

O-453-12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2545058  
BY LEATHERBERRY LIMITED TO REGISTER THE TRADE MARK**

**LEATHERBERRY**

**IN CLASSES 9, 18 AND 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 101046  
BY RESEARCH IN MOTION LIMITED**

## **BACKGROUND AND PLEADINGS**

1) On 19 April 2010, Leatherberry Limited (“the applicant”) applied under the Trade Marks Act 1994 (“the Act”) for registration of the mark LEATHERBERRY in respect of the following list of goods:

### **Class 9**

*Laptop bags and sleeves, mouse mats, mobile phone cases, spectacle cases and sunglasses cases.*

### **Class 18**

*Leather trunks and travelling bags, handbags, purses, briefcases, credit card holders, wallets, suit carriers, wash bags, key fobs, key holders, pouches, coin holders, messenger bags, suit cases, pilots cases, attache cases, needlework bags and cases, make up bags and cases, presentation cases and boxes, maternity bags, game bags, hat boxes, shoe bags and sailing bags.*

### **Class 25**

*Clothing, footwear, headgear, belts and other similar apparel.*

2) The application was published in the Trade Marks Journal on 9 July 2010 and on 8 October 2010, Research in Motion Limited (“the opponent”) filed notice of opposition to the application. The grounds of opposition were that:

- a) The application offends under Section 5(2)(b) of the Act because it is in respect of a similar mark and some or all of the goods claimed are identical or similar to those of ten earlier marks in the name of the opponent. The relevant details of these earlier marks (and what goods are being opposed) are provided at Annex 1 to this decision.
- b) The application offends under Section 5(3) of the Act.
- c) The application offends under Section 5(4)(a) of the Act because the opponent has used the mark BLACKBERRY since approximately September 2001 in the “national retail market for personal digital assistant devices and mobile telephones”. A list of goods and services where use is claimed is provided at Annex 2. The opponent claims a widespread goodwill as a result of this use in the UK and that use of the applicant’s mark would result in damage to this goodwill and that the applicant’s mark is likely to be prevented by the law of passing off.

4) The applicant subsequently filed a counterstatement denying the opponent's claims. It contained inconsistencies regarding what, if any, proof of use requirements were being placed upon the opponent and what was the precise scope of its concessions regarding proof of use and goodwill.

5) Following a case management conference ("the CMC") held on 9 December 2011, it was established that the applicant conceded that the opponent had used its marks in respect of *electronic handheld units for the wireless receipt and/or transmission of data that enable the user to keep track of or manage personal information and which may also have the capacity to transmit and receive voice communications*. It puts the opponent to proof of use in respect of earlier marks CTM1248335, CTM 3180445 and 2376792 insofar as they cover goods and services not covered by this concession. Further, it conceded that the opponent had goodwill, attached to its marks, in respect of the same list of goods where use has been conceded.

6) Also at the CMC, it was indicated that the opponent no longer wished to pursue the grounds based upon both Section 5(3) and Section 5(4)(a). Its actions appeared to be motivated by a desire to avoid filing evidence. However, following the applicant's clarification of its defences where it conceded the existence of goodwill in respect of certain goods (detailed in the above paragraph), it requested to retain the grounds based upon Section 5(4)(a). This was allowed.

7) In short, following the CMC, the Section 5(3) grounds were dropped by the opponent, and it was allowed a period to submit evidence on the issue of proof of use (insofar as use went beyond the applicant's concession). The opponent subsequently availed itself of this opportunity. The applicant also filed evidence. Both sides ask for an award of costs. Neither party requested to be heard and I make my decision after a careful consideration of the papers.

### **Opponent's Evidence**

8) This takes the form of a witness statement by Matthew Bull, Distributor Relationship Manager for Accessories for the opponent and covering the EMEA region. Mr Bull states that the BLACKBERRY mark has longstanding use in respect of a range of goods and services in the UK since July 2001. He splits use on a wide range of accessories into the following categories:

- Batteries and battery doors;
- Carrying solutions that include holsters, pockets, totes and folios designed to enable consumers to carry and protect their devices. He states that such goods are often made of leather and similar materials;
- Charging solutions that include cables, charging pods, external battery chargers, car chargers, wall chargers and power stations;
- Cable and wiring adaptors;
- Shells and skins to protect and personalise mobile phones;

- Audio apparatus including wireless headsets, portable headsets, music gateways and streamers and car kits.

9) Mr Bull states that he is informed by his legal team that the relevant date for demonstrating use is 19 April 2010, being the date of filing of the contested mark but, in fact, the proof of use provisions set out in the Act identify the date of publication as being the relevant date, namely, 9 July 2010. He states that at, or before, “the relevant date” goods on sale in the UK under the BLACKBERRY marks include swivel holsters, clip holsters and horizontal holsters made from both leather and lambskin, wrist lanyards, leather straps, leather and synthetic pockets, totes and folios, batteries, battery doors, USB cables and adaptors, charging and syncing pods, chargers, cradles and headsets. Photographs of accessories available, according to Mr Bull, in 2010 are presented at Exhibit MB-1. These photographs show headphones, a USB international travel charger, a mobile phone leather pocket (cover), a holster (a pocket with a waist clip), a folio (a mobile phone case with a wrist strap) and mobile phone skins (casing) all being promoted under both the word mark *BlackBerry* and the word and device mark as represented by the opponent’s earlier CTM 3937307.

10) Mr Bull states that BLACKBERRY accessories are sold to end users through a variety of distribution channels including the physical and online retail outlets of the wireless network operators *Orange*, *T-Mobile*, *O2*, *Vodafone* and *BT Mobile*. Such accessories are also sold through other retailers such as *Carphone Warehouse* and also directly to consumers through the opponent’s website [www.shopblackberry.com](http://www.shopblackberry.com) that has a dedicated UK site, with currency displayed in pounds sterling.

11) Mr Bull states that the mark BLACKBERRY has been used in the advertising and sale of the opponent’s products, in the UK, since July 2001. At Exhibit MB-2, Mr Bull provides copies of pages from the O2 customer brochure which, he states, was widely distributed in December 2009. It features a double page advertisement devoted to authentic BLACKBERRY accessories on sale in the UK. The accessories shown are mobile phone skins, a *Bluetooth* headset, a pocket pouch and a speakerphone. The word mark *BlackBerry* features prominently on each page in statements such as the following that appears on the page advertising coloured skins to protect mobile phone casings:

“Designed to add to your personal style, the BlackBerry® Premium Skin combines the skin with a colored trim to help protect against accidental bumps and scratches”.

And the following in respect of folios:

“Carry your BlackBerry® smartphone in the BlackBerry® Folio that includes a removable strap. ...”

12) Exhibit MB-3 consists of copies of pages from the O2 customer brochure for February 2010 showing further accessories, namely a “Sync Pod” and a protective mobile phone case. Once again, the mark *BlackBerry* appears prominently.

13) Mr Bull provides turnover figures for sales of accessories in the UK, between January 2008 and April 2010, in respect of accessories identified in the same groups as shown in paragraph 8, above. These figures are subject to a confidentiality order restricting disclosure to the applicant and the applicant’s legal advisors. Consequently, the following figures are redacted from the publicly available version of this decision:

Category of goods	Units sold	Revenue (\$US)
Batteries, battery doors		
Carrying solutions		
Charging solutions		
Miscellaneous Accessories		
Shells and Skins		
Wired Audio		
TOTAL		

### Applicant’s Evidence

14) This takes the form of a witness statement by Chris Bearblock, Director of the applicant. He states that he files evidence to support two submissions, namely that the range of goods sold under the LEATHERBERRY mark is “bespoke hand bag and leather products” and that, “by necessary consequence...some... products may be...used to store mobile phone and smart phone devices... [but this] is not ....their *raison d’etre*” and that the applicant’s goods will not confuse customers as to origin.

15) Mr Bearblock states that the applicant’s products are high-quality handbags. He supports this by including eight pages of screen shots from its website illustrating that the applicant trades in high-quality bespoke leather handbags. He states that “The simple reality is that a majority of people today use a mobile phone ... and it is as a result of this that we offer clients the option of having a mobile phone holder in their bag” but he reiterates that this is clearly not the *raison d’etre* of the bags.

16) Mr Bearblock states that the applicant uses its mark in a word and device style and illustrates the word and device actually used at pages 9 – 11 of his exhibit. He further states that he has not received any indication of confusion from the applicant’s customers.

17) Mr Bearblock also provides a number of submissions and criticisms of Mr Bull's evidence that I will not detail here but I will keep them in mind.

## **DECISION**

### **Proof of use**

18) The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

#### **“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services..."

19) Consideration has to be taken, also, of section 100 of the Act which states:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

Consequent upon section 100 the onus is upon the opponent to prove that it has made use of the marks in suit, or that there are proper reasons for non-use.

20) The requirements for "genuine use" have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Anna Carboni, sitting as the Appointed Person in BL O-371-09 SANT AMBROEUS:

42. The hearing officer set out most of the key extracts from *Ansul* and *La Mer* in his decision, so I shall not reproduce them here. Instead, I try to summarise the "legal learning" that flows from them, adding in references to *Silberquelle* where relevant:

(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely "token", which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e.

exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].

21) The application being challenged was published on 9 July 2010, consequently the five year period when the opponent is required to demonstrate use is between 10 July 2005 and 9 July 2010.

22) All three of the opponent's earlier marks that are subject to the proof of use provisions, namely 2376792, CTM 1248335 and CTM 3180445 are all in respect of word only mark BLACKBERRY. However, I intend to identify what I consider to be the opponent's best case by picking out the goods that will give it its best chance of success and limit my analysis of proof of use only to these goods. In this respect, I will limit my consideration to mark 2376792 and in respect of the following of its goods:

*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*

23) The opponent has not been required to provide proof of use of these goods except *accessories* [for electronic handheld units]. In his witness statement, Mr Bearblock appears to concede that the opponent trades in a variety of device accessories when he comments upon Mr Bull's evidence in the following way:

“Reading the Witness Statement of RIM's Matthew Bull, it is apparent that, as well as manufacturing and selling Blackberry mobile phone devices, RIM also market and sell “*a wide variety of BLACKBERRY device accessories.*””

24) However, he questions whether the nature of the use is sufficient to demonstrate use of the mark upon which the opponent relies upon. In particular, Mr Bearblock's criticism is that Mr Bull's evidence only shows the Blackberry cluster device but not the word mark BLACKBERRY applied to the products. Consequently, in respect of the goods I have identified in paragraph 22 above, the two issues I need to decide are firstly, does use include use of the mark as registered, and secondly, on what *accessories* has use been shown and, therefore, what would constitute a fair specification.

#### Variant use

25) Mr Bearblock criticizes the opponent's evidence for failing to illustrate that its word only mark is applied to the goods. It is true that the evidence fails to establish this, however, it is not necessary to do so in order to demonstrate genuine use. It is sufficient that the mark being relied upon is used in relation to the relevant goods (see Section 6A(3), above). The exhibits provided by Mr Bull illustrate various accessories with the word and device mark shown in its earlier CTM 3937307 and, in addition, each page of advertisements also makes prominent reference to the mark *BlackBerry* together with the ® symbol, for example, in statements such as “Designed to add to your personal style, the BlackBerry® Premium Skin combines the skin with a colored trim to help protect against accidental bumps and scratches”. There is little doubt in my mind that use of the mark *BlackBerry* is use in respect of the accessories shown. The more pertinent question is whether this mark constitutes an acceptable variant use of the mark as registered, namely, the mark BLACKBERRY.

26) It is established case law that to qualify as genuine, use of a mark must be in the form registered or in a form which does not alter the distinctive character of the mark in the form in which it is registered. The leading English authority on the issue is the Court of Appeal decision in *Budejovicky Budvar Narodni Podnik v*

*Anheuser-Busch Inc (BUD)* [2003] RPC 25. This court of appeal decision provides me with some guidance on how to approach this issue:

“.....The first part of the necessary inquiry is, what are the points of difference between the mark as used and the mark as registered? Once those differences have been identified, the second part of the inquiry is, do they alter the distinctive character of the mark as registered?”

27) The same issue has been considered by both the General Court (GC) and the CJEU. These cases have been reviewed by Richard Arnold QC, sitting as Appointed Person, in *NIRVANA Trade Mark* (BL O/262/06) and *REMUS Trade Mark* (BL O/061/08). He summarised his review in *NIRVANA* (and reiterated it in *REMUS*) in the following way:

“33. .... The first question is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period....

34. The second question is whether the sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all...”

28) The distinctive character of the mark BLACKBERRY resides in its totality. Whilst it is made up of two ordinary English words, when combined they become a single word to describe a well known soft fruit. The mark, as used, differs in that the two letter Bs are represented as capital letters but that all other letters are in lower case. However, the overriding impression of this mark is still the same, namely, a description of the soft fruit. The distinctive character is unchanged by these differences. Consequently, I conclude that the opponent’s use of the mark BlackBerry is acceptable variant use of its registered mark BLACKBERRY.

#### Fair specification

29) The issue that I must decide here is whether the use shown allows the opponent to retain the term *accessories* (for electronic handheld units for the wireless receipt and /or transmission of data and which may also have the capability to transmit and receive voice communications) and if not, what term/terms would accurately reflect this use.

30) The opponent's evidence clearly illustrates use of the mark *BlackBerry* in use during the relevant period in respect of Bluetooth headsets, a "sync pod", a speakerphone and various covers, cases and skins. Such exhibits are supported by turnover figures for such goods than runs into the multi-millions of US dollars a year. Having established that the opponent has demonstrated genuine use in respect of these goods, I must consider whether such use justifies it retaining the broad term *accessories*. In doing so, I keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

"29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the

fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

31) The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

32) I am also mindful of the guidance provided by the GC in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (ALADIN)* Case T-126/03:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made

of the marks (Case T-334/01 MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON) [2004] ECR II-0000, paragraph 32, and Case T-203/02 Sunrider v OHIM – Espadafor Caba (VITAFRUIT) [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of subcategories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the subcategory or subcategories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is

impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of „part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

...

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

33) Finally, I also take account of the comments of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited* BL O/345/10, where he stated:

“... I adhere to the view that I have expressed in a number of previous decisions. In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

34) Taking all of the above into account, it is likely that the “average, reasonably informed consumer”, when asked to collectively describe Bluetooth headsets, sync pods, speakerphone and covers, cases and skins (for electronic hand-held units), will say that they are *accessories* for such units. Whilst the goods, in respect of which use has been shown, do not constitute all the goods that may be covered by this term, they all belong to the group described as *accessories*. It is not obvious to me, nor is it suggested to me, that this range of goods would be described collectively by a more focussed term and I conclude that the use shown is sufficient to permit the opponent to retain this umbrella term.

35) Taking account of Mr Bearblock’s acceptance that Mr Bull’s evidence demonstrates that the opponent markets a “wide variety” of BLACKBERRY device accessories and that the exhibits provided by Mr Bull illustrate use of an acceptable variant use (*BlackBerry*) of its mark in respect of, amongst other accessories, leather cases, holsters, folios and skins for its electronic hand-held units, I interpret Mr Bearblock’s comments (subject to the issue of variant use

that I decided above) as an acceptance that the opponent has used its word mark in respect of these goods. As these, together with its electronic handheld units represent its best case (insofar as it relies upon its word only BLACKBERRY marks), I do not intend to consider proof of use on other goods and services covered by its three earlier marks that are subject to proof of use.

36) In conclusion, in respect of the marks subject to the proof of use requirements, the opponent is entitled to rely upon, at least, the following list of Class 9 goods:

*Electronic handheld units for the wireless receipt and /or transmission of data and which may also have the capability to transmit and receive voice communications; leather cases, holsters, folios and skins, all for electronic handheld units.*

### **Section 5(2)(b)**

37) Section 5(2)(b) reads:

“(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

38) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (CJEU) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) C-334/05 P. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant

- but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

### **Comparison of goods and services**

39) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23:

„In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

40) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] RPC 281).

41) I also bear in mind the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

42) Finally, in terms of understanding what a "complementary" relationship consists of, I note the judgment of the GC in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06 where it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Segio Rossi v OHIM - Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM - Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Ingles v OHIM - Bolanos Sabri (PiraNAN diseño original Juan Bolanos) [2007] ECR I-0000, paragraph 48)."

43) I will base my considerations upon the similarity of the applicant's goods with two different lists of goods as represented by the opponent's earlier marks 2376792 BLACKBERRY and 2496254 BLACKBERRY BOLD as these together represent its strongest cases. The first earlier mark, whilst it is only being relied upon to attack a narrow range of the applicant's goods, is in respect of a mark that is most closely similar to the applicant's mark. The second earlier mark is considered because it provides the best example of the opponent's broad attack upon the full list of the applicant's goods.

#### Similarity with goods covered by 2376792 BLACKBERRY

44) Here, I will restrict my consideration to the similarity with the list of goods identified in paragraph 22, above, namely *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*. These goods are relied upon in the opponent's attack upon the applicant's *Laptop bags and sleeves, mouse mats, mobile phone cases*.

45) After referring to the categories of *accessories* referred to by Mr Bull, Mr Bearblock claims that only "carrying solutions" bear any relevance to the goods of the application. I agree that these represent the opponent's best case insofar that it attacks the applicant's *laptop bags and sleeves* and *mobile phone cases*. In respect to the applicant's *mobile phone cases*, these are self evidently identical to the various covers for the opponent's electronic handheld units (that, of course, includes covers for *mobile phones*) that are included by its term *accessories* in Class 9.

46) In respect of the applicant's *laptop bags and sleeves*, these share the same nature and method of use as covers for electronic handheld units in that they are all designed to cover and protect the electronic equipment therein. Whilst the distinction between laptops and mobile phones has started to blur with the development, and increased popularity, of devices such as tablets and note books, it is my view that there is a good deal of similarity regarding intended purpose. Similar considerations apply as to whether these respective goods are in competition. With such a blurring between laptop computers and hand-held

communication devices, it is likely that covers for both may also overlap resulting in competition between the two. Taking all of this into account, I conclude that these respective goods share a high level of similarity.

47) Finally, in respect to the applicant's *mouse mats*, it is not clear to me that the opponent's goods share any similarity to these. Their nature, intended purpose and method of use are self-evidently different and neither are they in competition or complementary to each other. Consequently, I conclude that there is no similarity.

Similarity with goods covered by 2496254 BLACKBERRY BOLD

48) Here the comparisons of goods that represent the opponent's best case are detailed in the following table:

<b>Opponent's goods</b>	<b>Applicant's goods</b>
<p><b>Class 09:</b> <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of data, sound or images; magnetic data carriers, recording discs; calculating machines, data processing equipment and computers; computer software; electronic handheld units for the wireless transmission of data and/or voice signals; accessories for electronic handheld units for the wireless transmission of data and/or voice signals namely batteries, battery doors, car kits, chargers and charging pods, headsets, adapters, computer cables; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one or more electronic handheld units and data stored on or associated with a computer.</i></p>	<p><b>Class 9:</b> <i>Laptop bags and sleeves, mouse mats, mobile phone cases, spectacle cases and sunglasses cases.</i></p>
<p><b>Class 18:</b> <i>Leather and imitations of leather, and goods made of these materials and not included in other classes; umbrellas, parasols.</i></p>	<p><b>Class 18:</b> <i>Leather trunks and travelling bags, handbags, purses, briefcases, credit card holders, wallets, suit carriers, wash bags, key fobs, key holders, pouches, coin holders, messenger bags, suit cases, pilots cases, attache cases, needlework bags and cases, make up bags and cases, presentation cases and boxes, maternity bags, game bags, hat boxes, shoe bags and sailing bags.</i></p>
<p><b>Class 25:</b> <i>Clothing, footwear, headgear.</i></p>	<p><b>Class 25:</b> <i>Clothing, footwear, headgear, belts and other similar apparel.</i></p>

Class 9

49) I consider the most relevant parts of the opponent's Class 9 specification to be:

*... optical, ... apparatus and instruments; ... computers; ...; electronic handheld units for the wireless transmission of data and/or voice signals; accessories for electronic handheld units for the wireless transmission of data and/or voice signals namely batteries, battery doors, car kits, chargers and charging pods, headsets, adapters, computer cables; ...*

50) In respect to the applicant's *Laptop bags and sleeves*, the high point of the opponent's case lies with its term *computers*. This term includes laptop computers. The applicant's goods are considered to be complementary to laptop computers because the existence of such computers is essential to the existence of laptop bags and sleeves. The consumer will expect the manufacturer of laptop computers to also provide such accessories. Consequently, I conclude that there is a moderately high level of similarity.

51) The applicant's *mouse mats* are also accessories for computers and, as with the goods discussed in the previous paragraph, whilst they have different nature, purpose and methods of use to computers, there is a complementary relationship in that the existence of computers is essential for the existence of mouse mats. Therefore, as above, I find there is moderately high level of similarity.

52) Unlike in my comparison with the opponent's 2376792 BLACKBERRY mark, the opponent's *accessories* here are positively limited and such a limit does not include cases or covers of any kind. Consequently, its case based upon 2496254 BLACKBERRY BOLD, insofar as it attacks the applicant's *mobile phone cases* cannot be as strong as when it relies upon its 2376792 mark. Therefore, I need not consider the issue further here.

53) Finally, in respect of the applicant's *spectacle cases and sunglasses cases*, these are complementary to spectacles and sunglasses, which are covered by the opponent's *optical apparatus and instruments*. Consequently, I conclude that they share a moderately high level of similarity.

#### Class 18

54) All of the applicant's Class 18 goods can be made of leather or imitation leather and, consequently, they are identical to the same goods covered by the opponent's *leather and imitations of leather, and goods made of these materials*. Even where the applicant's goods are not made from leather or imitation leather, they will still share a very high level of similarity to the same goods that are, and covered by the opponent's specification.

#### Class 25

55) There is obvious identity between the two respective specifications insofar as they both contain the terms *clothing, footwear and headgear*. The applicant's specification also includes the additional term *belts and other similar apparel* and whilst it may be argued that these are not covered by the broad term clothing and, therefore, not identical, there is nonetheless a high level of similarity between belts and clothing as they are often sold together, with belts used both for practical and aesthetic purposes when complementing a fashion look.

### ***The average consumer***

56) Matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23), who is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, paragraph 27). The degree of care and attention the average consumer uses when selecting goods and services can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter-Ikea Systems B.V. v. OHIM*, Case T-112/06).

57) In respect of mobile phones, computers and related software, the consumer normally pays reasonably close attention to the specification of the goods and also, in respect to mobile phones in particular, to the appearance and ease of use. Consequently, in respect of these goods, the purchasing process is reasonably well considered. In respect of accessories for such goods, whilst some care will be taken to ensure compatibility with the phone or computer, the purchasing act will not involve the same level of consideration.

58) In respect of fashion goods such as most of the goods in the parties' Class 18 and Class 25 specifications and also spectacles, sunglasses and cases for the same in Class 9, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285 when he commented on the purchasing act in respect to clothing. His comments, below, appear to be equally applicable to fashion items covered by Class 18:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

59) The GC has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). In the absence of any evidence to the contrary, it is reasonable that I apply Mr Thorley’s comments here, and not only to clothes but also in respect of other fashion goods as identified in the above paragraph. The purchasing act will, generally be described as consumer items and will involve a reasonable degree of care and attention but not the highest

degree of attention. As Mr Thorley noted, the purchasing process is primarily a visual one but I do not ignore the aural considerations that may be involved.

### ***Comparison of marks***

#### **BLACKBERRY v LEATHERBERRY**

60) It is necessary for me to consider a comparison between the applicant's mark and two of the opponent's marks. Firstly, I shall compare the applicant's mark LEATHERBERRY and the opponent's mark BLACKBERRY.

61) When assessing the extent of similarity between the marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). In this case, both marks consist of two conjoined words, however, no one word dominates in either of the marks and I conclude that the distinctive character of both marks reside in their totality. In reaching this conclusion, I acknowledge the potentially descriptive nature of the LEATHER element of the applicant's mark, but that it is conjoined to the word BERRY which has no meaning in respect of the goods covered. The conjoining of the two marks results in the individual elements taking on a distinctive whole, rather than each word having an independent distinctive role.

62) From a visual perspective, both marks share the same last five letters, but there is no visual similarity between the first element of both marks, with the opponent's mark having the five letter word BLACK at the beginning, whereas the applicant's mark has the seven letter word LEATHER. These words are different in length and consist of virtually completely different letters. Taking all of this into account, I conclude the respective marks share only a low to moderate level of visual similarity.

63) Aurally, the opponent's mark consists of the three syllables BLAC-BER-EE and the applicant's mark consists of the four syllables LETH-ERR-BER-EE. Consequently, they are different in length and whilst the last two are identical, the sounds that occur before these are different. I conclude that this combines to result in no more than a low to moderate level of similarity.

64) Conceptually, the opponent's mark is likely to be recognised as the description of the well known soft fruit. The applicant's mark is likely to be perceived as the non-sensical description of a berry made of leather. The general meaning of the word BERRY in the applicant's mark and the occurrence of the same word in the specific description of the well known soft fruit, in the opponent's mark, gives rise to some conceptual similarity, but when the marks are considered as a whole, such similarity is on the low side.

65) In conclusion, the respective marks share a low to moderate visual and aural similarity and a conceptual similarity that is on the low side. This all combines so that the marks share a low to moderate level of similarity overall.

### **BLACKBERRY BOLD v LEATHERBERRY**

66) Secondly, I compare LEATHERBERRY with the opponent's mark BLACKBERRY BOLD. It is clear to me that when it is compared to the applicant's mark, the addition of the word BOLD to the opponent's mark adds an additional difference, both visually, aurally and conceptually. Consequently, I conclude that there is a low level of similarity between the respective marks.

### ***Distinctive character of the earlier marks***

67) I must consider the distinctive character of the earlier marks because the more distinctive they are, either by inherent nature or by use the greater the likelihood of confusion (*Sabel BV v Puma AG* [1998] RPC 199). The distinctive character of the earlier marks must be assessed by reference to the goods for which they are registered and by reference to the way they are perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91). As I have already noted, the opponent's mark BLACKBERRY is likely to be perceived as a description of the well-known soft-fruit. This has no meaning in respect of any of the goods at issue and, consequently, is endowed with a reasonable level of inherent distinctive character, but not the highest level that a made up word may be endowed with. In respect of its BLACKBERRY BOLD mark, the addition of the BOLD element only adds to this level of distinctive character, but it is my view that it is not to any significant extent.

68) In considering the use made by the opponent and its effect on the distinctive character, I note that its evidence is directed at illustrating proof of use of its range of accessories rather than demonstrating the scale of use of its core products, namely hand-held communication devices. However, with accessory sales amounting to nearly \$[REDACTED] in the UK over a period of a little over two years between January 2008 and April 2010, it is reasonable for me to infer that there was significant sales of its core products and that this will have led to at least a reasonable reputation. Such a reputation is likely to have resulted in an enhanced distinctive character of its BLACKBERRY mark. There is insufficient information for me to conclude the same for its mark BLACKBERRY BOLD.

### ***Likelihood of confusion***

69) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case, in particular the

interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*)

70) I will consider the likelihood of confusion based on two scenarios that I believe represent the opponent's strongest case, and referred to in paragraph 43 above. The first of these is the opponent's reliance upon its mark BLACKBERRY to attack, amongst other things, the applicant's *mobile phone cases*. I have found that the opponent's *accessories* include cases for hand-held units (that includes mobile phones) and consequently, the respective goods are identical. Because such goods are intrinsically linked to the goods that they are accessories to, namely mobile phone-type goods, I have found that the same care will not be taken as for the mobile phones themselves but that there is some care taken to ensure compatibility with the phone.

71) In his witness statement, Mr Bearblock points out that, in use, his mark is stylised and used with a device element. As a result, he concludes that because the font, style and "look and feel" are all very different to the opponent's mark, there is no likelihood of confusion. I disregard this argument because it presupposes that I can make a comparison between the opponent's mark and a mark in use that is different to that applied for. That is not what I must consider here. My considerations must be based upon the mark as filed and not any other mark that may be in use. With this in mind, the font and style are identical. Nevertheless, I have found that the respective marks only share a low to moderate visual and aural similarity and a conceptual similarity that is on the low side. This combines so that the marks share a low to moderate level of similarity overall.

72) Mr Bearblock also submits that the applicant uses its mark in respect of bespoke hand bags and similar goods and, whilst such goods may include pockets for mobile phones, this is not their *raison d'être*. Once again, this would require me to make a comparison between the opponent's goods and those goods that the applicant is currently trading in. It requires that I ignore the actual scope of the goods claimed in the application. I am guided by case law against doing this and, in particular, I am mindful of the comments of the GC in *Oakley, Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-116/06:

"76 Consideration of the objective circumstances in which the goods and services covered by the marks in dispute are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is prospective. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time, and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, that the relevant public may not be exposed to the risk of being misled as

to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not – and which are naturally subjective – of the trade mark proprietors (QUANTUM, paragraph 75 above, paragraph 104, and T.I.M.E. ART/Devinlec v OHIM, paragraph 75 above, paragraph 59).”

73) As a consequence of this, I must restrict my analysis of the goods listed in the application with those of the opponent.

74) Finally, Mr Bearblock relies on the fact that he is not aware of any actual confusion. I disregard this argument. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little. See, for example, *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff’s registered trade mark.”

75) In *Compass Publishing BV v Compass Logistics Ltd* Laddie J stated:

“22. It is frequently said by trade mark lawyers that when the proprietor’s mark and the defendant’s sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 (“the 1994 Act”), that is to say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer’s use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place.”

76) In the current case, as Mr Bearblock has been at pains to point out, the applicant's activities have related to bespoke luxury bags whereas the opponent's activities have focused on hand-held communication devices. It is therefore, not surprising that there has been no actual confusion as the parties are operating in different markets.

77) Having said all of this, I find that the differences between the marks are such as to dominate any similarities so that even where identical goods are involved (mobile phone cases) and where the consumer's level of attention is likely to be of a reasonable level (even if not as high as in respect to mobile phones), there is no likelihood of confusion. Whilst the shared BERRY element, present at the end of both parties' marks may be enough for the applicant's mark to bring the opponent's mark to mind, this is insufficient to result in the consumer believing that the respective goods originate from the same, or a linked undertaking.

78) I also consider the likelihood of confusion between the opponent's BLACKBERRY BOLD mark and that of the applicants because there are numerous identical goods involved in classes 18 and 25 (potentially providing the opponent with a broader scope of success). These can be collectively called fashion goods, and I have concluded that the level of consideration during the purchasing process is likely to be lower than during the purchase of technical products (and accessories) as discussed above and that the purchasing process will be even more based upon visual considerations.

79) Having said this, I find that the opponent's case is no stronger than when considering its case based upon BLACKBERRY alone. I am still of the view that although the applicant's mark may bring the earlier mark to mind, it is insufficient to lead the consumer to believe that the goods originate from the same or linked undertakings. Consequently, I find that there is no likelihood of confusion here either.

80) In summary, I find that even when considering the opponent's strongest cases that there is no likelihood of confusion and the opposition based upon Section 5(2)(b) of the Act fails in its entirety.

#### **Section 5(4)(a)**

81) I will also comment briefly on the ground under Section 5(4) (a) of the Act. That section reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

82) The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. The three elements that must be present can be summarised as follows:

(1) that the opponents’ goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents; and

(3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant’s misrepresentation.

83) The question of goodwill has been conceded by the applicant insofar as it is attached to the opponent’s BLACKBERRY electronic hand-held communication devices. Further, I accept that the evidence illustrates that this goodwill will also extend to accessories for such goods, including cases. Such cases are identical to mobile phone cases listed in the applicant’s Class 9 specification. However, I do not see how use by the applicant, of its mark, will result in misrepresentation. I have already found that there is no likelihood of confusion and it is my view that the opponent is no better off here because the public is not likely to be lead into believing the applicant’s goods are the goods of the opponent.

84) Therefore, I dismiss this ground of opposition in its entirety.

## **COSTS**

85) The opposition having failed, Leatherberry Limited is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place. I award costs on the following basis:

Considering Notice of Opposition and statement of case in reply: £500  
Preparing and filing evidence and considering other side’s evidence: £900

TOTAL

£1400

86) I order Research in Motion Limited to pay Leatherberry Limited the sum of £1400. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 19th day of November 2012**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**

**(R)**

REDACTED

## ANNEX 1 – Relevant details of earlier marks relied upon and goods opposed

Mark details and relevant dates	Goods relied upon	Goods being opposed
<p>2376792</p> <p>BLACKBERRY</p> <p>Filing date: 26 October 2004</p> <p>Registration date: 01 April 2005</p>	<p><b>Class 09:</b> <i>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; 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 remote station or unit and software which enables and provides one-way and /or two-way wireless connectivity to data, including corporate data.</i></p> <p><b>Class 38:</b> <i>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.</i></p> <p><b>Class 41:</b> <i>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, including corporate data, and /or voice communications.</i></p>	<p><b>Class 09:</b> <i>Laptop bags and sleeves, mouse mats, mobile phone cases</i></p>
<p>Community Trade Mark (CTM) 1248335</p> <p>BLACKBERRY</p> <p>Filing date: 20 July 1999</p> <p>Registration date: 5 March 2002</p>	<p><b>Class 9:</b> <i>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 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.</i></p> <p><b>Class 38:</b> <i>E-mail service; wireless data messaging services, including services that enable a user to send and/or receive messages through a wireless data network; one-way and two-way paging services.</i></p>	<p><b>Class 09:</b> <i>Laptop bags and sleeves, mouse mats, mobile phone cases</i></p>
<p>CTM 3180445</p> <p>BLACKBERRY</p> <p>Filing date: 23 May 2003</p> <p>Registration date: 9 November 2004</p> <p>Priority date: 26 November 2002</p>	<p><b>Class 9:</b> <i>Electronic handheld units for the wireless receipt and/or transmission of data that enable the user to keep track of or manage personal information and which may also have the capacity to transmit and receive voice communications; 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; 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.</i></p> <p><b>Class 38:</b> <i>E-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive voice messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services. Consulting 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, including corporate data, and/or voice communications.</i></p> <p><b>Class 41:</b> <i>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, including corporate data, and/or voice communications.</i></p>	<p><b>Class 09:</b> <i>Laptop bags and sleeves, mouse mats, mobile phone cases</i></p>
<p>CTM 3937307</p> <p></p>	<p><b>Class 9:</b> <i>Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data</i></p>	<p><b>Class 9:</b> <i>Laptop bags and sleeves, mouse mats, mobile phone cases, spectacle cases and sunglasses cases.</i></p>

<p>Filing date: 28 June 2004</p> <p>Registration date: 26 January 2006</p>	<p><i>carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</i></p> <p><b>Class 38:</b> Telecommunications.</p> <p><b>Class 41:</b> Education; providing of training; entertainment; sporting and cultural activities.</p>	
 <p>Filing date: 28 June 2004</p> <p>Registration date: 26 January 2006</p>	<p><b>Class 9:</b> Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus.</p> <p><b>Class 38:</b> Telecommunications.</p> <p><b>Class 41:</b> Education; providing of training; entertainment; sporting and cultural activities.</p>	<p><b>Class 9:</b> Laptop bags and sleeves, mouse mats, mobile phone cases, spectacle cases and sunglasses cases.</p>
<p>CTM 6305585</p> <p>BLACKBERRY CURVE</p> <p>Filing date: 24 September 2007</p> <p>Registration date: 2 September 2008</p> <p>Priority date: 26 March 2007</p>	<p><b>Class 09:</b> Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of data, sound or images, magnetic data carriers, recording discs, calculating machines, data processing equipment and computers; computer software.</p> <p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins, hides; trunks and travelling bags; umbrellas, parasols and walking sticks; whips; harness and saddlery.</p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>	<p><b>Class 9:</b> Laptop bags and sleeves, mouse mats, mobile phone cases, spectacle cases and sunglasses cases.</p> <p><b>Class 18:</b> Leather trunks and travelling bags, handbags, purses, briefcases, credit card holders, wallets, suit carriers, wash bags, key fobs, key holders, pouches, coin holders, messenger bags, suit cases, pilots cases, attache cases, needlework bags and cases, make up bags and cases, presentation cases and boxes, maternity bags, game bags, hat boxes, shoe bags and sailing bags.</p> <p><b>Class 25:</b> Clothing, footwear, headgear, belts and other similar apparel.</p>
<p>2441186</p> <p>BLACKBERRY PEARL</p> <p>Filing date: 11 December 2006</p> <p>Registration date: 22 June 2007</p> <p>Priority date: 10 July 2006</p>	<p><b>Class 09:</b> 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><b>Class 09:</b> Laptop bags and sleeves, mouse mats, mobile phone cases</p>
<p>2496254</p> <p>BLACKBERRY BOLD</p> <p>Filing date: 28 August 2008</p> <p>Registration date: 20 March 2009</p> <p>Priority date: 06 March 2008</p>	<p><b>Class 09:</b> Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of data, sound or images; magnetic data carriers, recording discs; calculating machines, data processing equipment and computers; computer software; electronic handheld units for the wireless transmission of data and/or voice signals; accessories for electronic handheld units for the wireless transmission of data and/or voice signals namely batteries, battery doors, car kits, chargers and charging pods, headsets, adapters, computer cables; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one or more electronic handheld units and data stored on or associated with a computer.</p> <p><b>Class 18:</b> Leather and imitations of leather, and goods made of these materials</p>	<p><b>Class 9:</b> Laptop bags and sleeves, mouse mats, mobile phone cases, spectacle cases and sunglasses cases.</p> <p><b>Class 18:</b> Leather trunks and travelling bags, handbags, purses, briefcases, credit card holders, wallets, suit carriers, wash bags, key fobs, key holders, pouches, coin holders, messenger bags, suit cases, pilots cases, attache cases, needlework bags and cases, make up bags and cases, presentation</p>

	<p><i>and not included in other classes; umbrellas, parasols.</i></p> <p><b>Class 25:</b> Clothing, footwear, headgear.</p>	<p><i>cases and boxes, maternity bags, game bags, hat boxes, shoe bags and sailing bags.</i></p> <p><b>Class 25:</b> Clothing, footwear, headgear, belts and other similar apparel.</p>
<p>CTM 6575872</p> <p>BLACKBERRY UNITE!</p> <p>Filing date: 14 January 2008</p> <p>Registration date: 12 November 2008</p> <p>Priority date: 24 July 2007</p>	<p><b>Class 09:</b> Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of data, sound or images, magnetic data carriers, recording discs, calculating machines, data processing equipment and computers and computers; computer software; electronic handheld units for the wireless transmission of data and/or voice signals; accessories for electronic handheld units for the wireless transmission of data and/or voice signals namely batteries, car kits, chargers, headsets; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one or more electronic handheld units and data stored on or associated with a computer.</p>	<p><b>Class 9:</b> Laptop bags and sleeves, mouse mats, mobile phone cases.</p> <p><b>Class 18:</b> Leather trunks and travelling bags, handbags, purses, briefcases, credit card holders, wallets, suit carriers, wash bags, key fobs, key holders, pouches, coin holders, messenger bags, suit cases, pilots cases, attache cases, needlework bags and cases, make up bags and cases, presentation cases and boxes, maternity bags, game bags, hat boxes, shoe bags and sailing bags.</p> <p><b>Class 25:</b> Clothing, footwear, headgear, belts and other similar apparel.</p>
<p>CTM 5692603</p> <p>BLACKBERRY CYPHER</p> <p>Filing date: 15 February 2007</p> <p>Registration date: 15 February 2008</p> <p>Priority date: 15 August 2006</p>	<p><b>Class 09:</b> 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><b>Class 09:</b> Laptop bags and sleeves, mouse mats, mobile phone cases</p>

## **ANNEX 2 – Goods and services where the opponent claims use for the purposes of Section 5(4)(a)**

*Electronic handheld units for the wireless transmission of data and/or voice signals; accessories for electronic handheld units for the wireless transmission of data and/or voice signals, namely, batteries, battery doors, car kits, chargers and charging pods, headsets, adapters, desk stands, docking cradles, computer cables, cases, totes and holsters; computer communication software for the synchronization, transmission and sharing of data, calendar, content and messaging between one or more electronic handheld units and data store on or associated with a computer.*

*Providing access to the Internet; providing access to electronic databases, providing access to GPS navigation services; e-mail service; wireless data messaging services, particularly services that enable a user to send and/or receive voice messages through a wireless data network; one-way and two-way paging services; transmission and reception of voice communication services; telecommunications consultation, namely, providing information to third parties to assist them in developing and integrating one way or two way wireless connectivity to data, including corporate and home/personal data, and/or voice communications.*

*Providing GPS navigation services; providing information relating to travel and transportation.*

*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; information related thereto*

*Consultancy and technical support services relating to computer hardware and software, and to telecommunication and GPS services; technical support services, namely, updating and maintenance of computer software and troubleshooting support for diagnosis and resolution of wireless connectivity devices and related computer software and hardware problems*

*Licensing of computer software*