



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

Citation: 2012 TMOB 254
Date of Decision: 2012-12-21

**IN THE MATTER OF AN OPPOSITION
by Research in Motion Limited to
application No. 1324993 for the trade-
mark BLACKPEARL in the name of LG
Electronics Inc.**

[1] On November 21, 2006, LG Electronics Inc. (the Applicant) filed an application for the trade-mark BLACKPEARL (the Mark) for proposed use in association with television sets.

[2] The application for the Mark was advertised on May 30, 2007. On July 9, 2007, Research in Motion Limited (the Opponent), filed a statement of opposition against the application.

[3] The grounds of opposition are summarized below:

- (a) the application does not conform to the requirements of section 30(i) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because the Applicant could not and cannot be satisfied of its entitlement to use or register the Mark in Canada because it must have been aware of the Opponent's prior use in Canada of the Opponent's BLACKBERRY trade-marks as set out in the statement of opposition in association with the wares and services identified in the registrations, all of which are confusingly similar to the Mark and the Opponent's prior applications and registrations for the BLACKBERRY trade-mark as set out in the statement of opposition;
- (b) the application does not conform to the requirements of section 30(b) of the Act since the Applicant does not intend to use the Marks in Canada in association with the applied for wares;

- (c) the Mark is not registrable pursuant to section 12(1)(d) because the Mark is confusing with the Opponent's BLACKBERRY trade-marks (set out in Schedule A attached to my decision, hereinafter referred to as the Opponent's Registered Trade-marks) which the Opponent has not abandoned.
- (d) the Applicant is not the person entitled to register the Mark pursuant to section 16(3) of the Act because, at the date of filing, the Mark was confusing with the Opponent's Registered Trade-marks and for the following trade-marks (set out in Schedule B attached to the Opponent's statement of opposition), which the Opponent had previously used in Canada and for which applications had been filed:
 - i. BLACKBERRY CURVE
 - ii. BLACKBERRY PEARL
- (e) the Mark is not distinctive of the Wares or Services because it does not actually distinguish, nor is it adapted to distinguish, the Wares and Services from the wares and services of others, including those of the Opponent.

[4] The Opponent filed the affidavits of Ruth M. Corbin, Robert T. Brockbank, Robert White, Mark Guibert, and Ronald Harvey Smyth. The Applicant filed the affidavits of Jocelyn Yurick and Linda Thibeault.

[5] Only the Applicant filed a written argument. An oral hearing was not held.

Onus and Material Dates

[6] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, S.A. et al* (2002), 20 CPR (4th) 155 (FCA)].

[7] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30 – the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB) and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- s. 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];

- s. 38(2)(c)/16(3) – the filing date of the application [see s. 16(2)];
- s. 38(2)(d)/2 – the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)].

Opponent's evidence

Affidavit of Robert T. Brockbank

[8] Mr. Brockbank is the President of R. T. Brockbank & Associates Inc., an Ontario based private investigative firm.

[9] Mr. Brockbank was engaged by the Opponent to conduct various investigations, presumably, based on my review of his affidavit, in an attempt to establish the absence of a Canadian presence for the Applicant in association with the Mark, as well as to show the proximity of the Opponent's wares to LG brand television sets in various retail outlets.

Affidavit of Mark Guibert

[10] Mr. Guibert is the Vice President of Corporate Marketing for the Opponent. His affidavit serves to introduce evidence of the viability of the Opponent and of promotion, advertising, and sales of its BLACKBERRY branded products.

[11] Mr. Guibert claims that the Opponent has sold in excess of 25 million handheld devices, and presently the Opponent provides service to over 14 million service subscribers on over 300 carrier partner networks in over 130 countries around the world. He further claims that the Opponent has sold a wide variety of BLACKBERRY branded handheld device accessories, including batteries, carrying cases, protective covers, charging stations, travel charging and adaptor kits (to convert local power and power outlets), earphones and headsets (headphones), and third party flash memory for data, music, pictures or video in Canada since 1999.

[12] Mr. Guibert states that on September 7, 2006 the Opponent announced the launch of its BLACKBERRY PEARL smartphone (see Exhibit MG-20). Mr. Guibert states that sales of the BLACKBERRY PEARL smartphones in Canada began in October 2006 and have continued since then. He does not provide a breakdown of BLACKBERRY sales to show what the sales figures have been for the Opponent's BLACKBERRY PEARL product.

Affidavit of Ruth M. Corbin

[13] Ms. Corbin is the Chief Executive Officer of Corbin Partners Inc. and an Adjunct Professor at Osgoode Hall Law School of York University. She states that Corbin Partners Inc. was retained in January 2008 to plan, design and implement a telephone survey of Canadian adults to measure the extent of awareness, if any, of the brand name BLACKBERRY. She attaches a number of documents to show the steps taken in designing and implementing the survey, including interviewer instructions and weighted results. However, none of the materials contain any reference to the BLACKBERRY composite marks of the Opponent.

[14] Ms. Corbin claims that 56% of the survey respondents were aware of a product or service with the brand name BLACKBERRY and they described it on an immediate and unaided basis, as one or more of the following products or services: E-mail device, E-mail service, mobile phone, cell phone, smart phone, mobile phone service, cell phone service, smart phone service, personal digital assistant, PDA, electronic organizer, software.

[15] Ms. Corbin claims that an additional 13% of survey respondents who were unable to associate the brand name BLACKBERRY with any of the above mentioned products or services acknowledged that they were aware of the brand name BLACKBERRY in association with a handheld device.

[16] Ms. Corbin claims that an additional 3% of survey respondents, who did not voluntarily associate the name BLACKBERRY with any of the above mentioned products or services, volunteered that they associated the brand name BLACKBERRY with a term that is an accurate descriptor of a product or service made available by the Opponent.

[17] Ms. Corbin claims that 72% of the respondents demonstrated awareness of the brand name BLACKBERRY in association with at least one product or service that is made available by the Opponent.

Affidavit of Ronald Harvey Smyth

[18] Mr. Smyth is an Associate Professor in the Departments of Humanities (Linguistics Discipline) and Psychology, and a member of the Cognitive Science Discipline of the University

of Toronto. Mr. Smyth states that he was retained on behalf of the Opponent to provide an opinion as to any similarities between the Opponent's trade-marks BLACKBERRY and BLACKBERRY PEARL and the Mark.

Affidavit of Robert W. White

[19] Mr. White is the Senior Vice-President, Canada of the Audit Bureau of Circulations. His affidavit serves to introduce the audited circulation figures for a number of magazines, newspapers, digests and journals.

Applicant's evidence

Affidavit of Jocelyne Yurick

[20] Jocelyn Yurick is an independent administrative assistant retained by the agents for the Applicant. She conducted a search of the Internet and published dictionaries for definitions of the words "black", "pearl", and "ruby". She noted that the dictionary definitions she located did not contain any references to the Opponent's marks or their associated wares and services.

Affidavit of Linda Victoria Thibeault

[21] Linda Victoria Thibeault is a trade-mark searcher with Trade-mark Reflections Ltd. The Thibeault affidavit serves to introduce 21 trade-mark registrations and 4 applications containing the word BLACK (alone or in combination) with Class 9 wares, as well as 12 registrations and 12 third party applications containing the word PEARL or its phonetic equivalent, in connection with Class 9 wares.

Preliminary Issue - Admissibility of Expert Evidence

[22] The Opponent's expert evidence has taken two forms: expert testimony from Mr. Smyth regarding the similarities between the Opponent's trade-marks BLACKBERRY and BLACKBERRY PEARL and the applied for mark BLACKPEARL, and a survey conducted by Ms. Corbin regarding the trade-mark BLACKBERRY and its association with at least one product of the Opponent in the minds of consumers.

[23] Recently, in *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC), the Court considered the judge's role in controlling the admission of expert evidence in trademark confusion cases. Justice Rothstein noted that courts must fulfill their gatekeeper role to ensure that unnecessary, irrelevant and potentially distracting expert and survey evidence is not allowed to extend and complicate court proceedings.

[24] Relying on the decision in *R v Mohan* (1994), 2 SCR 9, Justice Rothstein stated that the following four requirements must be met before expert evidence is accepted: a) relevance; b) necessity in assisting the trier of fact; c) the absence of any exclusionary rule; and d) a properly qualified expert. With respect to "necessity", the Court explained that an expert should not be permitted to testify if their testimony is not "likely to be outside the experience and knowledge of a judge."

[25] In *Masterpiece, supra*, the expert testimony did not meet the second requirement of necessity. In this regard, the expert evidence which simply assessed the resemblance between the marks was not considered necessary because the casual consumer is not expected to be particularly skilled or knowledgeable. Similarly, in the present case, the evidence of Mr. Smyth was put forth to provide an opinion as to similarities between BLACKBERRY and BLACKBERRY PEARL and BLACKPEARL. Although the Applicant did not object to this evidence, in the absence of any written or oral argument from the Opponent, and in view that this evidence is similar to the type that was presented in *Masterpiece*, I am not satisfied that this evidence is necessary. In this regard, I do not consider the evidence of Mr. Smyth to be outside of the experience and knowledge of a judge, or a board member as in the present case. I have therefore not given any weight to it.

[26] With respect to surveys, the Court in *Masterpiece, supra*, stated that surveys have the potential to provide empirical evidence which demonstrates consumer reactions in the marketplace, which is not something generally known to a judge and does serve to answer the question that the judge is addressing in a confusion case. The use of consumer surveys in trademark cases has been recognized as valid evidence to inform the confusion analysis and its main difficulty is often its reliability and possible invalidity (eg. instead of addressing the likelihood of confusion, it addresses the possibility of confusion). In the present case, I have no reason to

doubt that the results of Ms. Corbin's survey are both valid and reliable and I do recognize it as relevant to the confusion analysis. I am therefore prepared to give full weight to her evidence.

Grounds of Opposition

Section 30 Grounds of Opposition

[27] The Opponent has pleaded two grounds of opposition under section 30.

[28] Regarding the section 30(i) ground, I note that the Applicant has made the requisite statement and there is no evidence that it did so in bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The section 30(i) ground is accordingly dismissed.

[29] With respect to the section 30(b) ground, I note that the application is based on proposed use. The section 30(b) ground therefore appears to have been improperly pleaded and I have no arguments from the Opponent to suggest otherwise. The section 30(b) ground is accordingly dismissed.

Section 16(3)(a) Ground of Opposition

[30] Each of the final three grounds of opposition turns on the issue of the likelihood of confusion between the Mark and each of the Opponent's marks. I consider the Opponent's case to be strongest with respect to the ground that the Applicant is not the person entitled to register the Mark pursuant to section 16(3)(a) of the Act because this ground includes the Opponent's applied for mark BLACKBERRY PEARL which, arguably, is closer in resemblance to the Mark than the Opponent's other trade-marks. However, in view of the Opponent's extensive evidence of use and reputation of its BLACKBERRY mark, I will focus my analysis on the likelihood of confusion between the Opponent's BLACKBERRY and BLACKBERRY PEARL marks and the Mark. If the Opponent is not successful based on these marks, then it will not be successful based on any of its other marks. The wares and services for each of these marks are set out below.

BLACKBERRY, Registration No. 638,068

Wares:

Electronic handheld units and accessories for the wireless receipt and/or transmission of data; software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer on a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data.

Electronic handheld units and accessories for the wireless receipt and/or transmission of data; software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer on a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data; electronic handheld units and accessories for the wireless receipt and/or transmission of voice.

Electronic handheld units and accessories for the wireless receipt and/or transmission of voice communications.

Services:

E-mail services; wireless data messaging services, namely services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services;

Consulting and educational services in the nature of providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, namely corporate data;

Transmission and reception of voice communication services.

BLACKBERRY PEARL, Application No. 1308467

Wares:

Electronic handheld units namely, wireless handheld devices, namely personal digital assistants, wireless phones, mobile phones, cellular phones, smart phones, video phones, handheld, slate and tablet computers for the wireless receipt and/or transmission of voice and data and which may also have the capability to transmit and receive voice communications and accessories, namely, batteries, car kits, chargers, head sets, belt clips/holsters, cases, battery covers and docking/charging cradles; wireless communications software for the transmission and/or reception of messages, global computer network e-mail, voice and data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data.

Services:

E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services.

Test for confusion

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

[32] In applying the test for confusion, I 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 wares, 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.

[33] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. Recently, in *Masterpiece, supra*, the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

the inherent distinctiveness of the trade-marks and the extent to which they have become known

[34] Both of the Opponent's marks and the Mark are inherently distinctive in relation to their respective wares and services. However, in view that the Opponent's marks are ordinary dictionary words while the Mark is a coined word, I consider the Mark to be inherently stronger than both of the Opponent's marks.

[35] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. Mr. Guibert's evidence shows that the Opponent's BLACKBERRY mark has been used and made known extensively in Canada and worldwide since 1999. The evidence of Ms. Corbin is that 56% of survey respondents were aware of a product or service with the brand name BLACKBERRY in association with one or more of the following products or services: e-mail device, e-mail service, mobile phone, cell phone, smart phone, mobile phone service, cell phone service, smart phone service, personal digital assistant, PDA, electronic organizer, software. I am therefore satisfied that the Opponent has shown that a significant proportion of consumers in Canada would associate the trade-mark BLACKBERRY in association with at least one product or service that is made available by the Opponent.

[36] As for the Opponent's BLACKBERRY PEARL mark, while Mr. Guibert asserts that it has been used in Canada since October, 2006, he has not provided a breakdown of the Opponent's BLACKBERRY sales figures to show what amount may be attributable to BLACKBERRY PEARL. In any event, since the material date for this ground is Nov. 21, 2006, it is reasonable to assume that this mark was not known in Canada to a great extent by that date.

[37] With respect to the Mark, I note that it is based on proposed use and there is no evidence of any use of the Mark after the date of filing of the application.

[38] Based on the foregoing information, I conclude that the Opponent's BLACKBERRY mark has become known to a significant extent across Canada. As a result, the overall consideration of the section 6(5)(a) factor favours the Opponent, but only to the extent that its BLACKBERRY mark is concerned.

s. 6(5)(b) - the length of time each trade-mark has been in use

[39] The length of time that each mark has been in use favours the Opponent, at least with respect to its BLACKBERRY word mark.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[40] It is the Applicant's statement of wares as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [see

Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc (1986), 12 CPR (3d) 110 (FCA); *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[41] In its written argument, the Applicant commented on the Opponent's wares as follows:

The Opponent's evidence demonstrates that its primary wares are handheld devices that incorporate mobile phone, e-mail, and personal digital assistant functionalities (e.g. calendar, address lists, task lists). The Opponent also provides related software and accessories that include batteries, carrying cases, protective covers, charging stations, travel charging and adaptor kits. The Opponent's software includes an enterprise server that connects its handheld devices with enterprise e-mail server programs, desktop software for synchronizing data between its handheld device and a desktop personal computer, and various development tools for developing applications for its handheld devices.

[42] The Applicant further submits that, by contrast, the applied for wares are television sets. It argues that televisions range in size from smaller models to larger models, and are frequently sold in conjunction with other products such as stereos, surround sound or home theatre audio equipment, DVD players and standard or high definition cable/satellite television subscriptions. Further, as evidenced in the Guibert affidavit at para. 9, the Opponent's BLACKBERRY units are embraced by corporate professionals to keep in touch with work while the Applicant's product is a home entertainment product.

[43] I agree with the Applicant that the parties' wares do not overlap.

[44] With respect to the parties' channels of trade, the Opponent has adduced evidence regarding the proximity of the Applicant's LG brand televisions and the Opponent's wares in the same stores (see Brockbank affidavit). This is not surprising, however, given that the stores in which the wares were found to co-exist (e.g. Future Shop, Best Buy and Costco) are large electronics/computing stores in which a broad range of electronics would be sold.

[45] Based on the foregoing, I am satisfied that, despite the differences in the exact nature of the parties' wares and services, the evidence shows that the Applicant's wares could be sold through the same channels of trade as the Opponent's wares and services.

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

[46] While the Supreme Court of Canada in *Masterpiece* observed that the first word of a trade-mark may be the most important for purposes of distinction [see also *Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], it opined that the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[47] In the present case, the only resemblance between the Opponent’s BLACKBERRY mark and the Mark is the common use of the component BLACK. I do not consider this shared component to be particularly striking or unique. In this regard, the Mark includes the additional component PEARL while the Opponent’s mark features the additional component BERRY. The ideas suggested by the marks are also different. In this regard, the Mark suggests a type of jewel which is the colour black. The Opponent’s mark, on the other hand, suggests a type of fruit known as a blackberry.

[48] The degree of resemblance between the Opponent’s BLACKBERRY mark and the applied for mark BLACKSOX and Design was commented on by Member Flewelling in *Research in Motion Limited v Brandlab AG* (June 7, 2011 (TMOB); Application No. 1,270,112) as follows at para. 58:

“When considering the marks as a whole, I am not convinced that the mere fact that the Mark contains the word “black” is sufficient to find that the parties’ marks share any significant degree of similarity in either appearance or sound.”

[49] I find that the above comments are equally applicable to the present case.

[50] With respect to the resemblance between the Opponent’s BLACKBERRY PEARL mark and the Mark, there is a higher degree of resemblance because both parties’ marks include both the same first component (i.e. the component BLACK) and the word or component PEARL. However, as noted above, I do not consider neither the component BLACK nor the component PEARL to be very striking or unique components in the Opponent’s mark because both are ordinary dictionary words. The Mark BLACKPEARL as a whole, however, is unique in that it is a coined word. As for the ideas suggested, the Opponent’s mark suggests that its

BLACKBERRY PEARL wares are an extension of its BLACKBERRY product line, while the Mark, as noted above, suggests the jewel commonly known as a pearl which is the colour black.

Additional Surrounding Circumstances - State of the Register Evidence

[51] As a further surrounding circumstance, we have the evidence of other BLACK prefixed trade-marks on the Canadian Trade-mark Register in connection with Class 9 wares. Of course, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD)]. However, the decision in *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA), is support for the proposition that inferences about the state of the marketplace can be drawn from state of the register evidence where large numbers of relevant registrations are located. In the present case, there are sufficient numbers of relevant registrations that begin with the word BLACK (at least 15) as well as enough registrations that contain the component PEARL (or its phonetic equivalent) owned by a variety of companies for related wares and services that I may accept that the Canadian public is accustomed to distinguishing marks containing the prefix BLACK and the component PEARL for class 9 wares.

Conclusion

[52] Section 6(2) is not concerned with confusion between the marks themselves, but rather confusion as to the source of the goods or services. In this case, an assessment of confusion asks whether there would be confusion of the wares provided in association with the Mark, as emanating from or sponsored by or approved by the Opponent.

[53] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees BLACKPEARL on the Applicant's televisions at a time when he or she has no more than an imperfect recollection of the Opponent's BLACKBERRY or BLACKBERRY PEARL trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*]. It seems to me that such a consumer would not, as a matter of first impression, be likely to believe that the wares associated with the Opponent's

BLACKBERRY or BLACKBERRY PEARL mark and the Applicant's BLACKPEARL mark were manufactured, sold or performed by the same person.

[54] Having considered the all of the surrounding circumstances, in particular the lack of reputation for the Opponent's BLACKBERRY PEARL mark, the differences in the parties' wares, the common adoption by third parties of the component BLACK or PEARL for trade-marks for related wares and services, the fact that the Opponent may have lost interest in these proceedings as suggested by its decision to not put forward any argument in support of its opposition, and notwithstanding that the Opponent has demonstrated that its BLACKBERRY mark has acquired a significant reputation in general, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and either of the Opponent's marks as of the material date. The section 16(3)(a) ground therefore fails.

Section 12(1)(d) and Distinctiveness Grounds of Opposition

[55] As discussed further above in the analysis of the section 16(3)(a) ground of opposition, the Opponent has established use of its BLACKBERRY mark since 1999. It has therefore met its burden of proof under the distinctiveness ground. I also note that the Opponent's registration No. TMA638,068 for the Mark BLACKBERRY is extant. The Opponent has therefore also met its burden of proof under the section 12(1)(d) ground.

[56] The material dates for assessing the likelihood of confusion in respect of the non-distinctiveness and registrability grounds are, respectively, the date of opposition and the date of my decision. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, for similar reasons as those set out above, the section 12(1)(d) and section 38(2)(d) grounds of opposition fail.

Disposition



[57] For the reasons set out above, and 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.


Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office


SCHEDULE A

TRADE-MARK	REGISTRATION NO.	WARES & SERVICES
BLACKBERRY	TMA638068	<p>(1) Electronic handheld units and accessories for the wireless receipt and/or transmission of data; software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer on a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data.</p> <p>(2) Electronic handheld units and accessories for the wireless receipt and/or transmission of data; software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer on a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data; electronic handheld units and accessories for the wireless receipt and/or transmission of voice.</p> <p>(3) Electronic handheld units and accessories for the wireless receipt and/or transmission of voice communications.</p>

		<p>E-mail services; wireless data messaging services, namely services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services;</p> <p>Consulting and educational services in the nature of providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, namely corporate data;</p> <p>Transmission and reception of voice communication services.</p>
BLACKBERRY	TMA554,207	<p>Electronic handheld units for the wireless reception and/or transmission of data that enable the user to keep track of or manage personal information; software for the redirection of messages, global computer network e-mail, and/or other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; and software for the synchronization of data between a remote station or unit and a fixed or remote station or unit.</p> <p>E-mail service; wireless data messaging services, namely, services that enable a user to send and/or receive messages through a wireless data network using a handheld, portable electronic device; one-way and two-way paging services.</p>
BLACKBERRY CONNECTION	TMA624,894	<p>Newsletter relating to Internet e-mail services and wireless data messaging services and voice communication services and technical support services for hardware and software for wireless data network services and/or voice communication services.</p>
BLACKBERRY & BBBB	TMA659,954	<p>Electronic handheld units and</p>

<p>Design</p> 		<p>accessories, namely, batteries, car kits, chargers, head sets, belt clips/holsters, cases, battery covers and docking/charging cradles for the wireless receipt and/or transmission of data and which may also have the capability to transmit and receive voice communications; software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data.</p> <p>E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services.</p> <p>Consulting and educational services in the nature of providing information to third parties to assist them in developing and integrating one-way or two-way wireless connectivity to data, namely corporate data, and/or voice communications.</p>
<p>BLACKBERRY & BBBB Design</p> 	<p>659,946</p>	<p>Electronic handheld units and accessories, namely, batteries, car kits, chargers, head sets, belt clips/holsters, cases, battery covers and docking/charging cradles for the wireless receipt and/or transmission of data and which may also have the</p>

		<p>capability to transmit and receive voice communications; software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data.</p> <p>E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services.</p> <p>Consulting and educational services in the nature of providing information to third parties to assist them in developing and integrating one-way or two-way wireless connectivity to data, namely corporate data, and/or voice communications.</p>
<p>BLACKBERRY & Colour Design</p> 	<p>TMA554,206</p>	<p>Electronic handheld units for the wireless reception and/or transmission of data that enable the user to keep track of or manage personal information; software for the redirection of messages, global computer network e-mail, and/or other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; and software for the synchronization of data between a remote station or unit and</p>

		<p>a fixed or remote station or unit.</p> <p>E-mail service; wireless data messaging services, namely, services that enable a user to send and/or receive messages through a wireless data network using a handheld, portable electronic device; one-way and two-way paging services.</p>
<p>BLACKBERRY & Design</p> 	TMA555,231	<p>Electronic handheld units for the wireless reception and/or transmission of data that enable the user to keep track of or manage personal information; software for the redirection of messages, global computer network e-mail, and/or other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; and software for the synchronization of data between a remote station or unit and a fixed or remote station or unit.</p> <p>E-mail services; wireless data messaging services, namely, services that enable a user to send and/or receive messages through a wireless data network using a handheld, portable electronic device; one-way and two-way paging services.</p>