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THE TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Research In Motion Limited  
v.  
Fashionberry, Inc.

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Opposition No. 91191572

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William R. Towns and Jeffrey J. Morgan of Novak Druce + Quigg LLP  
for Research In Motion Limited.

Fashionberry, Inc., pro se.

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Before Bucher, Holtzman and Mermelstein, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Fashionberry, Inc. (applicant) has filed an application to  
register the mark shown below for "providing online non-  
downloadable magazines in the field of fashion design and fashion  
trends" in Class 41:<sup>1</sup>

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<sup>1</sup> Application Serial No. 77580530, filed September 27, 2008, based on  
an allegation of first use on August 1, 2008 and first use in commerce  
on September 1, 2008. The application contains the following color  
statement and description of the mark: "The color(s) light blue (RGB  
96/175/221) dark blue (RGB 16/9/86) grey (RGB 159/159/159) is/are  
claimed as a feature of the mark"; "The mark consists of the complete  
one word 'FASHIONBERRY' in the font style known as smart frocks and  
using the color light blue with a stylized earring loop with a dark  
blue berry on one end."



Research In Motion Limited (opposer) filed a notice of opposition on the ground of likelihood of confusion.<sup>2</sup> Opposer alleges that that it has used and registered the mark BLACKBERRY in connection with handheld electronic devices, including smart phones and related goods and services "as well as promotional and collateral goods"; that the BLACKBERRY mark "is famous in connection with such goods and services"; and that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered marks as to be likely to cause confusion. Opposer has identified various registrations for "BLACKBERRY" marks in its notice of opposition, including Registration Nos. 2402763, 2672464, 2700671, 2844340, 2842571 3098588 and 3102687.

Applicant's answer, in effect, denies the salient allegations of the notice of opposition.<sup>3</sup>

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<sup>2</sup> Opposer's pleaded claim of dilution was neither tried nor argued and it is therefore considered waived.

<sup>3</sup> Applicant's answer is more in the nature of argument than an answer, and does not specifically admit or deny opposer's allegations. Nevertheless, applicant's arguments indicate that applicant does not admit any of the allegations, but rather indicate a good faith attempt to dispute the allegations. We therefore construe applicant's answer as an effective denial of the allegations in the notice of opposition. We also note that this results in no prejudice to opposer inasmuch as opposer in its brief has not relied on any asserted admissions in the answer.

The record includes the pleadings; the file of the involved application; and opposer's notices of reliance on its 2010 Annual Report obtained from the Internet showing the URL and date of publication; TARR printouts of a number of opposer's pleaded registrations for its BLACKBERRY marks;<sup>4</sup> and printouts from applicant's website (fashionberry.com) and opposer's website (blackberry.com), showing the URL and the date they were accessed and printed.

Applicant did not take any testimony or offer any other evidence in its own behalf. Only opposer filed a brief.

#### STANDING AND PRIORITY

The TARR records submitted by opposer show that opposer is the owner of the following currently subsisting registrations:<sup>5</sup>

Registration No. 2672464 for the typed mark **BLACKBERRY** for "electronic handheld units for the wireless receipt and/or transmission of data, that enable the user to keep track of or manage personal information; software for the redirection of messages, global computer network e-mail, and/or other data to one or more electronic handheld units from a data store on or associated with a personal computer or a server; and software for the

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<sup>4</sup> Although opposer also alleged that it has used and registered marks other than BLACKBERRY that incorporate the suffix -BERRY, opposer submitted no evidence or argument on this point and we give it no further consideration.

<sup>5</sup> Office records show that subsequent to the filing of opposer's notice of reliance, two of the registrations opposer made of record, Registration Nos. 2402763 and 2842571, were cancelled on June 10, 2011 and December 24, 2010, respectively, for failure to file Section 8 affidavits. When a registration owned by a party has been properly made of record, and the status of the registration changes between the time it was made of record and the time the case is decided, the Board will take judicial notice of the current status of the registration, as shown by the records of the Office. See TBMP §704.03(b)(1)(A) (3d ed. 2011). Accordingly, the cancelled registrations have not been considered.

synchronization of data between a remote station or unit and a fixed or remote station or unit" in Class 9.<sup>6</sup>

Registration No. 2700671 for the typed mark **BLACKERRY** for "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" in Class 38.<sup>7</sup>

Registration No. 2844340 for the typed mark **BLACKBERRY** for "electronic handheld units for the wireless receipt and/or transmission of data that enable the user to keep track of or manage personal information 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 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 two-way wireless connectivity to data, including corporate data" in Class 9; "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; consultation on the topics of developing and integrating one-way or two-way wireless connectivity to data, including corporate data, and/or communications" in Class 38; and "educational services, namely, classes, seminars and conferences for the purpose 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 voice communications" in Class 41.<sup>8</sup>

Registration No. 3098588 for the standard character mark **BLACKBERRY CONNECTION** for "newsletter relating to internet e-mail services and wireless data


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<sup>6</sup> Issued January 7, 2003; Section 8 affidavit accepted.

<sup>7</sup> Issued March 25, 2003; Section 8 affidavit accepted.

<sup>8</sup> Issued May 25, 2004; combined Sections 8 and 15 affidavit accepted and acknowledged.

messaging services and voice communication services and technical support services for hardware and software for wireless data network services and voice communication services" in Class 16.<sup>9</sup>

Registration No. 3102687 for the mark  **BlackBerry** for "electronic handheld units and accessories therefore, namely, batteries, cases, battery chargers, holsters and antennas, for the wireless receipt and/or transmission of data and which may also have the capability to transmit and receive voice communications, namely handheld computers and personal digital assistants; computer communications software for the transmission and/or reception of messages, global computer network e-mail, and/or other data between one or more electronic handheld units and a data store on or associated with a personal computer or a server; computer communication software for the synchronization of data between a remote station or unit and a fixed or remote station or unit and software which enables and provides one-way and/or two-way wireless connectivity to data, including corporate data" in Class 9; "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" in Class 38; and "consulting and educational services namely, classes, seminars and conferences for the purpose 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" in Class 41.<sup>10</sup>

Having properly made its registrations of record, opposer's standing has been established, and its priority with respect to the registered marks for the goods and services identified therein is not in issue. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

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<sup>9</sup> Issued May 30, 2006.

<sup>10</sup> Issued June 13, 2006.

**LIKELIHOOD OF CONFUSION**

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and the differences in the marks."). We discuss the relevant *du Pont* factors below.

**Fame of Opposer's Mark**

Opposer argues that through its "longtime use" of the BLACKBERRY mark since 1999 and "[a]s a consequence of the significant sales, world-wide user base and extensive promotion and advertising" of its BLACKBERRY mark, the mark "has become famous and well known." Br., pp. 6-7.

The fame of a mark, if it exists, "plays a 'dominant role' in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Because of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it

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receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of a party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

Opposer has submitted no evidence establishing the fame or recognition of its BLACKBERRY mark. Opposer has relied on its annual report to show financial and other information concerning the sale of its goods and services under the mark. However, the statements contained in the annual report are hearsay, and not admissible for opposer's purpose. The annual report is of record only for what it shows on its face; it is not admissible for the truth of any matters stated therein, such as opposer's sales figures. See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 at n. 5 (TTAB 1989) (annual report in evidence only for what it showed on its face), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007) (materials made of record by notice of reliance under 37 CFR §2.122(e) not admissible for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters).

Opposer may rely on its registrations to prove its mark has been in use as of the filing date of the underlying applications, the earliest of which issued from an application filed in December 1998. However, this is not an extraordinary length of time, and in any event, long use and/or registration of a mark,

without evidence of the extent of consumer exposure to or recognition of the mark over the years, is not sufficient to prove fame or to demonstrate any degree of recognition and strength in the market.

**Similarity/Dissimilarity of the Goods/Services**

Opposer contends that applicant's services of "providing online non-downloadable magazines in the field of fashion design and fashion trends" are "highly related" to the goods and services identified in opposer's registrations. Opposer focuses, in particular, on the following goods and services set forth, for example, in Registration No. 2844340:

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 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 fixed or remote station or unit and software which enables and provides one-way and two-way wireless connectivity to data, including corporate data; and

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; consultation on the topics of developing and integrating one-way or two-way wireless connectivity to data, including corporate data, and/or communications.

In support of its contention that the respective goods and/or services are "highly related," opposer argues that its



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wireless communications devices include smartphones; that such goods, as well as the services of opposer, are related to applicant's services "as they are related to content that is commonly provided via wireless communication devices and software"; that content provided by applicant's online non-downloadable magazines in the field of fashion "is commonly accessed through wireless devices such as BLACKBERRY smartphones"; and that users of applicant's services "will access the online content" through opposer's smartphones. Br., pp. 8-9. Opposer points to the printout from its website, titled "BlackBerry App World," which shows, as described by opposer, "a wide variety of wireless applications for download," including applications with fashion content. Id., p. 8.

Opposer's website, like its annual report, is only of record for what it shows on its face, namely that the content appeared and the public was exposed to that content. To the extent that opposer is relying on the website for the truth of its contents, e.g., as evidence that opposer's goods are smartphones, or that opposer is actually using its mark on any goods or services displayed on the website, the website is hearsay and not admissible for that purpose. Even if we accept that opposer's goods, as identified, include "smartphones" and opposer's unsupported assertions regarding content that is "commonly provided" for download to those devices, the evidence is insufficient to establish whether a relationship exists between

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opposer's goods and applicant's services. As identified, applicant is offering services in the nature of non-downloadable online magazines, not software or an application for download on a mobile device. The goods and services are specifically different, and based on this record, any relationship between them is tenuous at best. There is no evidence that applicant's services are complementary in use or function to opposer's smartphones, or that the goods and services are of a type that purchasers would expect to emanate from, or be associated with, the same source. The fact that the goods and services in some broad sense may all be "related to content" is clearly not a sufficient basis, in and of itself, for a finding that the goods and services are related. See, e.g., *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1310 (Fed. Cir. 2002) ("broad general market category is not a generally reliable test of relatedness of products"). Furthermore, inasmuch as virtually all goods and services are accessible online, we could hardly find that applicant's online magazine services are related to opposer's smartphones simply because those services can be accessed through a smartphone.

As for opposer's email and other services, there is no evidence to even suggest that these services and online non-downloadable magazine services would be associated with a common source. We also have no evidence that consumers are

likely to encounter these services in such a manner that they would assume that there is a relationship between their sources.


**Channels of Trade/Conditions of Purchase**

In the absence of any restrictions or limitations in the application and registrations, we must assume that opposer's wireless devices and applicant's online magazine services are sold through all the normal and usual trade channels for such goods and services to all the usual purchasers of such goods and services. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

Applicant's services are obviously provided over the Internet. There is no evidence of record showing how opposer's goods or its services are marketed or sold. In any event, "the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade." *Parfums de Coeur Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007).

Further, while we can assume that the usual purchasers for smartphones and online non-downloadable magazine services would include ordinary consumers, we have no evidence as to the cost of opposer's smartphones or the degree of care consumers would exercise in purchasing them.

**Similarity or Dissimilarity Between the Marks**

We turn to a comparison of applicant's mark  with the closest of opposer's marks, the typed mark BLACKBERRY.

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We note at the outset that similarity is not an absolute matter but instead is a matter of degree. See *In re Coors Brewing Co.*, 68 USPQ2d 1059 (Fed. Cir. 2003). When goods and/or services are highly related, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Shen Manufacturing Co., Inc. v. The Ritz Hotel Limited*, 393 F.3d 1238, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004). Conversely, when goods and/or services are not highly related, and opposer has not shown that they are in this case, a greater degree of similarity in the marks is required to support a finding of likelihood of confusion. Nor has opposer shown that its mark is famous. The fame of a mark would magnify the significance of the similarities between the marks which are compared. See *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 181 (1992).

In determining the similarity or dissimilarity of marks, we must consider the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Opposer's mark BLACKBERRY and applicant's mark FASHIONBERRY (and design) are similar to the extent that they share the suffix BERRY. However, the mere fact that applicant's mark incorporates a component of opposer's mark does not in itself compel a finding that the two marks are confusingly similar. The first words in

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these marks, BLACK and FASHION, which contribute significantly to the overall impressions of the marks, look and sound nothing alike. We have considered that opposer's mark, registered in typed form, could reasonably be displayed in the same stylized format as applicant's mark thereby increasing the visual similarity of the two marks. See, e.g., Citigroup Inc. v. Capital City Bank Group Inc., 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011). However, the word portions of these marks would still make a strong visual impact, apart from the stylization, and their differences would be readily apparent.

Furthermore, the words BLACK and FASHION, respectively combined with BERRY, cause the marks as a whole to differ substantially in meaning and to create different, unitary commercial impressions. BLACKBERRY is a familiar word with a recognized meaning as a type of fruit. FASHIONBERRY, in contrast, is an unfamiliar term with no recognized meaning. Although applicant's mark contains the word "berry", and perhaps conveys the idea of a "berry," in the context of applicant's mark and services, that word incongruously suggests some connection to "fashion" or something fashionable, an impression totally absent from the mark BLACKBERRY. The design element in applicant's mark, whether perceived as a "berry" earring or simply a "berry," does not bring applicant's mark closer to opposer's mark, as opposer contends; rather it merely adds to the overall "fashion" image conveyed by the words in applicant's mark.

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To the extent that the marks have some similarities due to the presence of the word "BERRY" in both marks, we find that the differences between the marks as a whole are more significant and clearly outweigh those similarities, particularly when we consider the differences between the parties' respective goods and services.

We recognize that opposer's mark is arbitrary as applied to opposer's goods and services and it is therefore entitled to a broader scope of protection than a less distinctive mark. However, the scope of protection cannot extend so far as to prevent registration of applicant's dissimilar mark for essentially dissimilar services.

**Conclusion**

Opposer, as plaintiff in this proceeding, bears the burden of going forward with sufficient proof of the material allegations of the notice of opposition. See *Sanyo Watch Co. v. Sanyo Elec. Co.*, 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982); *Clinton Detergent Co. v. Proctor & Gamble Co.*, 302 F.2d 745, 133 USPQ 520, 522 (CCPA 1962) ("Opposer...has the burden of proof to establish that applicant does not have the right to register its mark."). In this case opposer has not met that burden. We find, on this record, that in view of the cumulative differences in the marks and the respective goods and services, a likelihood of confusion does not exist.

**Decision:** The opposition is dismissed.