

Federal Court of Appeal



Cour d'appel fédérale

Date: 20121116

Docket: A-308-12

Citation: 2012 FCA 292

Present: NOËL J.A.

BETWEEN:

BBM CANADA

Appellant

and

RESEARCH IN MOTION LIMITED

Respondent

Dealt with in writing without appearance of parties.

Order delivered at Ottawa, Ontario, on November 16, 2012.

REASONS FOR ORDER BY:

NOËL J.A.

Federal Court of Appeal



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REASONS FOR ORDER

NOËL J.A.

[1] BBM Canada (the appellant), together with its subsidiaries is the sole supplier of impartial radio and television ratings data in Canada. It owns the registered trade-mark TMA701,839 “BBM”.

[2] The appellant brought an application against Research in Motion Limited (the respondent) alleging trade-mark infringement arising from the respondent’s rebranding of its BlackBerry Messenger service as “BBM”. The application was dismissed by Near J. and the present appeal ensued.

[3] In dismissing the appellant's application, Near J. held among other things that the respondent's use of "BBM" was not likely to cause confusion with the appellant's registered trade-mark because each operated in distinct markets with no overlap (reasons at paras. 44 to 55).

[4] The appellant now brings a motion to present new evidence pursuant to Rule 351 of the *Federal Courts Rules*, SOR/98-106. This new evidence would reveal that after the decision under appeal was released, the respondent submitted a suggestion to the *Collins* dictionary for inclusion of "BBM" as a new word in its dictionary to be defined as meaning the respondent's BlackBerry Messenger application. *Collins* dictionary adopted the proposed definition and subsequently the respondent posted a video celebrating the addition of "BBM" to the *Collins* dictionary on its official BlackBerry blog page. It also posted a copy of the video on YouTube®.

[5] In order to obtain leave to file new evidence on appeal, the requesting party must demonstrate that the evidence in question was not available at the time of the hearing, is credible and is practically conclusive of an issue on appeal (*The Queen v. General Electric Capital Canada Inc.*, 2010 FCA 290 at para. 3; *Shire Canada Inc. v. Apotex Inc.*, 2011 FCA 10 at paras. 17 and 18).

[6] Only the last element of this test is in issue. The argument raised by the appellant boils down to this. The addition of "BBM" to the *Collins* dictionary at the instigation of the respondent reveals that the respondent has the desire and the means to give its trade-mark an acceptance which excludes all others, thereby undermining Near J.'s conclusion that the two marks can co-exist in their respective distinct universe.

[7] In my respectful view, the appellant has not succeeded in establishing that its proposed new evidence would practically be dispositive of an issue on appeal.

[8] The record reveals that Near J. had before him extensive evidence to the effect that the respondent has a capacity to build brand recognition which the appellant cannot hope to match (Affidavit of James MacLeod, para. 14, appeal book, pp. 61 and 62). The evidence establishing this imbalance is compelling and is already referred to in the appellant's memorandum of fact and law filed in support of its appeal.

[9] What the appellant seeks to do is to bring into the record additional evidence pointing in the same direction. This falls short of the high threshold which the third element of the test commands.

[10] The motion will accordingly be dismissed, with costs.

“Marc Noël”

J.A.

FEDERAL COURT OF APPEAL

NAMES OF COUNSEL AND SOLICITORS OF RECORD

DOCKET: A-308-12

STYLE OF CAUSE: BBM CANADA and RESEARCH IN
MOTION LIMITED

MOTION DEALT WITH IN WRITING WITHOUT APPEARANCE OF PARTIES

REASONS FOR ORDER BY: Noël J.A.

DATED: November 16, 2012

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