

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

Citation: 2012 TMOB 255
Date of Decision: 2012-12-21

**IN THE MATTER OF AN OPPOSITION
by Research in Motion Limited to
application No. 1324009 for the trade-
mark BLACKRUBY in the name of LG
Electronics Inc.**

[1] On November 14, 2006, LG Electronics Inc. (the Applicant) filed an application for the trade-mark BLACKRUBY (the Mark) for proposed use in association with the following wares, as amended:

Computer monitors, CCTV (closed circuit television), notebook computers, computer servers, computers, printers for use with computers, computer operating programs, computer software for computer aided mechanical design, personal digital assistants (PDA), semi-conductors, television sets, mobile phones, facsimile machines, camcorders, video tape recorders (VTR), an electric power outlet adaptor for use with battery powered electronic devices namely, an adaptor comprised of an electric current converter, an electric voltage converter, and an electric outlet plug, headphones, microphones, earphones, digital versatile disc (DVD) players, MP3 players, speakers, compact disc players (CDP), blank audio and video compact discs, head cleaning tapes for recorders, cathode-ray tubes (CRT), video cameras, digital cameras.

[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 for the Mark.

[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

have been 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 its 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 Mark 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 which the Opponent had previously used in Canada and for the following trade-marks (set out in Schedule B attached to the Opponent's statement of opposition) which had also been used and for which applications had been filed:
 - i. BLACKBERRY CURVE, Application No. 1340825
 - ii. BLACKBERRY PEARL, Application No. 1308467
 - iii. BLACKBERRY CYPHER, Application No. 1313127
- (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 Applicant filed and served a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[5] In addition to filing certified copies of its registrations and applications, the Opponent filed the affidavits of Ruth M. Corbin, Robert T. Brockbank, Robert White, Mark Guibert and Ronald Harvey Smyth as its evidence. The Applicant filed the affidavits of Jocelyn Yurick and Linda Thibeault.

[6] Only the Applicant filed a written argument in each opposition. An oral hearing was not held.

Onus and Material Dates

[7] 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, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

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

- sections 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)];
- sections 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)];
- sections 38(2)(c)/16(3) – the filing date of the application [see s. 16(2)];
- sections 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

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

[10] 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 applied for mark, as well as to show the proximity of the Opponent's wares to wares similar to those of the Applicant in various retail outlets. He also provided documents describing what the PALM PILOT, IPOD, MP3 and GPS products are and what they do.

Affidavit of Mark Guibert

[11] 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 the promotion, advertising, and sales of its BLACKBERRY branded products.

[12] 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 also 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 (para. 53 and Exhibit MG-32) in Canada continuously since 1999.

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. Having regard to her academic and professional qualifications, as well as her background and experience in business and marketing research which are set out in detail in her affidavit, I am satisfied that Ms. Corbin has qualified herself as an expert in the area of market research, consumer behaviour, business trends and in the conducting of market surveys.

[14] Ms. Corbin states that CorbinPartners 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.

[15] 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.

[16] 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.

[17] Ms. Corbin claims that an additional 3% of survey respondents, who did not voluntarily associate with 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.

[18] 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

[19] Mr. Smyth states that he 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 at Scarborough. He has been put forth as an expert in linguistics. Based on a review of his *curriculum vitae*, I am satisfied that Mr. Smyth is qualified as an expert in the field of linguistics.

[20] 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 applied for mark BLACKRUBY.

Affidavit of Robert W. White

[21] 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

[22] 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

[23] Linda Victoria Thibeault is a trade-mark searcher with Trade-mark Reflections Ltd. Her 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 6 registrations and 10 applications containing the word RUBY in connection with Class 9 wares.

Preliminary Issue - Admissibility of Expert Evidence

[24] 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 BLACKRUBY, 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.

[25] Recently, in *Masterpiece, supra*, the Court considered the judge’s role in controlling the admission of expert evidence in trade-mark 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.

[26] 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.”

[27] In *Masterpiece*, 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 BLACKRUBY. 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.

[28] With respect to surveys, the Court in *Masterpiece* 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 trade-mark 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

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

[30] 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.

[31] 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 12(1)(d) Ground of Opposition

[32] Each of the final three grounds of opposition turn 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 Mark is not registrable pursuant to section 12(1)(d) of the Act.

[33] I will focus my analysis on the likelihood of confusion between the Opponent's BLACKBERRY word mark and the Mark. If the Opponent is not successful based on this mark, then it will not be successful based on any of its other marks since the BLACKBERRY word mark has a greater degree of resemblance to the Mark than do the other marks of the Opponent.

[34] I have exercised the Registrar's discretion to confirm that the following registration of the Opponent for the BLACKBERRY mark is currently extant:

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.

Test for confusion

[35] 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.

[36] 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. This list is not exhaustive and all relevant factors are to be considered. While all factors do not necessarily have equal weight and the weight to be given to each depends on the circumstances: see *Gainers Inc v Tammy L Marchildon and The Registrar of Trade-marks* (1996), 66 CPR (3d) 308 (FCTD), the degree of resemblance is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion [see *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

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

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

[38] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent's affiant, Mr. Guibert, 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. The Applicant also acknowledges in its written argument that the Opponent's BLACKBERRY trade-mark may have acquired a secondary meaning in association with the Opponent's handheld devices.

[39] On the other hand, the Mark is based on proposed use and there is no evidence of any use of the Mark after the date of filing of the application.

[40] Based on the foregoing information, I conclude that the Opponent's mark has become known to a significant extent across Canada and this factor favours the Opponent.

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

[41] The length of time that each mark has been in use favours the Opponent.

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

[42] 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)].

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

It is apparent from the Opponent's evidence that the Opponent's handheld devices are primarily used for e-mail management. The Opponent's evidence in the Guibert affidavit at Exhibit 45 demonstrates that product's primary purpose is to manage e-mails, and is not promoted primarily as a mobile phone. Mention of the mobile phone feature is either absent or is noted as a secondary, less significant feature in its advertisements. Examples of statements appearing in advertisements at Exhibit 45 are "It's the best way to manage your e-mail and collaborate with your team – wherever you go BlackBerry works with your existing office e-mail... It even syncs with your calendar on the fly." "BlackBerry™ lets you take care of your email wherever business takes you." "BlackBerry™ is different. It's a wireless email solution that was specifically engineered to work with your business email." "BlackBerry. It's the wireless solution that lets you send and receive your email with ease."

[44] The Applicant further submits that not all of the applied for wares are similar to or overlap with the Opponent's products. In this regard, the Applicant submits that its wares are commonly known and referred to as office equipment (with very specific functionalities and intended purposes) and home entertainment products, few of which are adaptable or generally used in conjunction with a wireless handheld device such as a smartphone. Further, the Applicant submits that the Opponent's evidence shows that its products are "wireless technology" while, with the exception of the personal digital assistants (PDA) and mobile phones listed in the trade-mark application, none of the remaining applied for wares are considered "wireless technology" because their operation is dependent upon acquiring an electrical connection and, in some instances, cable or satellite hook up.

[45] I agree with the Applicant that the only wares that directly overlap with the Opponent's wares are the Applicant's personal digital assistants and mobile phones. In view of the evidence of the Opponent's related software for its handheld devices and BLACKBERRY device accessories, however, I would also consider that the Applicant's computer software for computer aided mechanical design, electric power outlet adaptor for use with battery powered electronic devices namely, an adaptor comprised of an electric current converter, an electric voltage converter, and an electric outlet plug, headphones, and earphones would overlap with the Opponent's wares. As for the remaining applied for wares, I only consider them to be related to

the Opponent's wares and services to the extent that both parties operate in the electronics and computing industry.

[46] I would add that the fact that the Opponent's handheld devices may have similar features to some of the applied for wares (eg. Digital camera features, music and sound file storage and playback) is not that relevant to the determination of confusion in the present case as I would think it is reasonable to assume that the average consumer would purchase the Opponent's smartphones for their primary function (i.e. e-mail management) as opposed to their secondary features.

[47] With respect to the parties' channels of trade, the Opponent has adduced evidence regarding the proximity of the parties' wares in the same stores. Specifically, the Opponent filed an affidavit of Robert T. Brockbank, a private investigator who attended at various electronics/computing stores in the Greater Toronto Area to look for products sold by the Applicant as well as the Opponent's smartphone. Although Mr. Brockbank did not observe any BLACKRUBY branded products being displayed at retail stores in Toronto, Oakville or Burlington between January 24, 2008 and March 24, 2008, he noted that most if not all of the products included in the applied for wares with the exception of semi-conductors could be found for sale under third party trade-marks at the stores he visited that sold the Opponent's BLACKBERRY smartphones. 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.

[48] 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

[49] 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.

[50] 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 RUBY while the Opponent's mark features the additional component BERRY. The ideas suggested by the marks are also different. 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.

[51] 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.”

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

Additional Surrounding Circumstances - State of the Register Evidence

[53] 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 [see *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 (i.e. at least 15) that begin with the word BLACK 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. The same cannot be said about marks that contain the word RUBY as Ms. Thibeault's search only revealed 6 registered marks that contained the component RUBY for similar wares in the names of 3 different owners which are too few to draw any inferences about the possible common adoption of such marks in the marketplace.

Conclusion

[54] Having considered all of the surrounding circumstances, I find that the Applicant has not established, on a balance of probabilities, that confusion is not likely between its BLACKRUBY mark and the Opponent's BLACKBERRY mark for the following wares: computer software for mechanical design, personal digital assistants (PDA), mobile phones, an electric power outlet adaptor for use with battery powered electronic devices namely, an adaptor comprised of an electric current converter, an electric voltage converter, and an electric outlet plug, headphones, and earphones. Confusion between these wares and those of the Opponent appears likely given the resemblance between the marks, the reputation of the Opponent's mark, especially with respect to its handheld devices and e-mail services, and the overlap between these wares and their channels of trade. Concerning the remaining wares, I find that they are sufficiently removed from those of the Opponent that the differences in the marks would suffice to make confusion unlikely, and the Opponent has presented no argument to suggest otherwise. The section 12(1)(d) ground of opposition therefore succeeds in part based on registration No. TMA 638,068. The Opponent's position is no stronger based on its other pleaded registrations.

Section 16(3)(a) and Non-Distinctiveness Grounds of Opposition

[55] As discussed further above in the analysis of the section 12(1)(d) ground of opposition, the Opponent has established use of its BLACKBERRY mark since 1999 and has therefore met its burden of proof under the section 16(3)(a) and the non-distinctiveness grounds of opposition. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. 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 16(3)(a) and non-distinctiveness grounds of opposition succeed with respect to “computer software for mechanical design, personal digital assistants (PDA), mobile phones, an electric power outlet adaptor for use with battery powered electronic devices namely, an adaptor comprised of an electric current converter, an electric voltage converter, and an electric outlet plug, headphones, and earphones” and fails with respect to the remaining wares.

Disposition



[56] For the reasons set out above, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to: “computer software for mechanical design, personal digital assistants (PDA), mobile phones, an electric power outlet adaptor for use with battery powered electronic devices namely, an adaptor comprised of an electric current converter, an electric voltage converter, and an electric outlet plug, headphones, and earphones” and I reject the opposition with respect to the remainder of the wares pursuant to section 38(8) of the Act [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Menagers Coronet Inc* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].


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> 	<p>TMA555,231</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 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>