



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 40

Date of Decision: 2025-02-28

IN THE MATTER OF AN OPPOSITION

Opponent: Sushi Nozawa, LLC

Applicant: Hello Nori, Inc.

Applications: 2,047,641 for HELLO NORI HAND ROLL

OVERVIEW

[1] Hello Nori, Inc. (the Applicant) has filed application No. 2,047,641 for the trademark HELLO NORI HAND ROLL (the Mark) in association with “sushi” and “restaurant services”.

[2] Sushi Nozawa, Inc. (the Opponent) has opposed the application. The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s previous use and/or registration of various of its trademarks including KAZU NORI Logo and THE ORIGINAL HAND ROLL BAR Logo, shown below, as well as the corresponding word trademarks KAZUNORI and THE ORIGINAL HAND ROLL BAR, all in association with “restaurant services”:



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

THE RECORD

[4] 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.

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

[6] 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, KAZU NORI Logo, and THE ORIGINAL HAND ROLL BAR, and a copy of its pending application for the trademark THE ORIGINAL HAND ROLL BAR Logo.

[7] 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 general information on sushi hand rolls and hand roll bars in Canada. Ms. Zhang also

provides information on the development, use, and promotion of the Mark in Canada.

[8] 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, KAZU NORI Logo, THE ORIGINAL HAND ROLL BAR registrations, and pending application for trademark THE ORIGINAL HAND ROLL BAR Logo.

[9] No cross-examinations were conducted.

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

LEGAL ONUS AND EVIDENTIAL BURDEN

[11] 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

[12] 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)].

[13] 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), KAZU NORI Logo (TMA1,138,261), and THE ORIGINAL HAND ROLL BAR (TMA1,002,905).

[14] The Opponent's registrations for the trademarks KAZUNORI (TMA1,002,911) and THE ORIGINAL HAND ROLL BAR (TMA1,002,905) were expunged on November 4, 2024, and September 27, 2024, respectively, following section 45 expungement proceedings [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]. However, the registration for the trademark KAZU NORI Logo remains in good standing, such that 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

[15] 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.

[16] 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

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

60. The Opposed Mark comprises the distinctive element "HELLO NORI" with the descriptive element "HAND ROLL". The distinctive element, notably appearing as the first element of the Opposed Mark, is composed of two unrelated words, "HELLO" and "NORI". The words "HELLO" and "NORI" are words that would not be expected 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.

61. The Opposed Mark comprises 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. Unlike the Opponent's Registrations, the Opposed Mark combines this distinctive element with the descriptive element "HAND ROLL" instead of a mere superlative adjective. The Opposed Mark is inherently distinctive.

[18] 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). As for the term "HAND ROLL", the Applicant provides an entry from the online *Oxford English Dictionary* (3d edition) defining it as "In Japanese cookery: a type of hand-rolled sushi, typically consisting of a cone of seaweed filled with rice, fish, vegetables, etc.... Frequently with preceding word or words denoting the ingredients" (Zhang affidavit, Exhibit M). This term was entered into this dictionary in June 2013 (Zhang affidavit, Exhibit L). Through the Zhang affidavit, the Applicant provides further information on hand rolls and hand roll bars, in particular explaining that hand roll bars are a type of sushi bar (paragraph 4), and that the Applicant's hand rolls are "prepared in the traditional hand roll sushi style using a nori (seaweed) wrapper to hand roll warm seasoned rice and fresh, locally sourced and sustainable seafood and produce..." (paragraph 7). Ms. Zhang also states that to her knowledge, hand roll bars featuring hand rolls have been part of the restaurant scene in Canada since at least as early as 2007, and in support, she cites three different restaurants operating as hand roll bars in Vancouver and Toronto during this time. Exhibits F and G are restaurant reviews published on the *blogTO.com* website for two Toronto restaurants serving hand rolls.

[19] With this in mind, I find the applied-for trademark HELLO NORI HAND ROLL to possess a fair degree of inherent distinctiveness as it features the unexpected and unique pairing of the common word HELLO and the descriptive word NORI combined with term HAND ROLL, which holds descriptive significance in relation to sushi and restaurant services.

[20] 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.

[21] Regarding the extent to which the parties' trademark have become known, this element is neutral. The Applicant's evidence establishes significant use and promotion of the trademark HELLO NORI since the opening of the Applicant's restaurant in Vancouver on February 8, 2021, with the HELLO NORI word and design trademark appearing on restaurant signage, in restaurant items such as menus and serving dishes, and on the Applicant's website *hellonori.com* and social media (Zhang affidavit, Exhibits A, J, O). However, the Applicant's evidence does not establish significant use and promotion of the trademark HELLO NORI HAND ROLL.

[22] As for the Opponent's trademark, the Opponent has provided no evidence of use or the extent known of its trademark in Canada.

[23] Overall, I find that this factor, which is a combination of inherent and acquired distinctiveness, does not significantly favour either party.

Length of time the trademarks have been in use

[24] As noted above, the Applicant's evidence establishes significant use of the HELLO NORI trademark since the opening of the HELLO NORI restaurant

on February 8, 2021. However, the Applicant's evidence does not touch on its particular use of trademark HELLO NORI HAND ROLL. With respect to the Opponent's trademark, the Opponent has provided no evidence that it 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)].

[25] Accordingly, this factor favours neither party.

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

[26] 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).

[27] 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 “sushi” to be closely related to the Opponent’s restaurant services.

[28] 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.

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

Degree of resemblance

[30] 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].

[31] 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.

[32] I consider the striking element of the Mark to be the combination of the words “HELLO NORI”. Likewise, I consider the striking element of the Opponent’s trademark to be the coined phrase “KAZU NORI”. While both marks include the element ‘NORI’, 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). The applied for trademark is also longer. Accordingly, the parties' marks are more different than alike.

[33] 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.

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

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

[35] 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.

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

16(1)(b) ground of opposition

[37] The Opponent has pleaded that the Applicant is not entitled to registration of the Mark because, as of the filing date of the application or at any other date, the Mark was confusing with the trademark THE ORIGINAL HAND ROLL BAR Logo, shown below, in respect of which an application (No. 1,981,745) was previously filed in Canada by the Opponent and which application was pending at the date of advertisement of the application. The Opponent does meet its initial evidential burden under this ground in that the relied-upon application was filed prior to the filing date of the Applicant's

application and was still pending when the Applicant's application was advertised for opposition. As a result, the Applicant bears the onus of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's trademark THE ORIGINAL HAND ROLL BAR Logo:



[38] In making this assessment, I will take into account all the relevant surrounding circumstances, including those listed at section 6(5) of the Act.

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

[39] As discussed in the above analysis, I find the applied-for trademark HELLO NORI HAND ROLL to possess a fair degree of inherent distinctiveness as it features the unique pairing of the common word HELLO and the descriptive word NORI combined with term HAND ROLL, which holds descriptive significance in relation to sushi and restaurant services.

[40] The Opponent's trademark possesses very little inherent distinctiveness. Its constituent words 'THE ORIGINAL HAND ROLL BAR FOUNDED 2014 IN LOS ANGELES' are highly suggestive if not descriptive of its restaurant services, and the design element of the trademark, limited to the placement of the words displayed in block lettering within a black border, does not increase its overall inherent distinctiveness.

[41] Regarding the extent to which the parties' trademarks have become known, this element is neutral. As discussed above, while the Applicant's evidence establishes significant use and promotion of the HELLO NORI

trademark, little focus is afforded to the trademark HELLO NORI HAND ROLL. As for the Opponent's trademark, the Opponent has provided no evidence of use or the extent known of its trademark in Canada.

[42] 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

[43] As noted above, the Applicant's evidence establishes significant use of the HELLO NORI trademark since the opening of the HELLO NORI restaurant on February 8, 2021. However, the Applicant's evidence does not touch on its particular use of trademark HELLO NORI HAND ROLL. With respect to the Opponent's trademark, the Opponent has provided no evidence that it has been used or become known in Canada in association with restaurant services.

[44] Accordingly, this factor favours neither party.

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

[45] The Applicant's application covers "sushi" and "restaurant services", and the Opponent's application covers "restaurant services".

[46] 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 "sushi" to be closely related to the Opponent's restaurant services.

[47] As for the nature and channels of trade, 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.

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

Degree of resemblance

[49] I consider the striking element of the Mark to the combination of the words HELLO NORI, which appears at the beginning of the Mark. In contrast, I do not consider any element of the Opponent's trademark to be particularly striking. Notwithstanding that both parties' marks include the descriptive words HAND ROLL, they appear and sound far more different than alike.

[50] As for the ideas suggested by the trademarks, while they both share the descriptive words HAND ROLL, this in itself does not give rise to a significant degree of resemblance in the ideas suggested.

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

Conclusion on the 16(1)(b) ground of opposition

[52] As noted in *Masterpiece, supra*, the resemblance between the marks will often have the greatest effect on the confusion analysis. I consider this to be the determinative factor in this case. Notwithstanding the overlap in the parties' goods, services and trade, 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.

[53] Accordingly, the section 16(1)(b) 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

[54] 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, THE ORIGINAL HAND ROLL BAR word trademark and Logo, as well as the trade names

KAZUNORI, KAZUNORI-THE ORIGINAL HAND ROLL BAR, and 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.

[55] 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)].

DISPOSITION

[56] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition to the application 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