

**IN THE MATTER OF AN OPPOSITION  
by Suzuki Motor Corporation to application  
No. 740,761 for the trade-mark SIDEKICK  
filed by Sahara Corp. Ltd. and subsequently  
assigned to Lisco Furniture, Inc.**

**On November 8, 1993, Sahara Corp. Ltd. filed an application to register the trade-mark SIDEKICK for “booster car seats” based on proposed use in Canada. The application was advertised for opposition purposes on June 8, 1994 and was subsequently assigned to Lisco Furniture, Inc. The statement of wares was amended to read: “portable booster car seats.”**

**The opponent, Suzuki Motor Corporation, filed a statement of opposition on October 20, 1994, a copy of which was forwarded to the applicant on January 6, 1995. The opponent was granted leave to amend its statement of opposition on February 6, 1997.**

**The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30(i) of the Trade-marks Act. In this regard, the opponent alleged that the applicant could not have been satisfied that it was entitled to use its mark in view of the prior use and registration of the opponent’s mark SIDEKICK.**

**The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the opponent’s trade-mark SIDEKICK registered under No. 369,331 for “automobiles.” The third ground is that the applicant is not the person entitled to registration of the applied for mark pursuant to Section 16(3)(a) of the Act because, as of the applicant’s filing date, the applied for trade-mark was confusing with the trade-mark SIDEKICK previously used in Canada with automobiles by the opponent. The fourth ground is that the applied for trade-mark is not distinctive in view of the opponent’s use of its trade-mark.**

**The applicant filed and served a counter statement. As its evidence, the opponent submitted the affidavits of Robert Chapman and Robert Graham. As its evidence, the applicant submitted an affidavit of Sylvia McIntyre and a certified copy of a third party registration (No. 209,886) for the trade-mark SIDEKICKS for “automotive exhaust systems**

and mufflers.” Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

As for the first ground of opposition, it does not raise a proper ground since the opponent did not allege that its mark was confusing with the applicant’s mark or that the applicant was aware of such confusion. Thus, the first ground is unsuccessful. If I am wrong in this conclusion, then success or failure of the first ground is contingent on a finding of confusion between the marks at issue.

At the oral hearing, the opponent’s agent submitted that the opponent’s evidential burden respecting its first ground was met by the fact that the original applicant, Sahara Corp. Ltd., assigned the present application and thus could not have had the requisite intention to use the applied for mark. I disagree since the opponent failed to rely on any such allegation in support of its first ground. In any event, it is not apparent how such an assignment by itself would affect the truth of the original applicant’s statement that it was satisfied as to its entitlement to use the trade-mark as of the filing of the application. While it is arguable that a proposed use application cannot be assigned because one cannot assign a mere intention to use, such an allegation would tend to support a ground of non-compliance with Section 30(e) of the Act rather than Section 30(i).

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, 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 forth in Section 6(5) of the Act.

The opponent’s trade-mark SIDEKICK is inherently distinctive when used in association with automobiles. The Chapman affidavit establishes that the opponent has sold

**SIDEKICK automobiles in Canada through its Canadian distributor since 1988. Sales through 1995 have totalled in excess of \$440 million which represents about 40,000 units. Mr. Chapman did not indicate what expenditures were made on advertising the opponent's mark in Canada. However, Exhibit C to his affidavit illustrates that it was advertised in several Canadian publications. It is also apparent that promotional literature for the SIDEKICK vehicle was provided to potential customers by the opponent's network of dealers throughout Canada. The Graham affidavit evidences a number of newspaper and magazine articles containing reviews of the opponent's SIDEKICK automobile. Furthermore, as noted by the opponent's agent, an automobile is a very public item such that a trade-mark appearing on it might gain additional exposure. Thus, I am able to conclude that the opponent's mark has become known to a fair extent throughout Canada.**

**The applicant's mark SIDEKICK is also inherently distinctive since it does not have any readily discernible laudatory or descriptive meaning in relation to portable booster car seats. In her affidavit, Ms. McIntyre identifies herself as Operations Manager of Evenflo Juvenile Products, a division of Spalding & Evenflo Canada Inc. She states that her company distributes SIDEKICK booster seats in Canada which are obtained from Evenflo Company, Inc., a licensee of the applicant Lisco Furniture, Inc. Canadian sales commenced in August of 1994 and by the date of her affidavit (July 19, 1996) totalled in excess of \$1,136,000 which represents more than 40,000 units. Although the trade-mark SIDEKICK appears in small letters on the name-plate affixed to the booster seat, the product label and the accompanying product literature feature the trade-mark more prominently. Advertising to date appears to have been effected primarily through the product catalogues of the retail chains which carry the applicant's products. Thus, I am able to conclude that the applicant's mark has become known at least to some extent in Canada.**

**The length of time the marks have been in use favors the opponent. The wares of the parties differ. The applicant's product is a booster car seat for children which appears to sell for about \$30. The opponent's product is an automobile which has a wholesale value of over \$10,000 and probably sells for much more. The only connection is that a booster car seat is used in an automobile. However, there is no evidence that the opponent or any other car**

makers sell booster car seats in Canada. Exhibit J to the Graham affidavit is a 1991 article from a Halifax newspaper making reference to integrated child seats. However, there is no evidence as to the extent of this feature on cars sold in Canada. More importantly, an integrated child seat is a built-in feature and not a portable booster seat.

The trades of the parties also differ. As evidenced by the Chapman affidavit, automobiles are retailed through a chain of dealers who specialize in such sales. Mr. Chapman states that the opponent sells accessories such as car radios, floor mats and roof racks for its vehicles but those accessories are also sold through the dealerships. The McIntyre affidavit, on the other hand, evidences the applicant's trade which consists of mass market retailers such as The Bay, Wal-Mart and Eatons. The materials appended to the McIntyre affidavit show that booster car seats are typically sold together with other products for infants and toddlers.

The marks at issue are identical in all respects.

As an additional surrounding circumstance, I have considered that there has been about a two year period of coextensive and not insignificant contemporaneous use of the marks at issue with no incidents of actual confusion having been evidenced by the opponent. Given the fact that the wares at issue were both sold throughout Canada in not insubstantial amounts during that period, one would have expected at least some such incidents to have arisen if confusion were to be likely.

The applicant also relied on the third party registration for SIDEKICK as a factor in this case. However, in the absence of evidence of use of that mark in the Canadian marketplace, I find that its mere existence on the register is of no significance in this proceeding.

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 differences between the wares and trades of the parties and the absence of evidence of any actual confusion, I find that the applicant has satisfied the onus on it to show that the

marks are not confusing. Given that the marks are identical and that the opponent's mark has become known to some extent in this country, it may be that some consumers seeing the mark SIDEKICK on a portable booster car seat in a retail store would think of the opponent's SIDEKICK vehicle. But it is highly unlikely that they would conclude that the applicant's product emanated from or was approved by the opponent given the wide differences in the wares and trades. Thus, the second ground is also unsuccessful.

As for the third ground of opposition, the opponent has met its initial burdens by evidencing use of its trade-mark SIDEKICK prior to the applicant's filing date and showing non-abandonment of that mark as of the applicant's advertisement date. The ground therefore remains to be decided on the issue of confusion between the marks as of the applicant's filing date. My conclusions respecting the second ground are, for the most part, also applicable here. One difference of note is that, as of the material time, the applicant's mark had not acquired any reputation in Canada because it had not yet been used. Although the period of contemporaneous use of the two marks with no evidence of actual confusion occurred after the material time, I consider that it is still relevant respecting the third ground. That period commenced only months after the material time and I consider that I can infer that the situation would have been similar as of that earlier date. Thus, I find that the marks were not confusing as of the applicant's filing date and the third ground is also unsuccessful.

As for the fourth 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 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. - October 20, 1994): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

**The fourth ground essentially turns on the issue of confusion between the applicant's mark and the opponent's trade-mark. Given my conclusions above respecting the issue of confusion respecting the second and third grounds, it also follows that the applicant's mark is not confusing with the opponent's registered mark as of the filing of the present opposition. Thus, the fourth ground is 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 15th DAY OF APRIL, 1998.**

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