



Judge In New Mexico Issues Temporary Restraining Order Against Research In Motion To Prevent Use Of BBX Mark At Conference In Singapore

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Research In Motion (RIM) planned to introduce its newest mobile platform at the BLACKBERRY developers' conference (DevCon) in Singapore. It was going to call it BBX – until Basis International obtained a temporary restraining order against RIM's use of the name the day before the conference opened. See *Basis Int'l Ltd. v. Research In Motion, Ltd.*, No. 11-cv-953, slip op. (D.N.M. Dec. 6, 2011).¹ Now, RIM is going to call the platform BLACKBERRY 10. Meanwhile, the suit continues with a hearing on Basis's motion for preliminary injunction, scheduled for December 19.

The Lanham Act can have extraterritorial application to stop foreign use of an infringing mark under appropriate circumstances. As stated in the order:

This Court may issue an injunction having extraterritorial effect in order to prevent trademark violations under the Lanham Act where: the extraterritorial conduct would, if not enjoined, have a significant effect on United States commerce, and then only after consideration of the extent to which the citizenship of the defendant and the possibility of conflict with trademark rights under the relevant foreign law might make issuance of the injunction inappropriate in light of international comity concerns.

Id. at 3.

The court decided the facts satisfied these conditions, so issuing a temporary restraining order was appropriate. From this author's view, three facts convinced the court: (1) RIM was going to use a

¹ Available here: http://www.pattishall.com/pdf/Basis_v_RIM_TRO.pdf.



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mark identical to Basis's mark; (2) the parties targeted identical consumers, *i.e.*, business software developers; and (3) actual confusion had already arisen – upon RIM's original announcement of the BBX platform in October, Basis had been contacted about the connection between RIM and Basis.

RIM, a Canadian company, argued that the Lanham Act should not be applied to stop the use of BBX by RIM's Singapore subsidiary (which was running the conference), but the court found that line of reasoning unpersuasive. “It is naive to believe that further confusion of the BBX mark in the United States will be confined to only those attending the conference from this country.” *Id.* at 4 (emphasis in original). The court did not explore this conclusion, but did say that “it is not a stretch to state that RIM is attempting global publicity, much of which is aimed at BASIS's core customer base—U.S. software developers.”

Companies with products in international markets must be cognizant that use of a mark that has a substantial or significant effect on U.S. commerce may result in a violation of the Lanham Act. This was true even before the age of the Internet, but the Internet has helped blur national boundaries – with no small help from RIM and its BLACKBERRY.

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