Does CRACKBERRY Parody BLACKBERRY? TTAB Says "No"

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On February 27, 2012, the Trademark Trial and Appeal Board issued its precedential opinion in *Research in Motion Limited v. Defining Presence Marketing Group, Inc. and Axel Ltd. Co.*, Opposition No. 91181076,[1] refusing registration of CRACKBERRY because it is likely to be confused with and to dilute RIM's famous BLACKBERRY mark. Defendant's ("Axel") main defense was that CRACKBERRY parodied BLACKBERRY. Axel's parody defenses failed, perhaps primarily because, according to the Board, Axel competes directly with RIM, rather than simply making a commentary on the BLACKBERRY product.

The Board summarily dealt with Axel's parody defense to likelihood of confusion, noting that in federal court "the protective penumbra of free speech may well support the premise that members of the public have a right to use words in the English language to interest and amuse other persons." However, the Board only has power to bar registration, not use. Thus "[t]he First Amendment claim is not as strong as with issues of restraint on use." In addition, "[t]he center of balance changes even further when the risk of confusion of source, affiliation, approval, or endorsement by the source of the known expression outweighs the newcomer's claim to the right to adopt and register a humorous moniker." The Board concluded that – at least for the purpose of registration – "likelihood of confusion will usually trump any First Amendment concerns." The Board then had no trouble finding that the *DuPont* factors supported the conclusion that CRACKBERRY was likely to be confused with BLACKBERRY.

The TTAB also found that CRACKBERRY is likely to dilute BLACKBERRY. Again, Axel hung its hat on the parody defense. Again, it failed. The Board first noted that the parody exclusion in the federal dilution statute, 15 U.S.C. 1125(c), by its terms does not apply to defendant's use of its mark "as a designation of source for the person's own goods or services." Axel obviously used CRACKBERRY as a mark.

[1] Decision available at http://ttabvue.uspto.gov/ttabvue/v?pno=91181076&pty=OPP&eno=8.

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However, the Board held that the statutory language does not end the analysis. The Board quoted the famous parody case *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007), explaining: "Like the Fourth Circuit, the Board will assess the alleged parody 'as part of the circumstances to be considered for determining whether the [opposer] has made out a claim for dilution by blurring.'" In finding dilution by blurring, the Board considered it persuasive that Axel itself did not create the parody – instead it adopted a term already in common parlance. Perhaps more importantly, the Board noted that Axel's CRACKBERRY services are closely related to those of RIM. Thus, if CRACKBERRY was a parody at all, it was not a very good one.

Axel operates an online retail store under the CRACKBERRY name, where it sells electronic handheld devices among other things that, the Board found, "are quite closely related" to RIM's BLACKBERRY devices. The CRACKBERRY site uses "the Blackberry mark as if their own source identifier." This likely was Axel's undoing. While the site may include a chat room for BLACKBERRY users, sale of goods on the site no doubt ended any "joke" Axel was trying to make of the CRACKBERRY name, and put it squarely in competition with RIM's BLACKBERRY products and services.

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