THE MATTER OF AN OPPOSITION
by The Proctor & Gamble Company
to application no. 788,370 for the trade-
mark MAX & CO. filed by Max Mara Fashion
Group S.r.l.**

On July 21, 1995 the applicant Max Mara Fashion Group S.r.l. filed an application to register the trade-mark MAX & CO. based on use and registration of the mark in Italy in association with a number of cosmetic products and wearing apparel. The Examination Section of the Trade-marks Office raised an objection to the description of some of the wares, which objection the applicant overcame by amending its application. The amended wares read as follows:

1(a). cosmetics, namely bath gel, bath oils, bath powders, bath salts (non-medicated), beauty masks, body creams, body oils, body powders, colognes, compacts, cosmetic 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, body and hair lotions, massage oils, essential oils, perfumes, toilet waters, moisturizers, dentifrices,

1(b). jewels, precious stones and imitation thereof, watches, clocks, wrist watches, pocket watches, electric clocks, electric watches and clocks, watch chains, alarm clocks, table clocks, wall clocks, hall clocks, measuring watches, stop watches, dial plate and watch bands,

2. spectacles, glasses, sunglasses, lenses, spectacle cases and holders, spectacle frames, chains, parts and fittings for all the aforesaid goods,

3. leather and imitations of leather, articles of luggage, namely bags, briefcases, hand bags, rucksacks, travelling bags and trunks for travelling, holdall, namely cases and holders (sold empty) for toilet articles, stationery articles and books, key cases and holders for business cards and credit cards, wallets and purses, all being of leather or imitation of leather, animal skins, hides, umbrellas, parasols, walking sticks, whips, harness, saddlery, textile goods being pieces of cloth, bed sheets, blankets, bed covers, pillow cases, table covers, napkins, towels and dishcloths.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 14, 1996 and was opposed by the Proctor & Gamble Company on January 14, 1997. A copy of the statement of opposition was forwarded by the Registrar to the applicant on February 3, 1997. The applicant replied by filing and serving a counter statement.

The first ground of opposition alleges that the applied for mark is not registrable, pursuant to Section 12(1)(d) of the *Trade-marks Act*, because it is confusing with one or more of the opponent's registered marks namely, MAX FACTOR, registered in 1967 under no. 149, 555; MAX FACTOR NAIL THICK, registered in 1992 under no. 405,801; and MAX FACTOR HOLLYWOOD & Design, registered in 1946 under no. NFLD002839. I note that the marks MAX FACTOR and MAX FACTOR HOLLYWOOD & Design cover a number of personal care and grooming products such as makeup, body lotions, soaps and shampoos while registration no. 405,801 covers only "nail top coat."

The second ground of opposition alleges that the applicant is not entitled to register the applied for mark because at the date of filing namely, July 21, 1995, the applied for mark was confusing with the opponent's trade-mark MAX FACTOR INTERNATIONAL & Design, application no. 773,934 (filed on January 27, 1995), shown below, covering a number of cosmetic and personal care products.

MAXFACTOR
INTERNATIONAL

Lastly, the opponent alleges that he applied for mark MAX & CO. is not distinctive of the wares of the applicant.

The opponent defaulted to file evidence pursuant to Section 41 of the *Trade-marks Regulations*, however, the opponent requested and was granted leave, under protest from the applicant, to file evidence under Section 44 of the *Regulations*: see the Board ruling dated June 9, 1998. At the oral hearing, the applicant again took issue with Board rulings (dated February 26, March 31 and June 9, 1998) which permitted the opponent to submit evidence rather than deem the opposition withdrawn on the basis that the opponent defaulted to comply with Section 41(1) of the *Regulations*. I have reviewed the Board rulings on this matter and I do not see that the Board was clearly wrong in law or that the rulings were made in disregard of the record material.

The opponent's evidence consists of the affidavits of Esther Benzie, Brand Manager for the mark MAX FACTOR; Susan Lo Re, trade-mark clerk; and Peter Stabins (two affidavits), articling student. The applicant filed as its evidence certified copies of several trade-mark registrations and one application wherein the term MAX comprises a portion of the mark; the affidavit of Luigi Maramotti and the affidavit of Janice Stevenson, secretary. The applicant was unable to provide Mr. Maramotti for cross-examination and consequently his affidavit was returned to the applicant pursuant to Section 44(5) of the *Trade-marks Regulations*: see the Board ruling dated Mach 11, 2002. Both parties filed a written argument and both parties were represented at an oral hearing.

Ms. Benzie's evidence may be summarized as follows. Max Factor was a make-up artist in the early days of Hollywood film-making. He began selling his make-up products to the public in 1909. Max Factor & Co. was incorporated in the United States in 1929 and in Canada in 1940. At present, Max Factor & Co. is a wholly owned subsidiary of Noxell Corporation which is a wholly owned subsidiary of the opponent. Cosmetic products bearing the mark MAX FACTOR have been sold in Canada since 1940. The applicant's products, prominently featuring the mark MAX FACTOR, are sold through retail outlets such as pharmacies, mass merchandisers and department stores. Since 1991 the opponent has provided stores with promotional items such as posters, brochures and cubes featuring the mark MAX FACTOR to display alongside the opponent's products. Peter Stabins' affidavit testimony confirms that MAX FACTOR brand products are readily available in and around the City of Toronto. His evidence also indicates that the component MAX has not been commonly adopted by third party traders, at least in and around the area of Toronto, for trade-marks used in association with body, cosmetic or fragrance products.

The opponent has sold cosmetics through retail outlets in Canada under its marks MAX FACTOR since 1991 and MAX FACTOR INTERNATIONAL & Design since 1993. The dollar value of such sales were \$ 3.9 million US in 1991, and averaged about \$6.8 million US annually for the period 1992 - 1998 inclusive. Over the period 1991 - 1998 unit sales totalled about 15 million. The opponent's primary method of advertising its MAX FACTOR products is through television although some print advertising is also done. The opponent's advertising expenditures averaged about \$3 million Cdn annually for the period 1991 - 1997. There are some hearsay

aspects to Ms. Benzie's affidavit testimony, however, no hearsay objections were raised by the applicant. In any event, the outcome of this case is not affected by whether or not the hearsay aspects of her evidence are taken into account.

Ms. Re's affidavit serves to introduce into evidence a TRADEMARK SCAN database search for marks comprised in whole or in part of the component MAX. Ms. Re provides no analysis of the search results except to note that 160 records were located.

Ms. Stevenson's affidavit indicates that cosmetic products sold under the mark MAX Design, ROBERT MAX & Design and MAXTRA are available through Robert Max Products Ltd. located in Vancouver. The manner of use of the above noted marks is shown below:

The applicant has not submitted any evidence which would indicate the extent to which the public may be familiar with the above marks.

The determinative issue raised by the pleadings is whether the applied for mark MAX &

CO. is confusing with the opponent's mark MAX FACTOR. The material times to assess the issue of confusion is the date of decision with respect to the first ground of opposition alleging non-registability (see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A)), (ii) the date of filing of the application namely, July 21, 1995, in respect of the ground of opposition alleging non-entitlement (see Section 16(2) of the *Trade-marks Act*), (iii) the date of filing the statement of opposition, in this case January 14, 1997 in respect of the ground of opposition alleging non-distinctiveness (see *Re Andres Wines Ltd.*, above, and *Park Avenue Furniture Corp.*, above). In the circumstances of this opposition proceeding, nothing turns on whether the issue of confusion is decided at any particular material date.

The legal onus is on the applicant to show, on a balance of probabilities, that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Act*, between the applied for mark MAX & CO. and the opponent's mark MAX FACTOR. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of

the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The opponent's mark MAX FACTOR possesses little inherent distinctiveness since it would be perceived as the name of a real or fictitious person. However, the opponent's mark has been used extensively in Canada prior to the earliest material date and I am prepared to find that the mark MAX FACTOR had acquired a significant reputation in Canada at all material times in connection with cosmetic products. The applied for mark MAX & CO. possesses little inherent distinctiveness as the dominant portion of the mark would be perceived either as the name of a person or as a laudatory term formed by truncating the word "maximum." The subject application for MAX & CO. is based on use and registration abroad and there is no evidence that the applied for mark had become known in Canada at any material date. Accordingly, the extent to which the parties' marks have become known in Canada favours the opponent.

The opponent's unchallenged evidence is that its mark MAX FACTOR has been used in Canada since 1940. Thus, the length of time that the marks in issue have been in use favours the opponent. The parties' wares are the same or closely related in respect of cosmetic and personal care products. In the absence of evidence to the contrary, I will take it that the parties' channels of trade would also be the same or overlapping in respect of cosmetic and personal care products,

but different with respect to the remaining wares specified in the subject application.

The marks in issue resemble each other visually and aurally as the component MAX forms the prefix of each mark. In this regard, it is generally accepted that the prefix component of a mark is the most important for the purpose of distinguishing between marks: see, for example, *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 46 C.P.R.(2d) 183 at 188 (F.C.T.D.), and *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 at 370 (F.C.T.D.). However, the marks in issue suggest different ideas, the opponent's mark suggesting a person's full name while the applied for mark suggests the first name of a person or a laudatory expression meaning "the best."

The applicant in its written argument argues that the Re affidavit establishes common use of the term MAX as a component of a significant number of trade-marks owned by a variety of third parties for use in association with cosmetics, toiletries, and personal care products. However, the applicant has not provided an analysis of the search results to support its claims, and I do not see that it is my function to pore over the voluminous and unwieldily material to confirm whether the applicant is correct. My own brief review of the search results reveals, for example, the marks OSTEOMAX for vitamins and nutritional supplements (record 3); \$MAX (record 20) and MAXADE (record 38) for dishwashing and laundry soaps and the like; SANS VAPEURS MAX for oven cleaner (record 54); MARY MAXIM for clothing and the like; and BLUE MAX for cleaning and waxing compounds (record 135). In view of the above, I have not accepted the applicant's submission that the component MAX is commonly found as a

component of marks for cosmetics and the like.

Having regard to all of the above, I find that the applicant has not 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 MAX & CO. and the opponent's mark MAX FACTOR, at any of the material dates, in respect of the cosmetic and personal care products specified in the subject application (that is, group 1(a) referred to earlier) namely:

cosmetics, namely bath gel, bath oils, bath powders, bath salts (non-medicated), beauty masks, body creams, body oils, body powders, colognes, compacts, cosmetic 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, body and hair lotions, massage oils, essential oils, perfumes, toilet waters, moisturizers, dentifrices.

The subject application is therefore refused in respect of the above-noted wares.

Further, I find that 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 MAX & CO. and the opponent's mark MAX FACTOR, at any of the material dates, in respect of the remaining wares specified in the subject application . The opposition is therefore rejected in respect of the remaining wares namely, groups 1(b), 2 and 3 referred to earlier. Authority for a

divided decision is found in *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.).

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 9th DAY OF March, 2004.

Myer Herzig,
Member,
Trade-marks Opposition Board