

O/039/12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2438610
BY LG ELECTRONICS FOR THE TRADE MARK:**

BLACKRUBY

AND

OPPOSITION THERETO (NO 95180) BY RESEARCH IN MOTION LIMITED

THE BACKGROUND AND THE PLEADINGS

1) On 15 November 2006 LG Electronics Inc (“LG”) applied for the word BLACKRUBY as a trade mark in respect of the following goods in class 9:

Computer monitors, CCTV [closed circuit television], notebook computers, computer servers, computers, printers for use with computers, recorded computer programs, recorded computer software, personal digital assistants [PDA], semi-conductors, television receivers [TV sets], mobile phones, facsimile apparatus, camcorders, video tape recorders [VTR], adaptors, headphones, microphones, earphones, digital versatile disc [DVD] players, MP3 players, speakers, compact disc players [CDP], unprocessed audio/video compact disc, head cleaning tapes for recorders, cathode-ray tubes [CRT], video cameras, digital cameras.

2) LG’s application was published in the Trade Marks Journal on 9 February 2007, following which Research In Motion Limited (“RIM”) filed a notice of opposition against it. RIM’s grounds of opposition are under sections 5(2)(b), 5(3), 5(4)(a) & 3(6) of the Trade Marks Act 1994 (“the Act”). Under the various section 5 grounds, RIM relies on a single trade mark/sign which consists of the word BLACKBERRY. All of the goods set out above are said to fall foul of the section 5(3) & 5(4)(a) grounds, but only certain goods¹ are said to be similar or identical to the goods/services of RIM’s earlier mark and, so, the ground under section 5(2)(b) can only relate to such goods (there being some similarity between the goods is a prerequisite under this ground²). It should also be noted that RIM’s earlier mark (UK registration 2376792) is not subject to the requirement to prove that it has been genuinely used as it had been registered for less than five years at the date when LG’s mark was published³. In view of this, the earlier mark may be taken into account for its specification as registered which reads:

Class 09: 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

¹ Computer monitors, notebook computers, computer servers, computers, printers for use with computers, recorded computer programs, recorded computer software, personal digital assistants [PDA], mobile phones, facsimile apparatus.

² See, for example, the CJEU’s judgment in *Waterford Wedgwood plc v OHIM* Case C-398/07.

³ See section 6A of the Act.

provides one-way and /or two-way wireless connectivity to data, including corporate data.

Class 38: 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.

Class 41: 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.

3) Under section 3(6), it is claimed that LG filed its mark as part of a pattern of copycat behavior intended to cause unnecessary commercial nuisance to RIM and, as such, LG have no intention of using its mark.

4) LG filed a counterstatement denying the grounds of opposition. It put RIM to proof of use in respect of its earlier mark, but, as noted above, this is not required. RIM filed evidence, LG did not. Both sides then attended a hearing, the parties' representatives being: for LG, Ms Anna Edwards-Stuart, of Counsel, instructed by Boulton Wade Tennant; for RIM, Mr Simon Malynicz, of Counsel, instructed by Dehns.

THE EVIDENCE

Witness statement of Mark Guibert

5) Mr Guibert is RIM's Vice President of Corporate Marketing. Most of his evidence relates to the use that RIM has made of its BLACKBERRY trade mark. I do not consider it necessary to provide a detailed summary of this part of the evidence. This is because it is abundantly clear from the evidence, and I did not understand Ms Edwards-Stuart to dispute this, that the BLACKBERRY mark had a strong reputation at the material date in relation to, at the least, a handheld device for voice/data communications. Ms Edwards-Stuart did, though, caution that Mr Guibert's evidence did not always differentiate between UK use and overseas use and, furthermore, that a lot of the evidence was from after the material date. This will be borne in mind, but these observations do not affect the primary finding that I have just made. At this stage, I will touch on two points that Mr Guibert's evidence deals with:

- i) Mr Guibert mentions a number of times in his evidence the BLACKBERRY PEARL handset. It is stated that LG's application for BLACKRUBY came shortly after RIM's announcement of the BLACKBERRY PEARL device on 7 September 2006 (a supporting press release is provided). It is stated that this new device contained extra features such as a

camera and multimedia capabilities. The devices were shipped to the UK in October 2006. Mr Malynicz reminded me that it was too late to disbelieve Mr Guibert's evidence on this. Whilst this may be so, I must still decide what it tells me. Beyond a press release and a statement that the devices were shipped to the UK in October 2006, there is nothing to suggest that sales had been made by the material date (15 November 2006) or otherwise promoted. The issues relevant to the BLACKBERRY PEARL will be discussed later, but as a primary finding, I take the view that at the material date it cannot be assumed that the average consumer was familiar with the BLACKBERRY PEARL device.

- ii) Ms Edwards-Stuart also referred to Mr Guibert's reference to certain of its devices being red in colour, the same colour as rubies. Mr Guibert states in his evidence that this may increase the risk of confusion or association. However, earlier in his witness statement (at paragraph 70) it is clear from his commentary that the red version of the BLACKBERRY PEARL 8120 was not available until 2007/2008, which is after the material date. Mr Guibert's evidence on this, therefore, can have no bearing on the questions before me.

6) In relation to the BLACKBERRY PEARL, Ms Edwards-Stuart submitted that its existence after the material date may count against RIM because this may have skewed the results of a survey which was conducted; I will come back to this submission later. I will also come back to Mr Guibert's evidence relating to the alleged bad faith on LG's part in making its application.

Witness statement of Lindsay Rae Thomas

7) Ms Thomas works for Farncombe International, she is an investigator. She explains that Farncombe were instructed to review the location in store, and proximity to each other, of LG and Blackberry mobile devices and accessories. Ms Edward-Stuart submitted that the evidence produced was irrelevant and inadmissible given that LG's BLACKRUBY mark has not been used and, so, only the notional and fair use of it may be considered. The evidence is not inadmissible. It has never been challenged and, so, it must be born in mind. Neither is the evidence completely irrelevant because it demonstrates the proximity at the point of sale of the goods and that LG's goods could be sold in close proximity to those of RIM. However, this is the sort of fact that the tribunal could have worked out for itself. An investigator was not needed to report on such a matter. I need say no more about this evidence.

Witness statement of Ronald Harvey Smyth

8) Mr Smyth is an Associate Professor in the Departments of Humanities (Linguistics Discipline) at the University of Toronto. He is put forward as a

linguistics expert. He has been asked to give an opinion on any similarities between BLACKBERRY and BLACKRUBY. He has also been asked to comment on whether the use of BLACKRUBY would give rise to confusion with BLACKBERRY. Ms Edwards-Stuart argued that Mr Smyth's evidence should be given no weight as such evidence is rarely significant. Lord Justice Millett noted in *The European Limited v The Economist Newspaper Limited* [1998] FSR, 283 at 291 that the role of an expert witness is as follows.

"The function of an expert witness is to instruct the Judge of those matters which he would not otherwise know but which it is material for him to know in order to give an informed decision on the question which he is called on to determine. It is legitimate to call evidence from persons skilled in a particular market to explain any special features of that market of which the Judge might otherwise be ignorant and which may be relevant to the likelihood of confusion. It is not legitimate to call such witnesses merely in order to give their opinions whether the two marks are confusingly similar. They are experts in the market, not on confusingly similarity ...In the end the question of confusingly similarity is one for the Judge. He was bound to make up his own mind and not leave the decision to the opinion of the witnesses."

9) I, therefore, agree with Ms Edwards-Stuart that there is little significance in the evidence of Mr Smyth. In any event, Mr Malynicz did not appear to place much weight on it. He did, though, stress certain aspects of the evidence including that more stress may be placed on the black element of BLACKRUBY than would have occurred if the mark had been applied for as BLACK RUBY. I will bear these observations in mind when I come to make my findings on what level of similarity exists between the marks; other than that, I do not propose to summarise this evidence any further.

The survey evidence

10) RIM's evidence includes the results of two public surveys. The surveys are introduced and explained in a witness statement of Mr John Kelly of MDL Research. In terms of the basic methodology and statistical relevance, I have no strong concerns. Whilst the number of participants (just over 300 per survey) is not the highest, it is not insignificant. The breakdown of participants (by age and gender) and their method of selection appear reasonable, as are the locations in which the surveys were conducted (avoiding locations near mobile phone shops or advertising for the same). One survey relates to the BLACKBERRY trade mark and was aimed at informing the tribunal of the mark's level of public awareness and reputation. I do not intend to provide a detailed summary of this survey. This is because I have already found that BLACKBERRY had a strong reputation at the material date.

11) The other survey relates to the word BLACKRUBY. The survey is named the ROBIN survey. 304 people participated in it. There is no evidence as to the number of people who refused to take part. Any true statistical analysis of a survey should take response rate into account, not least to identify such issues as response bias. It is quite possible that the response rate would not have had any effect upon the result but it would have been useful to have known it. Interviewers were not aware of the client who had instigated the survey or what its purpose was. The survey participants were shown a card with the word BLACKRUBY on and were asked:

Q1. What product, if any, would you think of if you saw this brand name?

12) Mr Malynicz thought that this was a good question being both open and non-leading. He highlighted that it did not place any context as to product field. Ms Edwards-Stuart disagreed; she argued that the question encouraged the participant to speculate. She argued that because the BLACKRUBY brand would not be known to anyone (it never having been used), the question encouraged the participant to speculate about another product that was familiar to them. I think this is a fair criticism. Whilst the word "product" was used in the question and, therefore, the question was aimed at understanding what goods the brand brought to mind, the word "product" may also be understood as a particular product of a company i.e. a brand. The question, therefore, may have made many of the participants speculate of another brand that was simply similar to BLACKRUBY (BLACKRUBY being unknown to them as it is an unused mark).

13) The results show that around 20% of the participants mentioned BLACKBERRY in their initial answer; a further 10% mentioned the type of goods for which BLACKBERRY is known, so leading to an assumption (on Mr Kelly's part) that they had BLACKBERRY in mind. Those who did not mention BLACKBERRY were additionally asked:

Q5. What electronic device, if any, would you think of if you saw this brand name?

14) Around 28% (around 18% of the total sample) of those asked this question mentioned BLACKBERRY. Follow-up questions were asked after questions 1 and 5 with the purpose of understanding why the respective answers were given. For those that mentioned BLACKBERRY the responses were based on a certain degree of similarity between BLACKBERRY and BLACKRUBY. I say a certain degree of similarity because the responses were varied. They ranged from the similarity being based simply on the common presence of the word BLACK, to the other end of the scale where some participants thought that the word they had been shown was actually BLACKBERRY.

15) In addition to those participants who referred to BLACKBERRY (be it following question 1 or question 5) other participants made no reference to

BLACKBERRY. Many simply said that nothing came to mind, others gave answers as varied as drinks, aftershave, chocolate, and jewellery.

16) Whilst I will come back to the implications of the survey when dealing with the various points that need to be determined, I should stress at this stage that I place little weight on the survey. This is primarily due to the speculative nature of the questions. Mr Malynicz submitted that the survey represents a useful barometer of the likely reaction of consumers. I am not convinced that this is the case; the various points I need to determine in these proceedings (for example, whether a likelihood of confusion exists and/or whether a link will be established) are underpinned by a particular approach on the part of the average consumer, an approach that is not well represented by the speculative nature of the questions. Other factors may also water down the significance of the survey, including that the fame of BLACKBERRY is likely to have increased between the material date and the date of the survey. However, I accept that this is not overly significant. The final point I should note relates to the use of the BLACKBERRY PEARL. Ms Edwards-Stuart argued that the use of the word PEARL in conjunction with BLACKBERRY after the material date meant that the survey participants were more likely to think of the BLACKBERRY name (because of the link between pearls and rubies). I acknowledge this submission, but I consider that this will have had only a minor impact (although not completely negligible) as few people referred to the BLACKBERRY PEARL in their answers.

17) I should add that witness statements have been provided from 19 of the survey participants. In the annex to this decision I have provided a flavour of what the witnesses said. Mr Kelly mentions these witness statements in his evidence. He says that one of the aims of the survey was to provide an opportunity to identify potential witnesses for follow-up by CMS Cameron McKenna LLP ("CMS") (RIM's lawyers). However, little evidence is provided as to how this process was conducted. It is not clear if all who agreed to be recontacted were recontacted. It is not clear if some who were recontacted chose not to provide a witness statement. It is not clear if some gave witness statements that were not filed. Further, the person(s) from CMS who spoke to the witnesses asked questions which gave rise to further speculation. Although it is not clear what exact questions were asked, it is clear from the answers given that the questions included asking the witnesses what they felt the motive was behind the BLACKRUBY brand and what impact this may have on RIM. Whilst the answers are borne in mind, the method in which the evidence has been collected is far from satisfactory. The interviewer from CMS may have led the witnesses. By talking of motive, the participant is being led toward there being something improper going on. I place little very weight on such evidence.

SECTION 5(2)(B)

The law

18) Section 5(2)(b) of the Act reads:

“5.-(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.”

19) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05). In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10) Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases:

"(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only

when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

20) The case-law informs me that the average consumer 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 or services can, however, vary depending on what is involved (see, for example, the judgment of the General Court ("GC") in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)).

21) The goods/services concerned are varied. The dispute focuses, in the main, on various pieces of electronic equipment such as mobile phones, hand-held communication devices, PDAs, computers etc. The average consumer could be a business obtaining such goods for business use, or a member of the public

obtaining such goods for personal use. Either way, I consider that the acquisition of such goods constitutes a reasonably considered purchase.

Comparison of goods/services

22) In terms of the comparison to be made, all relevant factors relating to the goods/services in the respective specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“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.”

23) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

24) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”⁴ and that I must also bear in mind that

⁴ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning⁵. Finally, when comparing the respective goods, if a term clearly falls within the ambit of a term in the competing specification then identical goods must be considered to be in play⁶ even if there may be other goods within the broader term that are not identical.

25) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 325/06* 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 *Sergio 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 Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

26) The goods claimed to be identical or similar which are contained in LG’s application are:

“Computer monitors, notebook computers, computer servers, computers, printers for use with computers, recorded computer programs, recorded computer software, personal digital assistants [PDA], mobile phones, facsimile apparatus”

27) RIM’s earlier mark contains a number of goods and services. Mr Malynicz’ skeleton argument contained a breakdown of where its primary arguments lie. Ms Edwards-Stuart’s skeleton did likewise. Both Counsel built on this during the hearing. The respective breakdowns and arguments are borne in mind in the flowing analysis.

⁵ See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

⁶ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM) Case T-133/05 (“Gérard Meric”)*.

Mobile phones

28) Identity is claimed on the basis of RIM's term "electronic handheld units... which may also have the capability to transmit and receive voice communications". Identity is conceded in Ms Edward-Stuart's skeleton. **The goods are identical.**

Notebook computers & personal digital assistants [PDA]

29) Identity is claimed on the basis of RIM's term "electronic hand-held devices...for the wireless receipt and/or transmission of data". Ms Edwards-Stuart concedes identity in relation to PDAs but only similarity in terms of notebook computers. Given this concession, I need say nothing in relation to PDAs. **The goods are identical.** In relation to notebook computers, I agree that they are similar rather than identical. Notebook computers would not ordinarily be described as hand-held devices. Nevertheless, they clearly have similar functions to hand-held devices which wirelessly receive and/or transmit data, they are similar in nature and they have similar methods of use. **I consider the goods to be highly similar.**

Computer monitors, computers, printers for use with computers

30) The goods are claimed to be highly similar to the earlier mark's hand-held devices as all the goods form part of business hardware aimed at facilitating the sending, receiving or printing of e-mail. Computers are conceded as being similar but no concession is made in relation to monitors or printers. The concession in relation to computers means there is little to say, I should add, though, that I regard the goods **as highly similar** as both could be used for the transmission of data etc, even if a computer may have other functions. The other terms require greater analysis.

31) In relation to computer monitors, such a thing is used to display information on screen, information which is generated by a computer. The hand-held devices covered by RIM's specification will already have a screen built in to display information. In view of this there is no complementary or competitive relationship and the actual purposes of the specific goods differ. That the goods may be used as business hardware is a relatively superficial argument. There may be a degree of similarity, but only of a low degree. Whilst there may be other similarities such as them being electronic and that they may be used in relation to/with computers, **the various factors indicate nothing more than a low degree of similarity.**

32) In relation to printers, whilst hand-held devices may have the capacity to connect (physically or wirelessly) to a printer, this does not strike me as the type of complementary relationship envisaged by *Boston Scientific*. The goods are not competitive. The purpose of a printer is to print information, the purpose of the

device is to send and receive information. **Again, I come to the view that there is nothing more than a low degree of similarity.**

Computer servers

33) These goods were not specifically mentioned in Mr Malynicz' skeleton argument or submissions. Mr Edwards-Stuart argued that there is no similarity. There is certainly no better prospect with these goods than with the goods assessed in the preceding paragraph. In fact, a computer server has a more specific computing function of serving clients on a network and performing computational tasks for it. Such specificity leads to less similarity with a hand-held device than assessed above. There is no complementary or competitive relationship. **I find that there is only a very low degree of similarity.**

Recorded computer programs, recorded computer software

34) Identity is claimed on the basis that RIM's earlier mark contains particular types of software (for data synchronization etc). The only concession is that the goods are similar. Given my comments in paragraph 24, **the goods must be identical** given that the applied for terms include those for which the earlier mark is registered.

Facsimile apparatus

35) Similarity is claimed and conceded. In terms of the degree of similarity, whilst there may be a similarity in purpose (both communicating data, potentially in written form) the nature and method of use is not on a par. There is a degree of competition given that a business may choose to purchase a facsimile machine to send/receive communications or may, alternatively, choose a hand-held unit instead. **I consider there to be a reasonable (but not high) degree of similarity.**

Comparison of the marks

36) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:

| LG's mark | RIM's mark |
|-----------|------------|
| BLACKRUBY | BLACKBERRY |

37) RIM's mark consists of the word BLACKBERRY. Although both the word BLACK and the word BERRY are words in their own right, they combine to create a single word, namely the well-known type of fruit. For this reason, the average consumer will perceive BLACKBERRY as a single component mark with neither BLACK nor BERRY dominating the overall impression. In relation to BLACKRUBY, the words BLACK and RUBY are, again, words in their own right, but they do not combine to create a single known word. The average consumer will regard the mark as the conjoining of two separate words, with the first qualifying the second, i.e. the ruby being qualified as black. Whilst I accept that rubies are ordinarily known for being red, this does not alter the perception of the mark. Given this, the mark BLACKRUBY forms a single phrase, and given that the word BLACK qualifies the word RUBY, the RUBY element is likely to be the most memorable aspect. Therefore, in this case the rule of thumb referred to by Mr Malynicz that beginnings of marks take on more significance does not apply. However, I do not ignore completely the BLACK aspect because the concept of a black ruby is an unusual one. Both words are, therefore, important in the overall impression of the mark.

38) From a visual perspective, the letters/word BLACK is common to both marks, appearing in both at the beginning. The marks are also of similar length. There is also some similarity in that the letter Y is the last letter in each mark and both endings have an R and a B in them, albeit not in the same order. In terms of differences, there is an additional R in RIM's mark (forming a double R) a U instead of an E, and the differing ordering of the letters B and R. This, in my view, does not equate to a high degree of similarity. I consider there to be only a low to moderate degree of visual similarity.

39) From an aural perspective, a similar theme runs through the analysis with the shared BLACK sound at the start of the mark and a degree of similarity based on the sharing of certain letters in the endings of the marks. The endings, though, are pronounced BEH-RRY as opposed to RUE-BE, so there is a reasonably noticeable difference, although, I, of course, bear in mind that it is the whole of the marks that I am considering. As a whole, I consider there to be a moderate degree of aural similarity. When coming to this view I have considered Mr Malynicz' point about greater stress being placed on the BLACK element of the marks when presented as whole words; the finding I have made reflects this, but I do not feel that such stress makes the similarity greater than moderate.

40) From a conceptual perspective, I have already identified what concepts are likely to be perceived by the average consumer. When doing so, I have borne in mind that for a conceptual meaning to be relevant it must be one capable of immediate grasp⁷. RIM's mark relates to a type of fruit. LG's mark relates to a ruby that is black. There is no conceptual similarity. In Mr Malynicz' skeleton

⁷ This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

argument, it was said that there is conceptual neutrality. According to the jurisprudence of the CJEU, if one mark has a meaning which is not shared by the other then this creates a conceptual difference. This is the case here. In fact, the position is even starker because both marks have a concept, concepts which are different. The marks are conceptually dissonant. I should add that Mr Malynicz' submission that both marks have a concept (and thus some conceptual similarity) based on the inclusion of the word BLACK is not accepted, given my assessment of what the average consumer will perceive.

The distinctiveness of the earlier mark

41) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

42) Although not an invented word, the word BLACKBERRY is not in any way allusive of the goods for which it is registered. It is a fanciful trade mark. It has a reasonably high degree of inherent distinctive character. The use made of the earlier mark must be considered. I have touched on the evidence earlier, and I will return to it when I come to assess whether there exists a likelihood of confusion. For the time being, it is sufficient to record that the earlier mark BLACKBERRY was, at the material date, a well-known trade mark in respect of particular goods, namely, hand held devices for transmitting messages and voice communication. The earlier mark, in relation to these goods, is highly distinctive.

Likelihood of confusion

43) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

44) I will consider the position, first, from the perspective of the terms mobile phones and PDAs covered by LG's specification. This represents RIM's best prospect of success due to the identity of the goods and, also, the trade mark's reputation in relation to the goods – such factors are clearly important when one bears in mind the interdependency principles and, also, that the more distinctive the earlier mark (including distinctiveness enhanced through use) the greater the likelihood of confusion. If RIM does not succeed here, then it is unlikely to succeed with the other goods it opposes. I have found that there is a low to moderate degree of visual similarity and a moderate degree of aural similarity, but that there is conceptual dissonance. Mr Malynicz argued that consumers see

what they expect to see and that, applied to this case, the similarity between the marks, coupled with RIM's strong reputation, will mean that a misreading of BLACKRUBY as BLACKBERRY may occur. This argument is based largely on the decision of Mr Richard Arnold QC (sitting as the Appointed Person) in *Kennedy Fried Chicken* O-227-04, where he stated:

"I consider that there is force in the appellant's submission that human beings have a tendency to see what they expect to see, and so some consumers would be likely to misread KENNEDY FRIED CHICKEN as KENTUCKY FRIED CHICKEN because, on a quick visual scan, they would see the overall structure KEN ... Y FRIED CHICKEN and jump to the conclusion that the phrase was KENTUCKY FRIED CHICKEN. I consider that there would also be potential for mishearing for similar reasons."

45) Whilst I bear the above in mind, each case must be determined on its own merits. For example, a further factor, which, in the *Kennedy Fried Chicken* case, made matters worse was the propensity of the average consumer to abbreviate the mark to KFC, something which the earlier mark in that case (Kentucky Fried Chicken) routinely did in its marketing. There is nothing similar in the case before me. That does not mean that the approach cannot apply, but, on the contrary, I must bear in mind the reasonably considered nature of the purchasing process of the goods I am considering. Quick scans of marks are not what this is about. I must bear in mind that some of the survey participants did misread the mark, however, as I stated earlier, the survey does little to reflect the purchasing considerations that an average consumer will undertake in respect of the goods at issue. I also expressed earlier that I placed little weight on the survey results. A blackberry is unlikely to be imperfectly recalled as a blackruby or vice versa. Weighing all the relevant factors, I conclude that there is no likelihood of the average consumer mistaking one mark for the other. This rules out the possibility of "direct confusion" i.e. confusing one trade mark for the other.

46) Irrespective of the above finding, I must also determine whether there is a likelihood of "indirect confusion"; where the average consumer considers that the goods or services marketed under the respective trade marks emanate from the same or an economically linked undertaking. Again, some of the survey participants came to this view. I also note the follow-up witness statements, a number of which expressed a view that BLACKRUBY may be seen as a new model of BLACKBERRY. The criticisms I have made of the survey apply here. This is particularly so with regard to the follow-up witness statements where the tribunal does not know of the nature of the follow-up questions and, on the face of it, the questions asked may have been speculative and leading. I placed very little weight on this evidence. I am also far from satisfied that the survey results represent the natural reaction by an average consumer encountering BLACKRUBY in trade. The argument that the average consumer will believe that the same or economically linked undertakings are involved, is based on the

common presence of the word BLACK and the similar overall construction of the marks. However, the average consumer will, I believe, appreciate that the differing concepts point away from an economic link. There is no reason to believe that BLACKBERRY will bring out a new product called BLACKRUBY. RIM has an established brand and, by the material date, had not sought to extend it to many variations of BLACKBERRY, indeed, there are no variations of any BLACK+ marks, only BLACKBERRY. Whilst this is not a prerequisite for a finding of indirect confusion, in the circumstances of this case, and weighing the various factors, it is too great a leap for the average consumer to come to the assumption that BLACKRUBY is produced by the same stable as BLACKBERRY. There is no likelihood of indirect confusion. **The ground under section 5(2)(b) fails.** As indicated earlier, I do not consider RIM to be in any better position in respect of the other goods it opposes so the ground also fails in respect of them.

SECTION 5(4)(A)

47) Given that my decision under section 5(2)(b) took into account the use that RIM had made by the material date, and given that such use would be representative of the business conducted by RIM, and given that the sign relied on is the same as the earlier mark relied on under section 5(2)(b), I do not see that RIM can be in any better position under this ground of opposition. **This ground of opposition fails for similar reasons to those set out above.**

SECTION 5(3)

48) Section 5(3)⁸ of the Act reads:

“5-(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

49) In order to succeed under this ground the earlier mark must have a reputation. In *General Motors Corp v Yplon SA* (Chevy) [1999] ETMR 122 and [2000] RPC 572 Chevy the CJEU stated:

⁸ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“Addidas-Salomon”) (C-408/01)).

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

50) I have little hesitation in concluding that RIM’s BLACKBERRY mark possessed the requisite reputation at the material date. Indeed, it had a particularly strong reputation.

51) In addition to having a reputation, a link must be made between the respective marks. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors relevant to the circumstances of the case (see, in respect of the likelihood of confusion, *SABEL*, paragraph 22, and *Marca Mode*, paragraph 40).”

52) In *Intel Corporation Inc v CPM (UK) Ltd* (C-252-07) (“*Intel*”), the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...”

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

53) Although one of the above factors is whether there exists a likelihood of confusion, this is not a prerequisite. Whether a link will be made can vary between the goods. I firstly consider the position in respect of mobile phones and PDAs. This represents RIM's strongest position in terms of both the establishment of a link, and whether one of the forms of damage will arise. RIM's reputation is strong and the goods identical or highly similar. The marks' similarity (as assessed earlier) needs to be borne in mind, together with their different concepts. Despite the differences between the marks, I come to the conclusion that a link is likely to be made. The BLACKRUBY mark will bring to mind BLACKBERRY. The link, although made, is not the strongest of possible links. Whilst over 50% of the survey participants got to BLACKBERRY (be it after question 1 or question 5), this was only following a speculative question.

54) The link must, though, lead to one of the heads of damage set out in section 5(3). The primary claim is made on the basis of the taking, without due cause, of an unfair advantage (often referred to as "free-riding"). In Case C-487/07, *L'Oreal SA and others v Bellure NV* ("Bellure") and *others* ("Bellure") the CJEU defined what is meant by "unfair advantage":

"41 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation.

50 In the light of the above, the answer to the fifth question is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the taking of unfair advantage of the distinctive character or the repute of a mark, within the meaning of that provision, does not require that there be a likelihood of confusion or a likelihood of detriment to the distinctive character or the repute of the mark or, more generally, to its proprietor. The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of the mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

55) RIM must establish not only that there would be an advantage, but also that it is unfairly taken. It is to be noted that the CJEU refers to the third party seeking to take advantage, i.e. a conscious decision being made. The question of the

unfair aspect was considered by Lloyd LJ in *Whirlpool Corporations and others v Kenwood Limited* [2009] EWCA Civ 753:

"136. I do not consider that Kenwood's design involves anything like a transfer of the image of the KitchenAid mark, or of the characteristics which it projects, to the goods identified by Kenwood's sign (see *L'Oréal v Bellure* paragraph 41). Of course, as a newcomer in a specialist market of which KitchenAid had a monopoly, and being (necessarily) in the basic C-shape of a stand mixer, the kMix would remind relevant average consumers, who are design-aware, of the KitchenAid Artisan. That, however, is a very different phenomenon, in very different commercial circumstances, from the situation considered in *L'Oréal v Bellure*. I find the Court's judgment instructive, but it does not seem to me to lead to the conclusion in favour of Whirlpool for which Mr Mellor contends. On the contrary, having rejected his radical submission that the word "unfair" could just as well have been left out of the article, it seems to me that the decision points away from, rather than towards, liability under the article on the facts of the present case. It is not sufficient to show (even if Whirlpool could) that Kenwood has obtained an advantage. There must be an added factor of some kind for that advantage to be categorised as unfair. It may be that, in a case in which advantage can be proved, the unfairness of that advantage can be demonstrated by something other than intention, which was what was shown in *L'Oréal v Bellure*. No additional factor has been identified in this case other than intention."

56) This matter was also considered by Mann J in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch):

"160. Thus something more than mere advantage is required. It must be an unfair advantage. Lloyd LJ seems to state that an advantage is rendered unfair if it is intended. He also leaves open the possibility that unintended advantage may have a sufficient quality of unfairness about it to qualify."

57) The primary concern I have relates to what advantage LG is gaining. Mr Malynicz referred to the evidence of a number of the survey participants. As can be seen from the table in the annex to this decision, a number of comments were made along the lines of BLACKRUBY being a "dodgy Japanese Knock-off", that LG might "...obtain some of the Kudos of Blackberry", that it is a "mimic Blackberry", that it might "get some advantage from this" and that "competitors are always trying to rip off people's product to make money from them..". Similar comments can also be seen in the survey results themselves. However, as stated earlier, I place little weight on this evidence due to the manner in which it was obtained. To exemplify my concern, it seems to me that if someone is asked a question encouraging them to speculate as to the intentions of the undertaking responsible for BLACKRUBY, particularly when this follows discussions about the

similarity of that mark to BLACKBERRY, the person is likely to believe that there must be some form of intention or plan behind such similarity. It is not therefore surprising that the witnesses speculated in the way that they did. I have serious reservations that this is representative of normal consumer reactions when BLACKRUBY is encountered. The barometer that Mr Malynicz referred to is not, therefore, in play. The *Bellure* case talks of benefitting from the “power of attraction, the reputation and the prestige” of the mark with a reputation. I do not see in the case before me why such benefit will be taken. Even if an average consumer brings BLACKBERRY to mind then the view likely to be taken is that this is a rival product the name of which has similarities to an established brand. It is not safe to infer that the consumer will consider that the BLACKRUBY product has the same qualities or characteristics of a BLACKBERRY or that it will benefit from some other form of reputation transfer. I do not see why a consumer would be attracted to BLACKBURY or be more likely to buy it; the type of goods in question will not ordinarily be purchased on a whim. As such, LG is not benefitting from RIM’s reputation or marketing initiatives. There is, therefore, no advantage, let alone unfair advantage.

58) The position is even weaker in relation to the other heads of damage. In relation to dilution, there is no reason why the BLACKBERRY mark will be any less distinctive of RIM. It would still be capable of arousing immediate association with RIM regardless of whether BLACKRUBY is used or not. In relation to tarnishing, no evidence, or even real arguments have been put forward here. **The ground of opposition under section 5(3) is dismissed.** As indicated earlier, I do not consider RIM to be in any better position in respect of the other goods it opposes so the ground also fails in respect of them.

SECTION 3(6)

59) Mr Guibert’s witness statement contains a section headed bad faith. He refers to a wider dispute that exists between LG and RIM. He refers to a number of applications that LG has made which he says amounts to a pattern of behavior designed to cause unnecessary commercial nuisance to RIM, to undermine its business and trade mark portfolio and, more specifically, to erode RIM’s distinctiveness and/or to take unfair advantage of RIM’s reputation and goodwill. He further states that LG may not have an intention to use the mark applied for.

60) The marks highlighted are, in Australia: Black Jewel, Black Jewelry, Black Ruby, PearlRing, Shine Black Label Series, Black Label, Black Label Series, Black Label, Chocolate Black Label Series; as CTMs: Shine Black Label Series, PearlRing; in the US: Black Jewelry, Black Jewelry, Black Pearl, Black Ruby, Chocolate Black Label Series, PearlRing, Shine Black Label Series, Black Label; in the UK: Black Jewel, Blackruby, BIM.

61) The above evidence is not compelling. The claim strikes me as nothing more than conjecture. I have already found that the BLACKRUBY mark will not cause

confusion or be detrimental to RIM. In view of this, the marks referred to above (particularly those that feature the word BLACK plus some other designation) can hardly be said to be causing commercial nuisance or taking advantage of RIM's reputation; they cannot therefore establish that there is such a pattern of behavior. Other marks (beyond those based on the word BLACK) are, of course, referred to by Mr Guibert. They will need to be determined by the relevant jurisdiction on their own merits. There are further problems with Mr Guibert's evidence on this given that no evidence is provided as to when such marks were filed, what the goods were etc. Mr Malynicz argued that the evidence leads to a reasonable inference that LG have no intention to use the mark and that in the absence of any evidence from LG as to its intentions the ground is made out. I disagree. This is mere conjecture and does not present a reasonable inference that there was no intention to use. **The ground under section 3(6) is dismissed. The opposition as a whole is rejected.**

COSTS

62) LG has been successful and is entitled to a contribution towards its costs. I hereby order Research in Motion Limited to pay LG Electronics the sum of £2300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£500

Considering RIM's evidence
£1000⁹

Attending the hearing
£800

63) The above sum should 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 2nd day of February 2012

**Oliver Morris
For the Registrar,
The Comptroller-General**

⁹ Even though LG filed no evidence, it still had to consider RIM's evidence, a lot of which was unnecessary.

Annex

| Witness | Summary |
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| Mrs Statham | Mrs Statham referred to BLACKBERRY in response to question 1. She said it was similar (to BLACKRUBY) and that “you miss out the middle bits of the word”. She provided further clarification in her witness statement, again referring to the beginnings and ends of the marks and, also, that the length and shape of the words are similar. She says that if BLACKRUBY were used on similar products to BLACKBERRY this would have been done so as to get people to misconstrue it or associate it with BLACKBERRY. She believes that people might be confused. She adds that if the BLACKRUBY product was a cheap item then this may not impact upon BLACKBERRY (in the same way that cheap Rolex watches have no impact on the Rolex brand), but if the items were not cheaper then people might be drawn in and this might have an impact of BLACKBERRY. |
| Theresa Hawksworth | Ms Hawksworth referred to BLACKBERRY in response to question 5 (so she had to be prompted towards electronic devices). The reference was made because both contain the word BLACK. In further clarification, she says that if BLACKRUBY was used on an electrical device people would think the products were linked to BLACKBERRY and they were made by the same person. |
| Gilly Staley | Ms Staley thought of cosmetic products in response to question 1 but in response to question 2 she said “either that” (a reference presumably to question 1) or that somebody could not spell BLACKBERRY. She said that when you first look at it you think it says BLACKBERRY and that you almost have to look twice. In further clarification, Ms Staley said that it was a word that looked like BLACKBERRY, like a visual trick. She thought it daft that someone couldn’t spell BLACKBERRY or that someone would choose a name so close to a well-known brand. She adds that she would think it was some form of cheap Japanese knock-off and that it was a bit cheeky. She says she would look to see if it were made by BLACKBERRY. If it were not then she would not be impressed and that they should have been more inventive. She says that BLACKRUBY would be used to get people to notice it. She does not know if this would be detrimental. She says that some people would think it was a Blackberry, but most wouldn’t. |
| Sandra Borland | Ms Borland answered “none at all” to question 1, but in follow up said that at first she thought it was BLACKBERRY but then realized it wasn’t. In further clarification she says that the reason for her initial view was due to the common element black. She refers to the possible motives of BLACKRUBY, suggesting that they may be attempting to gain some kudos from BLACKBERRY. She says that some consumers may be confused by this. She says that some people may buy a BLACKRUBY thinking it was the same as a BLACKBERRY and if they were expecting a BLACKBERRY or something of the same quality, and it was not, this would be likely to have an adverse effect on the BLACKBERRY brand. |

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| Mr Gallop | In response to question 1 Mr Gallop said “it’s spelt wrong but it’s going to be BLACKBERRY”. He said so because he works in the relevant industry and because of common sense. In further clarification he highlights the running together of the two words in the marks. He refers to the BLACKBERRY PEARL device and thought BLACKRUBY may be a misprint of this. He says that he assumed BLACKRUBY was going to be a product from BLACKBERRY, he believes that this must have been done to make a connection which could mislead uninformed people. He states that the BLACKRUBY brand may have been chosen to jump on the bandwagon. He says that people may think they are buying a BLACKBERRY. |
| Joanne Spencer-Hewitt | Ms Spencer-Hewitt answered BLACKBERRY to question 1 because “it looks like it says it”. In further clarification she says that she thought it had the word BLACKBERYY on it and she only noticed the difference on closer inspection (after the interviewer highlighted it). She says that the name may have been chosen to get people to buy it, thinking it was a BLACKBERRY. She says that after being informed that BLACKRUBY was not a BLACKBERRY product she was not surprised because people try to con others who are not very observant. |
| Darren Jones | Mr Jones answered BLACKBERRY to question 1 because he uses one at work and because of “word association”. In clarification, he says that he originally thought it said BLACKBERRY and “it was word recognition”. He says that if you say BLACKRUBY quickly it sounds like BLACKBERRY and makes you think of Blackberry. He says that there could be some confusion as it is playing on the BLACKBERRY name. |
| Peter Riley | Mr Riley answered question 1 by saying that it sounds like BLACKBERRY. In further clarification he states that there is little difference between them, they look and sound alike. In particular they start with the word BLACK, end in Y and have an R in them. He states that the name was probably chosen to mimic BLACKBERRY and could provide an advantage. If it were a better machine, then this could have a serious effect on BLACKBERRY. |
| William Currie | Mr Currie only got to BLACKBERRY via question 5 because it sounds similar and is all one word. He refers to the common word BLACK and that RUBY and BERRY sound similar. He says that people may think that BLACKBERRY have released a new product and people may be tempted to buy on account of this. |
| Dr Brown | In response to question 5 Dr Brown referred to a pocket organizer because BLACKRUBY sounds a bit like BLACKBERRY, which does exist. He adds in clarification that his view was based on the common element BLACK and because BLACKBERRY is well known. He says it may have been chosen to give the impression that BLACKRUBY was part of the same family as BLACKBERRY. He says that people could be confused and will think both devices are from the same people and BLACKBERRY may lose sales. |
| Ele Hunt | Ms Hunt only got to BLACKRUBY following question 5 because it sounds like BLACKBERRY. In clarification she says that she put two and two together and came up with the answer. She says the words were very similar. She says BLACKRUBY may be a copy of the BLACKBERRY. She says that |

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| | competitors often make similar products with similar names to copy their competitors' products. |
| Deb Rindl | Ms Rindl only got to BLACKRUBY following question 5 because it is similar to BLACKBERRY. In clarification she says that the word BLACK is common and that RUBY is very similar to BERRY with the B and R swapped around and when said aloud they sound the same. She says that BLACKRUBY may have been chosen in the hope of confusing people but she doesn't know whether people will be confused. She says that people would see it as a rip-off product but that this would not harm BLACKBERRY. Ms Rindle, nevertheless, expresses surprise that BLACKRUBY did not refer to a BLACKBERRY product because they are too close. |
| Mark Grant | Mr Grant answered BLACKBERRY to question 1 because it reminded him of it. In clarification, he says that the names are similar because when you read things at speed you don't take in the detail and BLACKBERRY was the first thing that came to mind. He says that the name may have been chosen to get cheap marketing. He says this may not reflect well on BLACKBERRY, it may look like a printing error. He says that if used on the same goods they could lose sales. |
| Samantha Round | Ms Round only got to BLACKRUBY following question 5 because it reminded her of BLACKBERRY. In clarification she confirmed this, adding that they sounded similar and it made her think of it. She says that people could be confused into believing that it was the same product from the same person. |
| Amrit Singh | Mr Singh answered question 1 by referring to a telephone because BLACKBERRY is a telephone. He says that the names are too similar and that people would think that BLACKRUBY is associated with the BLACKBERRY phone. It should be noted that Mr Singh is aware of the BLACKBERRY PEARL device because his initial recollection when contacted again was that the name on the card read BLACKBERRY PEARL. |
| Kevin Strauther | Mr Strauther answered question 5 by referring to a "lap top brand" because it sounds like some form of IT product, like the BLACKBERRY. He says, in clarification, that they sound similar because of the common word BLACK. He adds that the mark may have been chosen because competitors are always trying to rip-off other people's products to make money from them. |
| Mr D Hughes | Mr Hughes referred to BLACKBERRY in response to question 1 because at first he did not read it correctly. In clarification, he adds that they look very similar both starting with BLACK and ending in Y and that they sound similar when spoken out loud. He says that the name may have been chosen to influence people into thinking the product is a BLACKBERRY or that they are associated. He says this could harm BLACKBERRY because if there are problems they might think the problem is with BLACKBERRY. |
| Adam Lewis | Mr Lewis answered BLACKBERRY to question 1 because it looks like it. He says that he came to this view because it is the only product that sounded similar to BLACKRUBY. He adds that he would assume it was a technology based product and that people would associate it with a BLACKBERRY. |
| Mr K McGinn | In response to question 5, Mr McGinn stated that BLACKRUBY may possibly be a new BLACKBERRY phone because of the same number of syllables and |

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| | <p>because it starts with the words BLACK. He adds, in clarification, that they have a similar feel and is only a short stretch from ruby to berries (which are both red). He assumed that BLACKRUBY was another product from BLACKBERRY with new functions, possibly a more prestigious version. He says that BLACKBERRY may suffer through a loss of sales because people are often not astute to notice small differences. He says it would be easy for the public to think that they were sister companies.</p> |
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