

IN THE MATTER OF AN APPLICATION BY
BEST BUY ENTERPRISE SERVICES, INC. TO
REVOKE TRADE MARK "BEST BUY" (AND
DEVICE) REGISTRATION NO: 44,422 IN
CLASSES 9 AND 16

REASONS FOR DECISION

1. The following mark is registered under No. 44,422 in respect of classes 9 and 16.



2. The following is the decision of the Office of the Registrar of Industrial Property concerning the abovementioned Revocation proceedings filed by Agent for the Applicant *Livingston, Alexander & Levy* on January 15, 2010.

Facts

3. The Applicants based their claim for revocation of the mark on section 43(1) (a) of the Trade Marks Act 1999. To this end, their Statement of Grounds in support of their Application for Revocation stated the following;

“That up to the date of one (1) month before the date of this Application for Revocation, a continuous period of at least three (3) years has elapsed during which the registered trade mark numbered 44422 “BEST BUY JAMAICA & LOGO” was not put to *bona fide* use in Jamaica by BCM Technology Limited, or with its consent, in relation to the goods for which the said trade mark is registered.”

4. The Proprietors of the mark filed a Counterstatement along with submissions of evidence to prove use of the mark on October 29, 2010.

Class of Goods

5. The Applicants in the revocation hearing submitted that the mark should be BCM revoked in classes 9 and 16. The mark was originally registered by the Proprietor, Technology Limited.

6. These classes were as follows;
7. Class 9 – “Computers, Consumer Electronics, Computer Peripherals Devices”.
8. Class 16 – “All printing matter.”

Relevant time to prove use of the mark

9. Section 43 (1) of the Trade Marks Act 1999 states the following;

“43 – (1) The registration of a trade mark may be revoked on any of the following grounds;

(a) that within the period of three years following the date of completion of the registration procedure and up to one month before the date of application for revocation, the trade mark has not been put to *bona fide* use in Jamaica by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;”

10. The date of Registration of the mark was the 8th of October 2003 making the date for the beginning of the relevant period of use, October 8, 2006 (i.e. “...the period of three years following the date of completion of the registration procedure.”) The revocation application was filed on January 15, 2010 making the end of the relevant period of use, December 15, 2009 (i.e. “...up to one month before the date of the application for revocation”.)
11. All relevant evidence concerning the use of the mark submitted by the Proprietor should therefore, fall within the time period of *October 8, 2006 and December 15, 2009*.

Evidence

12. The evidence provided by way of exhibits attached to the Statutory Declaration of Brian Moore of BCM Technology Ltd. and dated October 28, 2010 were the following;
13. The Registration of the Trade Mark by the Jamaica Intellectual Property Office and the Registration of the Business Name by the Office of the Registrar of Companies, Jamaica which were submitted as exhibits BM1 and BM2 respectively.

14. The presence of the name Best Buy Jamaica in the Jamaica Telephone Directory and Caribbean Yellow Pages as shown in exhibit BM3 (which is undated) and BM4 with printed date, August 28, 2007 and October 29, 2010.
15. The advertising of the name under the bestbuyjamaica.com website exhibited as BM5 and BM6. The dates printed on these advertisements were August 28, 2007 and September 10, 2010 respectively.
16. Exhibit BM6A showing printouts from www.register.com and www.whois.com confirming the creation of the domain name bestbuyjamaica.com. The date printed on the copy of the domain name registration for www.register.com is April 3, 2007 the date of the evidence displayed for whois.com is October 29, 2010.
17. The use of the mark for advertising through promotional flyers as shown in BM7, BM8 and BM9. All these dates are written and not printed.
18. The exhibition of a display advertising invoice as BM10 for Mr. Brian Moore, all with printed dates appearing from the year 2005.
19. The use of the mark for advertising in the Jamaica Observer marked as, BM11 and BM12. The dates printed on the copies of the Jamaica Observer containing the advertisements for BM11 were as follows; August 24 and 27, September 19, October 26 and 31, November 28 and 30 and December 27, all in 2007. BM12 contained the date of February 18 and 20, March 18 and 25 and April 22, 2009.
20. The display of the name Best Buy as one of the sponsors of the Jamaica Consumer Electronics Show (BM13). The date printed on the evidence was August 30, 2007.
21. The display of a copy of a promotional flyer for the 2006 Jamaica Consumer Electronics Show which featured the mark (BM14). This evidence is also undated.
22. A photo published in the Sunday Observer featuring the "Best Buy Jamaica" (and design) banner at the JCES (BM15). The date of the Observer publication was September 23, 2007. The feature of the name Best Buy Jamaica on top5jamaica.com (BM16). This has a printed date of August 28, 2007.

23. As the relevant dates for providing evidence of the use of the mark in class 9 and 16 have already been mentioned, any evidence provided outside of these dates was automatically disregarded for the purpose of this decision.

CLASS 9

BM1 and BM2

24. These submissions were found to be irrelevant and did not prove the use of the mark under class 9. The registration of a mark with JIPO and the registration of a business with the Office of the Registrar of Companies, Jamaica do not go towards proving the actual use of the trade mark for particular classes of goods.

BM4

25. The submissions for BM4 were also not relevant as an advertisement in the yellow pages does not speak specifically to the advertising of goods in class 9. There is also no reproduction of the trade mark. What is referred to in the yellow pages is the name of the business, and not the trade mark itself.

BM 5 and 6

26. This exhibit contained the “Best Buy Jamaica” (and logo) mark with the advertising of goods that included computers and computer peripherals and consumer electronics.

BM6A

27. The dates of the registration of the domain name bestbuyjamaica.com are not relevant. It must however be mentioned here, that the Office found one of the dates displayed under exhibit 6A alarming, as the date reads October 29, 2010 yet the date of the Statutory Declaration is October 28, 2010.

BM9

28. Under BM9 the date, though a date within the accepted period, is not printed on the flier, but written. The Registrar’s Office cannot therefore be certain that this was _____ the date of the advertisement.

BM11

29. The dates included in these exhibits were relevant dates for the purpose of ascertaining evidence of use however the advertisements all appeared on pages without a date. The Proprietors would have fared better if they had exhibited the advertisement of the marks on the page containing the date. There is, as a result, too much uncertainty based on the manner in which the advertisements were displayed.
30. The office therefore, takes the decision that the Applicant's submission for revocation based on non use of the mark as per section 43(1) of the Trade Marks Act 1999 must be allowed as the Proprietors of the mark have failed to tender evidence that sufficiently demonstrates the use of their mark in class 9.
31. The Proprietors would have done well to tender into evidence copies of actual purchases of the class 9 items. Copies of receipts of actual computers, computer peripheral devices and computer electronics with clearly printed dates on the receipts would have left no doubt that the mark was in use for these purposes.
32. The evidence as provided was either for dates that were not relevant, or did not go towards proving unequivocally that the mark was being used for the said purposes.
33. The mark will therefore, be revoked in class 9.

CLASS 16

34. The trade mark will also be revoked in class 16 as the evidence presented by the Proprietors also went to proof of the mark being used for printed matter. It has already been established that this evidence was not sufficiently clear. The mark will therefore, be revoked in class 16 as well.

K. Davis
Acting Registrar of Industrial Prop

