



RESEARCH IN MOTION LIMITED,  
Opposer,

-versus-

HONG JIA YING,  
Respondent-Applicant.

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} IPC No. 14-2011-00383  
}  
} Opposition to:  
} Appln. Serial No. 4-2010-011504  
} Date Filed: 20 October 2010  
} TM: "CASTER BERRY"  
}  
}  
}  
}

**NOTICE OF DECISION**

**FEDERIS & ASSOCIATES LAW OFFICES**  
Counsel for the Opposer  
2005 88 Corporate Center  
141 Valero cor. Sedenos Sts.,  
Salcedo Village, Makati City


**CORDOVA & ASSOCIATES**  
Counsel for the Respondent-Applicant  
2801, 28<sup>th</sup> Floor, Ayala FGU Center  
6811 Ayala Avenue, Makati City

**GREETINGS:**

Please be informed that Decision No. 2013 - 103 dated June 18, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, June 18, 2013.

For the Director:

  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



**RESEARCH IN MOTION LIMITED,**  
*Opposer,*

**IPC No. 14-2011-00383**  
Case Filed: 09 August 2011

-versus-

Opposition to:  
Appln. Serial No. 4-2010-011504  
Date Filed: 20 October 2010

**HONG JIA YING,**  
*Respondent-Applicant.*

**TM: "CASTER BERRY"**

x-----x

**Decision No. 2013- 103**

### DECISION

RESEARCH IN MOTION LIMITED ("Opposer")<sup>1</sup> filed an opposition on 09 August 2011 to Trademark Application Serial No. 4-2010-011504. The application filed by HONG JIA YING ("Respondent-Applicant")<sup>2</sup>, covers the mark "CASTER BERRY" for use on " cellphone case, wallets, bags, throw pillows, bed sheets, curtains, blankets, table runners, pillow case, men's polo, jackets, t-shirts, blouse, skirts, pants and shorts" under Classes 9, 18, 20, 24 and 25 of the International Classification of Goods and Services<sup>3</sup>.

The Opposer anchors its opposition on the ground that "CASTER BERRY" is confusingly similar to its well-known and registered mark in the Philippines "BLACKBERRY". In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" – Affidavit of Jan Abigail L. Ponce;
2. Exhibit "B" – Special Power of Attorney;
3. Exhibit "C" to "C-12" – Certified copies of Philippine trademark applications and registrations;
4. Exhibit "D" – Witness Statement of Barnes Lam, Director of Marketing for Asia Pacific of Research in Motion Limited;
5. Exhibit "E" – Annual Reports of research in Motion Limited;
6. Exhibit "F" – Printout of the [www.shopblackberry.com](http://www.shopblackberry.com) website;
7. Exhibit "G" to "G-47" – Certified true copies of Opposer's trademark registration and applications in other countries;
8. Exhibit "H" – Printout of Opposer's database showing trademark registrations and applications worldwide for BLACKBERRY and other variations thereof;

<sup>1</sup> A foreign corporation organized and existing under the laws of Canada, with principal office address at 295 Phillip Street, Waterloo, Ontario Canada N2L 3W8.

<sup>2</sup> With address of record at 436-438 Elcano Street, San Nicolas, Binondo, Manila.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

9. Exhibit "I" – Opposition filed by Research In Motion Limited filed against the trademark application for BURBERRY in Class 9 in Brazil;
10. Exhibit "J" – Affidavit of Jan Abigail L. Ponce;
11. Exhibit "K" – Special Power of Attorney;
12. Exhibits "L" to "L-9" – Philippine Certificates of Trademark Registrations and Applications for BLACKBERRY and variations thereof;
13. Exhibit "M" – Certified true copy of Affidavit of Mark Guibert dated 04 February 2009;
14. Exhibit "N" – Certified true copy of the Articles of Amalgamation of Opposer;
15. Exhibit "O" – Certified true copy of the 2008 Brandz Report;
16. Exhibit "P" – Certified true copy of the press release relating to RIM's BLACKBERRY ranking in the Brandz Report for 2008;
17. Exhibit "Q" – Certified true copy of the Financial Times Special Report;
18. Exhibit "R" – Certified true copy of the Business Week/Interbrand Release of 2008 ranking BLACKBERRY as no. 73 with a brand value of US\$4,575,000,000;
19. Exhibits "S" to "S-43" – Certified true copies of some of Opposer's certificates of trademark registrations in various jurisdictions worldwide;
20. Exhibit "T" – Certified true copy of the press release concerning the Philippine launch of BLACKBERRY in 2003;
21. Exhibits "U" to "U-4" – Certified true copies of the Annual Reports of Opposer for the years 2004 to 2008;
22. Exhibit "V" – Certified true copies of Opposer's and BLACKBERRY's tv commercials aired in numerous tv channels worldwide;
23. Exhibits "W" to "W-4" – Certified true copies of celebrities endorsing BLACKBERRY;
24. Exhibits "X" to "X-6" – Certified true copies of advertisements and articles in newspapers and magazines available also in the Philippines featuring BLACKBERRY;
25. Exhibits "Y" to "Y-7" – Printouts of press releases taken from Opposer's website from 2001 to 2008;
26. Exhibits "Z" to "Z-14" – Printouts of websites showing extensive promotion, advertising, sale and distribution of Opposer's products bearing the "BLACKBERRY" mark;
27. Exhibits "AA" to "AA-3" – Printout of Opposer's websites;
28. Exhibits "BB" to "BB-8" – WIPO Decisions declaring that Opposer's BLACKBERRY is internationally well-known; and
29. Exhibits "CC" to "DD" – Printouts from the internet which show Filipino celebrities using, and endorsing Blackberry phones.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 21 September 2011. The Respondent-Applicant however, did not file an Answer. Accordingly, the Hearing Officer issued Order No. 2012-86 dated 12 January 2012 declaring the Respondent-Applicant in default and the case deemed submitted for decision based on the opposition, the affidavit of the witnesses and documentary evidence submitted by the Opposer.

Should the Respondent-Applicant trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his products<sup>4</sup>.

Records show that at the time the Respondent-Applicant filed the Trademark Application Serial No. 4-2010-011504, the Opposer already has numerous trademark registrations and applications in the Philippines for BLACKBERRY and variations thereof, to wit: <sup>5</sup>

1. Reg. No. : 4-2005-003824  
Issued On : 08 June 2006  
Mark : BLACKBERRY BBB DESIGN (above Blackberry)  
Class : 9, 38 and 41
  
2. Reg. No. : 4-2005-003825  
Issued On : 08 June 2006  
Mark : BLACKBERRY BBBB DESIGN (left & Blackberry)  
Class : 9, 38 and 41
  
3. Reg. No. : 4-2002-009141  
Issued On : 17 July 2005  
Mark : BLACKBERRY & ENVELOPE DESIGN  
Class : 9, 38 and 41
  
4. Application No. : 4-2007-610758  
Filed On : 26 September 2007  
Mark : BLACKBERRY CURVE  
Class : 9, 35, 38, 41 and 42
  
5. Application No. : 4-2008-010639  
Filed On : 09 September 2008  
Mark : BLACKBERRY BOLD  
Class :
  
6. Application No. : 4-2008-009172  
Filed On : 30 July 2008  
Mark : BLACKBERRY STORM  
Class : 6, 9, 11, 16, 18, 20, 21, 25, 28, 35, 37, 38, 39, 41, 42 and  
45
  
7. Application No. : 4-2008-000650  
Filed On : 01 January 2008

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<sup>4</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

<sup>5</sup> Exhibits "C" to "C-12".

Mark : BLACKBERRY UNITE  
Class : 9 and 38

Also, the Opposer presented or submitted evidence of the extensive and worldwide registration, protection and promotion of its mark BLACKBERRY. In this regard, Rule 102 of the Trademark Regulations provides:

Rule 102. *Criteria for determining whether a Mark is Well-known.* In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion, of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is well-known mark.

Obviously, the Opposer has sufficiently established the presence or concurrence of the criteria or at least a combination thereof for the mark BLACKBERRY to be considered as a well-known mark under the aforecited rule.

Also, this Bureau notices that the goods covered by the Opposer's trademarks are similar and/or closely related to those indicated in the Respondent-Applicant's trademark application, like the cellular phone and even clothing or goods falling under Classes 9, 18, 20 and 35. But, would the Respondent-Applicant's registration and/or use of its mark cause confusion, mistake or deception?

In this regard, the mark applied for registration by the Respondent-Applicant bears close resemblance to the Opposer's mark as shown below:

# BLACKBERRY

# CASTER BERRY

## Opposer's Mark

## Respondent-Applicant's Mark

The competing marks are both composed of two words and the word common to the two is "BERRY" wherein, exactly the same in spelling and pronunciation as well as in meaning which means a fleshy fruit produced from a single ovary<sup>6</sup>. It is the part or component of the Opposer's registered marks, where the weight and/or strength is concentrated when pronounced. In other words, it is the focal point of attention is accumulated. Hence, the difference in the other portion of the competing marks, such variance is without any significance because the aural and visual similarity in the dominant feature is already sufficient to give rise to confusing similarity. Because the Respondent-Applicant will use or uses the mark it applied for registration on goods that are similar and/or closely related to those covered by the Opposer's registered mark, the slight distinction or variance did not diminish the likelihood of the occurrence of mistake, confusion or even deception cannot be avoided. Consumers will likely assume that the Respondent-Applicant's mark is just a variation of or related to the Opposer's, and/or the goods and services originate or provided by one party alone, or the parties themselves are connected or associated with one another which in fact there is none. The likelihood of confusion would subsist not only on the purchaser's perception of the goods but on the origins thereof as held by the Supreme Court:<sup>7</sup>

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

In *MARVEX COMMERCIAL CO. INC. v. PETRA HAWPIA & CO., and THE DIRECTOR OF PATENTS*<sup>8</sup>, the Supreme Court found confusing similarity between the marks in each pair, as follows:

1. Salonpas and Lionpas;
2. Gold Dust and Gold Drop;
3. Silver Flash and Supper Flash;
4. Cascarete and Celbarite;
5. Cellulaid and Cellonite;

<sup>6</sup> Wikipedia, the free encyclopedia.

<sup>7</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc. et.al.* G.R. No. L-27906, 08 Jan. 1987.

<sup>8</sup> 18 SCRA 1178.

6. Chartreuse and Charseurs;
7. Cutex and Cuticlean;
8. Hebe and Meje;
9. Kotex and Femetex; and
10. Zusu and Hoo Hoo.

The likelihood of confusion, mistake or deception is heightened by the fact that, as discussed above, the goods on which the competing marks are used are the same or closely related.

Thus, this Bureau finds that the subject trademark application is proscribed by Sec. 123.1 par. (d) and (e), of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

(d) is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services, or
- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

(e) is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark.

It is emphasized that the law on trademarks and tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourages fair trade in every way and aims to foster and jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another<sup>9</sup>. A "boundless" choice of words, phrases and symbols is available to one who wishes a trademark sufficient unto itself to distinguish his products from those of others. When, however, there is no reasonable explanation for the defendant's choice of such a mark through the field for his selection was so broad, the inference is inevitable that it was chosen deliberately to deceive<sup>10</sup>.

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<sup>9</sup> See *Baltimore v. Moses*, 182 and 229, 34 A (2d) 338.

<sup>10</sup> *Converse Rubber Corporation v. Universal Rubber Products, Inc.* G.R. No. L-27906 08 Jan. 1987.

**WHEREFORE**, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-011504 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 18 June 2013.



**ATTY. NATHANIEL S. AREVALO**  
*Director IV*  
*Bureau of Legal Affairs*

*/pausi/fo*