

NATIONAL BOOKSTORE INC.  
Opposer,  
-versus-

IPC NO. 14-2011-00040

Opposition to:  
Appln. No. 4-2009-012859  
Date Filed: 20 October 2008  
TM: BEST MOBILE AND DESIGN

BBY SOLUTIONS, INC.  
Respondent-Applicant.  
x-----x

Decision No. 2012- 08

## DECISION

NATIONAL BOOKSTORE INC. (“Opposers”) filed on 08 February 2011 an opposition to Trademark Application No. 4-2009-012859. The application, filed by BBY SOLUTIONS INC. (“Respondent-Applicant”), covers the mark “BEST BUY MOBILE AND DESIGN” for use on goods under Class 35. The opposition is anchored on Sections 123.1 and 123.2 of Republic Act 8293 otherwise known as The Intellectual Property Code of the Philippines.

The Respondent-Applicant filed its Answer on 01 August 2011 refuting the material allegations of the Opposer.

In compliance to Office Order No. 154, s. 2010 (“Rules of Procedure for IPO Mediation Proceedings”) and Office Order No. 197 s. 2010 (“Mechanics for IPO Mediation ad Settlement Period”) thus Bureau issued on 08 August 2011 Order No. 2011-235 referring the case to mediation.

On 16 December 2011, this Bureau received a “MEDIATOR’s REPORT” indicating the successful settlement of the instant case. Attached to the Report is the parties’ “SETTLEMENT AGREEMENT” submitted to this Bureau for approval. The Agreement states, among other things:

“THUS, THE PARTIES HEREBY AGREE, AS FOLLOWS:

“1. National Book Store Inc. and its subsidiaries and affiliates will limit their use only to the goods listed in Schedule 1 (consisting of 3 pages) hereof when they use the following trademarks, namely: BEST BUY & DEVICE CONSISTING OF SEVERAL VERTICAL LINES WITHIN A RECTANGLE (covered by Registration No. 4-1995-103346 which was issued on May 10, 2002); BEST BUY PALS & DESIGN (covered by Registration No. 4-2005-009133, which was issued on January 15, 2007); BEST BUY PALS & DESIGN (IN COLOR) (covered by Registration No. 4-2005-009132 which was issued on January 15, 200); BEST BUY PREMIUM & DEVICE (IN COLOR) under Application No. 4-2009-01249; and such other trademarks bearing the words “BEST BUY” which National Book Store Inc. may apply for in the future subject to the condition In Clauses 2, 3 and 4 below.

“2. National Book Store Inc. and its subsidiaries and affiliates will not use the word mark BEST BUY alone or in a combination with a design similar to BBY Solutions, Inc.’s DEVICES as depicted in Schedule 2 hereof.

“3. National Book Store Inc. and its subsidiaries and affiliates will always use BEST BUY together with the words “NBS”, National Book Store” or any of its affiliates’ and/or subsidiaries’ name/s in the packaging of its products listed in Schedule 1 hereof.

“4. The limitation to the use by National Book Store Inc. and its subsidiaries and affiliates of the trademarks mentioned in Clause 1 to the goods specified in Schedule 1 hereof includes the prohibition of their use of BEST BUY as a service mark or as name of a distribution outlet or stand-alone store.

“5. National Book Store Inc. and its subsidiaries and affiliates shall not object to the use of BBY Solutions, Inc. of BEST BUY as a domain name, particularly [www.bestbuy.com](http://www.bestbuy.com).

“6. National Book Store Inc. and its subsidiaries and affiliates undertake not to use BEST BUY as a domain name.

“7. BBY Solution, Inc. and its subsidiaries and affiliates shall not object to nor oppose the trademark applications of National Book Store Inc. and its subsidiaries and affiliates for the trademarks mentioned in clause 1 above provided the mentioned trademarks’ goods specifications are limited to the goods listed in Schedule 1 hereof.

“8. BBY Solution, Inc. and its subsidiaries and affiliates shall not object to the use by National Book Store Inc. and its subsidiaries and affiliates of the trademarks referenced in Clause 1 and 7 above on posters and other advertising materials provided that such posters and advertising materials relate to the promotion and marketing of the goods in schedule 1 and provided further that when use as such, the name “National Book Store”, “NBS” or any of its affiliates’ and/or subsidiaries’ name/s is/are also clearly used or printed on said posters and advertising materials.

“9. . National Book Store Inc. and its subsidiaries and affiliates forever bind themselves not to use and/or register the trademarks and devices depicted and Schedule 2 hereof, including the RADIO WAVES DESIGN shown in the trademark BEST BUY MOBILE & DEVICES; nor shall National Book Store Inc. and its subsidiaries and affiliates use and/or register for the trademark BEST BUY alone or in combination with other words or devices covering goods other than those listed Schedule 1 hereof.

“10. It is understood however that National Book Store Inc. and its subsidiaries and affiliates shall have the right to use BEST BUY in combination with another words or words or with another device or devices that are not similar to those depicted in Schedule 2, subject to the condition in Clause 3 above.

“11. National Book Store Inc. and its subsidiaries and affiliates shall not object to nor oppose trademark applications filed by BBY Solution, Inc. for the trademarks depicted in Schedule 2 hereof or for other trademarks owned by BBY

Solution, Inc. using variation of the BEST BUY trademark provided that such application do not cover the goods listed in Schedule 1 hereof.

“12. Upon the signing of this Amicable Settlement, BBY Solution, Inc. undertakes to promptly withdraw its opposition, IPC No. 14-2010-00236, to the application for BEST BUY PREMIUM & DEVICE (IN COLOR) under Application No. 4-2009-012749 with filing date of December 11, 2009, National Book Store Inc. shall likewise promptly withdraw its opposition, IPC No. 14-2011-0040, to the application for BEST BUY MOBILE and DESIGN under Application No. 4-2008-012859 with filing date of October 20, 2008.”

This Bureau finds that the Agreement has been duly entered into by the parties with the terms and conditions thereof not contrary to law, morals, good custom, public order or public policy.

In this regard, an approved Compromise Agreement shall have the effect of a decision or judgment on the case and shall be enforced accordingly in accordance with the pertinent rules of IPO and the Rules of Court. (Sec. 5, Office Order No. 154, s. 2010)

WHEREFORE, premises considered, the submitted Settlement Agreement is hereby APPROVED. Accordingly, with the approved SETTLEMENT AGREEMENT having the force and effect of a decision or judgment, the parties are enjoined to faithfully comply with the terms set forth therein. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 January 2012.