

**THIS OPINION IS A
PRECEDENT OF THE TTAB**

Mailed:
February 27, 2012
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Research in Motion Limited

v.

Defining Presence Marketing Group, Inc. and Axel Ltd. Co.

Opposition Nos. 91178668, 91179490 & 91181076
against Serial Nos. 77059205, 77059214, 77059232 & 77179267

Jeffrey J. Morgan, William R. Towns and Monica M. Moussighi
of Novak Druce + Quigg LLP for Research in Motion Limited.

Matthew W. Swyers of The Swyers Law Firm PLLC for Defining
Presence Marketing Group, Inc. and Axel Ltd. Co.¹

Before Bucher, Zervas and Ritchie, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Defining Presence Marketing Group, Inc. (DPMG) filed
four separate applications for registration on the Principal
Register of the mark **CRACKBERRY** (*in standard character
format*) for goods and services described as follows:

"marketing services, namely providing
informational web pages designed to generate sales

¹ All four of these applications were assigned from Defining Presence Marketing Group, Inc., a Canadian corporation, to Axel Ltd. Co., a Florida limited liability corporation, as of September 7, 2007, recorded in the United States Patent and Trademark Office Assignment Division at Reel 3617, Frame 0992. The Board joined Axel as a party defendant in an order dated February 12, 2008. We refer to both defendants as "applicants."

traffic via hyperlinks to other websites; online retail store services featuring downloadable ring tones; online retail store services featuring consumer electronics and telecommunication products and accessories; providing online directory information services also featuring hyperlinks to other websites" in International Class 35;²

"computer services, namely, creating an online community for registered users to participate in competitions, showcase their skills, get feedback from their peers, form virtual communities, engage in social networking and improve their talent; computer services, namely, redirecting electronic mail to changed personal electronic address" in International Class 42;³

"providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; providing online chat rooms for transmission of messages among computer users concerning telecommunications, mobile telephony, e-mail, mobile phones, PDAs and wireless communications; providing general and non-consumer information online in the field of telecommunications, mobile telephony, e-mail, mobile phones, PDAs and wireless communications" in International Class 38;⁴ and

"headgear, namely, hats and caps; jackets; coats; dress shirts; polo shirts; shirts; shirts for suits; sport shirts; sweat shirts; t-shirts; denims; pants; sweat pants; board shorts; boxer shorts; shorts; sweat shorts; skirt suits; skirts and dresses; bathing suits; body suits; dress suits; jogging suits; boxer briefs; lingerie;

² Application Serial No. 77059205 was filed on December 7, 2006, based upon DPMG's allegation of a *bona fide* intention to use the mark in commerce, opposed in Opposition No. 91178668.

³ Application Serial No. 77059214 was filed on December 7, 2006, based upon DPMG's allegation of a *bona fide* intention to use the mark in commerce, opposed in Opposition No. 91178668.

⁴ Application Serial No. 77059232 was filed on December 7, 2006, based upon DPMG's allegation of a *bona fide* intention to use the mark in commerce, opposed in Opposition No 91179490.

socks; beach shoes; canvas shoes; shoes; gym shorts" in International Class 25.⁵

Research in Motion Limited [hereinafter "opposer" or "RIM"] opposed registration of applicants' mark in each of these applications, asserting as its grounds for opposition, (i) likelihood of confusion, namely that as used in connection with applicants' goods and services, the mark so resembles RIM's previously used and registered

BLACKBERRY mark as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); and (ii) dilution, namely, that applicants' mark is likely to dilute the distinctive quality of opposer's marks under Trademark Act Section 43(c), 15 U.S.C. § 1125(c)(2)(B). Opposer alleges that it has used its **BLACKBERRY** marks in connection with "handheld devices including smart phones and related goods and services as well as promotional and collateral goods"; and that its **BLACKBERRY** marks are famous for RIM's array of goods and services, and were famous before any of applicants' priority dates. Opposer also pleaded ownership of several registrations for **BLACKBERRY** or **BLACKBERRY**

⁵ Application Serial No. 77179267 was filed on May 11, 2007, based upon DPMG's allegation of a *bona fide* intention to use the mark in commerce, opposed in Opposition No 91181076.

formative marks in its notice of opposition, including Registration Nos. 2613308, 2672464, 2700671 and 2844339.

Applicants have filed answers denying the salient allegations of the notices of opposition, and pleaded affirmative defenses, which defenses were not pursued at trial. The affirmative defenses are considered waived and are given no further consideration.

The record includes the pleadings; the files of the involved applications; opposer's first notice of reliance filed on March 9, 2009, which introduced into the record TARR printouts of a number of opposer's pleaded registrations for its **BLACKBERRY** marks;⁶ opposer's second notice of reliance, also filed on March 9, 2009, which introduced into the record applicants' answers and objections to opposer's first set of interrogatories; opposer's third notice of reliance filed on August 7, 2009, which introduced into the record printed publications; opposer's fourth notice of reliance also filed on August 7, 2009, which introduced into the record the Declaration of James Yersh, with the attendant exhibits;⁷ and opposer's

⁶ Although opposer also alleged that it has used and registered marks other than BLACKBERRY that incorporate the suffix -BERRY, opposer submitted no argument on this point, and we give it no further consideration.

⁷ Applicants have stipulated that financial information may be entered into evidence in the form of the Yersh Declaration.

testimony deposition of Lee Potter, Director, Brand Communications for RIM, with the attendant exhibits.

Applicants submitted their notice of reliance on October 9, 2009, as well as testimony depositions of applicants' witnesses, Kevin Michaluk, co-founder and principal of Defining Presence Marketing Group, Inc., and Ronald Butters, Ph.D., an expert in the fields of linguistics, with the attendant exhibits.

The parties entered into a joint stipulation on March 4, 2011.⁸ The parties have fully briefed the issues still involved in this litigation.

STANDING

Copies of United States Patent and Trademark Office records submitted by opposer show that opposer is the owner of the following valid and subsisting registrations:⁹

BLACKBERRY	for "electronic handheld units for the wireless receipt 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
-------------------	--

⁸ The joint stipulation states that "BlackBerry-branded ads were placed on Applicants' web site between November 1, 2009 and February 24, 2011," that "the ads were not placed directly by Opposer" but by intermediaries, and that "There is no evidence of actual confusion from the ads ..."

⁹ Opposer's Notice of Reliance #1 filed on March 9, 2009, included printouts of information from the TARR electronic database records of the United States Patent and Trademark Office showing the current title and status of its **BLACKBERRY** registrations at that time. TTABVue entry #20.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.