



An agency of the Ministry of Industry, Investment and Commerce
18 Trafalgar Road, Kingston 10
Jamaica

IN THE MATTER OF AN APPLICATION BY BEST BUY ENTERPRISE SERVICES,
INC. TO INVALIDATE TRADE MARK “BEST BUY” (AND DEVICE)
REGISTRATION NO: 44,422 IN CLASS 35

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

DECISION AND REASONS FOR DECISION

1. On October 8, 2003, BCM Technologies Limited, through Mr. Brian Moore, Manager of the said BCM Technologies Ltd.(hereinafter referred to as the ‘Opponent’), applied under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) for the registration of **BEST BUY JAMAICA (and device)** in classes 9 and 16 in respect of the following;

In class 9 – “computers, consumer electronics, computer peripherals devices”

In class 16 – “all printing matter”

2. The mark was accepted for publication by the Trade Mark Registry on January 12, 2004 and publication of the mark effected thereafter in the Jamaica Gazette.

3. The date of registration was October 25, 2004 and the mark was, as is provided by the Act, regarded as having been registered from the date of filing (also known as the entitlement date) which was October 8, 2003.
4. Best Buy Enterprises Services, Inc. a company incorporated in Minnesota, USA applied for the mark ‘BEST BUY’ (and device) by way of form TM1 dated June 30, 2006 in class 35. JIPO communicated refusal of the application in a letter to the Applicants dated October 17, 2006 citing the reason as being

“..due to a likelihood of confusion with the Trade Mark No. 44,422 “Best Buy Jamaica” in the name of BCM Technology Limited...”
5. The Registrar further stated in the refusal letter that the refusal was in respect of BCM’s (Opponent) registration of their mark in classes 9 and 16.
6. By way of form TM16 filed on February 2, 2007, Best Buy Enterprises Services, Inc., (hereinafter referred to as the Applicant) through their Agent, Livingston, Alexander & Levy, Attorneys-at-Law, filed an application for the “BEST BUY JAMAICA” (and device) to be declared invalid.
7. On April 12, 2007 Foga, Daley & Co., Attorneys-at-Law, filed form TM3 and were appointed as the agents for the Opponent.
8. Through a letter dated June 26, 2009 a further TM3 was filed by Miss Analisa Chapman, Attorney-at-Law as a request for her appointment as the Agent for the Opponent. The TM3 was dated June 15, 2009.

Statement of Grounds of Application for a Declaration of Invalidity

9. The Applicant submitted that their mark “BEST BUY” (and device) qualified under section 14 of the Trade Marks Act as an earlier mark entitled to protection under the Paris Convention as a well known trade mark in Jamaica.
10. The Applicant further stated that as the Opponent’s mark “BEST BUY JAMAICA” was virtually identical or in the alternative, similar to the Applicant’s earlier mark, and that “BEST BUY JAMAICA” was also registered for goods which are similar to those of the Applicant’s earlier mark that the mark “BEST BUY JAMAICA” should be declared invalid in accordance with Sections 13(2) (b) and section 45(1) (b) of the Trade Marks Act. The Applicant argued that as a result of the similarity of the marks and the similarity of the goods, there exists a likelihood of confusion on the part of the public, including the likelihood of association with the Applicant’s earlier mark. The Applicant also stated that as an earlier trade mark, as defined in the Trade Marks Act 1999, they did not consent to the registration of “BEST BUY JAMAICA” and device.

11. Further or in the alternative, the Applicant argued that the Opponent's mark should be declared invalid as the Applicant has an earlier right to the trade mark by virtue of the law of passing off which protects the right of unregistered trade marks under section 13(4) and 45(1) of the Trade Marks Act 1999.
12. Further or in the alternative, the Applicant also argued that the registration of the Opponent's mark constituted bad faith and was therefore contrary to section 11(4)(e) of the Trade Marks Act 1999.

Applicant's submissions at the hearing

WELL KNOWN MARK

13. At the hearing the Applicant stated that their "BEST BUY" and device mark fell under the definition of an earlier trade mark as defined in section 14 of the 1999 Trade Marks Act. Section 14 states that the mark may be entitled to protection as at the date of application and that the priority claimed entitles the mark to protection as a well known mark under the Paris Convention.
14. In examining the definition of a well known trade mark, the Applicant looked at the text *Kerley's – The Law of Trade Marks and Trade Names* and noted that the well known mark should be considered well known in the United Kingdom as being the mark of a person who is a national of a Convention country or who is domiciled in or has a real and effective industrial or commercial establishment in a convention country, and that this should be the case whether or not the person carried on any business or had any goodwill in the UK. The Applicant therefore submitted that it was not a requirement that the proprietor have any goodwill or business in the UK.
15. This definition was also provided for in section 49 of the Jamaican Trade Mark Act. The Applicant therefore argued in turn that there was no need for the Applicant's mark to represent a business in Jamaica or to have established goodwill here to be known as an earlier mark.
16. In persuading the Registrar to find that the "BEST BUY" trade mark is a well known mark in Jamaica, the Applicants made reference to evidence submitted by way of Statutory Declaration. The Statutory Declaration of Mr. James Joyce stated and showed an exhibit that the Applicant's company was named Forbes Magazine's company of the year and the number one retailer of consumer electronics in the USA by Twice Special Reports.
17. The Applicant pointed out in line with their submission of the Joyce Declaration, that if the company was so well known in the US, considering Jamaica's geographical proximity to the US, it would follow that the company should also be well known and famous in Jamaica. This argument was buttressed by the evidence given by Judith Campbell, Managing Director of Novelty Trading Company Limited in her statutory

declaration concerning the local distribution of many of the magazines mentioned in the declaration of Mr. Joseph Joyce.

18. In addition, the Applicant also referred to evidence provided in exhibit JJ5 of the Joseph Joyce Declaration concerning the number of website hits from Jamaica to BEST BUY's online site as well as the statutory declaration of Miss Colleen Phillips which highlighted that a number of persons use the services of Mailpac Services Ltd. and Miss Christine Johnson who declared that this was also the case for Jamaica Freight and Shipping Co. Ltd., in order to access purchases from BEST BUY in the USA.

SIMILARITY OF MARKS

19. As the Applicant's mark is an earlier mark entitled to protection from a similar mark the Applicant also argued that the "BEST BUY" mark was visually and aurally similar to the "BEST BUY JAMAICA" mark. In examining the similarity of the marks the Applicant stated that there were three issues in for determination. These were 1) the actual similarity of the mark 2) the similarity of the nature of the goods/services which the marks represented and 3) the likelihood of confusion on the part of the public.
20. The Applicant submitted that based on the Sabel BV v. Puma AG, Rudolf Dassler Sport (1998) RPC 199, test of taking into consideration all of the elements of the mark and looking at the marks as a whole to determine similarity, and also paying attention to the dominant and distinctive components, it was evident that the marks were indeed similar.
21. In the determination of the actual similarity of the mark the Applicant's also highlighted the writing of *Bentley and Sherman – Intellectual Property Law – 3rd Ed.* where it was stated that the aural visual and conceptual similarity of the mark should be examined and also that attention should be paid to the dominant and distinctive components of the mark.
22. In examining the cases of Claudia Oberhauser v. OHIM [2002] ECR 4359 and Matrazen Concord GmbH v. OHIM [2003] ETMR 392, the Applicant's were able to point out a number of rules concerning the determination of similarity of marks.
23. The determination of similarity involved looking at the length of the word in the mark as well as their structure i.e. whether it is the same number of words etc, as well as the concept of imperfect recollection which would determine that the average consumer is not able to remember a mark exactly as they have previously viewed it and would rarely be able to make a direct comparison between marks. Therefore what might seem dissimilar when imperfect recollection is taken into account may actually be similar.
24. The Applicant also regarded the goods for which the two marks were being used as similar. In the determination of whether or not the goods were similar the Applicant

looked at the case of Canon Kabushiki Kaisha v. Metro Goldwyn Mayer Inc. case C 39/97 [1999] 1 CMLR 77 or [1999] ETMR 1 where it was outlined that in determining the similarity between goods and services of the mark their nature, end user, their method of use and whether they are in competition with each other should all be examined.

25. In terms of the argument concerning the likelihood of confusion, the Applicant stated that it fell to be determined – Who must be confused? What must they be confused about and how does one prove confusion?
26. In looking at who must be confused they stated that based on the *locus classicus* Sabel BV v. Puma AG, Rudolf Dassler Sport [1998] RPC 199 the average consumer would be the group that must be confused and that this would include the expectation that they would be reasonably well informed and reasonably observant and circumspect. Despite this the Applicant also referred to the fact that the characteristics of the average consumer may vary from sector to sector.
27. The Applicant argued that based on the average consumer in this sector, there exists no material difference between the marks or the goods and services.
28. In terms of what the consumer must be confused about the Applicant made reference to *Bentley & Sherman- Intellectual Property Law – 3rd Ed.* text where the learned writers stated that the

“consumers must be confused about the source or origin of the goods or services – that is, they must be confused as to the designer, manufacturer, selector, or supplier of the goods or services.”
29. By extension, the Applicant’s argued that “it is entirely probable that consumers will be confused about the source or origin of the Opponent’s goods.” When presented with the trade marks in question, consumers they stated, are likely to think that the trade marks are one and the same due to the insignificant differences in their sound and appearance, and the similar goods and services which they represent.
30. The Applicants in looking at how one must prove confusion also referred to the authorities where it was held that actual evidence of confusion need not be provided by the Applicant but that this could be derived from the surrounding circumstances.
31. The Applicants further submitted that the assessment must begin when the allegedly infringing sign starts to be used.
32. Of significance in the Applicant’s argument was that the outcome of whether confusion of the consumer can occur due to the similarity of the marks is affected by the interdependence between the similarity of the marks and the similarity of the

goods. Therefore if in the present case it was that in the alternative, the goods were not found to be very similar the degree of visual similarity between the two Best Buy marks would still result in a finding of confusion of the consumer.

33. The Applicant's argued that the use of the "BEST BUY JAMAICA" mark was, based on section 13(4) of the Trade Marks Act, consistent with the tort of passing off.
34. The final submission of the Applicant was that the Opponents registered their mark in bad faith according to section 11(4) of the Trade Marks Act 1999. The Applicant in connection to this, pointed out that in the case of Scania CV AB v. Westlye (2000) ETMR 767 and Davide Campari Milano Spa v. Ozal Finkol Giyim Sanayi Ve Ticaret Ltd STO (2002) ETMR 75 the application for a trade mark, once the earlier mark is a well known mark, should automatically be considered as having been made in bad faith.
35. As this was a mark applied for by the Opponent and it was also a well known mark the Applicant argued that it was evident that it was in fact made in bad faith by the Opponents.
36. In their reference to *Holyoake & Torremans – Intellectual Property Law - 5th ed.* the applicants highlighted that the court needed in the determination of bad faith, to consider the mental state of the Applicant in seeking to register the mark and "all of the surrounding circumstances."
37. Further to this the learned writers stated that the test is one of combining the objective with the subjective and that the proper standard of behaviour in demonstrating that bad faith does not exist, would be "acceptable commercial behaviour as observed by reasonable and experienced persons in the particular commercial area being examined."

Opponent's Counterstatement

38. The Opponents filed a counterstatement and grounds for counterstatement on April 12, 2007.
39. In the counterstatement the Opponents denied that the Applicant's mark was an earlier mark under section 14 of the Trade Marks Act and was therefore entitled to any protection under the Paris Convention as a well known mark.
40. The Opponent stated that the Applicant's mark was not well known in Jamaica and that further to this, the Applicant had not established any reputation or goodwill in Jamaica in connection with any of the goods under the Applicant's mark.
41. The Opponent also denied that their mark "BEST BUY JAMAICA" was similar to the mark of the Applicant and further denied that the goods of the Opponent's Trade Mark were similar to the services of the Applicant's trade mark.

42. It was submitted further by the Opponents that there did not exist a likelihood of confusion which would include a likelihood of association with the Applicant's mark.
43. In the event that the Registrar should agree with the Applicant's mark being an earlier mark, an argument of particular note was that the Opponents argued that conceptually, the "BEST BUY JAMAICA" (and device) mark was a combination of the three words with a triangular shaped figure located behind the words and was therefore in this sense distinctive. He further argued that the words "Best" and "Buy" are inherently descriptive words and open to use by anyone in the trade. This was further qualified by the submission that the words had become distinctive as in Jamaica they had become associated exclusively with the Opponent's goods. The Opponent had therefore built up a valuable reputation and goodwill in their "BEST BUY JAMAICA" mark.
44. Another significant argument of the Opponent was that the Applicant indicated by their prior conduct that they had no objection to the use of the mark by the Opponent as the latter had used and advertised the "BEST BUY JAMAICA" mark, allowing the Opponent to build goodwill and a reputation in the mark, and that the registration of the Opponent's mark only became an issue when the Applicant attempted to register their mark "BEST BUY" which was unsuccessful.
45. Also the Opponent stated that the Applicant did not therefore possess the earlier right to the mark they emphasized in their submission and as a result the law of passing off did not apply. The Opponent therefore did not require the consent of the Applicant in registering their mark.

Opponent's submissions at hearing

46. The Opponent argued that that the Applicant's mark was not entitled to protection as a well known mark.
47. The Opponent's first submission concerning this was that the Applicant's reliance on section 14 (b) of the Trade Marks Act 1999 was incorrect. This states that an earlier trade mark is one "which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection under the Paris Convention as a well-known trade mark..."
48. The Opponent argued that if the Applicant relied on the definition of an earlier mark in section 14(b) then all evidence provided to substantiate the claim that the mark was entitled to protection as a well known mark, would have to be based on evidence that existed either prior to or at the date of the registration of the mark. This date was October 8, 2002.

49. The Opponent also responded to the Applicant's claim that based on section 49(2) of the Trade Marks Act 1999 "a trade mark is entitled to protection under the Paris Convention if it is a well known mark in Jamaica..." The Opponent submitted that though there was not a question that the Applicant had a "real and effective" commercial establishment in the Convention country of the USA, the Applicant had not provided sufficient evidence to demonstrate the carrying on of any business or any goodwill in Jamaica.
50. The Opponent also stated that the Applicant's mark did not meet the criteria of being a trade mark and should therefore not fall under the TM Act as it did not satisfy the function of a trade mark i.e. being able to distinguish one undertaking from another. The Applicant stated that based on their opinion the words "best buy" were descriptive and as a self explanatory term, were commonly used in the English language.
51. In support of this the Opponents referred to the Best Buy Concept Inc. v. Office of Harmonisation of the Internal Market (Trade Marks and Designs) Case T122/01 in which it was also determined that the words "best buy" were to be
- "perceived immediately by the relevant public as a mere promotional formula or slogan which indicated that the services offer the best buy possible in their category."
- The Applicant submitted that this case should be considered highly persuasive.
52. The Applicant submitted that based on their findings precedence dictated that the standard of proof for the determination of whether a mark was considered a well known mark was a high standard. Through reference to cases such as General Motors Corporation v. Yplon (1999) ETMR 122 and The Opposition Matter Divovary Vratislav case (Application No. 206 1273) they submitted that the standard imposed for establishing a mark as a well known mark was a high standard.
53. The Opponent pointed out that Applicant's attempt to demonstrate that their mark was a well known mark was not satisfied by the evidence provided by the submitted declarations.
54. The Opponent made specific reference to the Applicant's submission of the Declaration of Mr. Joseph M. Joyce, Senior Vice President of Marketing for Best Buy Enterprise Services Inc., in which it was outlined that since the USA and Canada were geographically close to Jamaica that the evidence revealed that this made these countries accessible to the Jamaican population and that these countries were visited often by Jamaicans. The Opponent submitted that there was no evidence to this effect and that it was instead an assumption with insufficient evidence to substantiate the claim. In particular the Opponent referred to the fact that there was no evidence to show the frequency of travel of Jamaicans, the number of Jamaicans traveling at all

material times and the specific locations that such Jamaicans travelled to or where they spent their time when in such locations.

55. In connection with this the Opponent also made reference in the Joyce Declaration to the growth and success of the Applicant's stores in the USA and Canada however the Opponent submitted that this was only proof of the growth of their business in the USA and Canada and was therefore not relevant to the Jamaican jurisdiction.

56. The alleged evidentiary inadequacies of the Joyce Declaration were repeatedly referred to by the Opponent in terms of their reference to Best Buy advertisements in foreign publications, their advertising of business on televisions through cable networks and online advertising. In all cases, the Opponent submitted that the information to a well known mark in the Jamaican jurisdiction was either inadequate or irrelevant.

57. The Applicant claims that the "BEST BUY JAMAICA" mark should have been invalidated based on section 13(2)(b) which states that

58. "*a trade mark shall not be registered if -....*

(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected,"

and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark."

59. Based on this, the Opponent therefore reasoned that the Applicant would have to prove that the marks were similar, that the goods and or services were identical or similar in nature and that the public was likely to be confused by the two marks.

60. The Opponent submitted that the marks were not visually similar as the color scheme and shape and structure of the Opponent's mark differed from that of the Applicant's.

61. The Opponent also argued that though the Applicant had stated that the marks were similar, as they both used the words "best" and "buy", these words were not distinctive but descriptive and could therefore not be used as a measure of the similarity of the marks i.e. the similarity could not be determined by the use of these words as these words would not be considered distinctive by the average consumer.

62. The Opponent's final point in the submission concerning the visual similarity of the mark, was that the further addition of the word "Jamaica" to the Opponent's mark

made the mark distinctive. To support this argument the Opponent referred to the case of Sun Microsystems Inc. v. Pilar C. Reyes (decision no. 132647 April 8, 2005), where it was held that a mark is considered distinct from another mark where it contains an additional word. The Opponent therefore stated that “a non stylized addition of the word “Jamaica” would be given a distinctive weight, particularly as the word refers to a country which, unlike cars, or tyres or wholesale, is not a good or service which can be purchased.”

63. The marks were not similar as one possessed three words and therefore required a longer pronunciation and that the average consumer would notice the difference in the pronunciation with the Opponent’s mark possessing the additional word ”Jamaica.”
64. The Opponent submitted that there was no conceptual similarity between the marks as the presence of the word “Jamaica” in the Opponent’s mark distinguished it from the Applicant and connoted “some semblance of national pride.” According to the Opponent, the presence of the word “Jamaica” in their mark enabled the consumer to recognize that the mark is associated with Jamaica as opposed to the Applicant’s mark which simply possessed the generic words “Best Buy”. These words did not connote any connection with any particular country.
65. The Opponent submitted that there was no evidence to the effect that when the Applicant used its mark in different countries the name of the country was added to the mark i.e. “Best Buy India” for India etc. They therefore argued that the use of the word “Jamaica” in the Opponent’s mark conveyed to the average consumer that the Opponent’s mark originates from a different undertaking than that of the Applicant’s.

SIMILARITY OF GOODS AND SERVICES

66. The Opponent submitted that the Applicant had applied to register their mark under the services provided in class 35 however the Opponent’s mark was registered in class 9 which was in respect of “Computers, consumer electronics, computer peripherals devices.”
67. The basis of the Opponent’s argument was that the services under class 35 that the Applicant attempted to register and the goods registered by the Opponent under class 9 were not be similar in nature. As stated in the Opponent’s submission

“there is a marked difference between services and goods,
which is why the two are grouped into two distinct
categories for classification purposes.”

LIKELIHOOD OF CONFUSIONS

68. In the Opponent’s submission concerning whether a likelihood of confusion between the two marks existed it was stated that the evidence provided by the Applicant was insufficient, as none of the Statutory Declarations provided made mention of a

likelihood of confusion or association between the Applicant's and the Opponent's mark.

69. The Attorney for the Opponent, Miss Chapman, stated on the other hand, that she had provided sufficient evidence to show that the "Best Buy Jamaica" mark was used in the local media and at high profile electronic show events. This meant therefore that Jamaicans would be aware of how to contact "BEST BUY JAMAICA" and would not be likely to go to the Best Buy website in the USA or attempt to contact the Applicant's company with the impressions that this was somehow associated with the business of the Opponent.
70. Further to this argument the Opponent's also, submitted that the Registrar should take into account, not only the theoretical guidelines to determine a likelihood of confusion but more importantly, the practical circumstances in the marketplace. In examining the practical circumstances, the Opponent stated that when sourcing the products from the respective businesses of the Applicant and Opponent, the consumer would likely take into consideration the entire identity of the business. This would include the physical space, the uniforms of sales staff and the type of services provided. On a comparison of this, the Opponents argued that the distinctions between the businesses of the two marks were apparent. An example of this they noted was that the uniforms worn by employees of the Applicant's company were khaki pants and blue shirts and that the Applicant's company consisted of big establishments in comparison with, and not to be mistaken for, the small outfit of the Opponent's company.
71. Miss Chapman for the Opponent, in her submission, stated that the average consumer would not pick a purchase as expensive as a computer or any such digital item without giving careful thought to the mark that the product was associated with. In addition, the fact that the computer business was a popular one would lead consumers to be even more discerning in their purchasing choices and in therefore noting the distinction with the marks in this case.

PASSING OFF

72. Based on the submission, Miss Chapman also suggested that there was insufficient evidence that the Opponent's mark was sufficient to make a claim for passing off by the Applicant. Miss Chapman in reference to decided cases stated that in order to prove a sufficient case for passing off the Claimants must have acquired a good reputation in the market, misrepresentation of their mark should have taken place to the effect that it lead the public to believe that the offending goods were that of the Claimant and the Claimant should have suffered damage to their reputation due to the erroneous belief engendered by the misrepresentation.
73. The basis of the Opponent's argument is that as in so many other areas in the Applicant's submission, the evidence to establish the reputation of the Applicant's mark was insufficient. In making this claim, Miss Chapman again brought to the fore the view that the Applicant's reliance on the geographical proximity of Jamaica to

Canada and the USA to establish that goodwill in the mark, was erroneous. As was stated before the claim made by the Applicant that frequent visits were made by Jamaicans to these countries was insufficient. The Opponent further to this, argued that there was no evidence of any actual customers in the Jamaican market. In relation to this she directed the Registrar to the Application of Readmans Ltd. and Opposition of Westpoint Stevens Incorporated (LUXOR case) which established that a very high standard of proof was needed to establish the existence of goodwill.

74. Reference was also made to the 1-800 Flowers Inc. v. Phonenames Ltd. [2000] ETMR 369 which the Opponent used to buttress the argument that the Applicant's reliance on evidence concerning the website of their mark to establish evidence of was misplaced. This case highlighted the fact that the intention of the website owner and the understanding of the reader of the website, is central to establishing whether goodwill could be established through website use. Simple awareness of the website, according to this case, would therefore not be sufficient.
75. The Opponent in applying the reasoning of this case submitted that the evidence demonstrated that the Applicant's website was not designed to accommodate Jamaican consumers as persons with Jamaican credit cards and billing addresses would not have been accommodated during the relevant time and therefore could not use it. This website could therefore not be used to demonstrate evidence of goodwill in the mark.
76. In terms of establishing evidence of misrepresentation the Opponent also argued that with regard to the Jamaican consumer believing that the Opponent's mark was that of the Applicant, the evidence provided was insufficient. There was a failure to establish misrepresentation also because there were obvious conceptual aural and visual differences between the marks.
77. The Applicant, according to Miss Chapman, in failing to establish the first two criteria in collating evidence of passing off, could not in turn establish the third. The Applicant was unable, to demonstrate that their mark had established goodwill in the Jamaican jurisdiction and that there was misrepresentation of the mark. They could not establish actual or likely loss of reputation.

BAD FAITH

78. The Opponent acknowledged the Applicant's claim that the "BEST BUY JAMAICA" mark should be declared invalid as it was made in bad faith. The Opponent however argued that a significant onus would be placed on the party asserting bad faith. The evidence provided, Miss Chapman submitted, was by this standard not sufficient to establish bad faith. The Opponent however stated that Mr. Moore's declaration in comparison, made specific mention of the mark not being registered in bad faith and stated that his reasons for the creation of "BEST BUY JAMAICA" was that the words "best" and "buy" were a commonly used term in Jamaica.

COSTS

79. The Opponent requested costs in this matter.

DECISION

80. The Applicant's argument that the Opponent's "BEST BUY JAMAICA" mark was invalid, began with submissions that though the Applicant's mark was not registered in Jamaica, it was a well known mark under the Paris Convention and that this entitled it to legal protection. This protection meant that the subsequent registration of "BEST BUY JAMAICA" mark was to be declared invalid as the Applicant's mark was an earlier mark. The "BEST BUY JAMAICA" mark therefore could not be registered without the Applicant's permission.
81. In examining the meaning of a well known trade mark the text *Kerley's the Law of Trade Marks and Trade Names – 13th edition* made reference to the fact that the UK law detailed that the mark should be well known in the UK.
82. This is relevant in this case as in this context the equivalent law is section 49 of the Jamaican Trade Marks Act 1999 and the mark must be well known in the Jamaican jurisdiction. The evidence provided to this effect, was insufficient to establish that the Applicant's mark was well known in Jamaica. Though it was clear that part of that definition was that the mark need not have established goodwill in Jamaica, it was nevertheless the case that it would have had to have, at least, been known by a significant portion of the population in the jurisdiction.
83. The Applicant also made reference to the submission that a well known mark must be construed according to ordinary language. In looking at the ordinary meaning of "well known" the Concise Oxford Dictionary tenth edition refers to this as "known widely or thoroughly." The Applicant's evidence did not establish this.
84. Guidance was also given by the WTO Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement. Based on the TRIPS, this is to be measured by the knowledge the public has of the Trade Mark which may have been obtained by the promotion of the Trade Mark. Again the Applicant has demonstrated many cases of the mark being promoted in other countries but none of it being promoted here in Jamaica. This was not sufficient to measure the level of knowledge that the Jamaican consumer had concerning the "BEST BUY" mark.
85. The Opponent brought to the Office's attention section 14(b) of the Act where an earlier trade mark was defined as a trade mark entitled to protection under the Paris Convention as a well known trade mark but offered as a condition that this should be at the date of application. It seems however that the argument proffered by the Opponent that the evidence submitted by the Applicant concerning their mark being an "earlier mark" should be based on evidence that existed at the date of application and before, is erroneous. The Opponent suggested that the relevant evidence could also be based on information that existed prior to the application however as the Act

specifically states that an earlier mark is one entitled to protection at the date of the application then anything prior to this would be irrelevant. It would be more relevant to examine evidence after the application, however I agree that the strongest evidence would in fact exist at the time of the application itself.

86. Again the Opponent, who proffers the erroneous argument that based on the Trade Marks Act the establishment of whether the Applicant's mark was a well known mark should be up to the date of registration in 2002, also then provides evidence from 2003 in the declaration of Theresa Banes Allen. It was therefore fortunate for the Opponent in this instance that I was unable to see the merit of this argument concerning relevant evidence being only that of 2002 and before.
87. In addition the Opponent also argued that the term 'BEST BUY' did not meet the requirements of being a trade mark in that it is not distinctive. In reference to this the Opponents made reference to the Best Buy Concepts Inc. v. OHIM Case T 122/ 01 in which it was decided that the term "best buy" was

"..a mere promotional formula or slogan which indicates that the services in question offer the best buy possible in their category or the best price quality ratio..."

88. In establishing that the "BEST BUY" mark was well known in Jamaica, the Applicant relied chiefly on the Declaration of Joseph M. Joyce a Senior Vice President at Best Buy Enterprise Services, Inc. The declarant made reference to advertisements in foreign magazines such as Forbes. The Applicant's company had also been named the company of the year and was stated as the number one retailer of electronics. The Applicant then stated

"It is inconceivable, bearing in mind the proximity between Jamaica and the USA/Canada, the large number of Jamaicans who travel to the USA to shop.... [that the mark] could not be well known and famous in Jamaica."

89. This is not in fact inconceivable as there has been no evidence established that shows the number of Jamaican persons who regularly travel to North America and the proximity of these countries is therefore irrelevant. In other declarations the Opponent made repeated references to insufficient information being provided by the declarants and I am of the view that this was the basis of the error in the Applicant's arguments.

90. In the case of Miss Colleen Phillips from Mailpac Services Ltd. her declaration failed to point out when the clients became aware of the Applicant's mark and the specifics of the volume of deliveries. Mr. Ammar makes reference in his declaration to "numerous Jamaicans" being able to access BEST BUY and to the name Best Buy being around for "several years". None of this is helpful. In the Joyce Declaration reference to the other countries in which the marks are registered is in fact irrelevant.

91. In her statutory declaration Colleen Phillips states that she is a Director of Mailpac Services Ltd. and by her very position in the company she would be well aware of any and all of the businesses that clients would have goods delivered from. This would include both the well known and those that are not well known. It is the nature of her business that an enterprise that might not be well known to more than a handful of Jamaicans who request delivery from said business, would be known and familiar to Miss Phillips. It is in fact, her business to know where her clients receive goods from. Therefore in paragraph 3 of her declaration when she states that "I personally know of the Trade Mark "BEST BUY" her personal knowledge is not indicative of a significant portion of the population being aware of the mark and also not significant of the use by the average Jamaican consumer.
92. She continues on paragraph 4 by stating that "we have delivered several of our customers in Jamaica, goods which they have purchased from the USA retail store known as "BEST BUY." Her use of the word "several" does not tell us how many persons have purchased neither has she attached any evidence to this effect. Later on in the same paragraph she refers to the "volume of such deliveries." This again, gives us no clear picture of whether these persons who have made purchases through Mailpac Services Ltd. for "BEST BUY" items are a significant portion of the population.
93. Along this strain it is instructive to examine the statutory declaration of Mr. Michael Ammar Jnr. That he has indicated in paragraph 2 of his declaration that he frequently visits the USA "on both personal and business matters" is not surprising as he is a successful businessman. This however would set him apart from the average Jamaican consumer. Again he makes a vague reference in his fourth paragraph to personally knowing "numerous" Jamaican who visit "BEST BUY" in the USA. Separate and apart from this, the last paragraph is of significance and states

"There has never been any confusion as to which stores are being referred to."

The question must be asked then, how the Applicant could seek to argue that there is a likelihood of confusion that could be created by the co-existence of the two marks. They themselves through Mr. Ammar have presented evidence to the contrary.

94. Therefore when Mr. Ammar states in his final paragraph that

"The brand BEST BUY which is owned by the US company, Best Buy Enterprise Services, Inc., is a well known brand in Jamaica and associated exclusively with the business of the US company..."

it is impossible to see on what basis he makes this statement .

92. The evidence contrary to this can also clearly be seen in the Declaration of William Masterton who, after visiting the USA from “time to time” and having been familiar with the BEST BUY Stores where he purchased a laptop

“recently learned that there is business operating under the name BEST BUY JAMAICAand based on the nature of the business and the products being sold I thought that there must have been some association between the US operation and the Jamaican Store.”

93. Mr. Masterton did not provide any evidence to this effect, but simply states that it was his experience that the trade mark “BEST BUY” was well known in Jamaica. The evidence which Mr. Masterton did provide however was evidence of his purchase from “BEST BUY.” One purchase made by the declarant would be an insufficient means of trying to establish the mark as well known under the Trade Marks Act section 14 or as having helped to establish goodwill in the Applicant’s mark for the purpose of bringing a passing off action.

94. Again the statutory declaration of Miss Christine Johnson who is the Marketing Manager of Jamaica Freight & Shipping Co Ltd. makes reference to the fact that she has personally known about the “BEST BUY” brand as associated with the US retail store. However again, Miss Christine Johnson should know about this because of the specifics of her line of business as she is the Marketing Manager of Jamaica Freight Shipping Co. Ltd.. In her final paragraph she states as with all of the aforementioned declarations

“I am aware that many Jamaican including myself who purchase products such as appliances..... from the USA retail store BEST BUY...”

95. The shortcomings of the declaration of Joseph Joyce, the Senior Vice President of Best Buy Services Inc. have been referred to numerous times however it would be remiss of me not to point out some additional inconsistencies in this declaration.

96. The declaration is replete with numerous references to the well known nature of “BEST BUY” in the USA and Canada and then makes reference to the wholly unrelated concept that somehow Jamaica is sufficiently close to these countries to be influenced by its establishment in North America. Among some of the claims being made by the Applicant through this declaration which is an irrelevant document are the following;

97. Paragraph 3 – The fact that Best Buy Enterprises is the owner of the trade mark “BEST BUY” (& device) which is licensed to Best Buy Stores, L.P. a Virginia Limited Partnership which is a wholly owned subsidiary of Best Buy Co., Inc. There is no mention of what connection this has with Jamaica.

98. Paragraph 4 states that there are “now more than 940 retail stores across the United States and Canada.” Jamaica is mentioned here but only insofar as it is seen as a territory near North America and therefore likely to influence the customers there.
99. Paragraph 5 states that the registration of “BEST BUY” and “BESTBUY.COM” were secured and registered around the world in “many” countries. This again has no significance whatsoever to this jurisdiction.
100. Paragraph 6 states that Best Buy Inc. is a Fortune 500 company whose trade mark is well recognized around the world. There is no evidence provided that the fact that the company is a Fortune 500 means that it should be well known nor does this paragraph speak specifically to how this translates to the mark being well known in Jamaica.
101. Paragraph 8 again makes reference to the widespread availability of advertisements for the Applicant’s mark on USA and Canadian television. This is insignificant in establishing any presence in the Jamaican jurisdiction. What would have held far more significance would have been figures suggested in paragraph 9 which demonstrated the proportion of the Jamaican population which received the listed cable channels and evidence of how often the Best Buy advertisement rotated on these channels.
102. In relation to this point paragraph 10 is also significant in that reference was made of the mark being advertised in a list of magazines including Fortune, The New Yorker and GQ . Reference was made by the declarant Miss Judith Campbell, Managing Director of Novelty Traders Ltd., who stated in her declaration that her company distributed to retailers across Jamaica, the same magazines. However unfortunately this was all the information she provided which again struck a chord of vagueness which was unhelpful to the Applicant’s claim. The fact is the distribution of these magazines throughout Jamaica does not give specific figures as to the number of persons who purchase these magazines etc.
103. In paragraph 16 of the Joseph Joyce declaration further explained in exhibit JJ5, it was stated that the number of persons with Jamaican email addresses who visited BEST BUY websites were 7184. As the Opponent has stated, there is no guarantee that all these persons were actually logging onto the site from Jamaica and as the evidence of the website as provided by the Opponent states that there was no provisions made for Jamaicans purchasing from this jurisdiction, it cannot be accepted that all (if any) of these 7184 persons were attempting to purchase from Jamaica. While the provision by the Opponent of declarations by a varied number of individuals that they have done business with or who were recommended was noted, this falls short in terms of the inability of the Opponents to give detailed evidence concerning who those recommended are and whether or not these numbers are significant.
104. However it is my decision that as the Applicants are the ones who have asserted the claim of invalidity the onus was on them to provide the bulk of such detailed information. In light of this they have failed to do so and the fact that the Opponent could have in counterclaiming made a more vigorous and detailed defence than it did, does not negate

the fact that the Applicant has failed in its claim when establishing the well known nature of their mark and establishing goodwill.

105. The Opponent further stated that even with the number of persons indicated as logging unto the Applicant's website (this in the Joyce Declaration) that this was nowhere close to meeting the substantial portion of the population.
106. The Opponent argued that the Applicant sought to rely on the Joyce Declaration in particular paragraphs 4 and 15 which claim that the USA and Canada are geographically close to Jamaica. The Opponent was correct in stating that if the reader was to imply that the marks being well known in these countries which were geographically close to Jamaica, meant that the marks were well known in Jamaica then this was incorrect. As was stated earlier there was no evidence to support this assumption.
107. In terms of the constant references to articles in American magazines made in the Joyce Statutory Declaration, the Opponent demonstrated that these articles refer to matters affecting sales that are based on events in territories other than Jamaica. On page 18 of the Twice Special Report exhibit there is reference made to factors affecting sales which are blizzards, blackouts, high unemployment as well as the Iraqi war. These factors, it is agreed are unique and attributable to life in the USA.
108. The distribution of these magazines in Jamaica is done through Novelty Trading Company. This was highlighted in the Statutory Declaration of Judith Campbell. The evidence provided in this statutory declaration was, in the submission of the Opponent, considered insufficient. I am in agreement with this submission as there was no demonstration of the volume of magazines ordered and most importantly the number of magazines that were read by Jamaicans. The Registrar is also in agreement that it is more likely that the advertisement would be more noticeable in local periodicals such as the Jamaica Observer, the Jamaica Gleaner etc.
109. In terms of the advertising of the Applicant's business on television, I am in agreement that no specific evidence was provided concerning the availability of the relevant international channels that advertised the Applicant's company, in Jamaica. As was pointed out by the Opponents Mr. Joyce admits in his declaration that he has no first hand knowledge as to whether any of these channels are available in Jamaica but instead relies on the advice given to him by the Attorneys of the Applicant. I am in agreement that this information provided is not first hand information being given by the Declarant and therefore not relevant.
110. In consideration of the website it should be noted that the Opponent correctly submitted that on examining the website it was clear that concessions were not made for potential purchasers from this jurisdiction. The Opponent quoted from

the website which stated that Best Buy did not ship to known freight forwarders, and that such orders would therefore be cancelled.

111. In the hearing the Attorney for the Applicant stated that as the registrant is in the business of electronics would it not be conceivable that this person (Mr. Moore owner of BCM Ltd.) should have known that at the time he applied for the registration of the mark he must have known that another “Best Buy” existed? In defence of this the Opposition’s Attorney made reference to the case of CV Scania v. Westlye 2000 ETMR 67.
112. The Applicant also argued that since the mark was an earlier mark then 13(2)(b) would apply which states that

“A trade mark shall not be registered if....
(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected,”
113. As the Applicant has failed to establish their mark as an earlier mark to be protected by the Paris Convention it must be pointed out that it is not possible for their mark to meet the requisite criteria under section 45(1)(b) and section 13(2)(b) of the Act
114. The Applicant declared that the Opponent’s mark was similar to their earlier mark. I am in agreement that the marks look similar and are aurally similar. In particular it should be pointed out that the argument of the Opponent that the marks were not aurally similar because the Opponent’s mark had a longer pronunciation i.e. the word ‘Jamaica’ in addition to the similar BEST BUY, was an incorrect argument and did not negate the fact that the marks still share the dominant feature of both having the words “BEST BUY.”
115. I also did not agree with the submission that the goods and services which the Applicant and Opponent’s goods represented were similar as though they were close in nature services and goods can never be considered similar or identical.

Likelihood of confusion including likelihood of association

116. The Applicant’s submission that in this case the average consumer of the goods in question would be confused , is not accepted. It is the Registrar’s decision that the average consumer in the Jamaican jurisdiction would not be confused about the two marks and would not automatically associate the Applicant’s mark with that of the Opponent as the Applicant is unable to establish that their mark is even known in Jamaica. If it cannot be established that it is known, there can be no proving that there is a likelihood of the mark being confused with any other.

Passing Off

117. In order to prove passing off I am in agreement with the Applicant that three areas must be proven:

1. the acquisition of goodwill in the market by the mark
 2. misrepresentation of the mark by another party and that
 3. the owner of the mark has suffered or is likely to suffer damage as a result of the public belief with regard to the misrepresentation.
118. The Applicant in making reference to their mark, "BEST BUY", as being subject to the tort of passing off by the Opponent submitted that goodwill had been established in Jamaica. It is evident however that the evidence used to establish this was that there was goodwill established in the USA and Canada and due to the proximity of these jurisdictions that Jamaicans travelled to these countries therefore meaning that goodwill had been established in Jamaica. This is an incorrect argument that also cannot be substantiated based on the evidence.
119. Though the Applicant has attempted to provide evidence to this effect, there is no certainty establishing the number of persons in Jamaica who are aware of the "BEST BUY" mark.
120. The lack of evidence in the relevant declarations must be referred to again in establishing that there was no acquisition of goodwill by the Applicant's mark. If there was no acquisition of goodwill then it would be impossible to prove the other two categories.
120. The Applicant has asked that I consider the use of the mark by the Opponent as being liable to be prevented by the law of passing off and that it should therefore not have been registered. For this submission the Applicant also makes reference to *Bentley & Sherman- Intellectual Property Law* and stated that foreign traders can have goodwill existing overseas where there is evidence of business activity and or customers. It is my decision that there is no evidence of the relevant business activity and or customers available for "BEST BUY" in Jamaica.

BAD FAITH

121. In the submission made by the Applicant that the Opponent had acted in bad faith in registering their trade mark, it was established that the Applicant's mental state was a basis on which to determine whether there was an intention to register the mark in bad faith. In examining the surrounding circumstances and in noting that the issue of bad faith must be viewed from the date of the registration of the Opponent's mark in 2002, it must be an accepted fact that less persons in Jamaica then, had access to businesses in the USA through the internet etc. and that less of the Jamaican population would therefore have been aware of the Applicant's mark if relying on this medium.
122. It is unlikely that any use of the Opponent's mark would have resulted in the damaging of the goodwill of the Applicant's mark. Admittedly we cannot be certain that Mr. Moore did not himself know about the Applicant company and did not then seek to use the name for his local company however there is no evidence of this, and on the contrary, the Opponent did produce evidence and

legal precedence showing that the term “best buy” was generic and used throughout Jamaica by different businesses.

123. This went a long way to persuading that it was likely that the Applicant’s “BEST BUY” mark was not known specifically for its origin but that instead “best buy” was simply an accepted generic and descriptive term used by many merchants (even in Jamaica) to suggest a purchase of choice items. This would in turn suggest that Mr. Moore might have used the term simply based on this reference.
124. In establishing bad faith it must be clear that the person wishes to unscrupulously gain from the reputation of the mark to be used (i.e. earlier mark). The Applicant has been unable to establish any reputation therefore making any claim for bad faith impossible.

Summary of Decision

It is my decision that:

1. there was insufficient evidence to establish that the Applicant’s mark was a well known mark entitled to protection under the Paris Convention as per section 14 of the Trade Marks Act 1999;
2. even though the Applicant had established that the relevant Best Buy marks were visually and aurally similar, since they had failed to establish that their mark was an earlier mark they could not establish that they were entitled to protection from the Opponent’s similar mark;
3. the Applicant also could not establish that there were sufficient grounds to establish a claim under the tort of Passing Off and as a result, the Applicant was unable to establish that he had acquired goodwill in the mark. Since they were unable to establish this, they inevitably could not establish that there was a misrepresentation of the mark by the Opponent or that the Applicant’s mark had suffered damage as a result of the Opponent’s misrepresentation of the mark and
4. the Applicant was unable to establish that the Opponent had acted in bad faith.

The decision in this matter is therefore in favour of the Opponent as the Applicant has failed to establish sufficient grounds for declaring “BEST BUY JAMAICA” invalid. Based on this decision and, without prejudice to any other matter which may take place concerning these marks, “BEST BUY JAMAICA” will remain on the Register.

Costs

The Applicant and Opponent will bear their own costs.

*Kai-Saran Davis
Acting Registrar of Industrial Property
Jamaica Intellectual Property Office*

