



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 171

Date of Decision: 2021-07-30

IN THE MATTER OF AN OPPOSITION

Voyetra Turtle Beach, Inc.

Opponent

and

Elmorealty Inc.

Applicant

1,715,834 for EL MOCAMBO &

Application

PALM TREE DESIGN

INTRODUCTION

[1] Elmorealty Inc. (the Applicant) has filed application No. 1,715,834 (the Application) to register the trademark EL MOCAMBO & PALM TREE DESIGN (the Mark), depicted below.



[2] The Application was filed on February 18, 2015 based on proposed use of the Mark in Canada in association with the goods and services listed in Schedule A to this decision (the Goods and Services).

[3] The Application was advertised for opposition purposes in the *Trademarks Journal* on March 30, 2016. On May 29, 2017, Voyetra Turtle Beach, Inc. (the Opponent) filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[4] The Opponent raises grounds of opposition based on non-distinctiveness under section 2, non-registrability under section 12(1)(d), non-entitlement under sections 16(3)(a) and 16(3)(b), and non-compliance with sections 30(e) and 30(i) of the Act. For the grounds of opposition based on an alleged likelihood of confusion, the Opponent relies primarily on the following two trademarks:

Trademark	Reg. / App. Number	Goods
	TMA885296	(1) Computer peripherals, namely, computer audio processors, video game console audio processors, headphone adapters for computer audio systems and headphone adapters for video game consoles.
	1730630	(1) Ear buds; earphones; headphones; headsets for use with computers; headsets for use with mobile devices, namely, smartphones, MP3 players, tablets and PDAs; headsets for use with home entertainment systems; telephone headsets; adapter plugs; amplifiers; parts for headsets, namely, battery covers; audio cables; data cables; power cables; parts for headsets, namely, ear cushions; microphones; radio transmitters; digital sound processor; stands adapted for headsets; parts for headsets, namely speaker plates; audio mixer, namely, tournament mixer; software to control and improve audio equipment sound and quality; and computer software to improve performance of headsets; computer software for controlling settings on PC sound cards; headsets for use with game consoles; headsets for use with controllers for game consoles; headsets for use with hand-held units for playing video games other than those adapted for use with an external display screen or monitor; parts for gaming headsets, namely speaker plates, battery covers and ear cushions; stands for personal digital electronic devices, namely headsets

[5] I note that in its statement of opposition, the Opponent also relies on an unregistered design trademark entitled PALM TREES & Triangle Design which is comprised solely of the design element shown in application No. 1,730,630, above (i.e. the palm trees design within the inverted triangle), without the words “TURTLE BEACH”. However, the Opponent did not make

any subsequent submissions regarding this unregistered trademark, and focused its submissions on the two trademarks set out in paragraph 4 of this decision, above (for example, see paragraph 2 of the Opponent's Written Representations). In any event, to the extent that the unregistered trademark PALM TREES & Triangle Design discussed in the statement of opposition constitutes a separate trademark from those set out in paragraph 4, the outcome of the confusion grounds of opposition in respect of that unregistered trademark is the same as for the Opponent's trademarks identified in paragraph 4.

[6] The Applicant filed a counter statement denying the grounds of opposition. Both parties filed evidence and written representations and attended a hearing.

[7] For the reasons set out below, I refuse the Application in respect of the goods "computer games" and reject the opposition in respect of the remainder of the Goods and Services.

[8] I note that the same parties also participated in an opposition proceeding relating to application No. 1,715,830 for the trademark EL MOCAMBO & DESIGN. While there is a substantial degree of overlap in subject matter between the two proceedings and they were heard together, there are some differences in the evidentiary record (notably, separate cross-examinations were conducted of the Applicant's affiant) such that I have issued a separate decision relating to application No. 1,715,830.

EVIDENCE

[9] The parties' evidence is summarized below and is further discussed in the analysis of the grounds of opposition.

Opponent's Evidence

[10] The Opponent filed as its evidence the affidavit of Andrew Lilien sworn February 20, 2018 (the Lilien Affidavit). Mr. Lilien is the Vice President, Marketing of the Opponent. He was not cross-examined.

[11] Mr. Lilien indicates that the Opponent designs audio products for the consumer, commercial and healthcare sectors. He states that under the Opponent's Turtle Beach brands, the

Opponent has been the clear market share leader for the past five years with its wide selection of gaming headsets for use with the Xbox One and PlayStation 4 consoles, as well as personal computers and mobile and tablet devices.

[12] Mr. Lilien states that Turtle Beach branded headsets are distributed in forty-four countries across North America, South America, Europe, the Middle East, Africa, Australia, and Asia. He describes that Turtle Beach headsets are sold at more than 27,000 storefronts, including major retailers such as Amazon, Apple, Argos, Best Buy, GameStop, Sainsbury's Target and Walmart.

[13] The Opponent is the owner of Canadian registrations for the two trademarks set out in paragraph 4 of this decision, above (collectively identified in the Lilien Affidavit as the "Palm Tree Design trademarks"), as well as two registrations for the word trademark TURTLE BEACH (TMA850007 and TMA885297).

[14] Mr. Lilien states that the Opponent has used the Palm Tree Design trademarks in Canada since at least as early as October 2013, and that the Palm Tree Design trademarks are extensively used and prominently featured on the Opponent's goods. He indicates that the Palm Tree Design trademarks are prominently featured on the Opponent's website at *www.turtlebeach.com* as well as on promotional materials. Printouts from the Opponent's website with images of the Opponent's products, including headsets, bearing the Palm Tree Design trademarks, are included as Exhibit 4.

[15] Mr. Lilien states that in 2016 and 2017 alone, the Opponent generated in excess of USD\$320 million in sales, and a printout from the Opponent's website in support of this information is included as Exhibit 3. It is apparent from Exhibit 3 that these sales figures are not limited to only Canadian sales.

[16] Mr. Lilien states that the Opponent has invested significantly in promotion and advertisement of the Palm Tree Design trademarks, and examples of promotional materials are included as Exhibit 5 to his affidavit. These materials include in-store posters and other printed material promoting the Opponent's headsets bearing the Palm Tree Design trademarks. In

addition, included in Exhibits 5 and 6 are what appear to be invoices from the Opponent to Canadian retailers (including Wal-Mart Canada Corp.) for some of this advertising material.

[17] Sample invoices for products branded with the Palm Tree Design trademarks which were sold to Canadian businesses are included as Exhibit 6 to the Lilien Affidavit.

[18] Mr. Lilien states that the Opponent was recognized for a fourth consecutive year as the industry's "Best Peripherals and Accessories Brand" during the 2017 MCV Awards held in London, England. He describes MCV as a leading gaming news and community outlet for professionals working within the UK and international video games market.

Applicant's Evidence

[19] The Applicant filed as its evidence the affidavit of Kelly Pullen sworn June 15, 2018 (the Pullen Affidavit). Ms. Pullen is the Director of Communications & Special Projects for the Applicant. Ms. Pullen was cross-examined on her affidavit on November 13, 2018 and the transcript of that cross-examination, as well as written answers to undertakings, form part of the record.

[20] In 2014, the Applicant purchased the property located at 462-464 Spadina Avenue in Toronto. For decades prior to 2014, the property had been operated by previous owners as a music and entertainment venue under the name EL MOCAMBO. Over the years, and particularly during the 1970s and 1980s, the venue hosted several high-profile musical acts, including Elvis Costello, Blondie, U2 and The Rolling Stones. For example, Exhibits 13 through 17 and Exhibit 19 to the Pullen Affidavit include various album covers, photographs and media articles relating to the venue. For much of that time, the property had a 22-foot-high, neon-lit palm tree sign bolted to the façade of the building, displaying the name EL MOCAMBO. In the interior of the venue, a design with multiple palm trees was often used as a stage backdrop.

[21] A prior owner of the venue owned trademark registrations in Canada for the trademarks EL MOCAMBO & Design (TMA259587) and EL MOCAMBO & Design (TMA255422), depicted below. However, both of those registrations were expunged for failure to renew (in 1997 and 1996 respectively).

Reg. No.	Trademark	Owner
TMA259587		KRISBAIR TAVERN LIMITED, 464 Spadina Avenue, Toronto, ONTARIO M5T2G8
TMA255422		KRISBAIR TAVERN LIMITED, 464 Spadina Avenue, Toronto, ONTARIO M5T2G8

[22] In this decision, I will refer to these earlier trademarks as the “Previous One Palm Mark” (for the trademark that was the subject of expunged registration No. TMA259587) and the “Previous Multiple Palm Mark” (for the trademark that was the subject of expunged registration No. TMA255422). Much of the advertising of the venue by the prior owners that is included in the Pullen Affidavit incorporates the Previous Multiple Palm Mark.

[23] The Applicant purchased the property with a view to renovating and reopening it as a music and entertainment venue. Since the Applicant purchased the property in 2014, the venue has been closed to conduct renovations. Ms. Pullen indicates that the original exterior sign was taken down in 2016 to be refurbished; however, it was discovered to have suffered rust damage and will be replaced with an exact reproduction of the original.

[24] Since the Applicant purchased the property and commenced renovations, the property has been the subject of media articles, examples of which are included in Exhibits 19 through 22 to the Pullen Affidavit.

[25] In 2015, the Applicant opened a retail outlet in Toronto named “Prohibition by El Mocambo” selling various EL MOCAMBO branded items, including pillows bearing the Mark. Examples of such goods are included in Exhibit 24 to the Pullen Affidavit.

ONUS AND MATERIAL DATES

[26] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[27] The material dates for the grounds of opposition are set out below.

- Sections 38(2)(a) / 30(e) and (i) – the filing date of the Application [*Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB); *Tower Conference Management Co v Canadian Exhibition Management Inc.*, (1990) 28 CPR (3d) 428 (TMOB)];
- Sections 38(2)(b) / 12(1)(d) of the Act – 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)]
- Sections 38(2)(c) / 16(3)(a) and (b) – the filing date of the Application; and
- Sections 38(2)(d) / 2 of the Act - the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30(e) Ground of Opposition

[28] With this ground of opposition, the Opponent pleads that the Application does not comply with section 30(e) because at the date of filing the Application, namely, February 15,

2015, the Applicant did not have a real intention to use the Mark in Canada in association with all of the Goods and Services.

[29] With a ground of opposition under section 30(e), it has been recognized that an opponent's initial evidential burden is relatively light, given that the requisite facts to support such a ground are often uniquely within the knowledge of an applicant [see *Molson Canada v Anheuser-Busch Inc.*, 2003 FC 1287, 29 CPR (4th) 315 at paras 56-57].

[30] In the present case, for all but one of the Goods and Services, there is no evidence of record to suggest that the Applicant did not intend to use the Mark as of the Application filing date. However, during the cross-examination on the Pullen Affidavit, the Opponent asked questions regarding the Applicant's intention with respect to certain specific goods. In particular, the following exchange took place regarding the goods identified in the Application as "computer games" (see Question 159 of the cross-examination transcript):

Q. Was there an intention of using the mark in association with computer games?

A. We haven't elucidated a specific case where we would use the El Mocambo relating to computer games. But we feel like it is a...you know, a popular brand and name that could extend in to just -- to just about anything.

I don't know if that is a good answer. But we have pins. We have stickers. We have hats. We have T-shirts. We have -- we are develop -- we are doing a guitar in conjunction with Gibson guitars. We are doing a...a couple of pedals for guitars. Speakers are on the -- you know, things related to musical equipment, recording gear. That is all within -- we have guitar picks. We have ... we have a belt -- we are doing a belt, a belt buckle. [...]

I don't have anything -- I don't -- we don't have anything in mind in particular related to computers, computer games.

[31] In my view, the above answer provided by the Applicant's affiant Ms. Pullen is sufficient for the Opponent to meet its initial evidential burden for the section 30(e) ground of opposition in respect of computer games. The answer suggests that the inclusion of the goods "computer games" in the Application was based on a desire not to limit the scope of rights obtained, rather than any intention to actually use the Mark in association with computer games. In contrast, I note that Ms. Pullen was asked questions about the Applicant's intention to use the Mark in association with certain other goods and services in the Application (such as alcoholic beverages and hotel services) and she provided responses which in my view did suggest an intention on the part of the Applicant to use the Mark in association with those goods and services as of the

Application filing date (see Questions 167 to 171 of the cross-examination transcript). Therefore, with respect to “computer games”, I find that the Opponent has met its initial evidential burden for the section 30(e) ground of opposition; however, the Opponent has not met that burden for any of the remaining Goods and Services.

[32] Since the Applicant provided no other evidence of an intention to use the Mark in Canada in association with computer games as of the filing date of the Application, the section 30(e) ground of opposition succeeds in respect of the goods “computer games”. For all of the remaining Goods and Services, I reject the section 30(e) ground of opposition on the basis that the Opponent has not met its initial evidential burden.

Section 30(i) Ground of Opposition

[33] The Opponent pleads that the Applicant could not have been satisfied of its entitlement to use the Mark because it was confusing with the Opponent’s trademarks which had been previously used in Canada.

[34] Section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trademark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant’s statement untrue, such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent’s trademark is not sufficient to support a section 30(i) ground of opposition [see *Woot Inc v WootRestaurants Inc*, 2012 TMOB 197].

[35] In the present case, the Application contains the requisite statement and there is no evidence that this is an exceptional case. Accordingly, the section 30(i) ground of opposition is dismissed.

Section 12(1)(d) Ground of Opposition

[36] With the section 12(1)(d) ground of opposition, the Opponent relies on its registration No. TMA885296 for the trademark PALM TREES DESIGN. I have exercised my discretion to

check the register and confirm that registration remains extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden for the section 12(1)(d) ground of opposition.

[37] I note that the Opponent's application No. 1,730,630 for the trademark TURTLE BEACH & Palm Tree Design, referenced in the statement of opposition, subsequently proceeded to registration No. TMA974874 on July 4, 2017. However, the Opponent did not amend its statement of opposition to rely on TMA974874 as part of its section 12(1)(d) ground of opposition. Consequently, the Opponent's application No. 1,730,630 is considered in respect of the Opponent's section 16(3)(b) ground of opposition, discussed later in this decision. The analysis of the section 12(1)(d) ground is solely in respect of the Opponent's registration No. TMA885296.

[38] In conducting the confusion analysis, below, I have considered all of the Goods and Services listed in the Application, including "computer games", in the event that I am wrong in my finding that the section 30(e) ground of opposition succeeds in respect of "computer games".

Test for Confusion

[39] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods and services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[40] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC

23, 49 CPR (4th) 401; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. 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.

[41] 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 he or she has no more than an imperfect recollection of the opponent's trademark, and does 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].

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

[42] Both parties' trademarks are inherently distinctive, since neither trademark describes any aspect of the parties' goods and services. However, I consider the Applicant's Mark to have a higher degree of inherent distinctiveness than the Opponent's trademark, given the presence of the additional word matter "EL MOCAMBO" which is itself inherently distinctive in association with the Goods and Services, and thus adds to the inherent distinctiveness of the Mark as a whole. The term "EL MOCAMBO" has no dictionary meaning in English or French (I note that as part of the prosecution of the Application during the examination stage, the Applicant represented to the Examiner that the word "MOCAMBO" is Portuguese for "hut").

[43] The Opponent's trademark has been used in Canada since 2013. However, the Opponent's evidence regarding the scale of its use and advertising of the trademark in Canada is limited. In particular, the Opponent's evidence does not include any annual or total sales or advertising figures which are specific to Canada. The figures which are specific to Canada are limited to those contained in sample invoices from the Opponent to Canadian retailers. Consequently, at best for the Opponent, I conclude that its trademark has become known in Canada to some extent in the video game industry.

[44] The Application is based on proposed use of the Mark in Canada in association with the Goods and Services. However, when it comes to the extent to which the Mark has become known, the Applicant seeks to rely on the many years of prior use by the Applicant's

predecessors in title of the name EL MOCAMBO as well as the Previous One Palm Mark and the Previous Multiple Palm Mark. I disagree with the Applicant that it can rely on that prior use. While the name EL MOCAMBO may have become known over time by virtue of use by predecessors in title to the Applicant, the specific design trademarks used in the past were different than the Mark in issue in the present proceeding. In short, I do not consider that the Mark has become known to an extent that would assist the Applicant.

[45] On balance, taking into account both the inherent and acquired distinctiveness of the parties' respective trademarks, in my view, this factor does not favour either party. In particular, while the Opponent's trademark may be known to a slightly greater degree, the Applicant's trademark has a higher degree of inherent distinctiveness.

The length of time the trademarks have been in use

[46] The Opponent's trademark has been used in Canada since 2013. The Application is based on proposed use of the Mark, and there is very limited evidence of the use of the Mark since the Application filing date of February 18, 2015. This factor favours the Opponent.

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

[47] The Opponent's registration covers the following goods:

Computer peripherals, namely, computer audio processors, video game console audio processors, headphone adapters for computer audio systems and headphone adapters for video game consoles

[48] The Opponent's evidence of its use of its trademark is reasonably consistent with the above description, in that the Opponent focuses on the sale of audio headsets for video game play.

[49] For the vast majority of the Goods and Services listed in the Application (e.g. cosmetics, jewellery, printed materials, glassware, clothing), there is no overlap or similarity with the Opponent's goods. The exception to this is the following goods listed in the Application:

Audio equipment for musical instruments, namely, stereos, speakers, amplifiers, equalizers, crossovers, microphones, audio receivers, electrical audio and speaker cables

and connectors, audio decoders, video decoders, power converters, and power inverters and speaker housings; Electric audio playback units with lights and speakers; [...] educational toys and games namely [...] computer games,

[50] For the above audio-related goods in the Application, there is a degree of overlap with the Opponent's goods, in as much as both parties' goods relate to audio equipment. However, the Opponent's goods (both as described in its registration and in its evidence from the marketplace) appear to be designed for video game play, whereas the Applicant's audio-related goods as described in the Application appear to be designed for use with musical instruments.

[51] With respect to the "computer games" listed in the Application, there is potential overlap with the Opponent's goods since the Opponent focusses on audio headsets for video game play. However, the evidence does not indicate that the Opponent itself sells video games, but instead focusses on hardware such as headsets for use when playing video games.

[52] Overall, this factor strongly favours the Applicant for all of the Goods and Services, except for the goods identified in paragraph 49, above. For those goods identified in paragraph 49, this factor favours the Opponent, but only to a slight degree.

Degree of resemblance

[53] As noted above, the degree of resemblance is often the most significant factor in the confusion analysis. I consider that to be the case here.

[54] With the Opponent's trademark, the striking or unique aspect is the palm trees design.

[55] With the Applicant's Mark, I similarly consider the palm tree design to be the most striking element. However, the palm tree design in the Applicant's Mark is visibly quite different from the Opponent's trademark. In particular, the Opponent's trademark is comprised of a pixilated silhouette of two palm trees, whereas the Applicant's Mark includes an illustrated single palm tree with significantly more detail. In addition, the presence of the term "EL MOCAMBO" in the Applicant's Mark constitutes an additional point of difference – in terms of appearance, sound and idea – from the Opponent's trademark.

[56] On balance, when the parties' trademarks are considered as a whole, in my view, they are more different than they are similar. Consequently, this factor favours the Applicant.

Surrounding circumstance – state of the marketplace

[57] The Pullen Affidavit includes in paragraphs 32 and 33 (and the related Exhibits 25 and 26) examples of third party use of palm tree designs on various goods located online. I do not consider this evidence to assist the Applicant, as the evidence does not demonstrate that these products were sold or advertised in Canada on a scale such that Canadians would be familiar with them.

Surrounding circumstance – purported fame of the Mark

[58] Despite the Application being based on proposed use of the Mark in Canada, the Applicant asserts that the Mark is famous by virtue of the music venue having been operated for many years by previous owners. The Applicant asserts that this factor should weigh in its favour in the confusion analysis – for example, when considering the extent to which the parties' trademarks have become known. The Opponent contests whether any goodwill in the Mark actually passed from the Applicant's predecessors-in-title to the Applicant, and on this point, the parties contest the degree to which the contract to purchase the property (included as Exhibit 9 to the Pullen Affidavit) had the effect of transferring goodwill in the Mark from the previous owner to the Applicant.

[59] Ultimately, to the extent that any reputation may have existed in the Mark prior to the Applicant's purchase of the property, I do not consider that prior reputation to assist the Applicant in this case, and have given it no weight. However, I do not consider any prior reputation in the Mark necessary for the Applicant to succeed on the issue of confusion, given the other factors weighing in the Applicant's favour – most notably the low degree of resemblance between the parties' trademarks. Consequently, I will refrain from any further analysis of the purported fame of the Mark or the contractual issue note above.

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

[60] Having considered all of the surrounding circumstances, I conclude that the Applicant has satisfied its legal burden to show that there is no reasonable likelihood of confusion between the parties' trademarks. I do not consider the degree of resemblance between the trademarks to be sufficiently high as to give rise to a likelihood of confusion in respect of any of the Goods and Services listed in the Application.

[61] Consequently, I reject the section 12(1)(d) ground of opposition.

Section 16(3)(a) Ground of Opposition

[62] With this ground of opposition, I have considered each of the Opponent's trademarks discussed in paragraphs 4 and 5 of this decision, above.

[63] The Opponent has met its initial evidential burden for the section 16(3)(a) ground of opposition, as it has demonstrated use of its trademarks since prior to the material date, namely, the filing date of the Application.

[64] The Opponent having met its initial evidential burden for the section 16(3)(a) ground of opposition, the analysis of confusion is essentially identical to that set out above for the section 12(1)(d) ground. The earlier material date for the non-entitlement ground does not have any impact on the outcome of the analysis. I find that the Applicant has satisfied its legal burden to demonstrate that there is no likelihood of confusion between the Mark and the Opponent's trademarks. Therefore, I reject the section 16(3)(a) ground of opposition.

Section 16(3)(b) Ground of Opposition

[65] With this ground of opposition, the Opponent relies on the trademark TURTLE BEACH & Palm Tree Design which is the subject of application No. 1,730,630. That application has a priority filing date of December 2, 2014, which precedes the filing date of the Applicant's Application. While the Opponent's application No. 1,730,630 subsequently proceeded to registration, it was still pending on the date of advertisement of the Applicant's Application, and thus the Opponent may rely on it for the purposes of section 16(3)(b).

[66] With the Opponent's trademark TURTLE BEACH & Palm Tree Design, the degree of resemblance with the Mark is even lower than with the Opponent's trademark PALM TREES DESIGN (TMA885296), given the vastly different appearance, sound and idea conveyed by the word elements "TURTLE BEACH" as compared to "EL MOCAMBO". While the description of goods in the Opponent's application No. 1,730,630 is broader than in registration No. TMA885296, I consider the low degree of resemblance between the Mark and the Opponent's trademark TURTLE BEACH & Palm Tree Design to be dispositive of the issue of confusion.

[67] In view of the above, I reject the section 16(3)(b) ground of opposition.

Section 2 Ground of Opposition

[68] In order to meet its evidential burden with respect to the section 2 ground, the Opponent had to show that its trademarks had a substantial, significant or sufficient reputation in Canada in association with the relevant goods as of the filing date of the opposition [see *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 at para 34].

[69] In this case, even if I were to find that the Opponent had met its initial evidential burden, since this ground ultimately turns on the allegation of confusion with the Opponent's trademarks, I would come to the same conclusions as above with respect to the sections 12(1)(d) and 16(3)(a) and (b) grounds. Therefore, I reject the section 2 ground of opposition on that basis.

DISPOSITION

[70] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the goods "computer games" and I reject the opposition with respect to the remainder of the goods and services pursuant to section 38(12) of the Act.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1715834 for EL MOCAMBO & PALM TREE DESIGN

Goods

- (1) Cosmetics and toilet preparations namely soaps, shampoos, shaving cream and deodorant
- (2) Videotapes, audio tapes, CDs and DVDs containing pre-recorded musical performances; Pre-recorded audio tapes, compact discs containing music, videos and films; Phonograph records; Audio equipment for musical instruments, namely, stereos, speakers, amplifiers, equalizers, crossovers, microphones, audio receivers, electrical audio and speaker cables and connectors, audio decoders, video decoders, power converters, and power inverters and speaker housings; Electric audio playback units with lights and speakers;
- (3) Jewellery and watches;
- (4) Musical instruments namely woodwind, string, percussion and brass musical instruments; Musical instrument accessories, namely, stands, cases, carrying bags and storage bags; Electric and electronic musical instruments
- (5) Printed materials, namely newsletters, menus, notecards and post cards; stationery namely notebooks, writing paper, letter paper and note paper, stickers, pencils, school supplies namely pencil cases, rulers and binders; Pennants, key chains, umbrellas, pens, lighters; Wall calendars, loose-leaf desk calendars, calendar refills, tear-off wall/desk calendars, date books, memo pads holders, pencil caddies, blank books, diaries, address books, engagement books, desk pads, note pads, note pad portfolios, memo pads, waste paper baskets, clip boards, letter openers, stickers, sticker stationery, post cards, greeting cards, photo albums, autograph books, message pads, telephone pads and notice and message boards, scrap books and book marks, Paper plates and party napkins
- (6) Leather belts
- (7) Glassware, namely, drinking glasses, beer steins beer coolers, drink coasters, coffee mugs, ashtrays; thermal insulated containers for food or beverages; beverage containers; towels, duffel bags, shoulder bags, overnight bags, sports bags, toiletry bags and travel bags; Coffee mugs, coasters, serving trays, souvenir spoons, fridge magnets, bottle openers, shot glasses and ice buckets and pottery.
- (8) Clothing namely hats, socks, shoes, dresses, suits, skirts, pants, shirts, jackets; silk screen and flock-imprinted T-shirts, sports shirts, sweaters and fleece-lined shirts, sweaters and pants; T-shirts, tank tops, T-dresses, jogging suits, polo pajamas, short sets, underwear, knit tops and hats, caps, toques, shorts, jackets, caps, belts and sun visors, headbands and sweatbands; footwear namely sandals and casual shoes
- (9) Fanny packs and back packs
- (10) Toys namely beach toys, plush toys, small toys and educational toys and games namely board games, computer games, card games, party games and parlour games
- (11) Alcoholic cocktails and wine;
- (12) Non alcoholic beverages namely fruit juices and soft drinks and beer

Services

- (1) TV programming; operation of a website that provides streaming audio and video, music, movies, television shows, music videos, news and sports webcasts
- (2) Entertainment Services namely operation of a night club featuring performance of live and recorded music; music and talent agencies and consultants
- (3) Entertainment Services namely operation of radio station, recording studio and musical concert pay per view events; Telecommunication services, namely providing online and wireless networks for real-time interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices for social networking
- (4) Hotel, restaurant, bar and tavern

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HEARING DATE 2021-05-04

APPEARANCES

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AGENTS OF RECORD

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