



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 115

Date of Decision: 2020-10-26

IN THE MATTER OF AN OPPOSITION

BlackBerry Limited

Opponent

And

Eye Caramba Oy

Applicant

1,688,346 for BLACK EYE & Design

Application

OVERVIEW

[1] BlackBerry Limited (the Opponent) is a leading designer and developer of innovative enterprise solutions and wireless solutions for the worldwide mobile communications market, best known for its high quality and highly secure wireless handheld devices, related software, accessories and services. The Opponent has filed applications and/or registered numerous BLACKBERRY marks in over 160 jurisdictions worldwide, including Canada. Over the past decade, the Opponent has sold billions of mobile devices under its BLACKBERRY marks and has had over 85 million subscribers to its Internet service in over 91 countries.

[2] Eye Caramba Oy (the Applicant) has applied to register the trademark BLACK EYE & Design set out below (the Mark), in association with the goods, as amended, set out in Schedule A to this decision.



The Opponent opposes this application on the basis that the Mark is confusing with the Opponent's trade name and family of BLACKBERRY trademarks, as set out in the attached Schedule B.

[3] The Applicant has failed to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion for the applied for goods. Notwithstanding that there is only some degree or resemblance between the marks in appearance and as sounded, only the Opponent has shown a significant reputation in association with its family of BLACKBERRY trademarks, and the Applicant has failed to adequately differentiate the nature of the parties' goods. Accordingly, the opposition succeeds.

BACKGROUND

[4] On August 6, 2014, the Applicant filed an application to register the Mark based on its use of the Mark in Canada in association with the goods set out in the attached Schedule A since at least as early as May 1, 2014, use in Finland and registration in the E.U. The application claims priority on EUIPO application No. 012568713 filed February 6, 2014.

[5] The application was advertised for opposition purposes in the *Trademarks Journal* issue dated December 23, 2015. On May 24, 2016, the Opponent opposed the application. The *Trademarks Act*, RSC 1985, c T-13 (the Act) was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition and section 34 of the Act which refer to the Act before it was amended (see section 70 of the Act).

[6] The grounds of opposition, as amended, are as follows:

- a) The application does not comply with the requirements of section 30(b) of the Act as the Applicant has not used the Mark in Canada since the claimed date of first use;

- b) The application does not comply with the requirements of section 30(d) of the Act as the Applicant had not used the Mark in Finland or anywhere else in the world in association with the applied for goods, when the application was filed, namely August 6, 2014;
- c) The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent's Canadian trademark registrations identified on the attached schedule B;
- d) The Applicant is not the person entitled to registration of the Mark because at the claimed date of first use and at the filing date of the application, the Mark was confusing with the Opponent's trade name and family of BLACKBERRY trademarks which had been previously used and made known in Canada, and for which applications had been previously filed in Canada;
- e) The Mark is not distinctive in that it does not actually distinguish the goods identified in the application from the goods and services of the Opponent, nor is it adapted to do so, in light of the use and making known by the Opponent of the Opponent's family of BLACKBERRY trademarks in Canada.

[7] The Applicant filed and served a counter statement.

[8] The Opponent filed as its evidence the affidavit of Cindy L. Petrie. Ms. Petrie was not cross-examined. The Applicant elected not to file any evidence.

[9] Only the applicant filed a written argument. A hearing was not held.

EVIDENTIAL BURDEN AND LEGAL ONUS

[10] Before considering the grounds of opposition, it is necessary to review some of the requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[11] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited* (1990), 1990 CanLII 11059 (FC), 30 CPR (3d) 293 (FCTD) at 298]. An evidential burden on an opponent with respect to a particular issue means that in order for the

issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations which the opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

GROUND OF OPPOSITION

Section 30(b) and Section 30(d) Grounds of Opposition

[12] With respect to the section 30(b) ground, there is no evidence or argument that puts into issue whether the Applicant has used the Mark in Canada since the claimed date of first use. I am therefore dismissing this ground of opposition.

[13] With respect to the section 30(d) ground of opposition, there is no evidence that puts into issue the correctness of the use abroad basis claimed in the Applicant's application. I am therefore also dismissing this ground of opposition.

Section 12(1)(d) Ground of Opposition

[14] The material date for a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of TradeMarks* (1991), 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)].

[15] The Opponent has pleaded that the Mark is not registrable because it is confusing with one or more of 18 marks registered by the Opponent, as set out in the attached Schedule B of this decision. I have exercised my discretion and checked the Register to confirm that, with the exception of BLACKBERRY & Colour Design (TMA554,206) and BLACKBERRY & Design (TMA555,231) trademarks which were expunged in July of 2017 for failure to renew, each of the Opponent's registered marks is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[16] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more of the Opponent's registered trademarks.

[17] In view of the Opponent's extensive evidence of use and reputation of its registration Nos. TMA554,207 and TMA638,068, both for the trademark BLACKBERRY (the BLACKBERRY trademark), for use in association with, *inter alia*, electronic handheld units and accessories for the wireless reception and/or transmission of data, I will focus my analysis on the likelihood of confusion between the Mark and the Opponent's BLACKBERRY trademark. If the Opponent is not successful based on this mark, then it will not be successful based on any of its other marks.

[18] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[19] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Masterpiece Inc v Alavida Lifestyles Inc.*, 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) and *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), [2006] 1 SCR 772].

Summary of the Opponent's Evidence with Respect to Its BLACKBERRY Trademark

[20] The Opponent filed the affidavit of Cindy L. Petrie, Trademark Manager of BlackBerry Limited (formerly known as Research in Motion), who has been employed by the Opponent since 2008 (para. 1). Ms. Petrie states that the Opponent is a corporation organized and existing

under the laws of the Province of Ontario, and has a place of business located at 2200 University Avenue East, Waterloo. The remainder of Ms. Petrie's evidence may be summarized as follows:

- The Opponent has used its BLACKBERRY trademark and other related trademarks (the BLACKBERRY trademarks) to identify its mobile handheld communication devices (mobile phones, smartphones, PDAs, computer tablets), accessories, systems software applications and mobile device management services (para 8);
- The Opponent has filed applications and/or registered its BLACKBERRY trademarks in over 160 jurisdictions worldwide, including, Canada (para 9);
- The Opponent has marketed and sold its goods and services bearing the BLACKBERRY trademarks worldwide including in Canada through all of the major wireless telecommunications service providers and retailers, such as Bell, Best Buy, KODOO Mobile, Rogers Wireless, SaskTel, TELUS, The Source, Walmart and others (para 10, Exh B);
- Annual sales of goods and services sold worldwide, including Canada, in association with the BLACKBERRY trademarks have ranged between \$70.4 million to as high as \$19.9 billion between 1999 and 2016 (para 18, Exh G);
- In the "Message from the Co-CEOs" in the 2011 Annual Report attached as Exhibit G, the following is stated: "In 2010, BlackBerry was the #1 selling smartphone brand in a number of markets around the world including the United States, Canada, Latin America and the United Kingdom";
- In the "Notes to the Consolidated Financial Statements", also in the 2011 Annual Report attached as Exhibit G, revenue classified by Canada, the United States, the United Kingdom and other, was provided for the years which ended February 26, 2011, February 27, 2010, and February 28, 2009;
- Over the past decade, the Opponent has sold billions of mobile devices under the BLACKBERRY trademarks and has had over 85 million subscribers to its Internet service in over 91 countries (para. 19);

- The Opponent has invested hundreds of millions of dollars in the advertising and promotion of its BLACKBERRY goods and services, including media advertising, television ads, billboard displays, the Internet, printed trade publications and magazines of general circulation and point of sale displays, including a billboard in Ontario, Canada (para. 12 & Exh. D);
- The Opponent’s BLACKBERRY goods and services have been featured in some of the world’s most widely circulated publications among the general public and trade, in print and on the Internet including Time Magazine, The Boston Globe, Newsweek, Chicago Tribune, The New York Times, the New York Post and Fortune (para 20); and
- The Opponent has been recognized for its excellence and has received numerous industry awards between 2007 and 2014 (para 21).

[21] The Applicant’s objections to this evidence will be discussed further below.

Analysis of the Section 6(5) Factors

Inherent Distinctiveness of the Trademarks and the Extent to Which the Marks Have Become Known

[22] A trademark is inherently distinctive when nothing about it refers the consumer to a multitude of sources [*Compulife Software Inc v CompuOffice Software Inc* 2001 FCT 559 at para 19]. As noted by Justice Bédard in *Philip Morris Products SA v Imperial Tobacco Canada Limited*, 2014 FC 1237:

“Whether a trademark is distinctive is a question of fact that is determined by reference to the message that it conveys to the casual consumer of the goods or services in question when the trademark is considered in its entirety as a matter of first impression.”

[23] In this case, the word BLACKBERRY does not describe any inherent characteristic or quality of the Opponent’s mobile phones or related goods and services. I therefore find that, in the context of the Opponent’s goods and services, the Opponent’s BLACKBERRY trademark is inherently strong [see also *Motion Limited v Brandlab AG*, 2011 TMOB 91].

[24] The Applicant submits that the Mark comprises two dictionary terms, the combination of which has a recognized meaning in the *Canadian Oxford Dictionary*, namely a discoloration of the skin around the eye, resulting from a blow. The Mark also includes the design of a fish, for which various colours have been claimed. While I agree with the Applicant that the Mark is not suggestive of the applied for “goods (2)” (as set out in Schedule A) I do find that the word EYE in the Mark is somewhat suggestive of the applied for “goods (1)”, namely optical lenses and accessories. I therefore find that although the Mark does possess some degree of inherent distinctiveness, I do not find it to be as inherently strong as the Opponent’s BLACKBERRY trademark.

[25] The strength of a trademark, also referred to as the acquired distinctiveness of trademark, may be increased by means of the it becoming known through promotion or use. There is no evidence of use or reputation of the Applicant’s Mark in Canada.

[26] With respect to the Opponent’s trademark, the Applicant submits that since the Opponent has not provided any precise data pertaining to Canadian sales, its evidence cannot be relied upon to support the conclusion that any of the Opponent’s trademarks have been used in Canada for any length of time.

[27] I agree with the Applicant that Ms. Petrie’s evidence could have been more precise. However, the Applicant did not challenge Ms. Petrie’s evidence by way of cross-examination. In view of the fact that Ms. Petrie has provided considerable documentary evidence of the sales of the Opponent’s goods and services worldwide including Canada, states that the Opponent has marketed and sold its mobile devices through its website in Canada and throughout the world, and provides significant sales figures for goods and services sold under the BLACKBERRY marks between 1999 and 2016, I find that there is sufficient information from which I can find that the Opponent’s BLACKBERRY trademark is known to a considerable extent in Canada.

[28] This factor therefore favours the Opponent.

Length of Time in Use

[29] While the application was based on use in Canada since at least as early as May 1, 2014, the Applicant did not file any evidence of use. The Opponent filed a declaration of use for its BLACKBERRY registration No. TMA554,207, on November 9, 2001, and its BLACKBERRY registration No. TMA638,068, was based on use in Canada since at least as early as January 1999 on goods (1) and on services (1) and (2), and since at least as early as August 2001 on goods (3) and on services (3). The Opponent also filed significant evidence of use of its BLACKBERRY trademark worldwide, including Canada. I therefore have sufficient information to find that this factor favours the Opponent.

Nature of the Goods and Channels of Trade

[30] The following applied for goods are almost identical or very similar to the Opponent's goods sold in association with its BLACKBERRY trademark:

(2) Accessories for mobile phones, smart phones, tablet computers, personal digital assistants, namely, charging cables, AC adaptors, memory cards, and parts and fittings for mobile phones, smart phones, tablet computers, personal digital assistants and accessories for mobile phones, smart phones, tablet computers, personal digital assistants, namely, charging cables, AC adaptors, memory cards; batteries for mobile phones, for smart phones, for tablet computers, for personal digital assistants and for laptops; mobile phone battery chargers, tablet computer battery chargers, smart phone chargers, personal digital assistant chargers, laptop chargers; cases for mobile phones, for smart phones, for tablet computers, for personal digital assistants; straps for mobile phones, for smart phones, for tablet computers, for personal digital assistants; headsets.

[31] The remaining applied for goods include:

(1) Optical amplifiers; optical lenses; lenses for cameras; lenses for cameras in electronic mobile communication devices; covers and cases for optical lenses.

[32] While I do not consider the remaining applied for goods to be as similar to the goods of the Opponent, the Applicant did not make any submissions regarding how these goods are

different than those of the Opponent. In view that the Applicant's optical lenses are applied for in association with cameras in electronic mobile communication devices, I do find these goods to be at least somewhat related to those of the Opponent.

[33] With respect to the parties' channels of trade, in the absence of evidence to the contrary, I would expect the parties' channels of trade to overlap.

Degree of Resemblance Between the Trademarks

[34] It is a generally accepted principle that it is not the proper approach to break the marks into their elements and concentrate upon the elements that are similar, since it is the effect of the marks in their totalities that must be considered [*Ultravite Laboratories Ltd v Whitehall Laboratories Ltd* (1965), 1965 CanLII 43 (SCC), 44 CPR 189 (SCC)]; however, it is still acceptable to "focus on a particular feature of the mark that may have a determinative influence on the public's perception of it" [*United Artists Corp v Pink Panther Beauty Corp* (1998), 1998 CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA) at 263) and *Masterpiece, supra*]. Further, it is often the first portion of a trademark which is the most relevant for the purposes of distinction [*Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)].

[35] In this case, there is some degree of resemblance between the marks in appearance and sound because both trademarks begin with the component BLACK. The ideas suggested by the marks, however, are different. In this regard, by virtue of the extensive use and reputation of the BLACKBERRY brand, the Opponent's trademark suggests that the associated goods or services are owned by the Opponent. In contrast, as noted above, the Mark suggests the recognized meaning of the terms BLACK and EYE used together, namely a discoloration of the skin around the eye, resulting from a blow.

Surrounding Circumstance - Opponent's Family of Marks

[36] The Opponent refers to its trade name and BLACKBERRY trademarks identified in its statement of opposition as its "family of BLACKBERRY trademarks".

[37] While the Opponent has evidenced use of its BLACKBERRY trademark, it did not break down any of the Opponent's sales revenues by its different BLACKBERRY trademarks but

instead only provided aggregate figures. As such, it is difficult to assess the extent to which a family of trademarks would be recognized by the consumer. I therefore do not consider this to be a relevant surrounding circumstance.

Surrounding circumstance – Vocabulary That Should be Available to All

[38] Paragraph 37 of the Applicant’s written argument states as follows:

“The common portion between the marks is a descriptive word – BLACK. To find the marks confusing would be effectively granting the Opponent rights in a word describing a colour – terminology which should of course be available to all commercial traders. This would be inappropriate.”

[39] The Applicant also referenced the following decisions in its written argument: *Global Refund Holdings AB v Fintrax Business Development Limited*, 2009 CanLii 82109 (TMOB), *Manzen LLC v Coca-Cola Company*, 2013 TMOB 92 (CanLii), and *Movenpick Holding AG v ExxonMobil Oil Corporation* (2010), 86 CPR (4th) 102 (TMOB).

[40] The decisions cited by the Applicant are of interest to the extent that they involve opposition proceedings and address the principles that govern the test for confusion between trademarks. However, it is trite law that each case must be decided on its own merits. Further, there are other factors which distinguish the present proceeding from these decisions. For example, in each of these cases the common portions of the marks were considered to be either highly descriptive of their goods or services or there was evidence that these elements were common to the trade. In this case, the Opponent’s BLACKBERRY trademark is considered highly distinctive in the context of its goods and services and there is no evidence that the first component of both parties’ marks, namely the word BLACK, is an element that is common to the parties’ trade.

Conclusion Regarding the Likelihood of Confusion

[41] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the BLACK EYE & Design trademark on the Applicant’s mobile phones and related goods, when he or she has no more than an imperfect recollection of the

Opponent's BLACKBERRY trademark, and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[42] Having considered all of the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I arrive at the conclusion that the probabilities of confusion between the Mark and the Opponent's BLACKBERRY trademark are evenly balanced between a finding of confusion and of no confusion. The Applicant has therefore not met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the BLACKBERRY trademark. While the ideas suggested by the marks may be different, the Applicant has incorporated the first portion of the Opponent's mark in its entirety as the first portion of its word mark, the goods of the parties are very similar if not identical, there is no evidence that consumers are accustomed to seeing and having to distinguish between trademarks containing the word "black" in the parties' trade and only the Opponent has demonstrated any significant reputation of its mark in Canada. All of these factors favour a likelihood of confusion. The section 12(1)(d) ground of opposition therefore succeeds.

Sections 2 Ground of Opposition

[43] The Opponent also alleges that the Mark is not distinctive of the Applicant in light of the use and making known by the Opponent of its BLACKBERRY trademarks.

[44] The assessment of this ground of opposition differs from that under section 12(1)(d) in that the material date is May 24, 2016, the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185]. In order to meet its initial burden under this ground of opposition, the Opponent needs to have shown that one of its relied upon BLACKBERRY trademarks has become known sufficiently to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657]. To do so, the Opponent must establish that its trademark is either known to some extent in Canada or is well known in a specific area of Canada [*Bojangles, supra*, at paras 33-34].

[45] The evidence of the making known of the BLACKBERRY trademark discussed with respect to the section 12(1)(d) ground of opposition is sufficient to meet the Opponent's burden with respect to the section 2 ground of opposition. Further, the Applicant's position is no stronger as of the filing date of the statement of opposition. Therefore, the section 2 ground succeeds on the basis of a reasonable likelihood of confusion between the Mark and the Opponent's BLACKBERRY trademark for the same reasons as those set out under my discussion of the section 12(1)(d) ground.

REMAINING GROUNDS OF OPPOSITION

[46] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition with respect to this application.

DISPOSITION

[47] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1688346 BLACK EYE & Design

Goods

(1) Optical amplifiers; optical lenses; lenses for cameras; lenses for cameras in electronic mobile communication devices; covers and cases for optical lenses.

(2) Accessories for mobile phones, smart phones, tablet computers, personal digital assistants, namely, charging cables, AC adaptors, memory cards, and parts and fittings for mobile phones, smart phones, tablet computers, personal digital assistants and accessories for mobile phones, smart phones, tablet computers, personal digital assistants, namely, charging cables, AC adaptors, memory cards; batteries for mobile phones, for smart phones, for tablet computers, for personal digital assistants and for laptops; mobile phone battery chargers, tablet computer battery chargers, smart phone chargers, personal digital assistant chargers, laptop chargers; cases for mobile phones, for smart phones, for tablet computers, for personal digital assistants; straps for mobile phones, for smart phones, for tablet computers, for personal digital assistants; headsets.

SCHEDULE B

Opponent's Registered and Applied For Trademarks

TRADEMARK	APPLICATION or REGISTRATION NO.
BLACKBERRY	TMA554,207
BLACKBERRY	TMA638,068
BLACKBERRY	Application No. 1,629,931
BLACKBERRY & BBBB Design	TMA659,946
BLACKBERRY & BBBB Design	TMA659,954
BLACKBERRY & BBBB Design	Application No. 1,629,935
BLACKBERRY & Colour Design	TMA554,206
BLACKBERRY & Design	TMA555,231
BLACKBERRY 10	Application No. 1,573,556
BLACKBERRY BALANCE	TMA867,542
BLACKBERRY BLEND	Application No. 1,716,497
BLACKBERRY BOLD	TMA870,999
BLACKBERRY BRIDGE	TMA911,493
BLACKBERRY CLASSIC	Application No. 1,688,279
BLACKBERRY CLOUD	Application No. 1,650,600
BLACKBERRY CONNECTION	TMA624,894
BLACKBERRY CURVE	TMA764,275
BLACKBERRY LEAP	Application No. 1,733,153
BLACKBERRY PARTNERS FUND	TMA804,708
BLACKBERRY PARTNERS FUND & Design	TMA804,707
BLACKBERRY PASSPORT	Application No. 1,688,280
BLACKBERRY PEARL	TMA817,778
BLACKBERRY PROTECT	Application No. 1,488,291
BLACKBERRY SHIELD	Application No. 1,481,280
BLACKBERRY STORM	TMA843,966
BLACKBERRY TORCH	Application No. 1,476,005
BLACKBERRY TRAFFIC	TMA877,552
BLACKBERRY UNITE	Application No. 1,650,602
BLACKBERRY WORLD	TMA872,824
BLACKBERRY WORLD	TMA933,830

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENTS OF RECORD

Perley-Robertson, Hill & McDougall

For the Opponent

Marks & Clerk

For the Applicant