



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 39

Date of Decision: 2025-02-28

IN THE MATTER OF OPPOSITIONS

Opponent: Sushi Nozawa, LLC

Applicant: Hello Nori, Inc.

Applications: 2,047,643 for HELLO NORI
2,047,644 for HELLO NORI Design

OVERVIEW

[1] This decision involves oppositions by Sushi Nozawa, LLC (the Opponent) to applications for the trademarks HELLO NORI and HELLO NORI Design, shown below, by Hello Nori, Inc. (the Applicant).



[2] As the issues and the evidence in each proceeding are nearly identical, they are both addressed in this decision. I will begin with the opposition to the application for the word trademark HELLO NORI.

APPLICATION No. 2,047,643 FOR HELLO NORI

[3] The Opponent opposes registration of the trademark HELLO NORI (the Mark), which is the subject of application No. 2,047,643. The application is in association with “alcoholic cocktails” and “restaurant services”.

[4] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s previous use and registration of trademarks including KAZU NORI Logo, shown below, in association with “restaurant services”:



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

THE RECORD

[6] The application was filed on August 25, 2020, and was advertised for opposition purposes in the *Trademarks Journal* of August 24, 2022. On February 22, 2023, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition relate to registrability under section 12(1)(d), entitlement to register under section 16, distinctiveness under section 2, and an allegation of bad faith under section 38(2)(a.1) of the Act.

[7] The Applicant filed a counter statement denying the grounds of opposition.

[8] In support of the opposition, the Opponent filed the affidavit of Susan Trimble (sworn August 24, 2023), a legal assistant employed by the agent for the Opponent. Ms. Trimble provides copies of the Opponent’s registrations for the trademarks KAZUNORI and KAZU NORI Logo.

[9] In support of the application, the Applicant filed the affidavit of Jennifer Zhang (sworn January 5, 2024), the co-owner of the Applicant. Ms. Zhang provides information on the Applicant's business, as well as the development, use, and promotion of the Mark in Canada.

[10] The Applicant also filed the affidavit of Gloria Lam (sworn January 4, 2024), a legal assistant employed by the agent for the Applicant. Ms. Lam provides printouts of the Opponent's website found at *handrollbar.com*, as well as copies of the trademark file history for the Opponent's KAZUNORI and KAZU NORI Logo registrations.

[11] No cross-examinations were conducted.

[12] Only the Applicant filed written representations and attended a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

[13] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd* (1990), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155]. This means that if a determinate conclusion cannot be reached in favour of the Applicant after a consideration of all the evidence, then the issue must be decided against the Applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 12(1)(d) ground of opposition

[14] The material date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)].

[15] The Opponent has pleaded that the Mark is not registrable because, contrary to section 12(1)(d) of the Act, the Mark is confusing with one or more of the Opponent's registered trademarks KAZUNORI (TMA1,002,911) and KAZU NORI Logo (TMA1,138,261).

[16] While the registration for the word trademark KAZUNORI was expunged on November 4, 2024, following a section 45 expungement proceeding, the registration for KAZU NORI Logo is extant [see *Quaker Oats Co Ltd of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) which confirms the Registrar can exercise its discretion to check the status of registrations pleaded in a statement of opposition]. As the KAZU NORI Logo registration is in good standing, the Opponent has met its initial evidential burden for this ground of opposition. As a result, the Applicant bears the legal burden of demonstrating, on a balance of probabilities, that there is no likelihood of confusion between the Mark and the Opponent's registered trademark KAZU NORI Logo.

Test for confusion

[17] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between

the trademarks, including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), 49 CPR (4th) 401]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[18] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

Inherent distinctiveness of the trademarks and the extent to which they have become known

[19] The Applicant, in its written representations, submits the following regarding the inherent distinctiveness of the Mark:

53. The word element of the Opposed Mark comprises two unrelated words, "HELLO" and "NORI", that would not expect to be linked. The word "HELLO" is the commonly known greeting in the English language and the word "NORI" is the English translation for the Japanese word for the dried edible seaweed used to wrap sushi.

54. The Opposed Mark is a playful and unique combination of two unrelated words that the Applicant has coined to evoke feelings of welcome to Canadians to enjoy the Applicant's nori-wrapped hand rolls...

[20] In support, the Applicant provides entries for HELLO and NORI from the *Merriam-Webster* online dictionary, with NORI defined as a 'dried laver seaweed pressed into thin sheets and used especially as a seasoning or as a

wrapper for sushi' (Zhang affidavit, Exhibit I). I accept the Applicant's submission that the combination of the common word HELLO and the descriptive word NORI is unexpected and unique with the result that the Mark possesses a fair degree of inherent distinctiveness.

[21] The Applicant submits that the Opponent's trademark has a low degree of inherent distinctiveness as KAZUNORI is the first name of the founding chef of the Opponent's restaurants, and to this end, provides excerpts from the Opponent's website referring to the 'famed Sushi chef Kazunori Nozawa' (Lam affidavit, Exhibit I). However, there is no evidence that this would be known by the average consumer. Rather, I find it more likely that KAZUNORI, split into the elements KAZU and NORI in its logo design, would be perceived as a combination of the foreign or coined word KAZU and the descriptive word NORI, and I consider this trademark to possess a fair degree of inherent distinctiveness. The design element of this trademark does not materially increase its overall inherent distinctiveness.

[22] Regarding the extent to which the parties' trademarks have become known, this element favours the Applicant in view of its use of the Mark since the opening of the HELLO NORI restaurant in Vancouver on February 8, 2021. In particular, the Zhang affidavit establishes that the Mark has appeared on the outside of the restaurant since at least as early as February 8, 2021, and that since opening, the Mark has also been used on menus, to-go bags, gift cards for restaurant services, and serving dishes (Exhibit O). The Mark is also prominently featured on the Applicant's website at *hellonori.com*; this website is an essential part of the Applicant's business as it is used to promote the Applicant's services in Canada as well as to sell its take-out menu items, including sushi and alcoholic drinks (Exhibits A, J).

[23] Between 2021 and 2023, the revenue in Canada from the goods and services in association with the Mark was over \$9,400,000 CAD (Zhang

affidavit, para 54), and for the same period, the Applicant expended approximately \$700,000 CAD on advertising efforts in Canada in association with the Mark (Zhang affidavit, para 54). The Mark appears on a number of social networking platforms, including LinkedIn, Facebook, and Instagram (Exhibits K,L,M). The Mark also appears in various third-party Canadian articles promoting the Applicant's restaurant services (Exhibit D).

[24] In contrast, the Opponent has provided no evidence of use or the extent known of its trademark.

[25] Overall, I find that this factor, which is a combination of inherent and acquired distinctiveness, favours the Applicant.

Length of time the trademarks have been in use

[26] The Applicant has provided evidence of use of the Mark since February 8, 2021, as noted above. In contrast, there is no evidence from the Opponent that its trademark has been used or become known in Canada in association with restaurant services. While the mere existence of a registration for a trademark may raise an inference of *de minimis* use, this alone is not sufficient to give rise to an inference of significant and continuous use of the trademark [*Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[27] Accordingly, this factor favours the Applicant.

Nature of the goods, services or business; and nature of the trade

[28] In its written representations, the Applicant submits that the restaurant services of the parties are "being provided in completely different countries, and are, therefore, clearly different in nature..." (para 67). In support, the Applicant refers to printouts of the Opponent's website provided through the Lam affidavit indicating that the Opponent's KAZUNORI

restaurants are located in Los Angeles and New York (Lam affidavit, Exhibits L-U). The Applicant also argues that the “nature of the trade between the Opponent, providing restaurant services only in the United States, and the Applicant, providing restaurant services in Canada, is therefore clearly different and presents no risk of overlap” (para 70).

[29] This is not the correct approach when assessing the nature of the goods, services, and trade. The test for confusion assumes use of both trademarks in the same area, irrespective of whether this is actually the case [section 6(2) of the Act]. It is well-established that I am to compare the Applicant’s statement of goods and services with the statement of goods and services in the Opponent’s registration. Under this approach, I find there is direct overlap in the services of the parties insofar as they are both “restaurant services”. I also find the Applicant’s goods “alcoholic cocktails” to be closely related to the Opponent’s restaurant services.

[30] As for the nature and channels of trade, which are presupposed to be in Canada, given that the goods and services at issue are identical or closely related, it is reasonable to assume that their channels of trade would also overlap, particularly in the absence of evidence to the contrary, as in this case.

[31] Accordingly, the nature of the goods, services, and trade factors favour the Opponent.

Degree of resemblance

[32] As mentioned above, the degree of resemblance between the parties’ marks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion. This is particularly the case where the parties’ goods, services, and channels of trade are the same or overlapping,

as in this case [see *Reynolds Consumer Products Inc v PRS Mediterranean Ltd*, 2013 FCA 119, 111 CPR (4th) 155].

[33] In *Masterpiece, supra*, the Court observed that while the first word (or syllable) of a trademark may, for purposes of distinctiveness, be the most important in some cases [*Conde Nast Publications Inc v Union des editions moderns* (1979), 46 CPR (2d) 183 (FCTD)], a preferable approach is to first consider whether there is an aspect of the trademark that is particularly striking or unique.

[34] I consider the striking element of the Mark to be the coined phrase "HELLO NORI". Likewise, I consider the striking element of the Opponent's trademark to be the coined phrase "KAZU NORI". Since both marks end with 'NORI' there is some similarity between them in appearance and when sounded. However, the overall degree of resemblance in the sound and appearance of the parties' marks is significantly reduced by their very different first elements (the ordinary word HELLO and the coined or foreign term KAZU), rendering the parties' marks more different than alike.

[35] As for the ideas suggested by the trademarks, it is possible that both parties' trademarks could suggest the idea that their respective associated goods and/or services feature nori, which in and of itself does not lead to a high degree of resemblance in ideas suggested.

[36] Overall, this important factor favours the Applicant.

Conclusion on the section 12(1)(d) ground

[37] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. Notwithstanding the overlap in the parties' goods, services, and trade, and taking into account that both parties' trademarks are inherently distinctive, I do not consider the

degree of resemblance between the trademarks to be sufficiently high so as to give rise to a likelihood of confusion. The extent known and length of time in use factors also favour the Applicant.

[38] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Remaining grounds of opposition summarily rejected - Sections 16(1)(a), 16(1)(c), 2, and 38(2)(a.1) grounds of opposition

[39] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because it was confusing with a number of trademarks, including KAZUNORI and KAZU NORI Logo, as well as the trade names KAZUNORI and KAZUNORI-THE ORIGINAL HAND ROLL BAR, previously used and made known in Canada by the Opponent. The Opponent also pleads that the Mark is not distinctive because it does not distinguish, nor is it adapted to distinguish, the goods and services of the Applicant from the goods, services and business of the Opponent. The Opponent has also alleged bad faith pursuant to section 38(2)(a.1) of the Act on the basis that the Applicant adopted its Mark with knowledge of the Opponent's trademarks and business, and that in applying to register the Mark, the Applicant sought to benefit from the goodwill and reputation associated with the Opponent's trademarks and trade names.

[40] These grounds can be summarily rejected at least on the basis that the Opponent has not met its initial evidential burden for any of these grounds. The Opponent has not evidenced that any of its registered or unregistered trademarks and/or trade names was used, made known or had any reputation or goodwill in Canada as of the applicable material dates, as required to support the Opponent's allegations relating to these grounds. In this regard, I note that the mere filing of certified copies of the Opponent's registrations can establish no more than *de minimis* use of the Opponent's registered trademark and cannot give rise to an inference of significant and

continuous use of a trademark [*Entre Computer Centers, Inc v Global Upholstery Co.* (1992), 40 CP. (3d) 427 (TMOB)].

APPLICATION No. 2,047,644 FOR HELLO NORI DESIGN

[41] Application No. 2,047,644 (the '644 application) for the trademark HELLO NORI Design is in association with "sushi" and "restaurant services".

[42] The grounds of opposition, material dates, issues, and evidence in respect of the proceeding for the HELLO NORI Design trademark are the same as those discussed above for application No. 2,047,643 (the '643 application) for the HELLO NORI word trademark.

[43] In assessing the likelihood of confusion, and in particular the section 6(5)(c) and (d) factors, I do not find that the difference in the goods listed in the '643 and '644 applications, namely "alcoholic cocktails" and "sushi", respectively, to affect my finding on these factors as I consider "sushi" to be closely related to the Opponent's "restaurant services". The '644 application is also in association "restaurant services", which directly overlap with the Opponent's registered services.

[44] Further, with respect to the section 6(5)(e) degree of resemblance factor, I do not find that the design element of the trademark HELLO NORI Design significantly changes the degree of resemblance. It follows that I make the same findings with respect to the section 12(1)(d) ground of opposition as in the '643 application for HELLO NORI. I also make the same findings as in the '643 application for the remaining grounds of opposition, in that they are summarily rejected on the basis that the Opponent has failed to meet its evidential burden.

[45] Accordingly, all of the grounds of opposition against the '644 application are rejected.

DISPOSITION

[46] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions to both applications pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2024-11-18

APPEARANCES

For the Opponent: No one appearing

For the Applicant: Aiyaz Alibhai and Lisa Sim

AGENTS OF RECORD

For the Opponent: Osler, Hoskin & Harcourt LLP

For the Applicant: Miller Thomson LLP