



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

Citation: 2017 TMOB 41
Date of Decision: 2017-04-27

IN THE MATTER OF AN OPPOSITION

**Suisha Gardens Management
Corporation**

Opponent

and

Sushi Garden Restaurant Inc.

Applicant

1,645,800 for SUSHI GARDEN

Application

Introduction

[1] Sushi Garden Restaurant Inc. has applied to register the trade-mark **SUSHI GARDEN** (the Mark), for use in association with services which are described as “restaurant serving Japanese cuisine”. The application is based upon use of the Mark in Canada since August 1998.

[2] Suisha Gardens Management Corporation has opposed the application. Its opposition is primarily based upon an allegation that there is a reasonable likelihood of confusion between the Mark and its registered trade-mark **SUISHA GARDENS & Design** (shown below).



[3] The Opponent's registration for **SUISHA GARDENS & Design** covers "restaurant services" and claims a 1975 date of first use in Canada.

[4] For the reasons that follow, the opposition is rejected.

File History

[5] The application for the Mark was filed on September 30, 2013 and was advertised for opposition purposes in the *Trade-marks Journal* dated December 3, 2014.

[6] On January 22, 2015, the Opponent opposed the application for the Mark, by way of filing a statement of opposition. The grounds of opposition are based upon sections 30(b), 30(i), 16(1)(a), 12(1)(d) and 2 (non-distinctiveness) of the Act.

[7] On March 18, 2015, the Applicant filed a counter-statement denying each of the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavit of Frank Teshima, sworn July 16, 2015. Mr. Teshima was not cross-examined.

[9] In support of its application, the Applicant filed the affidavit of Jaekoo Lee, sworn November 16, 2015. Mr. Lee was not cross-examined.

[10] On January 7, 2016, the Applicant filed a revised application to make reference to use by its predecessor-in-title, Jaekoo Lee.

[11] Only the Applicant filed a written argument.

[12] No hearing was held.

Onus

[13] 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 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

Section 30(b) - paragraph 3(a) of statement of opposition

[14] In paragraph 3(a) of the statement of opposition, the Opponent has pleaded that the application does not comply with section 30(b) in that the Mark is not a trade-mark as defined in section 2 because any use that the Applicant has made or intends to make of the Mark is not for the purpose of distinguishing or so as to distinguish the Applicant's services and business, but rather, for the purposes of causing confusion with the Opponent's trade-mark SUISSA GARDENS & Design, which is the subject of registration No. TMA321,508. This is not a proper ground of opposition. Non-distinctiveness is properly pleaded under sections 38(2)(d) and 2 of the Act. Accordingly, this ground is rejected on the basis that it has been improperly pleaded.

Section 30(b) - paragraph 3(b) of statement of opposition

[15] In paragraph 3(b) of the statement of opposition, the Opponent has alleged non-compliance with section 30(b) of the Act on the basis that the Applicant has not used the Mark in Canada in association with its restaurant services from the date of first use claimed in the Application.

[16] The initial burden on an opponent is light respecting the issue of non-compliance with section 30(b) of the Act because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB) at 89]. An opponent can meet its initial burden under section 30(b) by reference not only to its own evidence but also to the applicant's evidence [*Labatt Brewing Company Limited v Molson Breweries, a Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, the opponent may only successfully rely upon the applicant's evidence to meet its initial burden if it can show that the applicant's evidence puts into issue the claims set forth in the Applicant's application [*Corporativo de Marcas GJB, SA de CV v Bacardi &*

Company Ltd 2014 FC 323 at paras 30-38 (CanLII); *Garbo Group Inc v Glamour Secrets Pro Inc*, 2016 TMOB 59 (CanLII) at para 48].

[17] In this case, the Opponent has not provided any evidence to support its section 30(b) ground of opposition, nor has the Applicant filed any evidence from which it may reasonably be concluded that facts alleged to support its section 30(b) ground of opposition exist. Accordingly, this ground of opposition is rejected as a result of the Opponent's failure to meet its evidential burden.

Section 30(i) – paragraph 3(c) of statement of opposition

[18] Section 30(i) of the Act merely requires that an applicant include a statement in its application that it is satisfied that it is entitled to registration of its trade-mark. Where this statement has been provided, 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 [*Sapodilla Co Ltd v Bristol Myers Co* (1974), 15 CPR (2d) 152 (TMOB)]. The application for the Mark contains the requisite statement and there is no evidence that this is an exceptional case. Accordingly, this ground of opposition is also rejected.

Section 16(1)(a) – paragraphs 3(e)(i)-(iii) of the statement of opposition

[19] In paragraphs 3(e)(i)-(iii) of the statement of opposition, the Opponent has essentially pleaded that the Applicant is not the person entitled to registration of the Mark because, contrary to section 16(1)(a), the application does not comply with sections 30(i), 30(b), and 2 of the Act. Section 16(1)(a) of the Act relates to non-entitlement based upon confusion, not based upon non-compliance with the Act or non-distinctiveness, which are properly the subject of independent grounds of opposition under sections 38(2)(a) and 38(2)(d) of the Act. Accordingly, these grounds of opposition are rejected on the basis that they have been improperly pleaded.

Analysis of Remaining Grounds of Opposition

Section 12(1)(d) – paragraph 3(d) of the statement of opposition

[20] In paragraph 3(d) of the statement of opposition, the Opponent has pleaded that “the Applicant’s Mark is not registrable because, contrary to section 12(1)(e), the Applicant’s Mark is confusing with the Opponent’s Mark”.

[21] I note that the reference to section 12(1)(e) of the Act in this ground of opposition appears to be incorrect, as section 12(1)(e) of the Act relates to prohibited marks, not confusion with a registered trade-mark, which is what is covered by section 12(1)(d) of the Act. This observation was also made by the Applicant in its written argument.

[22] While the statement of opposition references section 12(1)(e) of the Act, the Opponent does clearly allege that the Mark is not registrable because it is confusing with the “Opponent’s Mark”. Furthermore, I note that the “Opponent’s Mark” has been defined in paragraph 2 of the statement of opposition, as the Opponent’s registered trade-mark SUISSHA GARDENS & Design (TMA321,508). I further note that the Opponent’s evidence also identifies the SUISSHA GARDENS & Design registration and purports to show use and promotion of that trade-mark in Canada.

[23] Given that the sufficiency of the pleadings is to be assessed in association with the evidence filed [*Novopharm Limited v AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA)], and considering the statement of opposition as a whole, I am satisfied that the reference to 12(1)(e) was a typographical error which should be read as 12(1)(d). I am therefore prepared to consider this ground of opposition.

[24] The material date for assessing a non-registrability ground under section 12(1)(d) of the Act is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and the Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[25] I have exercised the Registrar’s discretion to confirm that the Opponent’s registration No. TMA321,508 for the trade-mark SUISSHA GARDENS & Design, is extant. On this basis, the Opponent has met its initial evidentiary burden under this ground [*Quaker Oats Co. of*

Canada Ltd./Cie Quaker Oats of Canada Ltee v Menu Foods Ltd. (1986), 11 CPR (3d) 410 (TMOB)].

[26] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and the Opponent's registered trade-mark.

[27] 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[28] 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 goods, 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 [*Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[29] The Mark is an inherently weak mark. The Applicant voluntarily disclaimed “sushi” and “garden”, in its application. By its own admission, the Applicant chose SUSHI GARDEN as its trade-mark because “sushi” represents the type of food that its restaurants primarily sell (Lee Affidavit, para 5). With respect to the word “garden”, I note that it is also somewhat descriptive. In this regard, I note that one definition for “garden”, is “an open-air eating or drinking place” [see *Merriam-Webster Dictionary*, online at www.merriam-webster.com; see also *Tradall SA v Devil's Martini Inc* 2011 TMOB 65 (CanLII), 92 CPR (4th) 408 (TMOB) at

para 29 which confirms that I may take judicial notice of dictionary definitions]. Accordingly, I do not consider the Mark to possess a high degree of distinctiveness.

[30] The Opponent's trade-mark SUISSHA GARDENS & Design is somewhat more inherently distinctive, owing to the first component SUISSHA and the design aspect of the mark. While the evidence indicates that SUISSHA is the Japanese word for 'waterwheel' [Lee affidavit, Exhibits B and C], there is no evidence that Canadian consumers would be aware of such meaning. It seems more likely that SUISSHA would be seen as a coined term. Either way, I am of the view that this component, along with the waterwheel design renders the Opponent's mark more inherently distinctive than the Mark.

[31] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[32] Both the Opponent and the Applicant filed evidence of use of their respective marks.

[33] The Opponent filed the affidavit of Frank Teshima, the president of the Opponent. Mr. Teshima states that he has had direct and extensive involvement in all of the business operations of the Opponent since its incorporation on June 4, 1979 (paras 1-4). According to Mr. Teshima:

- the Opponent currently operates a restaurant located in Niagara Falls, Ontario, under the name "Suisha Gardens" (paragraph 5).
- the Opponent registered the trade-mark SUISSHA GARDENS & Design in Canada on December 5, 1986 under registration No. TMA321,508 in association with "restaurant services" (para 6). The Opponent has used the SUISSHA GARDENS & Design trade-mark, the word mark SUISSHA GARDENS and various other SUISSHA GARDENS logos in Canada for approximately 40 years in association with restaurant services (paras 7 and 8).
- the Opponent has used and displayed its various trade-marks in Canada on its website, Facebook and Twitter, in Youtube videos, on restaurant menus, and in newspaper and billboard advertisements (para 9). The following exhibits are attached to Mr. Teshima's affidavit:
 - Exhibit 1: the front and back of Mr. Teshima's business card which he states he has used since at least as early as July 2001. I note that the

Opponent's registered trade-mark SUISHA GARDENS & Design appears on the card.

- Exhibit 2: a printout of the home page from the Opponent's website, dated July 9, 2015. The Opponent provides no indication as to when the website launched, nor is there any indication of the number of visits to the website by web users in Canada at any time. Notably, a different version of the Opponent's registered trade-mark appears in the print-out.
- Exhibit 3: a printout of the Opponent's Facebook home page dated July 9, 2015. There is no indication of the number of visits to the page by web users in Canada. Notably, a different version of the Opponent's registered trade-mark appears in the print-out.
- Exhibit 4: a printout of the Opponent's Twitter home page dated July 9, 2015. The Twitter feed Suisha Gardens (@SuishaGardens) appears to have 21 followers; there is no indication if any are Canadian web-users. Notably, a different version of the Opponent's registered trade-mark appears in the print-out.
- Exhibits 5 through 8: printouts of shots of videos posted on YouTube.com by the Opponent. There is no indication of when the videos were shot or posted, nor is there any information on the number of viewers in Canada. Of note, Exhibit 6 appears to show the front of the Opponent's restaurant. There is visible signage featuring a modified version of the Opponent's registered trade-mark.
- Exhibit 9: a printout of a picture of a billboard advertisement, which Mr. Teshima states is situated at the "busiest tourist corner" in Niagara Falls (Victoria Ave and Clifton Hill)". Mr. Teshima asserts that the advertisement has been continuously in place at this location since 2011. Once again, the advertisement features a different version of the Opponent's registered trade-mark.
- Exhibit 10: a picture of the menus currently in use at the Opponent's restaurant in Niagara Falls. Once again, the advertisement features a different version of the Opponent's registered trade-mark.
- Exhibit 11: a copy of an old menu used at the Opponent's restaurant in Niagara Falls. The menu states – 'Celebrate the New Year '91 '92' 'New Year's Eve Special Dinner Menu'. Once again, the advertisement features a different version of the Opponent's registered trade-mark.
- Exhibit 13: a sample invoice for advertisements placed by the Opponent in the Niagara Dining Guide Tourist (Summer 2014) Edition. The Opponent advises that the dining guides were placed in the Hilton, Sheraton Fallsview, Embassy Suites, Marriott Fallsview, and other

major hotels, and that the number of Dining Guides circulated with the advertisement was approximately 100,000. The advertisements also feature a modified version of the Opponent's registered trade-mark.

[34] I note that the Opponent has only referenced and relied upon its trade-mark SUISSA GARDENS & Design, which is the subject of registration No. TMA321,508 in its statement of opposition. However, the exhibits attached to Mr. Teshima's affidavit suggest that there has been very little use of the trade-mark as registered. Rather, the exhibits show use of various modified versions of the mark.

[35] While that may be so, I am of the view that at least some of the marks depicted in the exhibits (for example, Exhibits 3, 5, 6, 9, 10 and 13) would constitute use of the Opponent's registered trade-mark [*Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltee v Munsingwear Inc.*, 44 CPR (3d) 59 (FCA); *Nightingale Interloc Ltd v Prodesign Ltd.* (1984), 2 CPR (3d) 535 (FCTD)].

[36] According to Mr. Teshima, approximately 70,000 patrons have dined at the Opponent's restaurant in the previous 5 years (paragraph 11). Notably, the Opponent does not provide any sales figures covering this or any other period.

[37] In paragraph 12 of his affidavit, Mr. Teshima asserts that the Opponent has advertised its restaurant business extensively, and as a result of its advertising efforts, the Opponent's restaurant and its trade-marks are well-known in Canada. To support this assertion, Mr. Teshima attaches window stickers sent to the Opponent for display from TripAdvisor, Yelp, and Lonely Planet (Exhibits 14, 16 and 18). According to Mr. Teshima, these window stickers are only supplied to businesses recommended by consumers.

[38] Also attached to Mr. Teshima's affidavit, are print-outs from the TripAdvisor and Yelp websites (Exhibits 15 and 17) showing consumer reviews. The third party sites in Exhibits 15 and 17 identify the Opponent's Suisha Gardens restaurant located at 5701 Lewis Avenue, Niagara Falls, Ontario (the address referenced on Mr. Teshima's business card at Exhibit 1). Of note, neither site displays the Opponent's trade-mark. Moreover, while these print-outs may arguably demonstrate the presence of consumer reviews on the internet, due to hearsay issues, I

am unable to rely on the printouts for the truth of their contents and I do not consider the evidence to be particularly reliable.

[39] Mr. Teshima includes as Exhibit 19 an article in the Toronto Star dated July 7, 2004 referencing the Suisha Gardens restaurant as a 'Japanese food emporium'. The article does not depict the Opponent's SUISHA GARDENS & Design trade-mark. Mr. Teshima asserts that the cooking technique referred to in the article is shown in a number of Youtube videos which have gained close to 8,000 views (see paragraph 19). It is unclear what, if any, specific videos he is referring to, but in any event, he does not indicate that the Opponent's trade-mark is advertised in these videos, nor does he indicate how many of the 8,000 views were made by Canadians.

[40] Attached as Exhibit 20 to Mr. Teshima's affidavit is an advertisement for a fundraising event hosted by the Opponent at its restaurant in April 2011 to aid in the 2011 Japan earthquake and tsunami relief efforts. No information on the number of attendees is provided. I further note that the advertisement does not bear the Opponent's trade-mark.

[41] Based on a fair reading of Mr. Teshima's affidavit as whole and having regard to the accompanying exhibits, I am prepared to infer that the Opponent's trade-mark SUISHA GARDENS & Design, used in association with restaurant services, has acquired some reputation in Canada, at least in more recent years. However, in the absence of more quantitative evidence, like sales and advertising figures and more qualitative evidence, like additional examples and information pertaining to interior and/or exterior signage, examples of other promotional materials and precise dates for what has been provided, I am unable to conclude that the Opponent enjoys a substantial reputation in its trade-mark.

[42] I will now turn to the Applicant's evidence, which consists of the Lee affidavit. Mr. Lee is the president and a director of the Applicant (para 1). Mr. Lee asserts that he has been directly and extensively involved in the business operations of each of the restaurants from inception (paragraph 3). As an aside, I note that while Mr. Lee is named as the predecessor-in-title of the Applicant, his affidavit does not distinguish between his use as predecessor and use by the Applicant.

[43] According to Mr. Lee, the Applicant currently operates two Japanese restaurants under the name SUSHI GARDEN in the Greater Vancouver area. Both are located in Burnaby, BC. One of the locations has been operating continuously since August, 1998 and the other has been in operation since January 2010 (para 2). At the time that Mr. Lee swore his affidavit, a third location was expected to open in Burnaby, BC, in December 2015 (para 2).

[44] Attached as Exhibit A to Mr. Lee's affidavit is a copy of a current menu, bearing the Mark (para 5).

[45] According to Mr. Lee, the Mark is advertised and promoted in British Columbia in connection with the Applicant's restaurants, and the Applicant has spent money to distinguish its services from others. He indicates that he has reviewed the Applicant's Statement of Income, and that the Applicant spent approximately \$9,350 on advertising and promotion in 2014, and \$10,800 on advertising and promotion in 2013 (paragraph 9). I note that Mr. Lee does not elaborate on the type of advertising, nor does his affidavit include samples of advertising or promotional materials.

[46] According to Mr. Lee, the Mark has been recognized in association with the Applicant's restaurants on a number of occasions (paragraph 10). In support of this statement, he provides photographs of certificates for the SUSHI GARDEN restaurant being voted the favorite sushi by the 'Readers of Burnabynow' for the years 2015, 2012, 2008 and 2005 (Exhibits E, F, G and H). I note that he does not provide any information regarding the number of voters who participated during each of these years, or any information pertaining to the approximate readership, circulation, or web presence of this publication.

[47] Mr. Lee also cites an article from the Vancouver Sun (Exhibit I) dated September 18-24, 2008 recognizing the SUSHI GARDEN (4635 Kingsway) as "good food, cheap". No circulation figures have been provided. However, I am prepared to take judicial notice that the *Vancouver Sun* has a substantial circulation in Vancouver [*Northern Telecom Ltd. v Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 at 543 (TMOB); *R Griggs Group Ltd v 359603 Canada Inc.* (2005), 47 C.P.R. (4th) 215 at 227].

[48] Mr. Lee states that the Applicant's restaurants have been recognized on restaurant rating websites, including TripAdvisor, Yelp, and Zomato, and includes printouts of reviews relating to the Applicant's restaurants posted on these websites (Exhibits J – N). These third party sites identify the Applicant's restaurants located at 4635 Kingway (Exhibits J, K, N) and 4269 Lougheed Highway (Exhibits L, M). As was the case with the Opponent's evidence of this nature, since these entries constitute hearsay, I am unable to consider them as truth of their contents. I can accept them as evidence of their existence, but again, I do not consider this evidence to be particularly reliable.

[49] Since the Applicant has provided no sales figures, no information pertaining to how many customers visit its restaurants each year and has introduced only limited advertising information (ad spend for 2013 and 2014 but no indication of how the funds were directed), it is difficult to determine the extent to which the Applicant's Mark has become known in Canada. The Applicant has not provided examples of interior or exterior signage or other promotional materials bearing the Mark, such as take-out bags or containers, receipts, etc. which one would normally expect to see at a restaurant. Given these deficiencies, I am only able to infer that the Mark has become known to a limited extent.

[50] In the end, I find that the overall assessment of the section 6(5)(a) factor, which is a combination of the inherent distinctiveness of the parties' marks and the extent to which they have become known favours the Opponent, as I consider its trade-mark to be more inherently distinctive than the Applicant's Mark and although lacking in many respects, its evidence of promotion and use is still more substantial than what the Applicant has put forward in this case.

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

[51] The Opponent's registration for its SUSHI GARDENS & Design trade-mark claims use in Canada since at least 1976, whereas the application for the Mark claims use in Canada since August 1998. As previously discussed, both parties' evidence is somewhat lacking in precision with respect to dates and there is a noticeable lack of evidence for the earlier years. That being said, overall, this factor does still appear to favour the Opponent, as some of its evidence of use dates back to 1991. By contrast, the Applicant has only evidenced current use of the Mark.

Section 6(5)(c) and (d) – the nature of the goods, services or business and the nature of the trade

[52] When considering sections 6(5)(c) and (d) of the Act, it is the statement of services in an application for a mark and the statement of services in an opponent's registration that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. Evidence of the parties' actual trades is useful in this respect [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[53] The services in the application for the Mark are described as “restaurant serving Japanese cuisine”. Similarly, the services covered by the Opponent's registration are “restaurant services”. The evidence clearly demonstrates that both parties operate Japanese restaurants.

[54] Accordingly, these factors favour the Opponent.

Section 6(5)(e) – the overall degree of resemblance between the trade-marks in the appearance or sound or in the ideas suggested by them

[55] In *Masterpiece*, the Supreme Court of Canada considered the importance of section 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.

[56] In *Masterpiece*, the Court also advised that the preferable approach to considering resemblance “is to first consider whether there is an aspect of the trade-mark that is particularly striking and unique” (see para 64).

[57] In my view, it is the combination of the waterwheel and the stylized lettering for the words SUISSA GARDENS, which forms the dominant part of the Opponent’s trade-mark. This is the striking or unique part of the trade-mark. Unlike the Opponent’s trade-mark, the Applicant’s Mark does not include a design component and there is nothing striking or unique about it. It essentially consists of ordinary dictionary terms, which, in combination, are highly suggestive, if not descriptive of the Applicant’s services.

[58] While the parties’ marks are not entirely dissimilar due to the word GARDEN and to a lesser extent, the inclusion of some of the same letters in the first components of the marks (i.e. SUSHI and SUISSA), when viewed as a whole, I consider them to be quite different visually. This is primarily due to the design aspect of the Opponent’s trade-mark.

[59] In terms of sound, there is no evidence to establish how a Francophone, an Anglophone, or a bilingual Canadian consumer would pronounce the words in the Opponent’s registered trade-mark. However, the Applicant’s affiant has indicated that the Google translation service audio clip for the pronunciation of SUISSA sounds like “swee-sha” (Lee affidavit, para 7). In my view, either “swee-sha” or perhaps “soo-ee-sha” would be reasonable pronunciations. Either way, SUISSA would certainly not be pronounced in a similar manner to SUSHI, with the result being that the words “suissa gardens” and “sushi garden” would be fairly different when sounded.

[60] In terms of connotation, I note that the Mark has a very clear connotation (i.e. an open-air sushi eating/drinking place), whereas the Opponent’s trade-mark would likely be perceived as being coined in nature for those who are not familiar with Japanese. For those who would be aware of the translation as “waterwheel”, this would only serve to further emphasize the idea behind the design aspect of the Opponent’s trade-mark. Either way, the parties’ marks are quite different in terms of suggested idea.

[61] Overall, I find that this factor strongly favours the Applicant.

Surrounding Circumstances

Co-existence without any evidence of confusion

[62] An absence of confusion despite an overlap of the goods or services and channels of trade during a meaningful length of time may entitle one to draw a negative inference about an opponent's case [*Christian Dior SA v Dion Neckwear Ltd* 2002 FCA 29 (CanLII), 20 CPR (4th) 155 (FCA) at para 19].

[63] In the present case, there is no evidence of any actual instances of confusion, despite the fact that the marks may have co-existed since 1998.

[64] While a period of over 15 years of co-existence may well constitute a meaningful length of time, the absence of confusion in this case is not surprising, given the very limited and distinct geographic regions in which the parties carry on business. As previously noted, the Opponent's restaurant is located in Ontario, whereas the Applicant's restaurants are situated in British Columbia. In view of this, I do not consider the absence of evidence of actual confusion to be a particularly relevant surrounding circumstance in this case.

State of the register evidence

[65] State of the register evidence is sometimes introduced by a party to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. In this case, the Applicant, through the Lee affidavit (Exhibits O-Y), has cited a number of registrations, including: an expunged registration for the mark SUI SHA YA (Exhibit O) and eight registrations for marks including the word SUSHI, for use in association with restaurant services, one of which has been expunged (Exhibits P-W). In addition, the Applicant has cited two registrations for marks including the word GARDEN.

[66] It has been held that state of the Register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [*Ports International Ltd. v Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (TMOB); *Welch Foods Inc. v Del*

Monte Corp (1992), 44 C.P.R. (3d) 205 (FCTD); and *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[67] The Applicant has not located a large number of relevant active registrations. Accordingly, I do not consider the state of the register evidence to be particularly useful to the Applicant in the present case.

Conclusion re likelihood of confusion

[68] In applying the test for confusion, I have considered the parties' marks as a matter of first impression and imperfect recollection.

[69] Even though my assessment of the circumstances of this case leads me to conclude that the section 6(5)(a) through (d) factors favor the Opponent, I consider the differences between the parties' marks in appearance, sound and suggested idea to be significant enough to shift the balance of probabilities in favour of the Applicant. As noted by the Supreme Court in *Masterpiece* [supra], the other factors (6(5)(a) through (d)) only become significant once the trade-marks are found to be identical or very similar and for the reasons previously mentioned, I do not find the parties' trade-marks to be very similar at all in the present case.

[70] Based on the foregoing, I conclude that the Applicant has discharged the legal onus on it to show, on a balance of probabilities, that confusion between the Mark and the Opponent's registered trade-mark is not likely. The section 12(1)(d) ground of opposition is therefore unsuccessful.

Non-entitlement – section 16 – paragraph 3(e)(iv) of the statement of opposition

[71] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act, in that "at the date of filing of the Application, the Application was confusing with the Opponent's Mark, which the Opponent had previously registered and used in Canada in association with the Opponent's Services".

[72] The material date for assessing this ground of opposition is not the filing date of the application, as pleaded by the Opponent, but rather the application's claimed date of first use,

namely August 1998 [see Section 16(1)(a)]. In order to meet its evidential burden under this ground of opposition, the Opponent must show that as of August 1998, its trade-mark SUISSA GARDENS & Design had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the Applicant's application (December 3, 2014).

[73] The Applicant argues that the Opponent has failed to discharge its initial burden as almost all of the Opponent's evidence dates after August 1998. The Applicant also argues that to the extent Mr. Teshima broadly deposes that the Opponent's Trade-marks have been used for approximately 40 years, he does not distinguish between them individually, nor does he depose that various marks, or any of them, have been used continuously.

[74] Even if I were to conclude that the Opponent has met its evidential burden in respect of this ground of opposition, it would fail for reasons similar to those set out above in my analysis under section 12(1)(d) of the Act. The difference in material dates does not impact my conclusion with respect to the issue of confusion. My finding that there is no likelihood of confusion between the parties' trade-marks also applies to this ground of opposition. Accordingly, the section 16(1)(a) ground of opposition is unsuccessful.

Section 2 (non-distinctiveness) – paragraph 3(f) of statement of opposition

[75] The Opponent has pleaded that the Mark is not distinctive at the material date because:

- the Mark was not adapted to distinguish the Applicant's Services from the Opponent's Services which were previously provided by the Opponent in Canada in association with the Opponent's Mark and;
- The Applicant's Mark does not actually distinguish the Applicant's Services given that it is confusing with the Opponent's registered mark which the Opponent has used and made known in Canada.

[76] To meet its evidential burden in respect of this ground, the Opponent must show that its SUISSA GARDENS & Design mark had become known in Canada as of the material date of January 22, 2015 so as to negate the distinctiveness of the Mark (*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 (CanLII), 48 CPR (4th) 427).

[77] As was the case with the non-entitlement ground of opposition, even if I were to conclude that the Opponent has met its evidential burden in respect of this ground, it would still fail for reasons similar to those set out in my analysis under section 12(1)(d) of the Act. The difference in the material date would not change my conclusion regarding the likelihood of confusion in this case. Accordingly, this ground of opposition is also unsuccessful.

Disposition

[78] 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.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No Hearing Held

AGENTS OF RECORD

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FOR THE OPPONENT

Lindsay Kenney LLP

FOR THE APPLICANT