



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

**Citation: 2011 TMOB 91**  
**Date of Decision: 2011-06-07**

**IN THE MATTER OF AN OPPOSITION by  
Research in Motion Limited to application  
No. 1,270,112 for the trade-mark BLACKSOCKS &  
DESIGN in the name of Brandlab AG**

[1] On August 26, 2005, Blacksocks S.A. filed an application to register the trade-mark BLACKSOCKS & Design (the Mark) reproduced below:

[2] The application was filed based on use of the Mark in Canada since 2001 and on use and registration in Switzerland under numbers 471,368 and 522,530 in association with the following wares and services, as amended (the Wares and Services) [TRANSLATION]:

Wares: Clothing namely shorts, pants, shirts, blouses, suits, dresses, robes, skirts, coats, anoraks, jackets, jeans, overalls, jumpers, tank tops, t-shirts, socks and stockings made of nylon, suspenders, panty hose; scarves, underwear namely boxer-shorts, socks; footwear namely boots, sandals, shoes, slippers;

Services: Advertisement services, namely advertising the goods and services of others, advertising agency services, direct mail-order advertising, namely selling the goods and services of others by mail; marketing, namely marketing of products and services for the benefit of others through multimedia presentations, market research and analysis; telemarketing; public relations; organization of commercial and industrial exhibitions in the garment industry; office work, namely word processing, bookkeeping; business organization and management consulting; accounting, financial auditing and account verification; business affairs management; making commercial information available through computer networks in the garment industry, namely online stores, distribution of

information related to the garment industry through an Internet database; business administration, namely administration of residences, businesses, properties, shopping centers; consulting regarding the execution of business operations, namely business administration, business management, business networking, business planning, business relocation, business research, human resources, liquidation services, consulting regarding business mergers, risk management, trade-marks, web page design; data collection, processing and systematization in computer data banks; computerized file management; e-commerce services, namely information on products through global computer or telematic networks for advertising or sales purposes by means of email, electronic publishing; retail services through global electronic networks (the Internet) in the garment industry; transmission, distribution and sending of documents, messages, data and information in the garment industry by means of computer networks or other electronic or digital communication networks; provision of access to websites in the garment industry by means of global computer networks (the Internet); consulting for others on all the following services in the garment industry: advertising services, namely advertising the goods and services of others, advertising agency services, direct mail-order advertising, namely selling the goods and services of others by mail; marketing, namely marketing of products and services for the benefit of others through multimedia presentations, market research and analysis; telemarketing; public relations; organization of commercial and industrial exhibitions in the garment industry; office work, namely word processing, bookkeeping; business organization and management consulting; accounting, financial auditing and account verification; business affairs management; business administration, namely administration of residences, businesses, properties, shopping centers; consulting regarding the execution of business operations, namely business administration, business management, business networking, business planning, business relocation, business research, human resources, liquidation services, consulting regarding business mergers, risk management, trade-marks, web page design; data collection and processing in computer data banks; computerized file management; provision of telecommunication installations for electronic ordering of goods and services.

[3] On April 17, 2007, an assignment was recorded from Blacksocks S.A in favour of Brandlab AG (the Applicant).

[4] The application was advertised in the *Trade-marks Journal* of April 25, 2007.

[5] On September 25, 2007, Research in Motion Limited (the Opponent) filed a statement of opposition against the application. The grounds of opposition can be summarized as follows:

- (a) the application does not conform to the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 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:

- i. at the date of filing the application, the Applicant must have been aware of (a) 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 (b) the Opponent's prior applications and registrations for the BLACKBERRY trade-mark as set out in the statement of opposition;
  - ii. at the alleged date of first use of the Mark in Canada, the Applicant must have been aware of the Opponent's prior use in Canada of the BLACKBERRY trade-marks in association with the wares and services identified in the statement of opposition all of which are confusingly similar to the Mark.
- (b) the application does not conform to the requirements of s. 30(b) of the Act since the Applicant has not used the Mark in Canada in association with each of the Wares and Services since 2001 as claimed in the application.
- (c) the application does not conform to the requirements of s. 30(d) of the Act since at the date of filing the application and at any relevant time thereafter, the Applicant had not used the Mark in Switzerland with each of the Wares and Services.
- (d) the Mark is not registrable pursuant to s. 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.
- (e) the Applicant is not the person entitled to register the Mark pursuant to s. 16(1)(a) of the Act because, at the date of the Applicant's alleged first use of the Mark in Canada, the Mark was confusing with the Opponent's BLACKBERRY trade-marks (set out below), which the Opponent had previously used and made known in Canada with the wares and services identified in the registrations, and which it has not abandoned:
  - i. BLACKBERRY & Colour Design – TMA554,206
  - ii. BLACKBERRY – TMA554,207
  - iii. BLACKBERRY & Design – TMA555,231
  - iv. BLACKBERRY CONNECTION – TMA624,894

(f) the Applicant is not the person entitled to register the Mark pursuant to s. 16(2)(a) because, at the date of filing the application, the Mark was confusing with the Opponent's BLACKBERRY trade-marks (set out below, hereinafter referred to as the Opponent's Previously Used Marks), which the Opponent had previously used and made known in Canada with the wares and services identified in the registrations, and which it has not abandoned:

- i. BLACKBERRY & Colour Design – TMA554,206
- ii. BLACKBERRY – TMA554,207
- iii. BLACKBERRY & Design – TMA555,231
- iv. BLACKBERRY CONNECTION – TMA624,894
- v. BLACKBERRY – TMA638,068

(g) 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.

[6] The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[7] The Opponent's evidence consists of the affidavits of Mr. Robert T. Brockbank a private investigator and Mr. Andreas Schlecht a Swiss lawyer.

[8] On May 20, 2009, the Applicant filed an amended application deleting the s. 16(1) basis of use in Canada, and revising its services with respect to the s. 16(2) basis of use and registration in Switzerland. In light of the amendments, the Applicant elected not to file any evidence. The amended application, which was made of record May 29, 2009, deleted the following services [TRANSLATION]:

... customer lists, ... information technology ... telecommunications services namely, providing access to a global computer network for many users, package services related to air time for wireless communications and telecommunications services for the creation, planning, maintenance and management of telecommunications networks; ... data banks and ... providing access to a global computer network for multiple users; providing telecommunications facilities for placing electronic orders for goods and services; ... above-mentioned ...making commercial information available through computer networks in the garment industry, namely customer lists, online stores, distribution of information related to the garment industry though an Internet database; ... information technology ...and

systematization ... e-commerce services, namely information on products through global computer or telematic networks for advertising or sales purposes by means of email, electronic publishing; retail services through global electronic networks (the Internet) in the garment industry; telecommunications services namely, providing access to a global computer network for many users, package services related to air time for wireless communications and telecommunications services for the creation, planning, maintenance and management of telecommunications networks; transmission, distribution and sending of documents, messages, data and information in the garment industry by means of computer networks or other electronic or digital communication networks; provision of access to databases and websites in the garment industry by means of global computer networks (the Internet); providing access to a global computer network for multiple users;

[9] Both parties filed written arguments. Neither party requested an oral hearing.

#### Onus and Material Dates

[10] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[11] 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 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)];
- s. 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(1)(a) – the date of first use claimed in the application [see s. 16(1)];
- s. 38(2)(c)/16(2)(a) – 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 C.P.R. (4th) 317 (F.C.T.D.)].

### Opponent's evidence

#### *Affidavit of Robert T. Brockbank*

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

[13] 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.

[14] I note that Mr. Brockbank also attaches archived copies of the Applicant's websites *www.blacksocks.com* and *www.blacksocks.ch* obtained using the "Wayback Machine" at *www.archive.org*.

[15] In light of the amended application made of record on May 29, 2009 deleting the s. 16(1) basis of registration (further discussed above in paragraph 8 and below in paragraph 20), the issue of the Applicant's use of the Mark in Canada has become moot. As a result, Mr. Brockbank's affidavit insofar as it relates to the absence of a Canadian presence for the Applicant has also become moot.

#### *Affidavit of Andreas Schlecht*

[16] Mr. Schlecht is a Swiss lawyer employed by Bovard Ltd., Patent and Trademark Attorneys in Berne Switzerland. Mr. Schlecht states that he has been qualified to practice law in Switzerland since 1994 and has been practicing there since that time in the field of trade-mark law, amongst others.

[17] Mr. Schlecht provides particulars of the Swiss registrations relied upon by the Applicant, including assignments (Exhibits A, B), corporate information for the Applicant and its

predecessors in title, as well as his opinion on Swiss trade-mark law and the results of his review of the Applicant's websites (Exhibits C, D).

[18] I find that Mr. Schlecht is qualified as an expert to provide opinion evidence on Swiss trade-mark law.

[19] Mr. Schlecht's evidence will be discussed in further detail below in the analysis of the ground of opposition based on s. 30(d) of the Act.

#### Preliminary matter – summary dismissal of the “use-based” grounds of opposition

[20] In view of the amended application accepted May 29, 2009 deleting the use in Canada basis, the grounds of opposition based on use in Canada are now considered moot.

[21] Accordingly, the s. 30(b) and 16(1)(a) grounds of opposition are hereby dismissed.

#### Non-compliance with Section 30 of the Act

##### *Section 30(d)*

[22] The Opponent alleges that the Applicant has not used its Mark in Switzerland in association with all of the wares and services covered in the application prior to the filing date of the present application (August 26, 2005).

[23] While the legal onus is upon the Applicant to show that its application complies with s. 30(d) of the Act, there is an initial evidential burden on the Opponent in respect of this ground [see *Joseph E. Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 (T.M.O.B.)]. Also, the amount of evidence required to discharge this evidential burden may be very slight [see *Canadian Council of Professional Engineers v. 407736 Ontario Corp.* (1987), 15 C.P.R. (3d) 551 (T.M.O.B.)].

[24] Section 30(d) provides as follows:

30. An application for the registration of a trade-mark shall file with the Registrar an application containing

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor in title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant and the applicant's named predecessor in title, if any, in association with each of the general classes of wares or services described in the application.

[25] As stated earlier, the Applicant has not adduced any evidence of use of the Mark in Switzerland or any other country or territory. The Opponent for its part filed the Schlecht affidavit.

[26] In his affidavit, Mr. Schlecht explains that, pursuant to Swiss trade-mark law, a person can apply for and obtain a trade-mark registration prior to having used the trade-mark anywhere in the world. In order to keep the registration valid and enforceable, however, the applicant must commence use of the trade-mark in Switzerland within five years of the end of the three month opposition period.

[27] Referring to the Applicant's second Swiss registration 522,530, Mr. Schlecht expresses his opinion that he finds it unusual for the owner of a Swiss registered trade-mark to apply to register the trade-mark a second time in conjunction with the same or very similar wares and services, as the Applicant has done. Mr. Schlecht states that, in his experience, a registered trade-mark owner who has not used its mark in Switzerland in association with all of the wares and services listed in its registration may sometimes file a new application to register the mark within this five year period in hopes of initiating a new five year period for commencing use of the trade-mark.

[28] Mr. Schlecht states that, in his opinion, it is not sufficient under Swiss law to file a second application for the same or very similar wares and services for the purpose of avoiding the consequences of non-use of a trade-mark. Mr. Schlecht further states that the simple act of filing a trade-mark application is not in and of itself a valid act of trade-mark use, pursuant to Swiss trade-mark law.



[29] Mr. Schlecht makes statements regarding his review of the corporate details listed in Switzerland for the Applicant and its predecessors in title. I note that Mr. Schlecht does not attach copies of the relevant corporate details.

[30] Mr. Schlecht states that he reviewed the contents of the Applicant's website at *www.blacksocks.com* as well as archived versions of the site which he states he obtained using the "Wayback Machine" at *www.archive.org* (Exhibit C). Mr. Schlecht also states that he used Wayback Machine to review archived versions of the website *www.blacksocks.ch* (Exhibit D). He further states that when he attempted to access *www.blacksocks.ch*, he was immediately transferred to *www.blacksocks.com*. I note that Mr. Schlecht does not attach copies of the Applicant's websites to his affidavit or provide any sworn statements regarding the nature of the content of these websites.

[31] Mr. Schlecht also states that he reviewed German language commentary regarding the Applicant which was posted on various third party websites as well as in the February 2008 issue of *KTipp*, a German consumer magazine published in Switzerland.

[32] Mr. Schlecht expressed his opinion that, under Swiss law, the display of the Mark in association with the above-mentioned websites and magazine would not constitute use of the Mark in Switzerland in association with many of the Applicant's Services as listed in the original application for the Mark. Mr. Schlecht attaches to his affidavit a list of services which he alleges his evidence suggests the Applicant has not provided in Switzerland (Exhibit E).

[33] Mr. Schlecht concludes by stating that the Applicant and its predecessors have at best only used the Mark in association with a small subset of the Applicant's Services, which he defines as "promoting, offering for sale and selling their own products by means of their website" and which he sets out in Exhibit F to his affidavit as follows:

- (a) advice for the execution of business operations namely ... systemization in computer databanks;
- (b) making commercial information available through computer networks in the garment industry namely ... on-line stores, dissemination of information related to the garment industry through a database on the Internet;

- (c) e-commerce services namely information on products through global computer or telematic networks for advertising purposes or sales by electronic mail, electronic publishing;
- (d) retail sale through global electronic networks (internet) in the garment industry ...
- (e) transmission, dissemination and forwarding of documents, messages, data and information in the garment industry via computer networks or other electronic or digital communications networks; and
- (f) providing access to ... websites in the garment industry via global computer networks (Internet);

[34] I note that Mr. Schlecht makes no statements regarding the Opponent's allegation of non-use in association with the Wares.

[35] I am not satisfied that the Opponent has provided sufficient evidence to support an allegation that the Applicant has not used the Mark in association with the Wares and Services in Switzerland. In particular, I am not satisfied that Mr. Schlecht's opinion evidence regarding Swiss trade-mark law, his vague statements regarding his review of the Applicant's website, or his opinion evidence that the display of the Mark on the Applicant's website would not constitute use of the Mark in Switzerland, are sufficient to satisfy the Opponent's initial evidential burden.

[36] Based on the foregoing, I dismiss the ground of opposition based on s. 30(d) of the Act.

*Section 30(i)*

[37] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Ground of opposition based on s. 12(1)(d) of the Act

[38] I note that the Opponent did not make any submissions on this ground of opposition or more generally on the issue of confusion.

[39] I have exercised the Registrar's discretion to confirm whether the registrations for the Opponent's Registered Trade-marks are in good standing as of today's date. I note that BLACKBERRY CYPHER (1,313,127) was abandoned June 14, 2010; BLACKBERRY PEARL (1,308,467) remains pending and BLACKBERRY UNITE! (1,357,009) has been allowed but not registered. These marks, which have not matured to registration, cannot be relied upon in support of the s. 12(1)(d) ground of opposition. The remainder of the Opponent's Registered Marks remain in good standing as of today's date.

[40] Since the Opponent's initial burden has been discharged with respect to this ground of opposition, the burden of proof lies on the Applicant to convince the Registrar, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent's Registered Trade-marks.

[41] 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.

[42] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.).]

*s. 6(5)(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known*

[43] The Mark is a coined word made up of the words "black" and "socks" along with design elements in the form of a black box and a stylized letter "O" in the word "socks". While the

Mark is a coined word, it is somewhat suggestive of the Applicant's clothing-related wares and services as it suggests socks in the colour black.

[44] The Opponent's Registered Marks all feature the word "blackberry" which is a name of a fruit, specifically, a type of berry. However, in the context of the Opponent's wares and services, the word "blackberry" has no meaning and thus it possesses a high degree of inherent distinctiveness.

[45] Based on the foregoing, although the Mark is not without distinctive character, I find that the Opponent's Registered Marks, which include the arbitrary BLACKBERRY element, possess a higher degree of inherent distinctiveness.

[46] As the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use, I will now turn to the extent to which the trade-marks have become known in Canada.

[47] Neither party has filed evidence of use or reputation for their marks and as a result I am unable to conclude as to the extent to which the parties' marks have become known. I note that the mere existence of the registrations for the Opponent's Registered Marks can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of the Opponent's Registered Marks [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.) (*Entre Computer*)].

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

[48] The Mark was applied for on August 26, 2005 based on use of the Mark in Canada since 2001 and on use and registration in Switzerland under numbers 471,368 and 522,530. On May 29, 2009, the Applicant's amended application deleting the s. 16(1) basis of use in Canada was made of record. The Applicant has not established that the Mark has been used in Canada.

[49] The Opponent's Registered Marks have proceeded to registration as set out in Schedule A to my decision. However, as pointed out previously, the mere existence of these registrations can establish no more than *de minimis* use and cannot give rise to an inference of significant and continuous use of the Opponent's Registered Trade-marks [see *Entre Computer, supra*].

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

[50] It is the Applicant's statement of wares and services as defined in its application versus the Opponent's registered wares and services that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[51] The Applicant's clothing wares are entirely unrelated to the Opponent's wares, as set out in Schedule A to my decision, which largely relate to "electronic handheld units and accessories for the wireless receipt and/or transmission of data...".

[52] With respect to the parties' services, the Opponent's Registered Marks are registered for *inter alia* "e-mail services" which are distinct from the Applicant's services. However, I note that there is a potential for similarity with the Opponent's services "wireless data messaging services, particularly services that enable a user to send and/or receive messages through a wireless data network" and the following services of the Applicant [TRANSLATION]:

... transmission, distribution and sending of documents, messages, data and information in the garment industry by means of computer networks or other electronic or digital communication networks ...

[53] That said the similarity between these services and the services of the Opponent is minimal due to the fact that these services are limited to the clothing industry.

[54] I have no evidence establishing the parties' channels of trade. Given the lack of direct overlap between the parties' wares and services, I am unable to conclude that the channels of trade associated with the Mark and the Opponent's Registered Trade-marks would overlap. Furthermore, I note that I have not been provided with any evidence to the contrary.

*s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them*

[55] The only similarity between the parties' marks is the inclusion of the word "black" as the first element of all of the marks at issue.

[56] Confusion will be unlikely in situations where marks share common features but also feature dominant differences [see *Foodcorp Ltd. v. Chalet Bar B Q (Canada) Inc.* (1982), 66 C.P.R. (2d) 56 at 73 (F.C.A.)].

[57] The Mark includes the additional word “socks” along with design features whereas the Opponent’s Registered Trade-marks feature the additional word “berry” and some also include design features and/or other word elements.

[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.

[59] As both parties’ marks have known meanings, i.e. the Mark means socks that are black in colour and the Opponent’s BLACKBERRY element suggests a type of fruit, specifically a berry known as a blackberry, I find that there is no resemblance in terms of the ideas suggested by the parties’ marks.

[60] Based on the foregoing, there are important differences between the Mark and the Opponent’s Registered Marks in terms of sound, appearance and ideas suggested.

#### *Conclusion on Confusion*

[61] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, in particular the lack of similarity in the nature of the wares, services and trade and the differences in sound, appearance and ideas suggested, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and any of the Opponent’s Registered Trade-marks.

[62] Based on the foregoing, I dismiss the ground of opposition based on s. 12(1)(d) of the Act.

Ground of opposition based on s. 16(2)(a) of the Act

[63] The s. 16(2)(a) ground of opposition is based upon the previous use and making known in Canada by the Opponent of the Opponent's Previously Used Marks used or made known in association with the wares and/or services claimed in the associated registrations.

[64] Despite the burden of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's Previously Used Marks, the Opponent has the initial onus of proving that the trade-marks alleged in support of its ground of opposition based on s. 16(2)(a) of the Act were used or made known in Canada prior to the filing date for the Applicant's application (August 26, 2005) and had not been abandoned at the date of advertisement of the application for the Mark (April 25, 2007) [s. 16(5) of the Act].

[65] As I have previously noted, the Opponent did not adduce any evidence of use or making known in Canada of the Opponent's Previously Used Marks. Accordingly, the Opponent has not discharged its burden of showing prior use and/or making known of any of the Opponent's Previously Used Marks and I dismiss the ground of opposition based on s. 16(2)(a) of the Act accordingly.

Ground of opposition based on s. 38(2)(d) and 2 of the Act

[66] This ground of opposition essentially turns on the issue of confusion between the Mark and the Opponent's Marks.

[67] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its Wares and Services from those of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness.

[68] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the filing of the statement of opposition, one or more of the Opponent's BLACKBERRY trademarks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles'*

*International, LLC v. Bojangles Café Ltd.* (2004), 40 C.P.R. (4th) 553, affirmed (2006), 48 C.P.R. (4th) 427 (F.C.T.D.)].

[69] As discussed, the Opponent has not filed any evidence relating to the use and reputation of the Opponent's BLACKBERRY trade-marks. I am unable to conclude on the evidence of record whether the any of the Opponent's BLACKBERRY trade-marks had become known sufficiently to negate the distinctiveness of the Mark. Based on the foregoing, I dismiss the ground of opposition based on non-distinctiveness.

#### Disposition

[70] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office




**Schedule A**

<b>Trade-mark/Reg'n No.</b>	<b>Wares/Services</b>	<b>Reg'n Date/Use Claim</b>
<p>BLACKBERRY CURVE</p> <p>TMA764,275</p>	<p><u>Wares</u>: Electronic handheld units and accessories for the wireless receipt and/or transmission of data and which may also have the capability to transmit and receive voice communications namely, handheld computers and personal digital assistants; computer 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 personals computer or a server; computer communication 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, including corporate data.</p> <p><u>Services</u>: 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; Education and training services, namely, classes, seminars and conferences for the purpose of providing information to third parties to assist them in using developing and supporting wireless connectivity devices and related (or computer communication) software; Technical support services, namely, updating and maintenance of computer software and troubleshooting support programs for diagnosis, and resolution of wireless connectivity devices and related computer software and hardware problems.</p>	<p>April 15, 2010</p> <p>Dec. of use filed March 26, 2010</p>
<p>BLACKBERRY</p>	<p><u>Wares</u>: Electronic handheld units and</p>	<p>Abandoned June 14,</p>



<p>CYPHER</p> <p>1,313,127 (app. No.)</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><u>Services:</u> 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>2010</p>
<p>BLACKBERRY PEARL</p> <p>1,308,467 (app. No.)</p>	<p><u>Wares:</u> 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</p>	<p>Pending</p> <p>Proposed use</p>

	<p>enables and provides one-way and/or two-way wireless connectivity to data, namely corporate data.</p> <p><u>Services:</u> 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>BLACKBERRY UNITE! 1,357,009 (app. No.)</p>	<p><u>Wares:</u> Electronic handheld units namely, wireless handheld devices, smartphones, wireless phones, mobile phones and cellular phones for the wireless receipt and transmission of voice and data which may also have the capability to transmit and receive voice communications; accessories for electronic handheld units namely, wireless handheld devices, smartphones, wireless phones, mobile phones and cellular phones for the wireless transmission of data and voice signals namely batteries, car kits, chargers, headsets, belt clips/holsters, carrying cases, battery covers and docking/charging cradles for wireless handheld devices, smartphones, wireless phones, mobile phones and cellular phones; wireless computer software for the synchronization, transmission and sharing of data, calendar, content and messaging between a remote station or unit and a fixed or remote station or unit which enables and provides one-way and two-way wireless connectivity to data, namely, corporate data.</p> <p><u>Services:</u> Licensing of computer software; Marketing services in the fields of handheld wireless devices and telecommunications, namely advertisement services to third parties, on-line advertising, advertisement planning, corporate advertisement and promotion, television and radio advertising, organization of trade fairs or exhibitions for commercial or advertising purposes all of the foregoing</p>	<p>Allowed – pending Proposed use</p>

	<p>advertisement services to third parties; e-mail service; wireless data messaging services, namely services that enable a user to send and receive messages through a wireless data network; one-way and two-way paging services; wireless transmission and reception of voice communications by means of electronic handheld units, namely wireless handheld devices, smartphones, wireless phones, mobile phones and cellular phones; Telecommunications consultation to third parties in the fields of development and integration of one-way or two-way wireless connectivity to data and to voice; education and training services, namely, classes, seminars and conferences for the purpose of providing information to third parties to assist them in using, developing and supporting wireless connectivity devices and related wireless connectivity and computer communication software; technical support services, namely, updating and maintenance of computer software and troubleshooting support programs for diagnosis, and resolution of wireless connectivity devices and related computer software and hardware problems.</p>	
<p><b>BLACKBERRY</b> TMA554,206</p>	<p><u>Wares</u>: 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><u>Services</u>: 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</p>	<p>November 21, 2001 Dec. of use filed: Nov. 9, 2001</p>

	and two-way paging services.	
BLACKBERRY TMA554,207	<p><u>Wares:</u> 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><u>Services:</u> 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>November 21, 2001</p> <p>Dec. of use: Nov. 9, 2001</p>
 TMA555,231	<p><u>Wares:</u> 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><u>Services:</u> 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>	<p>December 11, 2001</p> <p>Dec. of use filed: Nov. 29, 2001</p>
BLACKBERRY	<u>Wares:</u> Newsletter relating to Internet e-mail services and wireless data messaging services	November 8, 2004

<p>CONNECTION TMA624,894</p>	<p>and voice communication services and technical support services for hardware and software for wireless data network services and/or voice communication services.</p>	<p>Claims use in Canada since April 2000</p>
<p>BLACKBERRY TMA638,068</p>	<p><u>Wares:</u> 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.</p> <p><u>Services:</u> 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</p>	<p>April 21, 2005</p> <p>Claims use in Canada since January 1999; August 2001</p>

	corporate data; Transmission and reception of voice communication services.	
 TMA659,946	<p><u>Wares</u>: 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 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><u>Services</u>: 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; 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>	March 1, 2006  Dec. of use filed: January 25, 2006
 TMA659,954	<p><u>Wares</u>: 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 capability to transmit and receive voice communications; software for the transmission and/or reception of messages, global computer network e-mail,</p>	March 1, 2006  Dec. of use filed: January 25, 2006

	<p>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><u>Services:</u> 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; 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>	
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