

**IN THE MATTER OF AN OPPOSITION
by Superkids Karate Inc. to application No. 809,995
for the trade-mark CANADA'S BEST KARATE &
Design filed by Canada's Best Karate Inc.**

On April 16, 1996, the applicant, Canada's Best Karate Inc., filed an application to register the trade-mark CANADA'S BEST KARATE & Design (shown below) based on proposed use with the following wares:

clothing, namely T-shirts, sweatshirts, uniforms, crests, ribbons, sleepwear, kimonos, jackets, coats; audio tapes and records, books, manuals, newsletters, brochures, pamphlets, audio videotapes, posters; training equipment, striking equipment and protective equipment namely, blockers, pads, helmets and gloves for chest, hand and head

and with the following services:

provision of karate, martial arts and self defence instruction, education, seminars, classes, competitions, demonstrations, accreditation and grading; entertainment services namely, competitions, school, television and radio programs relating to karate, martial arts and self defence.

The application as filed and as advertised contained the following color claim:

The applicant claims the colours red, white and blue as features of the mark as follows: the background in the upper left portion of the design behind the man configuration is red; the background in the lower right portion of the design, behind the man configuration is blue; the words CANADA'S BEST KARATE are blue; the man design and the leaf design are white.

The application was amended to include a disclaimer to the words CANADA, BEST and KARATE. The application was subsequently advertised for opposition purposes on February 26, 1997.



The opponent, Superkids Karate Inc., filed a statement of opposition on July 28, 1997 and a revised statement of opposition on September 22, 1997. A copy of the revised statement was forwarded to the applicant on November 12, 1997.

The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(i) of the Trade-marks Act because the applicant knew or ought to have known of the existence of the opponent's well known trade-marks. The second ground is that the applicant is not the person entitled to registration of the applied for mark pursuant to Section 16(3) of the Act because, as of the applicant's filing date, it was confusing with the trade-marks SUPERKIDS & Design (shown below) and WE TEACH KIDS TO FLY & Design previously used in Canada by the opponent with wares and services similar to those set out in the applicant's application. The third ground of opposition is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's two trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of its President, Wally Slocki. As its evidence, the applicant submitted an affidavit of its President, Bob Mueller and an affidavit of Ben Bundle, a trade-mark searcher. Only the applicant filed a written argument and no oral hearing was conducted.

The first ground does not raise a proper ground of opposition. The mere fact that the applicant may have been aware of the opponent's trade-marks does not support a ground of non-conformance with the provisions of Section 30(i) of the Act. The opponent did not allege that the applicant was aware that its applied for mark was confusing with the opponent's marks. Thus, the first ground is unsuccessful.

As for the second ground of opposition, there was an initial burden on the opponent to evidence use of one or both of its trade-marks prior to the applicant's filing date. As for the trade-mark WE TEACH KIDS TO FLY & Design, the opponent did not adequately identify that mark in its revised statement of opposition. In paragraph 1.(a) of the revised statement of opposition, the opponent refers to Schedules A, B and C to identify that mark. However, none of those schedules identifies any mark which includes the words WE TEACH KIDS TO FLY. Furthermore, the Slocki affidavit fails to evidence use of the mark WE TEACH KIDS TO FLY & Design at any time. Thus, that aspect of the second ground is unsuccessful.

As for the opponent's trade-mark SUPERKIDS & Design, Schedule A to the revised statement of opposition includes a representation of that mark. In his affidavit, Mr. Slocki refers to various flyers, brochures and booklets distributed by his company in the Toronto area or in southern Ontario. Most of those materials were distributed after the applicant's filing date. However, some of the materials bearing the trade-mark SUPERKIDS & Design were distributed prior to that time. Thus, I find that the opponent has evidenced use of its trade-mark SUPERKIDS & Design in association with the services of providing martial arts instruction prior to the material time. However, the Slocki affidavit fails to evidence use of that mark with wares prior to the applicant's filing date.

In view of the above, the second ground remains to be decided on the issue of confusion between the applicant's mark CANADA'S BEST KARATE & Design and the opponent's mark SUPERKIDS & Design. The material time for considering the circumstances respecting this issue is the applicant's filing date. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set out in Section 6(5) of the Act.

As for Section 6(5)(a) of the Act, the applicant's mark is inherently distinctive in relation to its applied for wares and services. However, the words CANADA'S BEST KARATE and the representation of a karate participant are descriptive of those wares and

services. Thus, the applicant's mark is inherently weak. As of the material time, the applicant's mark had not been used or advertised and therefore had not become known at all in Canada.

The opponent's mark SUPERKIDS & Design is also inherently distinctive. Similarly, though, the use of the descriptive words SUPERKIDS and KARATE and the descriptive representation of two karate participants points to the inherent weakness of the opponent's mark. As of the material time, the opponent had evidenced some minor advertising of its trade-mark in the Toronto area and in southern Ontario. Thus, I am only able to conclude that the opponent's mark had become known to a limited extent in that region as of the applicant's filing date.

The length of time the marks have been in use is not a material circumstance in the present case. The opponent's services are the same as the applicant's services and are closely related to the applicant's wares. The Slocki and Mueller affidavits show that the parties are in the same trade, namely the operation of martial arts schools.

As for Section 6(5)(e) of the Act, there is little resemblance between the marks at issue in any respect. Although both marks include the word KARATE and a representation of one or more karate participants, those elements are non-distinctive and open to all traders in the field to use. The other elements of the marks bear no resemblance at all.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the inherent weakness of both marks, the absence of any significant reputation for the opponent's mark and the low degree of resemblance between the two marks, I find that the applicant's mark is not confusing with the opponent's trade-mark. Thus, the first aspect of the second ground of opposition is also unsuccessful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares and services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - July 28, 1997): see Re 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) 412 at 424 (F.C.A.).

Given the absence of evidence of any reputation for the opponent's mark WE TEACH KIDS TO FLY & Design, the third ground essentially turns on the issue of confusion between the applicant's mark and the opponent's mark SUPERKIDS & Design. My conclusions respecting this issue for the second ground of opposition are also applicable, for the most part, to the third ground. The only difference of note is that the Slocki affidavit evidences additional distributions of flyers and the like bearing the opponent's mark in southern Ontario after the applicant's filing date but prior to the filing of the present opposition. However, that additional evidence is not extensive. Thus, I find that the marks at issue were not confusing as of the filing of the opposition. The third ground is therefore also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 4th DAY OF MAY, 2001.

David J. Martin,
Member,
Trade Marks Opposition Board.