



RESEARCH IN MOTION LIMITED,
Opposer,

-versus-

BURBERRY LIMITED,
Respondent-Applicant.

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}
} IPC No. 14-2010-00160
} Opposition to:
} Application No.4-2009-500851
} Date filed: 12 November 2009
} TM: "BURBERRY"
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NOTICE OF DECISION

FEDERIS AND ASSOCIATES LAW OFFICES

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GREETINGS:

Please be informed that Decision No. 2015 - 230 dated October 28, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 28, 2015.

For the Director:


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



RESEARCH IN MOTION LIMITED, } IPC NO. 14-2010-00160
Opposer, } Opposition to:
-versus- }
} Appln. Ser. No. 4-2009-500851
} Date Filed: 12 November 2009
} Trademark: **BURBERRY**
BURBERRY LIMITED, }
Respondent-Applicant. }
x-----x } Decision No. 2015- 230

DECISION

RESEARCH IN MOTION LIMITED, (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2009-500851. The application, filed by **BURBERRY LIMITED** (Respondent-Applicant)², covers the mark “BURBERRY”, for use on “telephones, mobile telephones, mobile electronic devices, accessories for the telephones, mobile telephones and mobile electronic devices” under Class 9 of the International Classification of Goods³.

The Opposer based its opposition on the following grounds:

“a. The trademark ‘BURBERRY’ when used in connection with ‘telephones, mobile telephones, mobile electronic devices, accessories for the foregoing: cases and holders for telephones, mobile telephones and mobile electronic devices’ in Class 9, is confusingly similar to Opposer’s ‘BLACKBERRY’ trademark that is already registered in the Philippines under Class 9 and other Classes, and hence, the approval of the challenged TM Application will violate Opposer’s trademark rights under Section 123.1 (d) (i) (ii) (iii) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (‘IP Code’).

“b. Opposer’s ‘BLACKBERRY’ trademark is a well-known trademark in connection with goods in Class 9, and hence, the approval of the challenged TM Application will violate the rights of Opposer arising from Section 123.1 (e), and (f) of the IP Code.

“c. The use and registration of the ‘BURBERRY’ trademark for goods in Class 9, in the face of the nearly similar or confusingly similar ‘BLACKBERRY’

¹ A foreign corporation organized and existing under the laws of Canada, with address at 295 Philip Street, Waterloo, Ontario Canada N2L3W8.

² Horseferry House, Horseferry Road London SW1P2AW

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

trademark of Opposer, also in Class 9, will cause confusion, mistake and deception upon the consuming public particularly as to the true origin, nature, quality and characteristics of the herein parties' respective goods and businesses, under Section 123.1 (g) of the IP Code.

"d. The use and registration of the 'BURBERRY' trademark by Respondent-Applicant for 'telephones, mobile telephones, mobile electronic devices, accessories for the foregoing, cases and holders for telephones, mobile telephones and mobile electronic devices', without the consent of Opposer, who is the registered owner of the 'BLACKBERRY' trademark, will violate Section 147 of the IP Code.

"e. The approval of the subject TM Application will violate the proprietary rights and interests, business reputation and goodwill of the Opposer whose 'BLACKBERRY' trademark has long enjoyed unparalleled fame and patronage in the Philippines and in numerous countries worldwide, for products and goods under Class 9.

"f. The approval of the challenged TM Application will enable the Respondent-Applicant to unfairly profit from the goodwill, fame, notoriety of the trademark 'BLACKBERRY' on goods under Class 9, to the damage and prejudice of the Opposer herein, contrary to Section 168.1 of the IP Code.

"g. The word element 'BERRY' constitutes the dominant component in the Opposer's trademark 'BLACKBERRY', thus, the appropriation by Respondent-Applicant of the 'BURBERRY' for use with goods that directly compete with the goods of Opposer will effectively diminish the uniqueness and distinctiveness of Opposer's 'BLACKBERRY' trademark.

"h. Opposer's 'BLACKBERRY' trademark is highly distinctive and unique and is recognized dominant trademark for goods in Class 9 not only in the Philippines but also internationally. As such, to allow Respondent-Applicant to venture also in the same Class 9 business, namely mobile communications, using 'BURBERRY', a trademark that is normally used for clothing in Class 25, will cause the dilution of the 'BLACKBERRY' trademark, contrary to the legal doctrine laid down by the Supreme Court in the case of Levi Strauss v. Clinton Apparelle as follows: xxx

"i. The approval of the challenged TM Application involving a mark 'BURBERRY', where the essential portion, i.e. 'BERRY', constitutes a reproduction of the 'BERRY' portion of the well-known 'BLACKBERRY' mark of Opposer, will likewise be contrary to Article 6bis of the Paris Convention xxx"

Opposer alleges, among others things, that:

"4. In the Philippines, Opposer is the first to use, the first to file for the registration of 'BLACKBERRY' trademark and variations thereof, for, among others, goods and services. xxx

“11. Opposer is a multi-national company based in Waterloo, Ontario, Canada where it was founded in 1984.

- a. Presently, it operates offices in North America, Europe, Asia Pacific. The common shares of Opposer are listed on the NASDAQ Stock Market (NASDAQ RIMM) and the Toronto Stock Exchange (TSX RIM).

“12. Opposer is the leading designer, manufacturer and marketer of the ‘BLACKBERRY’ innovative wireless solutions for the worldwide mobile communications market, and of the ubiquitous ‘BLACKBERRY’ handheld units developed around these wireless solutions, which as shown below, have attained well known status.

- a. The wireless solution is necessary solution to the development in this age and time of what is known as integrated software and services in worldwide mobile communications market.
- b. In order to achieve ‘seamless access of time sensitive information’ over this integrated hardware, software and services involved in the worldwide communications market, Opposer came out with a solution involving wireless access, comprising of wireless devices, software and services.

This wireless solution achieved seamless access information, including those from email, phone, SMS messaging, Internet and intranet-based applications.

- c. This wide range of wireless solutions comprises Opposer’s portfolio of award winning products, services and embedded technologies, and they are known the ‘BLACKBERRY’ wireless platform, software development tools and other hardware and software, used by thousands of organizations around the world. Xxx
- d. The well-known status of these devices is such that these phones are known all over the world as ‘BLACKBERRY’ phones, or simply, ‘BLACKBERRY’.
- e. The mere mention of ‘BLACKBERRY’ today is but to refer to this type of smartphones of Opposer, and to all the wireless BLACKBERRY platforms.xxx

“17. To date, Opposer owns approximately over 800 trademark registrations for ‘BLACKBERRY’ and variations thereof in numerous countries worldwide for Class 9 products, among others, Opposer likewise owns over 1,900 trademark applications for ‘BLACKBERRY’ and variations worldwide applications and registrations for the

'BLACKBERRY' trademarks and variations thereof trademark will be submitted with the Verified Notice of Opposition. xxx

"29. Opposer's 'BLACKBERRY' products are sold in many countries including but not limited to countries such as Argentina, Australia, Bahrain, Bangladesh, Bolivia, Belgium, Brazil, Bulgaria, Canada, Caribbean, China, Croatia, Cyprus, Denmark, Ecuador, Egypt, El Salvador, Fiji, France, Germany, Greece, Guam, Guatemala, Hong Kong, Hungary, India, Indonesia, Israel, Japan, Jordan, Kenya, Korea, Kuwait, Malaysia, Mexico, Morocco, Netherlands, New Zealand, Nicaragua, Nigeria, Norway, Pakistan, Paraguay, Peru, Philippines, Poland, Portugal, Puerto Rico, Qatar, Romania, Russia, Saudi Arabia, Singapore, Serbia, South Africa, Spain, Switzerland, Sweden, Turkey, Ukraine, United Arab Emirates, United Kingdom and United States of America. xxx

"23. To maintain this goodwill and fame, Opposer continues to advertise its 'BLACKBERRY' trademark and goods in numerous magazines such as Business Week, Newsweek, People, Time, Los Angeles Times, New York Times, USA Today and the Wall Street Journal, most of which are widely sold and circulated in numerous countries worldwide, including the Philippines.

"24. Achieving the fame and notoriety for its 'BLACKBERRY' mark came at a staggering price. Opposer has spent and invested hundreds of millions of dollars to advertise and promote its 'BLACKBERRY' trademark during the last three years. xxx

"27. Because of Opposer's aggressive worldwide sales, promotions and advertising, no doubt, Opposer's trademark 'BLACKBERRY' is well-known internationally as well as in the Philippines.

"28. One only has to go to the Internet to see the extensive advertising, sale and distribution of Opposer's products bearing the 'BLACKBERRY'. xxx

"29. More information about the Opposer and its 'BLACKBERRY' products are available at the Website <http://www.BLACKBERRY.com> and <http://www.rim.com.Visitors> to these websites include internet users and customers from all parts of the world, including the Philippines.

"30. To further illustrate the well-known status of the 'BLACKBERRY' word, in January 2009, the search engine 'Google' generated 104,000,000 hits for the keyword 'BLACKBERRY' only. xxx

"35. But Opposer has been very aggressive and vigilant in protecting 'BLACKBERRY' trademark. It has filed and won numerous cases against third party infringers of its well-known trademark 'BLACKBERRY'.

To support its opposition, the Opposer submitted as evidence the following:

1. Written Statement of Barnes Lam dated 26 July 2010;
2. Annual Reports of Research in Motion Limited ;
3. Print-out of www.shopblackberry.com website;
4. Certified copies of Opposer's trademark registrations and applications abroad;
5. Print-out of database BLACKBERRY applications and registrations;
6. Copy of Opposition against trademark application filed in Brazil;
7. Affidavit of Jan Abigail Ponce dated 2 August 2010;
8. Special Power of Attorney dated 28 June 2010;
9. Copies of trademark registrations and applications in the Philippines;
10. Affidavit of Mark Guilbert dated 4 February 2009;
11. Certified true copy of Articles of Amalgamation of Opposer;
12. Copy of 2008 Brandz Report and press releases concerning "BLACKBERRY";
13. Copy of Financial Times Special Report;
14. Copy of Business Week Interbrand Release of 2008;
15. Copies of advertisements, commercials, articles, celebrity endorsements of "BLACKBERRY";
16. Print-out of press releases from Opposer's website;
17. WIPO decisions declaring "BLACKBERRY" as well-known.⁴

The Respondent-Applicant filed its Answer on 30 December 2010, alleging among other things, the following facts and defenses:

"17. In the first place, much consideration must be given by this Honorable Office to the fact that Respondent-Applicant's own 'BURBERRY' mark is internationally well-known mark as this is defined under Rule 102 of the Trademark Rules and Regulations and therefore equally entitled to a broad scope of protection as similarly claimed by Opposer for its 'BLACKBERRY' mark;

"17.1. The adoption of the mark 'BURBERRY' is certainly no coincidence. The 'BURBERRY' mark was naturally used by Respondent-Applicant as it is in fact the name of its founder, Mr. Thomas Burberry (Burberry), who in 1856 as a then 21 year old draper's apprentice, opened a small outfitter's shop in Basingstoke, Hampshire, England, By 1870, the small shop grew into a virtual emporium with a loyal following enticed by Burberry's commitment to quality and innovation in fabric and outdoor design.

"17.2. In 1891, Burberry, now trading as Thomas Burberry & Sons and known to the rest of the world as 'Burberrys of London', opened a shop in the West End of London at 30 Haymarket. xxx Respondent-Applicant has established over 440 shops worldwide either as stand-alone shops or concessions in renowned malls and department stores. In addition, the Respondent-Applicant supplies more than 900 wholesale customers worldwide, who sell Burberry-branded products through more than 1,600 retail locations.

⁴ Exhibits "A" to "W" inclusive of submarkings

“17.3. The Respondent-Applicant is a designer, manufacturer, retailer, wholesaler and licensor of a broad range of luxury goods all marketed and distributed under the BURBERRY brand. Such products include apparel, scarves, silk squares, footwear, headwear, eyewear, timepieces, fragrances, cosmetics, umbrellas, handbags, leather goods including cases and holders for electronic devices such as mobile phones, childrenwear, jewellery, pet accessories.

“17.4. In the Philippines, Respondent-Applicant’s products under the BURBERRY name have been available for over 10 years. In conjunction with franchise partner, Respondent-Applicant currently operates three stand alone stores in the Philippines, located in Greenbelt 4, Rustan’s Department Store Makati and Shangri-la Plaza Mall. Needless to say, the ‘BURBERRY’ mark has long been in existence and enjoying worldwide brand notoriety for almost one hundred fifty (150) years now and even before the inception of Opposer’s ‘BLACKBERRY’ mark.

“17.5. Among the goods then invented and manufactures by Respondent-Applicant’s predecessors are gabardine fabric, a hard-wearing, water-resistant yet breathable tearproof fabric which was patented in 1888. Burberry branded gabardine clothing was used by various explorers and adventurers including Roald Amundsen reaching the South Pole in 1911, and Ernest Shackleton in Antarctica. Similar success was found with Burberry’s achievements in military wear, which were endorsed by the War Office and Admiralty in the First World War. It is estimated that half a million Burberry coats were worn by combatant officers between 1914 and 1918. In the 1920’s, these trench coats were lined with now famous Burberry Check design which presently is one of the most copied trademarks in the world.

“17.6. As one of the most copied trademark in existence, Respondent-Applicant has sought protection worldwide for its ‘BURBERRY’ mark through numerous registrations obtained and presently in force.

“17.7. The worldwide notoriety of Respondent-Applicant’s BURBERRY’ mark is likewise strengthened through its marketing efforts which include print, billboard, advertising, social media networking and point of sale material. xxx

“17.8. Respondent-Applicant likewise maintains a successful internet site, www.burberry.com which is accessible to consumers around the world, including the Philippines. xxx

“17.10. As a further testament to its enjoyed brand notoriety, Respondent-Applicant has reported sales revenue in its financial year 2009(ending 31 March 2010) at USD 1,280 million or 6.5% higher than its sales revenue in 2008/2009.xxx

“17.11. xxx Respondent-Applicant and its ‘BURBERRY’ mark are among those privileged to be bestowed with two royal warrants issued by her Majesty Queen Elizabeth II and HRH the Prince of Wales in 1955 and 1989, respectively—a distinction awarded to merchants who are permitted to claim and advertise the fact that they have the honor of supplying and servicing the Royal Family. xxx

“17.15. All told, it is clear that Respondent-Applicant’s BURBERRY mark is internationally well-known xxx”

The Respondent-Applicant submitted as evidence, the following:

1. Legalized and authenticated Affidavit of Stuart John Lockyear dated 28 September 2010;
2. Special Power of Attorney dated 28 September 2010;
3. List of trademark registrations for the mark “BURBERRY”;
4. Samples of press articles in fashion magazines such as *Vogue*, *Elle*, *Wall*, *Street Journal*, *The Times* and *In Style*;
5. Pictures of various press conferences and fashion shows;
6. Print-out of internet websites where “BURBERRY” is displayed, Interbrand Survey;
7. Print-out of “BURBERRY” twitter page, Facebook Page and You Tube Channel.⁵

The Preliminary Conference was held on 16 June 2010 wherein the parties were directed to file their respective position papers. The Opposer and Respondent-Applicant submitted their position paper on 27 June 2010 and 28 June 2010, respectively.

Should the Respondent-Applicant be allowed to register the trademark BURBERRY?

Records show that at the time Respondent-Applicant applied for registration of the mark “BURBERRY” the Opposer already registered the mark “BLACKBERRY” under Certificate of Registration No. 4-2002-009142⁶. The goods covered by the Opposer’s trademark registration are also under Class 09, same as indicated in the Respondent-Applicant’s trademark application.

But are the competing marks, depicted below resemble each other such that confusion, even deception, is likely to occur?

BLACKBERRY



Opposer’s marks

⁵ Exhibits “1” to “9” inclusive of submarkings

⁶ Exhibit “I”

A handwritten signature in blue ink, appearing to be the initials "AZ", is located in the bottom right corner of the page.

BURBERRY

Respondent-Applicant's mark

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks, are similar with respect to the last syllables ("BERRY"). The first two (2) syllable "BLACK" and "BUR" do not sound the same. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. The consumers can easily see the differences between the two marks. The Respondent-Applicant has proven that its trademark enjoys considerable amount of fame and popularity around the world. Evidence shows that the Respondent-Applicant created a "check" design associated with its mark, as seen in one of its press articles, reproduced below:



Respondent-Applicant's press article⁷

It is difficult to infer, much less conclude, that the Respondent-Applicant is motivated or has the intention to copy or colorably imitate the Opposer's mark. Respondent-Applicant's mark is the surname of Thomas Burberry, its founder. More importantly, the product upon which the marks are used are branded mobile telephones under class 9, which are not inexpensive. The buying public should be credited with a

⁷ Exhibit "2"

modicum of intelligence and discernment in purchasing articles, such as gadgets and mobile phones. Mobile phones are such kind of consumer goods where brand patronage or consciousness is concededly prevalent.

In *Emerald Garment Manufacturing Corporation v. Court of Appeals*⁸, the Supreme Court held:

Finally, in line with the foregoing discussions, more credit should be given to the "ordinary purchaser." Cast in this particular controversy, the ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved.

The definition laid down in *Dy Buncio v. Tan Tiao Bok*³⁵ is better suited to the present case. There, the "ordinary purchaser" was defined as one "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2009-500851 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 October 2015.


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

⁸ G.R. 100098, 29 December 1995