CARIBBEAN TRADE MARKS MANUAL

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Introduction

The objective of this project, sponsored by the World Intellectual Property Organisation, is to develop a Caribbean Trade Marks Manual for English-speaking Caribbean Community (CARICOM) countries[1]. The project was divided into the following phases: -

1. Comparative Analysis of Trade Marks Laws across the Caribbean region and submission of topics to be covered in the Manual;
2. Submission of recommendations with respect to Uniform Procedures that may be utilized throughout the region for examination and opposition of trade marks and
3. Preparation of a first draft of the Manual.

The *Comparative Analysis of Trade Marks Laws across the Caribbean Region* is attached as **Appendix I** to this Manual and the *Recommendations with respect to Uniform Procedures* are incorporated within the contents of this Manual.

The relevant international agreements that impact upon trade mark examination within CARICOM are: -

- Nairobi Treaty on the Protection of the Olympic Symbol[2];
- Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks[3];
- Paris Convention for the Protection of Industrial Property[4];
- The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs)[5];
- Singapore Treaty on the Law of Trademarks[6];
- The Trademark Law Treaty[7];
- The Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol)[8] and

[1] The participating countries in this project were Antigua and Barbuda, Barbados, Belize, Bahamas, Dominica, Grenada, Guyana, Jamaica, St. Kitts and Nevis, Saint Lucia, St. Vincent and the Grenadines, Trinidad and Tobago.

[2] The CARICOM countries that are parties to the Nairobi Treaty are Barbados, Jamaica and Trinidad and Tobago.

[3] The CARICOM countries that are parties to the Nice Agreement are Barbados, Dominica, Jamaica, St. Kitts and Nevis, Saint Lucia, Suriname and Trinidad and Tobago. Although Antigua and Barbuda is not a party to the Nice Agreement, the Nice Classification is used for the classification of goods and services.

[4] Fourteen CARICOM countries are parties to the Paris Convention, namely, Antigua and Barbuda, Bahamas, Barbados, Belize, Dominica, Grenada, Guyana, Haiti, Jamaica, St. Kitts and Nevis, Saint Lucia, St. Vincent and the Grenadines, Suriname, Trinidad and Tobago.

[5] Fourteen CARICOM countries are parties to the TRIPs Agreement, see footnote 4 supra.

[6] Haiti is the only CARICOM country that is a party to the Singapore Trademark Law Treaty.

[7] Trinidad and Tobago is the only CARICOM country that is a party to the Trademark Law Treaty.

[8] Antigua and Barbuda is the only CARICOM country that is a party to the Madrid Protocol.

- Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks[9].

Regionally, pursuant to Article 66 '*Protection of Intellectual Property Rights*' of the *Revised Treaty of Chaguaramas Establishing the Caribbean Community including the CARICOM Single Market and Economy*[10]: -

> *'COTED*[11] *shall promote the protection of intellectual property within the the Community by inter alia: -*
>
> *(a) strengthening the regimes for the protection of intellectual property rights and the simplification of registration procedures in the Member States;*
>
> *(b) the establishment of a regional administration for intellectual property rights except copyright'.*

This Manual is therefore a step towards achieving the aforementioned objective under Article 66 of the Revised Treaty of Chaguaramas and the harmonization of trade mark examination practices throughout the CARICOM region.

It must be emphasized that in examining trade mark applications, examiners must comply with the relevant national trade marks law and rules / regulations, case law and any other national laws that impact upon trade mark examination in the respective jurisdictions. International agreements or treaties to which a country is a party, only become effective when national laws are enacted to give effect to the provisions of the international agreement or treaty. This Manual is therefore a guide which may be used to enhance office procedures that comply with national trade marks legislation. The Manual will be divided into the following sections: -

1. Searches of Trade Marks Records
2. Types of Marks
3. Filing of Trade Mark Application
4. Formalities
5. Classification Examination (Vienna Classification[12] and Nice Classification[13])

[9] The CARICOM Countries that are parties to the Vienna Agreement are Jamaica, Saint Lucia and Trinidad and Tobago.

[10] For the complete text of the Revised Treaty of Chaguaramas including Article 66 , please view: - www.wipo.int/edocs/trtdocs/en/caricom/trt_caricom_2.pdf.

[11] Council for Trade and Economic Development.

[12] International Classification of the Figurative Elements of Marks under the Vienna Agreement.

[13] International Classification of Goods and Services for the Purposes of the Registration of Marks (Nice Classification).

6. Search for Prior Rights
7. Substantive Examination (Determination of Registrability)
8. Submission of Evidence (Affidavits or Statutory Declarations)
9. Appeals
10. Publication
11. Opposition
12. Trade Marks Register and Certificate of Registration
13. Registration of United Kingdom Registered Trade Marks
14. Assignments, Mergers, Change of Name, Change of Address
15. Renewal
16. Madrid Protocol
17. Practice Directions

1. Searches of Trade Marks Records

Intellectual Property Offices (IPOs) should provide a means by which members of the public may conduct searches of Trade Marks records. This search may be conducted manually or electronically by a review of the relevant documentation at the IPOs which may be searched by the public e.g. Trade Marks Registers / pending Trade Marks Summary Sheets / Trade Marks Index Cards / Trade Marks books. In some jurisdictions, the search may be conducted or initiated online[14].

In Jamaica, a request may be submitted to the IPO, for the IPO to conduct the preliminary search and provide advice, based on the payment of the prescribed fee. The applicant must submit a copy of the mark to be searched with the request, together with details of the Classes, goods and/or services to be searched.

It is incumbent upon an IPO to ensure that records which may be searched by the public are updated in a timely manner and are accessible to the public. Applicants and/or their representatives should be encouraged to conduct pre-application searches to identify any similar or potentially confusing marks prior to filing a trade mark application.

2. Types of Marks

National legislations provide express definitions of what is a trade mark[15]. Simply stated, a trade

[14] In Trinidad and Tobago, the search may be conducted completely online at www.ipo.gov.tt and in Belize, a search request form may be submitted online at www.belipo.bz with the search request.
[15] See Appendix I.

mark is any sign which is capable of distinguishing the goods or services[16] of one individual or entity from those of another. Applications may be filed for the protection of trade marks, certification marks[17] and collective marks[18].

A certification mark is a mark that indicates the goods or services in connection with which it is used, are certified by the proprietor of the trade mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics. The mark may be used by anyone who may certify that the product or service complies with the defined standards. 'Jamaica Blue Mountain' is a certification mark owned by The Coffee Industry Board of Jamaica. The following certification marks are owned by The Competitiveness Company of Jamaica: -

Sauces & Spices	**Scotch Bonnet Pepper**	**Honey**
Processed Ackees	**Generic**	

The Regulations governing the use of the 'Jamaica Finest certified' trade marks limit their use to "goods which are of Jamaican origin and have been manufactured in Jamaica in conformity with the standards outlined in the Jamaica Certification programme covering the particular good to ensure that it is safe, unadulterated, or premium quality and authentically Jamaican".

[16] A trade mark application may be filed in relation to goods or services in Antigua and Barbuda, Barbados, Belize, Bahamas, Dominica, Grenada, Jamaica, St. Kitts and Nevis, Saint Lucia, St. Vincent and the Grenadines, Trinidad and Tobago. In the Bahamas and Guyana, a trade mark application may be filed only in relation to goods. In Guyana a service mark may only be registered if it is based on a prior United Kingdom registration and it will be registered in Guyana under Part C of the Trade MarksRegister.

[17] Filing of a trade mark as a certification mark is not listed in the Antigua and Barbuda Trade Marks Act No. 18 of 2003, Dominica Trade Marks Act No. 12 of 1999 or the St. Kitts and Nevis Trade Marks Act Cap. 18:22.

[18] Filing of a trade mark as a collective mark is not listed in the Bahamas Trade Marks Act Ch. 322.

A collective mark is a mark that distinguishes the goods or services of members of an organisation, which is the proprietor of the trade mark, from those of other organisations. A collective mark is usually owned by an association or any other entity, such as a public institution or a cooperative, for example: -

The following collective marks are owned by the Jamaica Exporters Association and managed by The Competitiveness Company of Jamaica: -

The Saint Lucia, Guyana and St. Vincent and the Grenadines legislations refer to defensive trade marks. The registered proprietor of a mark, may apply for the defensive registration of the trade mark, if, based on the notoriety of the mark, it is likely that use in relation to other goods or services, will be taken to indicate a connection between those other goods or services and the registered proprietor of the trade mark. Defensive registrations are usually applied for in relation to well-known marks which are registered in particular Classes, however, the unauthorized use of the mark in relation to other goods or services, is likely to suggest a connection to the registered proprietor of the mark.

In the Bahamas, Dominica, Guyana, Jamaica, Saint Lucia, St. Vincent and the Grenadines and Trinidad and Tobago, a series of trade marks is registrable in one application. A series of trade marks is a number of trade marks which resemble each other as to their material particulars but

differ only as to matters of a non-distinctive character, not substantially affecting the identity of the trade mark e.g. colour, fonts and statements related to number, price, quality or locations. The following reproduction of marks constitutes a series mark: -

There are various types of marks as follows: -

2.1 Word Marks

A word mark is a trade mark that consists of words only without any accompanying design or graphics, for example: -

LIAT

or

WESTERN UNION

2.2 Design / Device Marks

A design / device mark is a mark which consists of a graphical / pictorial representation without any accompanying words, for example, Usain Bolt's "Lightning Bolt" pose: -

2.3 Word and Design / Device

Word and design / device marks, otherwise known as combination marks or mixed marks, are marks which are comprised of words and pictorial elements, for example: -

2.4 Colour Marks

Colour marks are marks which are filed in colour and which may have any or all of the elements identified at 2.1 – 2.3 above or the mark for registration may be a particular colour, that is used or proposed to be used to identify the goods and/or services of the trader. Applicants should be required to identify the colours in the mark and if possible, refer to the colour definition standards such as the Pantone system, RAL colour chart, or RGB colour system.

2.5 Hologram Marks

Hologram marks are marks which change in appearance e.g. colour or form, when viewed from different angles. Hologram marks typically appear on currency notes, credit cards, tickets, packaging of pharmaceutical products and anti-piracy labels. A hologram mark should not be accepted for registration if the examiner perceives that it may be considered as more than one trade mark.

2.6 Non-Traditional Marks: Sound, Scent, Motion, Touch (tactile) and Taste

Sound, scent, motion, touch (tactile) and taste marks must be capable of graphical representation in order to be filed at the IPOs. The IPOs within CARICOM do not as yet accept audio files (for sound marks) or swatch samples (for scent marks) or .gif files or videos (for motion marks) or taste marks.

Therefore, in order to file an application for a sound, the applicant's graphical representation of the sound may include the musical score, a written description of the sound and/or an image of the instrument on which the sound is played.

Scent marks may consist of a written description that describes the scent clearly or the chemical formulation that creates the particular scent in order to differentiate the scent from other scents.

Motion marks may be filed by submitting a series of graphical images that represent the motion with a written description of the movement, provided that the IPO's legislation allows the filing as a series mark or the examiner is of the view that the various images represent one mark, as opposed to requesting that separate trade mark applications be filed for each moving image.

Touch marks may be represented graphically through a written description of what the mark feels like, with a clear and unambiguous description of the touch characteristics in order to differentiate it from other touch marks. A mark submitted in braille may be considered as a touch mark.

Taste marks should consist of a written description of the taste or the chemical formulation that produces the particular taste.

In practice, the IPO will have to determine whether the submitted representation of the mark (sound, scent, motion, touch or taste) complies with the definition of a trade mark and meets the criteria for registrability under the national trade marks law.

The majority of applications filed at the IPOs usually fall under one or a combination of the categories listed at 2.1 – 2.4 above.

3. Filing of Trade Mark Application

There are minimum requirements for the filing of a trade mark application. Typically, these minimum requirements require the completion of a prescribed form that includes: -

- Applicant's name and address;
- Representation of the mark;
- Specification of goods and/or services;
- Applicant's country of nationality / State of Incorporation (if a company);
- A signature and
- Priority claim, if any

and the payment of filing fees for the trade mark application.

Some jurisdictions have additional requirements in relation to the type of agent who may file a trade mark application. In Guyana, only the applicant or a registered trade mark agent may file a trade mark application. In order to be a registered trade mark agent in Guyana, there is a registration fee of Twenty Five United States Dollars (US$25.00), which is an annual fee in order to practise as a trade mark agent. A licence to practise as a trade mark agent is issued by the Commercial Registry, Intellectual Property Office of Guyana. The prescribed licence is attached as **Appendix II** to this draft Manual. In Antigua, Belize, Dominica, St. Kitts and Nevis, Saint Lucia and St. Vincent and the Grenadines, a trade mark agent must be an Attorney-at-Law.

The trade mark application form may include a declaration that the mark is being used by the applicant or with his consent or that there is a bona fide intention that it will be used for the goods and/or services listed in the application. In Belize, Saint Lucia, St. Kitts and Nevis and St. Vincent and the Grenadines, the applicant must indicate that there is an intention to use the mark on the prescribed application form.

If the application is filed directly by the applicant, the applicant's address contained in the application is used as the address for service of all correspondence between the IPO and the applicant. However, if the application is filed by a trade mark agent, a document authorizing the agent to file the application is usually required with an address for service. In Dominica, Guyana, Jamaica and St. Kitts and Nevis, the Authorisation of Agent must be filed with the trade mark application. However, in some jurisdictions, such as Trinidad and Tobago, the Authorisation of Agent may be filed subsequent to the filing of the trade mark application but prior to the substantive examination of the application. In Jamaica, applicants must supply some form of identification e.g. a driver's permit, identification card or passport, for all transactions with the IPO.

In each IPO, a standard checklist of the minimum requirements for the filing of a trade mark application should be created. A specimen form for the checklist, which should be tailored according to national trade mark law requirements, is attached as **Appendix III** to this draft Manual. As the trade mark application is received, the application should be reviewed by the

officer who receives the application, to determine whether the minimum requirements for filing the application have been fulfilled.

If the trade mark application may be filed electronically, there should be triggers in the online form that prevent the applicant from submitting the application, until all the minimum requirements are fulfilled. In Belize, a trade mark application may be filed online at www.belipo.bz . The applicant must notify the Belize IPO of the format of the applicant's electronic signature, which may be comprised of a combination of letters, numbers, spaces or punctuation marks placed between two forward slash (/) symbols. In Trinidad and Tobago, a trade mark application may be filed by facsimile transmission, however, the applicant must submit the hard copy of the application within one month of sending the application by facsimile transmission.

Once the minimum requirements have been met, the trade mark application number should be assigned together with the filing date. If the minimum requirements are not met, the trade mark application number and filing date should not be assigned until such time as all the minimum requirements are fulfilled. It should be noted that in Antigua and Barbuda[19], Grenada[20], Belize[21], Jamaica[22], Saint Lucia[23] and Trinidad and Tobago[24] there are express provisions that indicate what is deemed to be the date of filing of the trade mark application.

In order to be assigned the filing date and trade mark application number, the fees for the filing of the trade mark application must be paid. If the filing fees are not paid, the filing date and trade mark application number should not be assigned. In Barbados, the date of payment of the filing fees for the trade mark application, is deemed to be the filing date of the trademark.

The IPO should issue a receipt that identifies the trade mark application number and the payment of the fees associated with the filing of the trade mark application.

Each trade mark application should be placed in a separate folder and all issues related to the trade mark should be logged on the file, where hard copy files are maintained of trade marks.

In the file, there should be a form where the relevant examiner logs the date that the file is examined, the particular area of examination that is conducted by the examiner and the examiner signs the file accordingly. A specimen form is attached as **Appendix IV** to this draft Manual.

[19] Regulation 15, Trade Marks Regulations 2006.
[20] Regulation 15, Trade Marks Regulations No. 18 of 2012.
[21] Section 13, Trade Marks Act Cap. 257.
[22] Section 17, Jamaica Trade Marks Act No. 32 of 1999.
[23] Sections 2 and 34, Trade Marks Act No. 22 of 2001.
[24] Section 5(4), Trade Marks Act No. 8 of 2015.

A trade mark summary sheet / document should be created that includes all the pertinent information in relation to the trade mark which members of the public may view, if a member of the public has to conduct a search relative to a particular trade mark. The trade mark summary sheet should include the trade mark application number, the date of filing, representation of the mark, specification of goods and/or services, applicant's name and address, the trade mark agent's (if applicable) name and address for service and the general status of the application e.g. if the mark is accepted, refused or published.

If an automated database is used to record all actions relative to a trade mark, all information on the trade mark must be entered into the database from the time of filing, including the representation of the mark. The database should be updated each time there is activity on the file relative to the trade mark.

Trade mark applications should be examined in order, as far as possible, according to the filing date of the trade mark application (earlier applications being examined prior to later applications), unless the application to be reviewed should not progress, due to the fact that the applicant has to submit a response.

4. Formalities

The formalities examination should be conducted as soon as possible after the filing of the trade mark application, preferably within one (1) to three (3) months of the filing of the trade mark application.

Issues relative to formalities may include: -

- Misspellings in the trade mark application form;
- Incomplete documentation e.g. insufficient representations of the mark, failure to supply an Authorization of Agent, failure to complete sections of the form;
- Requesting a clearer depiction of the mark;
- Failure to supply a priority document where priority is claimed in the application;
- Requesting a translation or transliteration of the mark if the mark is not written in English;
- Omission of the applicant or trade mark agent's signature on the application form;
- Removal of the trade mark symbols ™ or ® from the mark[25];

[25] In Jamaica, the removal of trade mark symbols is not required during formalities examination. The practice is to request the removal of the registration symbol during substantive examination unless the examiner is satisfied that the mark was registered in another jurisdiction.

- Requests for submission of the rules[26] governing the use of a certification mark or collective mark.

The examiner who identifies the formalities issues should seek to provide a comprehensive list of issues that must be addressed by the applicant before the application moves forward to examination of the specification of goods and/or services.

In Dominica, if a mark is not filed in English, the translation of the mark must be stated on the trade mark application form. In Barbados, St. Kitts and Nevis and St. Vincent and the Grenadines, all translations must be verified / certified by a translator. In Antigua and Barbuda, the translation must be notarized and include the translator's stamp.

Even if the applicant has a grace period to submit the required documentation (e.g. an Authorisation of Agent or a priority document), a letter should be issued to the applicant or the applicant's agent, identifying the issue to be addressed and providing the deadline date for submission of the response.

Most IPOs issue official letters as the primary means of communication with the applicant or agent. In Jamaica, e-mails are utilised, in addition to official letters. In Belize, e-mails are utilised only in relation to disclaimers.

Once formalities have been completed, the examiner should confirm with a file note[27] that the formalities examination was completed satisfactorily and then the file moves forward to examination of the specification of goods and/or services. The automated database should be updated to reflect the completion of the formalities examination.

[26] In Jamaica, an applicant has nine months within which to file the rules associated with a certification mark. Therefore, the rules are not requested at the formalities stage.

[27] See Appendix IV.

5. Classification Examination (Vienna Classification[28] and Nice Classification)

The figurative (design / device) elements of the mark are classified according to the Vienna Classification. This is an important aspect of the examination process since it impacts upon the searches for prior rights as it relates to the figurative elements of the mark.

Some trade mark application forms allow the applicant to describe the mark. This description is particularly useful for Vienna Classification, because it gives the examiner, the applicant's perspective of what the mark represents. If an examiner is in doubt in relation to what the mark represents, it is recommended that the examiner requests that the applicant / applicant's agent describe the mark. This description will then assist the examiner in classifying the figurative elements of the mark. Dominica, Guyana and St. Kitts and Nevis do not utilize the Vienna Classification.

The Nice Classification of Goods and Services indicates the international classification system for goods and services. An applicant must include a list of goods and/or services in the trade mark application. In some jurisdictions, multi-class applications[29] may be filed whereas in other jurisdictions[30] separate applications must be filed for each Class of goods and/or services. In reviewing the application, the examiner must ensure that the Class number is correct and that the list of goods and/or services fall within the particular Class.

Where goods and/or services do not belong to a particular Class, the applicant is required to remove the goods from the Class. During the examination of the specification, the examiner may request the applicant to delimit the goods/services to make them more specific, remove goods or transfer goods/services between Classes. National law may allow the applicant to add additional Classes to the specification of goods and/or services subject to the payment of prescribed fees. In Grenada and Guyana, applicants are allowed to add goods within the same Class. However, such a practice should not be allowed because the applicant is expanding the goods within the Class.

Examiners have deemed the following Class specifications to be acceptable: -

- Class 5 "herbal tea for medicinal purpose; vitamin drinks"
- Class 25 "belts [clothing]; boots (heelpieces for-); boots (welts for-); shoes (welts for-); soles for footwear; sports shoes; clothing made of all kinds of materials for general purpose wear"

[28] See footnote 9 supra.

[29] Antigua and Barbuda, Belize (maximum of five classes per application), Dominica, Grenada, Guyana (only if based on a prior U.K. registration), Jamaica, St. Kitts and Nevis, Saint Lucia, St. Vincent and the Grenadines, Trinidad and Tobago.

[30] Separate applications must be filed for each Class of goods in Barbados and Guyana. In Guyana, if the application is based on a prior UK registration and the U.K. registration contained more than one class, the mark may be accepted with the multiple classes.

- Class 30 “Fruit jellies [confectionery]; macaroon [pastry]; sweets (confectionery); caramels (candy); rolls (bread); pasties (pastry).

- Class 32 “Energy drinks; aerated water; malt-based beverage; isotonic beverages; non-alcoholic beverages; fruit juices; fruit beverages; all being non-alcoholic beverages”

- Class 33 “Alcoholic beverages (except beers)”

- Class 42 “Providing temporary use of online non-downloadable computer software for payment processing, user authentication and management of payment transactions; providing temporary use of online non-downloadable software for electronic communication regarding payments and transactions.

A specification that simply states ‘All goods in Class 25’, for example, is not acceptable since it will give the applicant an absolute monopoly over all the goods in the Class, if the mark is registered. Examiners are encouraged to ensure that an applicant is as specific as possible in identifying the goods and/or services in relation to which the mark will be used in the trade mark application.

Although some IPOs within CARICOM accept the entire Class headings as an acceptable Class specification, this practice should be discouraged since the reproduction of Class headings is deemed to be too broad and vague. It is therefore recommended that applicants who reproduce Class headings should be requested to identify the exact goods and/or services in relation to which the mark will be used. Examples of some acceptable Class specifications of published marks are attached as **Appendix V** to this Manual. For the Classes in relation to which most trade mark applications are filed in a particular jurisdiction, examiners may consider developing an internal list of acceptable Class specifications, which would serve as a reference point for all examiners in the IPO. The internal list would be used in tandem with the Nice Classification.

There may be words that are used in one’s jurisdiction which are not in the Nice Classification, for example, *paime*[31], *johnny cake*[32], *bammy*[33], however, it is understood in the particular jurisdiction what the particular word means. In creating an internal list of acceptable Class specifications, the IPO should seek to determine the relevant classes into which those indigenous

[31] Trinidad and Tobago sweet delicacy made of cornmeal, flour, coconut, raisins, sugar and other ingredients and steamed in a banana leaf.
[32] A mixture of flour, water, baking powder, salt and corn meal which is baked.
[33] Jamaican cassava flat bread.

goods / services will be placed and maintain the use of those indigenous words in the Class specification. Internal lists of acceptable Class specifications may be shared between IPOs with the ultimate aim of creating a regional database of goods and services.

The use of definite terms such as 'namely[34]', 'specifically' and 'consisting of' are acceptable, followed by named goods and may be used to make the specification more specific. Indefinite terms such as 'and the like', 'etc.', 'and similar goods/services', 'related to' should be deleted from the specification.

Examiners should ensure that the specification of goods and/or services is delimited in accordance with the relevant edition of the Nice Classification that is used by the IPO based on its national trade marks law.

The letter that is issued to the applicant on the specification issue should seek to address clearly all issues related to the specification of goods and/or services.

The Registrar / Controller's / Executive Director's decision on the specification of goods and/or services is final[35] in certain jurisdictions.

Some countries[36] do not utilize the Nice Classification but use their own classification system as contained in their national trade marks law.

The Vienna Classification of the mark and the examination of the specification of goods and services should be conducted within six (6) months of the filing of the trade mark application.

The automated database should be updated when the classification examinations are completed.

[34] For example, in Class 11 'Electrical appliances, namely espresso makers, coffee makers, kettles, teapots'.

[35] Section 14, Belize Trade Marks Act Cap. 257; Section 18, Jamaica Trade Marks Act No. 32 of 1999; Section 5(1)(c), St. Kitts and Nevis Marks, Collective Marks and Trade Names Act Cap. 18.22; Section 16, Saint Lucia Trade Marks Act No. 22 of 2001; Section 7, Trinidad and Tobago Trade Marks Act No. 8 of 2015.

[36] Bahamas and Guyana maintain their own local classification systems as contained in their national trade marks laws. However, in Guyana, trade marks already registered in the United Kingdom (U.K.) utilizing the Nice Classification may be registered in Guyana with the same Classes as contained in the U.K. registration.

6. Search for Prior Rights

The search for prior rights is required to identify any prior identical or confusingly similar marks to the applicant's trade mark. The search should be done via an automated database such as WIPO's Industrial Property Automated System (IPAS). The search report identifies all marks that are identical or similar to the applicant's trade mark. The examiner should identify all marks that were either registered prior to the applicant's mark or marks that possess an earlier filing date that are pending registration, which are identical or confusingly similar to the applicant's mark. The search for protected emblems under Article 6ter of the Paris Convention should also be conducted and any similar or identical protected emblems identified in the search report.

In Guyana, device marks are searched manually through picture books and word marks are searched electronically through IPAS. In St. Kitts and Nevis, device marks are searched manually in the relevant search books.

If a mark is filed in a foreign language or non-English alphabet characters, a search should be conducted for the English translation of the mark and that search report must be included for review by the examiner, in addition to the search report of the foreign language words or non-English characters.

Refusal of the mark on the grounds of identical or confusingly similar marks is one of the relative grounds for the refusal of the mark. Considerations relative to assessing the similarity of marks are detailed under substantive examination.

In reviewing the list of identical or similar marks, the examiner should ensure that only active marks are identified as a ground for refusal of a trade mark. Trade marks that are removed from the Register or deemed abandoned should not be cited.

The automated database should be updated when the search for prior rights is completed.

7. Substantive Examination (Determination of Registrability)

The substantive examination of the trade mark application should not be conducted unless all the previous processes were conducted, that is, formalities, Vienna Classification (if applicable), Nice Classification and the search for prior rights.

In conducting the substantive examination, the examiner should identify all the grounds for the refusal of the mark and provide a cogent refusal that identifies the relevant sections of the law, any applicable case law[37] and learning relative to the refusal of the mark.

In the first instance, in preparing a refusal, the examiner should review the search report and cite any active identical or confusingly similar trade marks in the name and/or address of a different proprietor. Where there are identical or confusingly similar marks, the examiner should cite the trade mark number, the name of the mark and the name of the owner of the mark together with the applicable section of the national law that bars the registration of identical or confusingly similar marks and any relevant case law.

Where there are discrepancies vis a vis the address or owner's name of the prior registered or earlier pending marks, those marks should still be cited even where the examiner may be of the view that the previous marks and the mark that is being examined may be owned by the same proprietor. The onus is upon the applicant to demonstrate to the examiner that the marks are owned by the same entity. Where the mark being cited as a relative ground for refusal may contain figurative elements and it is possible to print the mark, the specimen of the mark should be included in the objection letter to the applicant.

All applicable relative and absolute grounds for refusal of the mark should be cited in the same refusal letter. Therefore, a refusal letter may contain more than one ground of refusal. The refusal letter should cite the relevant section of the national law and any case law that supports the refusal of the mark.

The applicant should be given an opportunity to respond to the refusal within a specific timeframe as indicated in the national law. In order to ensure that the application moves along the examination process and that refused marks are not reconsidered several times, the office should indicate the number of times that the refusal of a mark will be reconsidered, subject to the payment of a fee, with an increased fee for a second reconsideration, after the first reconsideration. It is therefore recommended, if not included already in the national law, that there

[37] In Trinidad and Tobago, case law is not cited in the first refusal response from the IPO.

should be a fee paid for the reconsideration of a refusal of the trade mark and that there is a maximum limit of reconsiderations that may be requested at the IPO. The applicant / the applicant's agent may, in the alternative, be given an opportunity to be heard orally if the national law permits.

An acceptance letter (without conditions) usually details the trade mark number that was accepted, name of the mark, its filing date, the applicant's name, address and details of the goods and/or services in relation to which the mark will be published.

If a trade mark is accepted subject to certain conditions e.g. a disclaimer, the applicant will be given a timeframe within which to comply with the condition. The exact wording of the condition should be detailed in the acceptance letter together with the timeframe for submitting the required document in reply.

The automated database should be updated when the substantive examination is completed to reflect the current status of the mark.

The absolute grounds for refusal of a trade mark application are: -

- Signs which do not satisfy the definition of a trade mark under the country's national law;
- Trade marks which lack distinctiveness or are incapable of distinguishing the applicant's goods or services;
- Trade marks which consist exclusively of signs or indications that serve to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production or of rendering of services or other characteristics of goods or services;
- Signs which have become customary in the current language or in the bona fide and established practices of the trade;
- Signs which consist exclusively of the shape, which results from the nature of

goods or which are necessary to obtain a technical result or give substantial value to the goods or services;

- Signs which are contrary to public policy or morality;
- Signs which may deceive the public as to the nature, quality or geographical origin of the goods or services;
- A trade mark, the use of which is prohibited by national law;
- Applications filed in bad faith;
- Applications that contain or consist of a geographical indication and the trade mark is used or intended to be used in relation to goods or services not originating from the place indicated in the geographical indication;
- Signs which consist of or contain a representation of the Coat of Arms, national flag or other national symbols of the country;
- Signs which consist of protected emblems under Article 6ter of the Paris Convention or armorial bearings, flags or other emblems unless permission is received from the relevant competent authority of the other country.

The relative grounds for refusal of a trade mark application are that the mark: -

- is identical to an earlier trade mark and the goods or services are identical with those for which the earlier trade mark is protected;
- is identical to an earlier trade mark and the goods or services are similar to those for which the earlier trade mark is protected and there exists a likelihood of confusion on the part of the public;
- is similar to an earlier trade mark and the goods or services are identical 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;
- is identical or similar to an earlier trade mark that is well-known and the goods or services are not similar, however the registration of the mark would indicate a connection between those goods or services and the proprietor of the earlier mark, there exists a likelihood of confusion on the part of the public because of such use and the interests of the proprietor of the earlier mark are likely to be damaged;
- conflicts with any rule of law (in particular, the law of passing off) protecting an unregistered mark or other sign used in the course of trade;
- conflicts with an earlier right, in particular the law of copyright or any law in relation to the trade mark.

In this draft of the Manual, I will outline the considerations to be addressed in determining similarity of marks and considering whether a mark is well-known and begin to address the absolute grounds for refusal of a trade mark.

7.1 Relative Grounds for Refusal of a Trade Mark

7.1.1 Similarity of Marks

In assessing the similarity of the marks, the examiner must review the visual, phonetic and conceptual similarities of the marks in light of the goods and/or services and the channels of trade. In *Pianotist Co.'s Application (Pianola),* [1906] 23 R.P.C. 774, it was stated: -

> "*You must take the two words. You must judge of them both by their look and their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in the normal way as a trade mark for the goods of the respective owners of the mark. If, considering all those circumstances, you come to the conclusion that there will be confusion in the mind of the public, which will lead to confusion in the goods – then you may refuse the registration, or rather you must refuse the registration". @ page 777.*

In *Sabel* v. *Puma* [1998] E.T.M.R. 1, it was stated: -

> *"In determining whether there is a likelihood of confusion, the court must focus on the overall impression made by the respective signs. It is not permissible to isolate one element out of a graphic ensemble and to restrict examination of the*

likelihood of confusion to that element alone. However, an individual component may be recognized as having a particularly distinctive character which characterizes the sign as a whole, and, consequently, a likelihood of confusion may be found to exist if another party's sign resembles the whole of the sign so characterized. Even in such a case, however, the two signs must be compared in their entirety and the comparison must not be confined to their individual (characterizing) elements." @ page 8.

In assessing the similarities of marks, the mark must be assessed as a whole, as opposed to dissecting the mark into its constituent elements, unless the elements are likely to cause confusion in relation to the source of the goods and/or services. In reviewing the visual and phonetic similarities of the mark, greater emphasis is placed on the beginning of marks, rather than the ending of the mark, bearing in mind the imperfect recollection of the consumer. The channels of trade are important. For example, the likelihood of confusion is usually less between two pharmaceutical products where one product is sold by prescription and the other is sold over the counter. Similarly, in relation to luxury items and more expensive goods, the consumer is likely to pay more care and attention in purchasing the product or service and as a result, the likelihood of confusion is usually less.

In Jamaica, *In The Matter of Application No. 44756 by Egis Gyogyszerggyar RT to Register a Mark* in Class 5, the applicant's trade mark 'Parlazin' in Class 5 for "pharmaceutical preparations for human use" was opposed based on the trade mark 'Baralagin' in Class 5 for "pharamaceutical, veterinary and hygienic preparations andsubstances".

In referring to *Sabel* v. *Puma* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha* v. *Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1 and *Lloyd Schufabrik Meyer & Co. GmbH* v. *Adidas AG* (2000) E.T.M.R. 723, it was stated by the examiner: -

"*It is clear from these cases that: -*

(a) the likelihood of confusion must be appreciated globally, taking into account of all relevant factors; Sabel v. Puma AG page 8, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; Sabel v. Puma page 8 paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant but who rarely has the chance to make direct comparisons between marks and must instead reply upon the imperfect picture of them he has kept in mind; Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V. page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; Sabel v. Puma AG page 8;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; Sabel v. Puma AG page 8, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a degree of similarity between the goods, and vice versa; Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc. page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; Sabel v. Puma AG page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of section 5(2); Sabel v. Puma AG page 8, paragraph 26;

(h) but if the association between the marks cause the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; Canon Kabushiki

Kaisha v. Metro-Goldwyn-Meyer Inc. page 9, paragraph 29".
@ page 4, paragraph 17.

The examiner, Edward G. Brightly, Acting Registrar, of the Jamaica Intellectual Property Office, found that the goods of the both marks were similar, that the marks themselves were similar and that there would be a likelihood of confusion in relation to the applicant's mark. The Opposition was therefore upheld.

The complete decision is attached as **Appendix VI** to this Manual.

In the Jamaican case, *Claim No. 2013 HCV 00372 In the Matter of the Trade Marks Act, 1999 In the Matter of Application No. 47,769 to register the trade mark '3M & Design' in classes 7, 11 and 12 in the name of Manufacturers 3M, S.A. de C.V. of Av. José B. Lizardi, Zona Industrial, 94640, Córdoba, Veracruz, Mexico and Opposition No 36/TM 2008 filed by the 3M Company, In the Matter of an Appeal against the decision of the Registrar of Industrial Property dated 21 December 2012 between 3M Company and Manufacturera 3M S.A. de C.V. and Registrar of Industrial Property*, Justice Sykes stated that in assessing the similarity of marks: -

> *"all the relevant factors relating to the goods must be taken into account including their nature, their end users and their method of use and whether they are in competition with each other or complementary." @ page 39, paragraph 14.*

In summary, in making a determination on the similarity of marks, the examiner must compare the visual and phonetic similarity of the marks, the goods and/or services of the marks, the channels of trade for the marks and assess the likelihood of confusion on the part of the public.

7.1.2 Well-Known Marks

All the trade marks legislations of the English-speaking CARICOM countries contain provisions relative to well-known marks, the genesis of which lies in Article 6bis of the Paris Convention as follows: -

> ***"Article 6bis***
> ***Marks: Well-Known Marks***
>
> *(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.*
>
> *(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.*
>
> *(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith"*

In Belize, in Civil Appeal No. 1 of 2009, *In the Matter of The Trade Marks Act, Cap. 257 Laws of Belize, Revised Edition 2000 and In the Matter of Application No. 5082.07 by British American Tobacco (Brands) Limited to register The Trademark and the Opposition thereto by Philip Morris Products S.A.*[38], it was stated by the Honourable Chief Justice, Abdulai Conteh in reviewing Article 6bis of the Paris Convention that: -

> *"The issue therefore always in the case of a well known mark is: does the other mark (in this case BAT's application for its EMBASSY mark) constitute* ***a reproduction***, ***an imitation*** *or* ***a translation likely to create confusion*** *with Philip Morris's admittedly well known MARLBORO Mark? A subsidiary but important question as well is:* ***does the essential part of BAT's EMBASSY mark constitute a reproduction of Philip Morris' MARLBORO Mark or an imitation liable to create confusion***

[38] See Appendix VI.

with the latter? That is to say, is BAT's trade mark identical to or similar to Philip Morris; in the instant case?" @ page 17, paragraph 36.

The Court of Appeal in Belize maintained the Registrar's decision that the Embassy and Marlboro marks were dissimilar and dismissed Philip Morris' appeal.

In interpreting what constitutes a well-known mark, the English-speaking CARICOM countries apply the *Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks* adopted by the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organisation at the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO September 20 to 29, 1999, that provides under Article 2, the following matters for consideration in determining whether a mark is well-known in a Member State: -

"(1) [Factors for Consideration] (a) In determining whether a mark is a well-known mark, the competent authority shall take into account any circumstances from which it may be inferred that the mark is well known.

(b) In particular, the competent authority shall consider information submitted to it with respect to factors from which it may be inferred that the mark is, or is not, well known, including, but not limited to, information concerning the following:

1. *the degree of knowledge or recognition of the mark in the relevant sector of the public;*
2. *the duration, extent and geographical area of any use of the mark;*
3. *the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods*

and/or services to which the mark applies;

4. *the duration and geographical area of any registrations, and/or any applications for registration, of the mark, to the extent that they reflect use or recognition of the mark;*
5. *the record of successful enforcement of rights in the mark, in particular, the extent to which the mark was recognized as well known by competent authorities;*
6. *the value associated with the mark.*

(c) The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in subparagraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.

(2) [Relevant Sector of the Public] (a) Relevant sectors of the public, shall include. but shall not necessarily be limited to:

(i) actual and/or potential consumers of the type of goods and/or services to which the mark applies;
(ii) persons involved in channels of distribution of the type of goods and/or to which the mark applies;
(iii) business circles dealing with the type of goods and/or services to which the mark applies.

In Belize, *In the Matter of Registration No. 7351.10 by Medizinisch-technishe Handelsgellschaft mbH (Medi plus Tec) of the trademark: EMPIRE and the Invalidation thereto by BAT Caribbean*

S.A.[39], BAT Caribbean S.A. (BATC) applied to invalidate trade mark no. 7315.10 on the grounds, inter alia, that BATC's Empire mark was well-known and qualified for protection under the Paris Convention, and sections 38(1)(b) and 61 of the Belize Trade Marks Act. BATC's invalidation application was not successful and the Deputy Registrar stated inter alia that: -

> *"Section 38(1)(b) provides that an earlier trade mark in which priority is claimed, is a trade mark entitled to protection under the Paris Convention as a well known trade mark. Section 61, which speaks to the protection of well known trade marks under Article 6bis of the Paris Convention, states that references to a trade mark which is entitled to such protection are to a mark which is well- known in Belize. The existence of "well-known marks" within the meaning of Article 6bis of the Paris Convention is to be assessed "in a Member State".*
> *Hence, while the proprietor of said mark does not have to carry on business or have any goodwill in Belize, it must be established that the mark is well known in Belize.*
>
> *In Case C-328/06 Alfredo Nieto Nuno v Leonci Monlleo Franquet, it was decided that the existence of "well known marks" under Article 6bis of the Paris Convention is to be interpreted as meaning that the earlier trade mark must be well known throughout the territory of the Member State of registration or in a substantial part of it.*
>
> *The scope of section 61 was also considered in General Motors Corp v Yplon SA (CHEVY) [1999] ETMR 122 and [2000] RPC 572, wherein it was the Advocate General Jacobs' opinion that as the protection of well known marks under the Paris Convention and TRIPS is an exceptional type of protection afforded even to unregistered marks, it would be proper that the requirement of being well known imposed a relatively high standard for a mark to benefit from such exceptional protection, there being no such consideration in the case of marks with a reputation. Thus the burden of proof that a mark is well known is very high". @ page 10.*

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[39] The decision is published online at http://www.belipo.ba/wp-content/uploads/2015/03/Invalidation-No-1-of-2014.pdf

The aforementioned decision established that the mark must be well-known in Belize, the burden of proof is high and the person / entity making an assertion that its mark is well-known must provide the relevant evidence in that regard.

In the Jamaican case, *Claim No. 2013 HCV 00372 In the Matter of the Trade Marks Act, 1999 In the Matter of Application No. 47,769 to register the trade mark '3M & Design'***,** Justice Sykes stated that well-known marks: -

> *"receive additional protection because they are well known. There is no need to prove a likelihood of confusion and the protection applies to similar and identical goods or services once the marks can be said to be similar enough to have the effect that the relevant section of the public established a link between the well known mark and the questioned mark." @ page 40.*

A mark may be refused, opposed or invalidated on the basis of an earlier mark which is well-known in the particular jurisdiction. In assessing the issue of whether or not a mark is well known, an assessment has to be made of whether the mark is well known in the particular jurisdiction based on the evidence provided.

7.2 Absolute Grounds for Refusal of a Trade Mark

7.2.1 Definition of a Trade or Service Mark

In all the jurisdictions, the terms "mark" or "trade mark" are defined in section 2 of the respective Trade Marks Act. In order for a mark to be registrable, it must comply with the trade mark definition as contained in the Trade Marks Act. The definition of a trade mark refers to goods or services, except in Bahamas and Guyana, where the definition of a trade mark refers to goods only.

In Dominica, a mark is defined as "any visible sign capable of distinguishing the goods ("trademark") or services ("service mark") of an enterprise". In Grenada, a trade mark is defined

as "(a) any sign capable of being represented graphically, which is capable of distinguishing good or services of one undertaking from those of other undertakings; (b) a collective mark; or (c) a certification mark, and may in particular, consist of words (including personal names) designs, letters, numerals or the shape of goods or their packaging". In Jamaica, a trade mark is defined as "any sign that is capable of being graphically represented and capable of distinguishing the goods or services of one undertaking from those of another undertaking". In Saint Lucia, a trade mark is defined as "a sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person". Any sign which does not satisfy the definition of a trade mark is not registrable.

7.2.2 Distinctiveness

A trade mark may be distinctive or capable of distinguishing the applicant's goods or services in order to be registrable. In this regard, a mark may be inherently distinctive, for example, an invented word or alternatively, the mark may have acquired distinctiveness through use.

In *The Matter of Application No. 7271.10 by British American Tobacco (Brands) Limited to register the trade mark CLICK and the Opposition thereto by Philip Morris Products S.A. TM Ruling No. 1/2013*, it was stated that: -

> *"A sign is distinctive for the goods to which it is to be applied when the relevant consumers can identify the goods as originating from a particular undertaking and thus distinguishing it from other undertakings. Societe des Produits Nestle SA; Winward Industries Inc.; Windsurfing Chiemsee.*
>
> *A trademark's distinctiveness must therefore be assessed by reference to first, the goods or services in respect of which registration is sought and second, the perception of the relevant persons, namely the consumers of the goods or services. According to case law, that means the presumed expectations of an average consumer of the category of goods or services in question, who is reasonably well informed and reasonably observant and circumspect. Windsurfing Chiemsee; Sabel v. Puma; Societe des Nestle SA." @ page 4.*

Therefore, in making an assessment of whether or not a mark is distinctive, this has to be done based on the goods or services in relation to which the mark is applied for, having regard to the absolute and relative grounds for refusal of the mark in the particular jurisdiction.

7.2.3 Examples of Distinctive and Non-Distinctive Marks

Letters and Numerals

It should be noted that in the Bahamas, Belize, Grenada, Guyana, the definition of a trade mark includes a reference to letters and numerals. In Jamaica, Saint Lucia and Trinidad and Tobago, where 'sign' is defined, in addition to 'trade mark', the definition of 'sign' includes letters and numerals. Therefore, letters and numerals are registrable as trade marks provided that they serve to identify the goods or services in the application.

Marks comprising of one letter or one numeral are usually not registrable unless the letter or numeral is presented in a stylized manner or evidence of the use of the mark has been submitted to show that the particular letter or numeral over time, has served to identify the goods or services. There should be some measure of originality in the presentation of the letter or numeral where a single letter or numeral is used as a trade mark. The applicant may be requested to disclaim exclusive rights to the use of a letter, except as it appears in the mark. The following is an example of the letter 'T' which was registered in relation to entertainment services: -

In the Matter of Ford Werke AG's Application for a Trade Mark (1955) 72 R.P.C., Lloyd-Jacob J. stated: -

"(1) Monograms, if of three or more letters are prima facie considered to be adapted to distinguish; and if of two letters, are prima facie considered capable of distinguishing.

Capacity to distinguish may also be inferred if two letters not monogrammed, and therefore showing a definite sequential order, are so run together as to involve an elision of part of one of the letters. (2) If to a letter or letters some additional features are added (other than borders or decorative features of non-distinctive character), so as to create a combined device, the presence of such letter or letters will not prevent a finding of distinctiveness, but in general their exclusive use will need to be disclaimed. (4) A combination of non-distinctive integers, one of which consists of one or two letters, may in the totality possess distinctiveness, although disclaimer may be required of some or all of the component parts" @ page 196.

Lloyd-Jacob J. therefore dismissed an appeal against an Assistant Comptroller's decision to register the following mark: -

If the letters or numerals are used to describe the character or quality of the goods, such letters or numerals are not registrable as a trade mark and the applicant should be requested to file a disclaimer of the descriptive elements. Letters or numerals which may be deemed to descriptive include signs which indicate: -

- quantity e.g. 200ml;
- size e.g. S, M, XL or XXL for clothes;
- date of production for goods or services e.g est. since 1990;
- speed ;
- strength e.g. 90 proof for alcoholic beverages.

Two and Three Letter Marks

Two and three letter marks may be registered as a trade mark unless it is otherwise objectionable under the particular Trade Marks Act. Some two and three letter marks that have been registered in Belize include: -

PF in Class 25

in Class 34

A & F in Class 25

BFO in Class 35

GSI in Class 5

KTM in Classes 7, 9, 12, 18 and 25

in Classes 38 and 41.

Combinations of Letters and Numeral Marks

A combination of letters and numerals are usually registrable as a trade mark provided that they are sufficiently random to identify the goods or services contained in the application. In Belize, the following mark was registered in Classes 38 and 41: -

In Saint Vincent and the Grenadines, the following marks were registered in Class 12: -

GC70
GC80
GC90

Three, Four and Five Digit Numbers and Letter/Number Combinations

Signs that include three or more digits, with or without letters may be registered as trade marks, provided that the numbers or letters are not descriptive of the goods or services.

Slogans

Slogans are registrable as trade marks. In determining the registrability of a slogan, the examiner should assess whether the slogan is used as a trade mark to identify the goods or services contained in the application or for the consumer to recall the product, as opposed to being utilized for ornamental or informational purposes. For example, an application was filed in Trinidad and Tobago for the slogan 'The best beer in the Caribbean', however, the evidence of the use of the mark which was submitted revealed that the particular slogan was not used to identify the goods or to assist in recalling the goods.

7.3 Disclaimers

Where a mark is comprised of non-distinctive elements, a disclaimer may be requested by the examiner. In the letter from the Intellectual Property Office, the precise wording of the disclaimer should be stated. Some common forms of the disclaimer include: -

(i) Registration of this mark shall give no right to the exclusive use of the letter "_____".
(ii) Registration of this mark shall give no rights to the exclusive use of the device of a_____.

In the above forms (i) and (ii), the applicant disclaims the letter or device as it appears in the mark and in all other forms of the word or device.

(iii) Registration of this mark shall give no right to the exclusive use of a letter "_____".

(iv) Registration of this mark shall give no right to a device of a "_____".

(v) Registration of this mark shall give no right to the exclusive use of a word "_____" except as it appears in the mark.

(vi) Registration of this mark shall give no right to the exclusive use of a word "_____" separate and apart from the mark.

In forms (iii) – (vi), the examiner's intention is to allow registration of rights in respect of the particular representation of the word or device as it appears in the mark, but in no other form.

When the trade mark is published for opposition by third parties, the disclaimer must be published with the application and if the mark is registered, the disclaimer must be stated on the Certificate of Registration.

The final version of this Manual will explore further absolute and relative grounds for the refusal of a trade mark.

8. Submission of Evidence (Affidavits or StatutoryDeclarations)

Evidence of the use of a trade mark may be submitted to support arguments that the trade mark is distinctive or capable of distinguishing the goods or services of the applicant from those of other traders.

Submission of evidence relative to the use of a mark should relate to the use of the mark in the particular jurisdiction or use which has a direct commercial impact in the jurisdiction. In order

to be admissible, the use should have occurred prior to the filing date of the trade mark application since the mark is deemed to be registered from its filing date[40].

Evidence of use will include: -

- Date of first use of the mark in the jurisdiction;
- Details of the goods and/or services in relation to which the mark isused;
- Any advertisements bearing the mark;
- Labels of the goods bearing the mark;
- Details of the places where the goods/services areoffered;
- The turnover or volume of sales for goods bearing themark;
- Any other materials that show the goods/services beingused.

Prior use of the mark is not a requirement in order to secure the registration of a mark within the English-speaking CARICOM countries. However, for marks that may be considered as lacking in distinctiveness, evidence of the use of the mark may be filed by the applicant to demonstrate that the mark is capable of distinguishing the goods and/or services of the proprietor from those of other traders. Evidence of use may be submitted to demonstrate honest concurrent use of a trade mark where there are competing claims to identical or similarmarks.

National legislations[41] contain provisions in relation to the submission of evidence.

[40] In Barbados, a mark is deemed to be registered from the date of filing of Form No. 9 'Fee for Registration of a Mark' and the applicant must pay the fees for the Certificate of Registration to be issued.

[41] Regulations 37-38, Antigua and Barbuda Trade Marks Regulations; Section 49, Bahamas Trade Marks Act Ch. 322 and Rules 86, 90 and 96 Trade Marks Rules 1984; Section 36B, Barbados Trade Marks Act Cap. 319; Section 8(4), Belize Trade Marks Act Cap. 257 and Trade Marks (General Procedures) Administrative Instructions No. 1 of 2005 dated the 7th day of March, 2005; Regulations 22-25, 44, Dominica Trade Names Regulations, 2009; Regulations 33-34, Grenada Trade Marks Regulations No. 18 of 2012; Section 65, Guyana Trade Marks Act Cap. 90:01 and Rule 108 Trade Marks Rules 1955; Rules 43-44 Jamaica Trade Marks Rules 2001; Rules 32-33, St. Kitts and Nevis Trade Marks Rules, Cap. 18:22; Section 190, Saint Lucia Trade Marks Act No. 22 of 2001 and Regulations 31-39, 73 and 89-95 Trade Marks Regulations 2003; Rule 92, St. Vincent and the Grenadines Trade Marks Regulations 2004 and Section 90 Trinidad and Tobago Trade Marks Act No. 8 of 2015.

9. Appeals

Various aspects of the trade mark application process may be subject to appeal either before the Registrar / Controller / Executive Director or to the High Court, except where it is expressly stated that the relevant officer's decision is final[42].

Once there is sufficient staff in an office, an appeal should be heard by an examiner who did not conduct any prior review of the application in order to ensure that there is a fresh impartial review of the application. National legislations provide details of the matters that may be appealed in the trade mark process and whether the request for the appeal should be lodged at the IPO or the High Court.

10. Publication

All trade marks must be published in order to give the public notice of the rights that are being granted and to give third parties the opportunity to oppose the trade mark. Some countries publish the trade marks in a daily newspaper, the Gazette, Trade Marks Journal or online[43] at the office's website. From the publication of the mark, third parties may oppose the trade mark application[44].

The publication should provide sufficient information to allow a third party to oppose the trade mark application, which typically will include the applicant's name and address, the representation of the trade mark, the specification of the goods and/or services, the agent's name and address, the date of filing of the trade mark application and any conditions that were imposed in accepting the trade mark application.

[42] See footnote 12 supra.

[43] In St. Vincent and the Grenadines, trade marks are published online at: - **http://www.cipo.gov.vc/cipo/** in the Intellectual Property Electronic Publications and in Belize in the Intellectual Property Journal at: www.belipo.bz . In Dominica, there is an Intellectual Property Journal on their website and an insert in their Gazette.

[44] Please refer to Appendix I for the relevant sections of national law in relation to the publication of a trade mark and the time frames for the filing of a Notice of Opposition.

Where the applicant filed the application without a trade mark agent, it is useful to notify the applicant that they must pay for the trade mark publication, if there are fees required to be paid for the publication of the mark.

The automated database should be updated to reflect the publication date of the trade mark.

11. Opposition

When a trade mark is opposed, an opposition file should be created for all documents associated with the opposition proceedings. There should be a checklist that is placed in the file in order to ensure that there is strict adherence to the timelines. The checklist should indicate what has been filed and when the next document is due. The IPO should require that sound reasons be submitted for extensions of time, even when both parties consent to an extension of time, since the office does not wish to create a backlog of pending oppositions to be heard whilst the parties attempt to resolve the matter. A sample checklist form for opposition proceedings is attached as **Appendix VII** to this draft Manual, which should be tailored according to national trade mark law requirements.

The status of the trade mark opposition should be updated in the automated trade marks database.

This section will be elaborated further in the final version of the Manual to include a tabular diagram of the varying timelines for the filing of forms in the twelve jurisdictions.

12. Trade Marks Register and Certificate ofRegistration

Provided that an opposition is not filed to the trade mark application, the mark is entered in the Trade Marks Register. In Guyana, the Trade Marks Register is divided into three parts, namely, Part A, Part B and Part C. Part A is for distinctive marks, Part B for marks which are capable of distinguishing and Part C is for marks that were registered initially in the United Kingdom.

The Trade Marks Register should be updated routinely. The Register must contain information in relation to the trade mark number, the filing date, a representation of the mark, proprietor's

name and address, specification of goods and/or services, the agent (if any, on record), conditions of registrability and other changes in the trade mark registration from the date that the mark is entered in the Register.

If a mark is registered, the automated database should be updated to reflect the changes accordingly.

The Certificate of Registration is issued upon payment of the prescribed fee.

13. Registration of United Kingdom Registered Trade Marks

In Guyana, there is provision for the registration of trade marks, already registered in the United Kingdom. This is contained in Part 11, sections 40-51 of the Guyana Trade Marks Act, Chap. 90:01. The applicant must complete the prescribed trade mark application form, provide a certified representation of the trade mark with a certificate from the Comptroller of the United Kingdom Intellectual Property Office, giving full particulars of the registration of the trade mark in the United Kingdom and pay the filing fee. When the application is lodged at the IPO, the Registrar has to enter the particulars of the trade mark in Part C of the Trade Marks Register and issue the Certificate of Registration to the applicant. There is no substantive examination of trade marks that are already registered in the United Kingdom.

The lack of examination of United Kingdom prior registered marks is a lacuna in the examination process for the Guyanese IPO since those United Kingdom marks may conflict and frequently do conflict, with prior existing trade mark rights in Guyana. It is therefore recommended that even if a mark is already registered in the United Kingdom, the law should be amended so that the application must be subjected to the same examination process as other marks filed nationally, including searches for any conflicting prior marks, substantive examination to determine whether the mark meets the national criteria for registrability and publication for third party opposition.

In Saint Kitts and Nevis, the Second Schedule "Registration of United Kingdom Trade Marks Rules" of the Marks, Collective Names and Trade Names Act, Cap. 18.22, provides for the registration of marks already registered in the United Kingdom. However, the rules under the Saint Kitts and Nevis legislation do not provide that such marks must be entered automatically into the Register. Therefore, the examiners should examine the marks already registered in the United Kingdom to determine whether the marks are registrable under the Saint Kitts and Nevis law.

The Guyana and Saint Kitts and Nevis legislations are both based on the United Kingdom Trade Marks Act 1938.

It is recommended that amendments should be passed to the Guyana and Saint Kitts and Nevis legislations to remove the provisions in relation to trade marks registered in the United Kingdom.

14. <u>Assignments, Mergers, Change of Name, Change of Address</u>

Assignments, mergers, changes of name should not be entered in the Register unless the prescribed application form is submitted together with the relevant supporting documentation e.g. a signed assignment document that identifies the mark to be assigned or documentation from a Companies Registry e.g. Certificate of Merger or Notice of Change of Address, and the payment of the application fees. Certified copies (as being true and correct copies of the original documents) of the relevant documentation are sufficient. If the documentation is in a foreign language, an official translation should be requested. In processing assignments, mergers and changes of name, multiple changes may be required and the effective date of the change as recorded in the documentation must be entered on the Trade Marks Register when the mark is registered.

Any changes in relation to the specification of goods and/or services as a result of an assignment must be noted on the Trade Marks Register when the details of the assignment are recorded in the Register.

A change of address does not usually require supporting documentation, unless national

legislation states that supporting documentation is required. When a change is entered on the Register, the automated database should be updated.

15. Renewal

Prior to the expiry of a trade mark, a notice advising the applicant that a mark is due to expire should be issued within the stipulated timeframe as required by the national law.

The information on the renewal application form (as filed by the proprietor seeking to renew the mark) should match the data on the Trade Marks Register. If there are discrepancies, the applicant should be invited to file the requisite documentation to ensure that the name and address on the Register is the same as that which is contained in the renewal application, prior to the processing of the renewal application.

Where a mark is not renewed within the prescribed timeframe, it should be removed from the Trade Marks Register.

16. Madrid Protocol

Strict adherence to timelines is critical in dealing with applications filed pursuant to the Madrid Protocol.

To date, in the Caribbean Region, only Antigua and Barbuda is a party to the Protocol. However, there are no regulations in the Antigua and Barbuda legislation governing the procedures for dealing with Madrid Protocol applications.

Jamaica and Trinidad and Tobago are preparing to accede to the Protocol. Amendments to Jamaica's Trade Marks Act are being effected in order to facilitate its accession to the Protocol. In Trinidad and Tobago, the Trade Marks Act No. 8 of 2015 gives effect to the Madrid Protocol and regulations are being drafted to govern applications filed under the Protocol.

It is recommended that applications received under the Protocol should be assigned with the letter ‘M’ followed by the relevant numbering system and tracked closely to ensure that the application is examined within the prescribed timeframe, failing which, the mark is deemed to be registered automatically without further examination.

A national IPO that is a designated country for the receipt of a Madrid Protocol application, must ensure that an office action / letter is issued within the prescribed timeline which may be twelve (12) or eighteen (18) months from the IPO's receipt of the application, failing which the trade mark is deemed to be automatically registered in the particular jurisdiction.

Where the IPO is the office of origin for the filing of an international application, the IPO must ensure that the international application is based on an existing application or registration. When the national IPO is the office of origin for an international application, it must receive the application, the filing fees, conduct formalities examination and the examination of the specification of goods and services, before transmitting the international application to the International Bureau of WIPO together with the appropriate fees.

17. Practice Directions

In Jamaica and Trinidad and Tobago, the IPO may issue Practice Directions from time to time to address any matters that occur before the Office.

In Jamaica, Practice Directions were issued indicating that in examining a trade mark application, a determination will be made as to whether the application contains any traditional knowledge (TK) or traditional cultural expressions (TCEs). If the application contains TK or TCEs, the mark may be refused or accepted with disclaimers / limitations.

In Trinidad and Tobago, a Practice Direction was issued in relation to extensions of time. In this regard, it was stated that an extension of time would not be granted for frivolous or vexatious reasons and the Practice Direction enumerated examples of frivolous or vexatious reasons.

The Practice Directions are attached as **Appendix VIII**.

18. Conclusion

In most offices within the Caribbean, there is limited staff assigned to the examination of trade marks. Therefore, the Head of the Office must determine the best manner to deal with trade mark examination in order to ensure that trade mark applications are examined in a timely manner. Some offices may be able to assign separate officers who deal with formalities, classification, searches, substantive examination, appeals, whereas other officers may assign a file to one

officer who conducts all aspects of the examination process from formalities to substantive examination. Each office has to determine what is best given the resources that are available. The overriding principle is that the trade mark examination must be conducted in accordance with national trade marks law.

This is a first draft of the Manual. Additional issues relative to substantive examination, oppositions, transactions which may be entered in the Register and the Madrid Protocol will be addressed in the final Manual.

APPENDIX II

COMMERCIAL REGISTRY

INTELLECTUAL PROPERTY OFFICE

LICENCE

INTELLECTUAL PROPERTY AGENT

This Licence is granted to C. A. NIGEL HUGHES, Attorney -at-Law of Lot 62 Hadfield & Cross Streets, Georgetown, Demerara, Guyana, on the 2nd February, 2017 to transact business as an Intellectual Property Agent in accordance with the Patents and Designs Act, 90:03 and the Trade Mark Act, 90:01 and the Geographical Indications Act No. 15 of 2005 of the Laws of Guyana.

This Licence ceases on 2nd February, 2018.

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Registrar of Commerce (Ag)

APPENDIX III

CHECKLIST FOR FILING OF TRADE MARK APPLICATION

	Requirements for filing of trade mark application	**Yes**	**No**	**Date**
1.	Request for the registration of the trade mark			
2.	Applicant's name			
3.	Applicant's address			
4.	Representation of the mark			
5.	List of goods and/or services			
6.	Payment of filing fees			

APPENDIX IV

APPLICATION STATUS FORM

FORMALITY EXAMINATION:	YES	NO	N/A
Requirements for Formality Examination completed	☐	☐	
- Authorization of AgentFiled.	☐	☐	☐
- Translation.	☐	☐	☐
- Legal Entityidentified.	☐	☐	☐
- Priority Document	☐	☐	☐

Responsible Officer:	**Signature:**	**Date:**

VIENNA CLASSIFICATION:	YES	NO	N / A
Vienna Classification completed.	☐	☐	☐

Responsible Officer:	**Signature:**	**Date:**

CLASSIFICATION EXAMINATION:	YES	NO
Nice Classification completed.	☐	☐

Responsible Officer:	**Signature:**	**Date:**

SEARCH REPORT COMPLETED:	YES	NO
Search Report – Similar Marks found.	☐	☐

Responsible Officer:	**Signature:**	**Date:**

VERIFICATION OF THE ABOVE DONE BY:

TRADE MARK EXAMINER	
Signature:	Date:

DETERMINATION OF REGISTRABILITY:

TRADE MARK EXAMINER	
Signature:	Date:

Publication date:

Filing date of Notice of Opposition (if any):

Date of Registration:

REVISED SEARCH REPORT
FORM EXAMINATION CHECK LIST

FOR

TRADE/SERVICE MARKS

APPLICATION NO: 81/ _____

Formalities Check	Yes	No	N/A	Finding	Signature of Officer Reporting
Authorisation Sec 10(3)					
Business Name Sec 8(1) (d)					
Priority Requested Secs 11 & 12					
Were Priority Documents filed on time Reg 22 (1)					
Is the Priority document in English					
If no, was a translation filed Reg 22 (2)					
Was the Priority translation duly endorsed by the applicant or agent? Reg 22 (2)					
Is the mark in English? Does it contain words or letters in Characters Other than Roman? Was an endorsement made? Reg 21(1) & (2)					
Limitation of colours					
Disclaimer					
Search Report					

(P.T.O.)

Formalities Check	Yes	No	N/A	Finding	Signature of Officer Reporting
Vienna Classification					
Device Search Report					
Nice Classification Sec 10(2)(d)					
Letters to be sent					

Comments:

APPENDIX V

SAMPLE CLASS SPECIFICATIONS

REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORDS "KRISPY KRUNCHY" SEPARATE AND APART FROM THE MARK.
REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORDS "CAJUN RECIPE".
REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORD "CHICKEN".
THE APPLICANT CLAIMS THE COLOURS RED, YELLOW, WHITE AND BLACK
CFE (7) 1.3.2, 11, 20; 25.1.6; 26.4.2; 26.5.1, 18

50801 Class 29 "Prepared meals consisting primarily of meat, fish, poultry or vegetables."
Class 30 "Seasoned coating for meat, fish or poultry."
Class 42 "Fast-food restaurants."
KRISPY KRUNCHY FOODS, L.L.C., a Limited Liability Company organized and existing under the laws of the State of Louisiana, United States of America, whose trade or business address is at 1615 Harris Street, Alexandria, Louisiana 71301, United States of America.

Date Received December 8, 2015
Address for Service J.D. SELLIER & CO.
129-131 Abercromby Street, Port of Spain, Trinidad, West Indies.

REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORD "FIVE" SEPARATE AND APART FROM THE MARK.
REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORD "ISLANDS" SEPARATE AND APART FROM THE MARK.
REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORDS "A WORLD OF FUN".
REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE DEVICE OF PALM TREES SEPARATE AND APART FROM THE MARK.
REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE DEVICE OF A WAVE EXCEPT AS IT APPEARS.
CFE (7) 1.15.15, 1.15.24; 5.1.3, 8

50634 Class 41 "Entertainment services in the nature of amusement and water parks." FOURAIME ENTERPRISES LIMITED, a Limited Liability Company organized and existing under the laws of Trinidad and Tobago, whose trade or business address is at PO Box 5091, Port of Spain, Trinidad and Tobago.

Date Received November 5, 2015
Address for Service M. HAMEL-SMITH & CO.
Eleven Albion, Cor. Dere & Albion Streets, Port of Spain, Trinidad, W.I.

YOUTHBERRY

50765 Class 30 "Tea and herbal tea; tea and herbal tea-based beverages; tea-based beverage mix; herbal tea-based beverage mix."
Class 32 "Fruit drinks and soft drinks containing fruit juices; fruit juices, sparkling fruit and juice-based beverages and soda beverages; liquid and powdered beverage mixes; flavoring syrups for making tea and herbal tea-based beverages."
STARBUCKS CORPORATION, a Corporation organized and existing under the laws of the State of Washington, United States of America, whose trade or business address is at 2401 Utah Avenue South, Seattle, WA 98134, United States of America.

Date Received November 26, 2015
Address for Service J.D. SELLIER & CO.
129-131 Abercromby Street, Port of Spain, Trinidad, West Indies.

TEAVANA EMPEROR'S CLOUDS AND MIST

50767 Class 30 "Tea and herbal tea; tea and herbal tea-based beverages; tea-based beverage mix; herbal tea-based beverage mix."
STARBUCKS CORPORATION, a Corporation organized and existing under the laws of the State of Washington, United States of America, whose trade or business address is at 2401 Utah Avenue South, Seattle, WA 98134, United States of America.

Date Received November 26, 2015
Address for Service J.D. SELLIER & CO.
129-131 Abercromby Street, Port of Spain, Trinidad, West Indies.

ASSOCIATED WITH TRADEMARK NOS. 46820, 47498 AND 50057.

VADOREX

50792 Class 1 "Chemicals used in agriculture, horticulture and forestry (except fungicides, weedkillers, herbicides, insecticides and parasiticides) namely, plant fortifying preparations, chemical and/or biological preparations for stress management in plants, plant growth regulating preparations, chemical preparations for the treatment of seeds, surfactants, natural or artificial chemicals to be used as sexual baits or agents to confuse insects."
Class 5 "Preparations for destroying and combating vermin, insecticides, fungicides, herbicides, pesticides."
BASF SE, a Company organized and existing under the laws of Germany, whose trade or business address is at Carl-Bosch-Str. 38, Ludwigshafen am Rhein, Germany.

Date Received December 3, 2015
Address for Service J.D. SELLIER & CO.
129-131 Abercromby Street, Port of Spain, Trinidad, West Indies.

CFE (7) 1.15.3; 27.3.1, 4

50803 Class 3 "Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive (cleaning) preparations; soaps; perfumery; essential oils; cosmetics; hair lotions; dentifrices; detergent, other than for use in manufacturing operations and for medical purposes."
MAHS INVESTMENT HOLDING LTD., a Limited Liability Company organized and existing under the laws of the Cayman Islands, whose trade or business address is at P.O. Box 309, Ugland House, Grand Cayman KY1-1104, Cayman Islands.

Date Received December 8, 2015
Address for Service J.D. SELLIER & CO.
129-131 Abercromby Street, Port of Spain, Trinidad, West Indies.

REGISTRATION OF THIS MARK SHALL GIVE NO RIGHT TO THE EXCLUSIVE USE OF THE WORDS "KRISPY KRUNCHY" SEPARATELY.

KRISPY KRUNCHY

50802 Class 29 "Prepared meals consisting primarily of meat, fish, poultry or vegetables."
Class 30 "Seasoned coating for meat, fish or poultry."
Class 42 "Fast-food restaurants."
KRISPY KRUNCHY FOODS, L.L.C., a Limited Liability Company organized and existing under the laws of the State of Louisiana, United States of America, whose trade or business address is at 1615 Harris Street, Alexandria, Louisiana 71301, United States of America.

Date Received December 8, 2015
Address for Service J.D. SELLIER & CO.
129-131 Abercromby Street, Port of Spain, Trinidad, West Indies.

ASSOCIATED WITH TRADEMARK NO. 50801

Agent (740): MISS CAROL HANSCHELL, Hanschell & Company, Croton Court, Cr. Pine & Belmont Roads, Belleville, St. Michael

Class (511): Alcoholic beverages, except beer, namely, rum and rum-based liquors; spirits and liqueurs in International Class 33

File No (210): 81/ 027711 Applicant (730): BRUICHLADDICH DISTILLERY COMPANY LIMITED a Company duly incorporated under the Laws of United Kingdom of The Bruichladdich Distillery, Islay, Argyll PA49 7UN, United Kingdom Filing date (220): 31/01/2011	**RENEGADE**

Agent (740): MESSRS. CARRINGTON & SEALY, Belmont House, Belmont Road, St. Michael

Class (511): Alcoholic beverages, except beer; spirits [beverages]; rum in International Class 33

File No (210): 81/ 027722 Applicant (730): Meguiar's Inc., a corporation of the State of California of 17991 Mitchell South, Irvine, California 92614, USA Filing date (220): 04/02/2011	**MEGUIAR'S**

Agent (740): MESSRS. CARRINGTON & SEALY, Belmont House, Belmont Road, St. Michael

Class (511): Surface care products for vehicles, namely, cleaners, waxes, polishes, shampoos, and conditioners; vehicle washing and polishing preparations in International Class 3

File No (210): 81/ 028134 Applicant (730): Lisa Adina Carter, a Barbadian individual trading as Lazon Services a Barbadian business registered under the Business Name Act, Cap 317 of the Laws of Barbados of # 8 Diamond Corner, St. Peter, Barbados Filing date (220): 29/04/2011	

Agent (740):

Class (511): Aprons [clothing], Bandanas [neckerchiefs], Caps [headwear], Jackets [clothing], Jerseys [clothing], Camisoles [clothing], Vests [clothing], Pants [clothing], Skirts [clothing], Shirts [clothing], Tee-shirts [clothing], Wristband [clothing] in International Class 25

File No (210): 81/ 031091 Applicant (730): FOSSIL GROUP, INC., a company duly formed and existing under the laws of Delaware, of 901 S. Central Expressway, Richardson, Texas 75080, USA Filing date (220): 26/07/2013	**FOSSIL**
Agent (740): MESSRS. CARRINGTON & SEALY, Belmont House, Belmont Road, St. Michael Class (511): Watches, jewelry, clocks in International Class 14	
File No (210): 81/ 031099 Applicant (730): SHAANXI YANCHANG PETROLEUM GROUP RUBBER CO., LTD, a limited liability company incorporated under the laws of the People's Republic of China of FENGHE AREA QINDU DISTRICT, XIANYANG, SHAANXI, PEOPLE'S REPUBLIC OF CHINA Filing date (220): 29/07/2013	**DYNACARGO**
Agent (740): MISS CAROL HANSCHELL, Hanschell & Company, Croton Court, Cr. Pine & Belmont Roads, Belleville, St. Michael Class (511): Vehicles for locomotion by land, air, water or rail; cars; casings for pneumatic tires (tyres); motorcycles; bicycles; cable cars; trolleys; aeroplanes; boats; hubs for vehicle wheels; tyres for bicycles, cycles; spikes for tires (tyres); treads for retreading tires (tyres); pneumatic tires (tyres); tires, solid, for vehicle wheels; vehicle wheel tires (tyres); adhesive rubber patches for repairing inner tubes; automobile tires (tyres); tubeless tires (tyres) for bicycles, cycles; repair outfits for inner tubes in International Class 12	
File No (210): 81/ 031100 Applicant (730): SHAANXI YANCHANG PETROLEUM GROUP RUBBER CO., LTD, a limited liability company incorporated under the laws of the People's Republic of China of FENGHE AREA QINDU DISTRICT, XIANYANG, SHAANXI, PEOPLE'S REPUBLIC OF CHINA Filing date (220): 29/07/2013	**DYNACARGO**
Agent (740): MISS CAROL HANSCHELL, Hanschell & Company, Croton Court, Cr. Pine & Belmont Roads, Belleville, St. Michael Class (511): Building construction supervision; construction; drilling of wells; cleaning of buildings (exterior surface); heating equipment installation and repair; machinery installation, maintenance and repair; washing; burglar alarm installation and repair; motor vehicle maintenance and repair; car wash; vehicle lubrication (greasing); vehicle polishing; vehicle service stations; vehicle maintenance; vehicle cleaning; vehicle repair; shipbuilding; retreading of tires (tyres); vulcanization of tyres (repair); airplane maintenance and repair in International Class 37	

File No (210): 81/ 027379

Applicant (730): HENKEL AG & Co. KGaA, a company duly incorporated under the laws of Germany of Henkelstrasse 27, 40589 Düsseldorf, Germany

Filing date (220): 21/10/2010

Limitations of colours: The mark is limited to the colour red as shown on the representation of the mark.

Henkel Excellence is our Passion

Agent (740): MESSRS. CARRINGTON & SEALY, Belmont House, Belmont Road, St. Michael

Class (511): Perfumery, essential oils, cosmetics, soaps, dentifrices, hair lotions, non-medicated hair care preparations, hair styling preparations, hair color preparations for dying and preparations for permanent waving of hair; bleaching preparations for laundry and other substances for laundry use, namely, laundry preparations; cleaning, polishing, scouring and abrasive preparations; laundry starch, dish washing detergents, floor cleaning and caring agents, namely, floor wax, non-slipping wax for floors, floor wax removers [scouring preparations] and non-slipping liquids for floors; impregnated cleaning cloths in International Class 3

File No (210): 81/ 027495

Applicant (730): Daimler AG, a company organized under the laws of Germany, of Mercedesstrasse 137, 70327 Stuttgart, Germany

Filing date (220): 29/11/2010

Priorities (300): The applicant claims priority under Section 12 of the Act on the basis of a CTM Trademark Application No. 009149402 dated 2nd June, 2010 and a UK Trademark Application No. 2554611 dated 30th July, 2010.

Agent (740): MESSRS. CARRINGTON & SEALY, Belmont House, Belmont Road, St. Michael

Class (511): Educational services; practical training [demonstration]; entertainment; sporting and cultural activities, namely sports information services, sports coaching services, sports education services, sports entertainment services and organisation of exhibitions for cultural and educational purposes; organisation of competitions for education in the field of repair services; provision and arrangement of seminars and workshops; provision of educational information about automotive technology and history; driving instruction; organisation of motor racing, namely, organisation of motor racing events and motor racing teams; organisation of fan clubs for automobile enthusiasts; organization of fashion show services for entertainment purposes in International Class 41

File No (210): 81/ 027658

Applicant (730): Innovative Liquors, LLC a limited liability company incorporated under the laws of Florida, U.S.A. of 6100 Hollywood Boulevard, 7th Floor, Hollywood, Florida 33024, U.S.A.

Filing date (220): 12/01/2011

CARIBANA SOL

Application# 057839

Filing Date: APRIL 5, 2011

JAMAICA CHOICE

Disclaimer: **Registration of this Trade Mark shall give no right to the exclusive use of the word "Jamaica"**

It is a condition of registration that the mark shall be used in relation only to goods produced in Jamaica

Priority :

Translation:

Colour:

In respect of the following international class (es) 29, 30 and 32;

Class Details:

In International Class 29
Meat, fish, poultry; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jams and jellies; eggs, milk, milk products, edible oils & fats.

In International Class 30
Coffee, tea, cocoa, sugar, rice, bread, pastry, confectionery, vinegar, spices, sauces (condiments).

In International Class 32
Mineral & aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Applicant

Erwin McLee Burton
30 Norbrook Drive, Kingston 8, Jamaica

Agent/Address for Service
Erwin McLee Burton
30 Norbrook Drive, Kingston 8

Application# 063190

Filing Date: AUGUST 14, 2013

Soyfresh

Disclaimer:

Priority :

Translation:

Applicant

SAMSUNG ELECTRONICS CO., LTD
129, Samsung-ro, Yeongtong-gu, Suwon-si, Gyeonggi-do, Rep.of Korea

Agent/Address for Service
MYERS, FLETCHER & GORDON
21 East Street, Kingston

Application# 064147

Filing Date: FEBRUARY 10, 2014

Disclaimer:

Priority :

Translation:

Colour:

In respect of the following international class (es) 25 and 41;

Class Details:

In International Class 25
Clothing, footwear, headgear.

In International Class 41
Entertainment services in the nature of live musical performances; production of sound and music video recordings.

Applicant

Tanice Morrison
40A Portview Road, Manor Park, Kingston 8, Jamaica

Agent/Address for Service
Tanice Morrison
40A Portview Road, Manor Park, Kingston 8

Applicant

DePuy Synthes, Inc.
700 Orthopaedic Drive, Warsaw, Indiana 46581, U.S.A.

Agent/Address for Service
Myers, Fletcher & Gordon
21 East Street, Kingston

Application# 066487

Filing Date: FEBRUARY 9, 2015

Disclaimer:

Priority :

Translation:

Colour: **The Trade Mark is limited to the colours Blue, Yellow and White.**

In respect of the following international class (es) 29;

Class Details:

In International Class 29
Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats.

Applicant

Chiquita Brands L.L.C.
550 South Caldwell Street, Charlotte, North Carolina 28202, U.S.A.

Agent/Address for Service
Livingston, Alexander & Levy
72 Harbour Street, Kingston

Application# 066488

Filing Date: FEBRUARY 9, 2015

CHIQUITA

APPENDIX
VI

IN THE MATTER OF APPLICATION NO. 44 756
BY EGIS GYÓGYSZERGYÁR RT
TO REGISTER A TRADE MARK IN CLASS 5

JAMAICA INTELLECTUAL
PROPERTY OFFICE
(An Agency of the Ministry of
Industry, Investment & Commerce)

IN THE MATTER OF APPLICATION NOS. 44 756
BY EGIS GYÓGYSZERGYÁR RT
TO REGISTER A TRADE MARK IN CLASS 5

DECISION AND GROUNDS OF DECISION

1. On the 9th of January 2004, Egis Gyógyszergyár RT, through its agents, Myers, Fletcher and Gordon, Attorneys-at-Law, (hereinafter referred to as "the Applicant") applied under the Trade Marks Act 1999 (hereinafter referred to as "the Act") for registration of the trade mark **PARLAZIN** in Class 5 in respect of:

   "Pharmaceutical preparations for human use"

2. The mark was accepted for publication by the Trade Marks Registry on March 30, 2004 and publication effected in the Jamaica Gazette thereafter.

3. A Form TM 4 - Notice of Opposition accompanied by the Statement of Grounds was filed on November 18, 2004 by Livingston, Alexander and Levy, Attorneys-at-Law, on behalf of Aventis Pharma Deutschland GMBH (hereinafter referred to as "the Opponent"). The Opponent is a pharmaceutical manufacturer and is the registered proprietor in Jamaica of Trade Mark number 10 137 - BARALGIN – which is also registered in Class 5 in respect of "pharmaceutical, veterinary and hygienic preparations and substances".

4. The Opponent asserts that the registration of the trade mark PARLAZIN contravenes Section 13 (2) (b) of the Trade Marks Act, 1999 in that the proposed mark is greatly similar to its trade mark and is in respect of identical goods such that there exists a likelihood of confusion including the likelihood of association on the part of the public of the Applicant's mark with the Opponent's earlier trade mark.

5. The Opponent further states inter alia, that :

(1) *The proposed mark is an infringement of the Opponent's rights as under Section 9 (3) (b) of the Trade Marks Act 1999.*

(2) *The proposed mark is not distinctive of the pharmaceutical products of the Applicant and is derived from the Opponent's trade mark and as such the application has been made in bad faith and should therefore be refused registration by virtue of Section 11 (4) (e) of the Trade Marks Act 1999.*

6. Form TM 5 and Grounds of Counterstatement were filed on behalf of the Applicant on January 20, 2005.

7. The Applicant denied all the allegations set out in the Opponent's Grounds of Opposition. In particular, the Applicant stated the following:

(i) *It denies the Opponent's allegation that the proposed PARLAZIN is similar to the Opponent's Trade Mark BARLAGIN and that there are sufficient visual and phonetic differences between the marks which would avoid confusion or the likelihood of confusion on the part of the public between the two marks.*

(ii) *The Applicant's and Opponent's marks stand side by side on the trade mark registers of several countries throughout the world without any confusion on the part of the public.*

(iii) *The product bearing the Applicant's mark is intended and marketed as an atiallergic whilst the product bearing the Opponent's mark is used as an analgesic.*

(iv) The Applicant's mark is made in good faith and is a genuine and ingenious trade mark.

8. On the 31st October, 2005 the Opponent filed a joint Statutory Declaration of Joëlle Sanit-Hugot and Jean-Pierre Pousset, Trade mark Counsels of the Opponent company.

9. On the 31st January, 2006 the Applicant filed a Joint Statutory Declaration of Dr. György Ujfalussy and Dr. Attila Mándi, Deputy Director for Pharmaceutical Development and head of the Intellectual Property Department of the Applicant company.

10. Opposition Hearing was held on the 11th October, 2006. Ms. Sanya Young and Ms. Andrea Scarlett, Attorneys-at-Law of the Firm Myers, Fletcher and Gordon, appeared for the Applicant and Ms. Kathryn Cousins, Attorney-at-Law of the Firm Livingston, Alexander & Levy, appeared for the Opponent.

11. At the hearing Counsel for the Opponent indicated that the Opponent would not be pursuing the opposition under Section 9 (3) (b) of the Act.

12. This Opposition is brought in respect of Section 13 (2) (b) of the Act which states as follows:

> *13 (2)*
> *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.

13. The term "earlier trade mark:" is defined in Section 14 of the Act as follows:

> 14(1) In this Act an "earlier trade mark" means-
>
> (a) a registered trade mark; or
>
> (b) a trade mark 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; or
>
> (c) a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (b), subject to it being so registered.

14. The trade mark on which the Opponent seeks to rely is, BARALGIN registration number 10 137 is an earlier trade mark as defined in Section 14.

15. Although several other cases were referred to by the parties I found the following cases the most helpful in providing guidance in this matter:

16. *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v.Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R.1 and in *Lloyd Schufabrik Meyer & Co. GmbH v. Adidas AG (2000) E.T.MR. 723.*

17. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 8, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 8, paragraph 23, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schufabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 8, paragraph;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 8, paragraph 23;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 9, paragraph 26;

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section;

Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc page 9, paragraph 29.

18. The two trade marks to be considered are:

Opponent's Trade Mark	Applicant's Trade Mark
BARALGIN	**PARLAZIN**
Class5	**Class 5**
Pharmaceutical, veterinary and hygienic preparations and substances.	Pharmaceutical preparations for human use.

19. Let me first consider whether the goods herein are similar or identical. The goods or the application have not been limited in any way. The comparison that has to be made is between the goods as applied for and the goods as registered. Thus evidence as to how the Applicant intends to use the proposed mark cannot and ought not to be taken into account.

20. The goods of the application which are under attack are: *pharmaceutical preparations for human use.* The goods of the earlier registration are: *pharmaceutical, veterinary and hygienic preparations and substances.*

21. The Applicant denies in its Counterstatement that the respective goods are neither identical nor similar. I do not agree with this position. I find that whilst the goods or the respective trade marks are not identical they are in fact similar.

22. The goods cannot be considered identical because the specification relating to veterinary preparations would not be included in goods specified as pharmaceutical preparations for human use. However, it is my view that the goods are similar as pharmaceutical preparations for human use must encompass pharmaceutical and hygienic preparations and substances.

23. I therefore find that goods of the respective trade marks are similar.

24. The Opponent's Counsel in her submissions at the hearing urged the tribunal to treat marks relating to pharmaceutical goods with special care

25. To that submission I would cite the following statement in the case of *Glaxo Group Plc v Allergan Inc (BL O/414/01 and BL O 293/02)*:

> "It seems to me that the role of the Registrar is to apply the Trade Marks Act 1994 and its subordinate legislation to the proceedings brought before her. Other provisions and authorities exist for the licensing of pharmaceuticals and in my view, it is not the role of the Trade Marks Registry to stray into these areas. Under the provisions of the Act and acting on behalf of the Registrar I must consider whether there exists a likelihood of confusion if the applicants' and opponents' trade marks are used in respect of the goods for which they are respectively applied for and registered. I must find a likelihood of confusion not merely a possibility of confusion"

26. I therefore place no special importance on whether a higher or lower threshold needs to be reached before confusion can be established in conflicts between pharmaceutical trade marks.

27. That being said I do accept that the as it relates to pharmaceutical products that one may need to consider:

(1) whether the goods maybe available over the counter or by prescription;
(2) That the average consumer may be medical professionals and/or the public at large;
(3) That where the good will be available by prescription that some of those prescriptions may be handwritten;
(4) That the public may be purchasing goods in the environment of a busy chemists shop; and

(5) That the average person is unlikely to be so careless in health issues that he or she will act in other than a reasonably circumspect and observant fashion.

28. It should be noted no evidence was filed as to whether two marks are available as over the counter or prescription..

29. Notwithstanding I think it is fair to say that visual appreciation of a pharmaceutical mark is of great importance. This is so since generally pharmacists will be working from (type or handwritten) prescription. In over the counter medication these will often be selected by the consumer from the displays of the goods in the pharmacy, supermarket or other places of purchase. Oral usage should not be discontinued as they are instances where doctors will telephone prescriptions to pharmacists.

30. I now turn to the actual comparison of the marks.

31. Each trade mark is of three syllables. Although the first syllables of each mark -PAR" and "BAR" are not identical visually I am of the view that the are phonetically similar. As well I am of the view that the last syllable of each mark – "ZIN" and "GIN" are also phonetically similar. It is of course likely that in oral use that the final syllable will be less clearly pronounced than the first two syllables. I therefore consider that the marks do share a good deal of phonetic similarity.

32. The marks are invented words. Despite this the Applicant has argued that its mark PARLAZIN has a conceptual meaning which it has set out at Paragraph 7 of its filed Counter-Statement whereby it states that the first part of the mark – PARLA – is derived from the Hungarian word "**PARLA**GFU" the name of the plant causing certain allergies that the Applicant's product, an anti-allergic, seeks to treat. The second part of the mark it argues is derived from the active ingredient "CETIRI**ZIN**E".

33. I agree however, with the submissions of the Opponent that it is very unlikely that the conceptual meaning that the Applicant ascribes to its mark will be readily recognizable and appreciated by the Jamaican consumer who is not familiar with Hungarian or the plant cited so as to make the Applicant mark conceptually distinctive. I therefore find that the words "BARALGIN" and "PARLAZIN" have no significance for the Jamaican consumer.

34. Visually the trade marks obviously share various letters. It is important to bear in mind that the public rarely has the opportunity to compare trade marks directly and since in this case there are no conceptual aids which the public can use to distinguish the marks there is more likelihood for imperfect recollection to be brought into play. I think there is some visual similarity between the marks because of the common presence of the letters "a" and "r".

35. I therefore am of the view that the Applicant's mark is similar to that of the Opponent's mark.

36. All that is therefore left is to determine whether there is a likelihood of confusion.

37. The relevant consumer for the goods in question can be anyone. I do agree with the Applicant's submission that customers will take some care and are in fact expected to, when dealing with pharmaceutical products whether they be for allergies or are analgesics. However, in this case the customer would be faced with identical goods, similar trade marks which have no conceptual association to aid memory and an earlier trade mark that is distinctive.

38. Taking all those factors into account I consider that there is a likelihood of confusion in respect of the Applicant's trade mark.

39. In their submission Counsel for the Applicant brought my attention to an extract taken from the treatise "**TRADE MARK LAW: A PRACTICAL ANATOMY" by Jeremy Philips**. The extract pro-offered the position that "Evidence of co-existence without actual confusion is good evidence that there is no likelihood of confusion". They then stated that since the marks BARALGIN and PARLZALIN were co-existing on the trade mark Register of twenty-six (26) and since the Applicant had not provided any evidence of confusion in those twenty-six countries it therefore means that there is no likelihood of confusion.

40. I cannot accept this argument as it is difficult to conflate a trade mark application with use in the market place. There are several factors that have to be considered:

(i) Has the trade mark been used with other indicia?

(ii) Has it been used for the full range of goods in the specification?

(iii) Has it been sold through the same retail channel?

41. I refer to and rely on the case of *Compass Publishing BV v Compass Logistics Limited [2004] RPC 41* in which Laddie J held:

> "It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to say s 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of

> the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

42. I also adopt the dicta of Millet LJ in the case of *The European Limited v The Economist Newspaper Ltd [1998] FSR 283* where he said:

> "Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

43. Thus the Applicant's assertion that the evidence of likelihood of confusion must be present by the Opponent to the tribunal is rejected.

44. In the circumstances the Opposition is upheld.

45. There is no Order as to costs.

Edward G. Brightly

Acting Registrar of Industrial Property

IN THE SUPREME COURT OF BELIZE,

A.D. 2010 CIVIL APPEAL NO. 1 OF 2009

IN THE MATTER OF THE TRADE MARKS ACT, CAP. 257 LAWS OF BELIZE, REVISED EDITION 2000

AND

IN THE MATTER OF APPLICATION NO. 5082.07 BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED TO REGISTER THE TRADEMARK

AND

THE OPPOSITION THERETO BY PHILIP MORRIS PRODUCTS S.A.

—

BEFORE the Honourable Abdulai Conteh, Chief Justice.

Mr. Nicholas Dujon SC for the applicant.
Ms. Ashanti Arthurs Martin with Mr. Rishi Mungal for the respondent.

—

JUDGMENT

This judgment concerns a decision of the Registrar of Intellectual Property (the Registrar) relating to an application for registration by British American Tobacco (Brands) Ltd (BAT) of its cigarette product label **EMBASSY** as a trademark under the Trade Marks Act – Chapter 257 of

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the Laws of Belize. The application was opposed by Philip Morris Products S.A. (Philip Morris).

2. Both parties are manufacturers and purveyors of tobacco products in particular cigarettes. In fact, Philip Morris at the time of BAT's application for the registration of its own **EMBASSY** was already the owner of Belize

trademark registration No. 4388.07, under Class 34 of the Nice Agreement for the MARLBOORO mark. The Registrar admirably recapitulated the contending arguments between the parties and I gratefully reproduce these here.

3. In its opposition to the registration of BAT's EMBASSY trademark before the Registrar, Philip Morris claimed that the BAT trademark was substantially identical to or deceptively similar to Philip Morris' registered trademark and the goods of the BAT application were identical with or similar to those for which Philip Morris' earlier trademark is protected. Philip Morris claimed that its trademark had acquired a reputation in Belize and that the use of BAT's **EMBASSY** trademark was confusingly similar because a similar design to Philip Morris' earlier trademark appeared at the bottom of the BAT trademark. Philip Morris further claimed that that confusion was also reinforced by the facts that the targeted consumers were identical or substantially similar because they were cigarette buyers, and that the trade channels were also identical or substantiallysimilar.

4. BAT answered to the opposition by submitting that its trademark was neither substantially identical nor deceptively similar to Philip Morris' registered trademark, and was therefore not likely to deceive or cause confusion in Belize. According to BAT, the design colour, and word elements of the parties' trademarks would allow consumers to distinguish between their respective trademarks. Although BAT conceded that Philip Morris' trademark might have acquired a reputation in Belize, BATargued

that its various trademarks have peacefully co-existed with Philip Morris' registered trademark in several markets in the world. BAT also conceded that targeted consumers and trade channels were identical and substantially similar.

5. After reviewing the evidence (by affidavits) submitted by both sides and having heard attorneys who represented them, the Registrar proceeded to analyze the provisions of what he regarded as the relevant law in the case. This is **section 37(1) and (2)** of the Trade Marks Act which for the purposes of the application before him provides the relative grounds for refusal of an application for the registration of trademark:

> *"37.- (1) A trade mark shall not be registered if it is identical with an earlier mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.*
>
> *(2)* ***A trade mark shall not be registered if because****:*
>
> *(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or*
>
> ***(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to***

> ***those for which the earlier trademark is protected****,*
>
> *there exists a likelihood of confusion on the part of the public,*

which includes the likelihood of association with the earlier trademark." (Emphasis added).

I reproduce subsection (3) later as it is the special object of complaint by Mr. Dujon SC (see paras. 18 and 19 below), sub-section (4) is not relevant to the facts of this case.

6. The Registrar then analyzed para. (b) of section 37(2) and then undertook a comparison of the goods for which BAT's **EMBASSY** application for registration was made with those of Philip Morris' trademark registration No. 4388.07. He found that the goods were similar: they were both in respect of tobacco products, particularly cigarettes.

7. The Registrar then proceeded to a detailed comparison of the respective trademarks of both the earlier trademark MARLBORO of Philip Morris and BAT's trademark EMBASSY which was the subject of the application. After a detailed analysis of the two trademarks, the Registrar found that the respective marks were not similar.

8. The Registrar also examined the issue of the **likelihood of confusion in Belize** between the respective trademarks of Philip Morris and BAT. **He concluded**, after references to some case law on this issue, **that there was no likelihood of confusion between the parties' trademarks**.

9. The Registrar then concluded as follows in his decision dated 9th October 2009 in **TM Ruling No. 1 of 2009:**:

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> **"BAT's trademark is allowed to proceed to registration because the mark is not similar to Philip Morris' earlier trademark. Also, there exists no likelihood of confusion on the part of the public, nor does there exist the likelihood of association with the earlier Philip Morris**

trademark under section 37(2)(b) of the Act.'

10. By Notice of Appeal dated 30th October 2009, Philip Morris filed the following ground of appeal against the Registrar's decision:

> **"The Registrar having accepted that the opponent's mark was well known within the meaning of the Paris Convention as incorporated into the Trade Marks Act of Belize by section 60 thereof and that the targeted consumers and trade channels were identical and substantially similar, thereafter failed to consider all or any of the legal implications thereof and the added protection that the law affords to such marks."**

11. Philip Morris in this appeal now seeks a reversal of the Registrar's decision and an order directing him to refuse the registration of BAT'S Trade Mark which was the subject of the application before the Registrar.

12. Section 70 of the Trade Marks Act provides for an appeal to this Court from any decision of the Registrar under the Act. And Order 68 of the Supreme Court Rules 2005, provides for the hearing of such an appeal and in particular Rule (3) states that the appeal is to be by way of a rehearing.

13. However, the appeal was not conducted by way of a rehearing. Mr. Nicholas Dujon SC, the attorney for Philip Morris the appellant, and Mrs.

Ashanti Arthurs-Martin, the attorney for BAT, the respondent, instead made extensive written and oral arguments and submissions on behalf of their respective clients. I am constrained to observe however, that despite the promise of both attorneys to send to the court colour reproductions of the respective trademarks of the clients that are in issue, only the

attorneys for the respondent BAT finally did so on 5th July 2010, after reminders from the Court staff.

14. Order 60.8(2) of the Supreme Court rules 2005, permits the Court on hearing of an appeal to receive further evidence on matters of fact. Accordingly, I reproduce hereunder colour reproductions of the earlier Trade Mark of Philip Morris the appellant's registration No. 4388.07 for its MARLBORO brand of cigarettes and BAT, the respondent's EMBASSY mark which is the subject of the Registrar's decision in respect of application No. 5082.07.

6

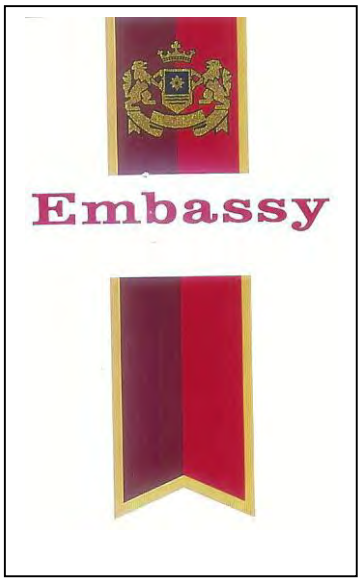

Fig. 1: The Embassy Mark - App. No. 5082.07

Fig. 2: The Embassy Mark alongside the Appellant's Marlboro Mark – Registration No. 4388.07

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15. Both sides however relied on the evidence which was presented before the Registrar which consisted for Philip Morris an affidavit by Irina Lucidi, Senior Counsel at Philip Morris International Management SA and exhibits thereto. And for BAT, the evidence was in an affidavit by Clyde Elliott Woods, Trade Mark Manager, BAT Mark Ltd and exhibits thereto. These were all contained with bundle for this appeal which I have had the benefit of reading.

On the evidence, I am satisfied that the Registrar admirably summarized this in paras. 8 and 10 of his decision.

16. This appeal arises however not on the evidence but on the findings of law and the Registrar's conclusion thereon. The sole ground of appeal which I have reproduced at para. 10 of the judgment takes issue with para. 12 of the Registrar's decision. In this paragraph the Registrarstated:

> "*12) This ruling does not cover Philip Morris' allegations that its trademark is well known in Belize and that targeted consumers and trade channels are identical and substantially*

similar. This omission is based on the fact that these grounds of opposition are not in dispute."

17. Mr. Dujon SC for Philip Morris has argued and submitted essentially that notwithstanding that its trademark is well known in Belize and that the targeted consumers and trade channels are identical and substantially similar to those of BAT, and that these matters were conceded by the latter, there was therefore a duty incumbent upon the Registrar to consider the implications of such a concession. In failing to do so, the argument runs, the Registrar failed to consider the **added protection** to which Philip Morris's earlier trademark was entitled.

8

18. This added protection for Philip Morris's earlier trademark, Mr. Dujon argued and submitted, arises by reason of the provisions of **section 37(3)** of the Trade Marks Act and the operation of **Article 6** *bis* of the **Paris Convention for the Protection of Industrial Property** of March 20th 1883. This Convention is incorporated into Belize's law by **section 60** of the Trade Marks Act. And **section** 61 of the Act gives direct effect to **Article 6** *bis* of the Paris Convention.

61.- (1) References in this Act to a trade nark which is entitled to protection under the Paris Convention as a well-known trade mark are to a mark which is well-known in Belize as being the mark of a person who –

(a) is a national of a Convention country; or

(b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in

Belize, and references to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well known trade mark is entitled to restrain by injunction the use in Belize of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or

services, where the use is likely to cause confusion, but this right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any bona fide use of a trade nark begun before the commencement of this section. (Emphasis added).

19. **Article 6** *bis* of the Paris Convention provides:

Article 6 bis

Marks: Well-Known Marks

(1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of

the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention, and used for identical or similar goods,. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The

countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in badfaith.

20. **Section 37(3)** of the Trade Mark Act provides:

"(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark isprotected,

shall not be registered if, or to the extent that, the

***earlier trade mark has a reputation in Belize and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*"**

21. The nub of Philip Morris' appeal is that given the fact that its mark is well known in Belize, the Registrar should have specifically adverted to this and given play to the additional protection afforded to its mark and upheld its opposition to the registration of BAT's application.

22. In particular, relying on **Article 6** *bis* of the Paris Convention, Mr. Dujon SC contends that these provisions apply when the essential part of the mark (sought to be registered) constitutes a reproduction of any well-known mark or an imitation liable to create confusion therewith. He contends therefore that the device used in the EMBASSY application No. 5082.07 (the object of Philip Morris' opposition before the Registrar) is an essential part of that mark and as such when compared with the MARLBORO Roof Device registered trade mark No. 4388.07, would be liable to create confusion therewith. I have reproduced the respective trademarks in issue in this appeal at para. 14 of thisjudgment.

23. Mr. Dujon SC also takes issue with the Registrar in his written submission when he attributed to the Registrar in his decision at para. 12 that he saw *"no need to decide upon the ground of opposition relating to section 37(3) (unfair competition with an identical/similar mark for dissimilar goods) because as will be shown below the goods in this case are clearly identical."*

24. I must say that I find no basis for this complaint in para. 12 of the Registrar's decision. The statement attributed to the Registrar is nowhere to be found in his decision, certainly not in para. 12. I have reproduced

para. 12 of the Registrar's decision at para. 16 of this judgment. However, there is no reference in the Registrar's decision to **section 37(3)** of the Trade Marks Act. In my view, given the finding of the Registrar at paras. 13 and 14 of his decision that the respective goods of the parties (tobacco products such as cigarettes, cigars etc.) **are similar**, there was perhaps no need to refer to section 37(3) of the Act which deals with identical or similar trade mark to an earlier trade mark which is sought to be registered for **goods or services which are not similar to those for which** the earlier trade mark is protected. The Registrar after a comparison of the respective goods of the parties found that they **are identical**. But this was a limited view by the Registrar, given the admitted reputation of Philip

Morris's trade mark. He ought to have considered sub-section (3) of the Act. The Registrar should, I think, given the claimed distinctive character of Philip Morris's earlier trade mark and its admitted reputation, have taken into account when determining whether the similarity or identity between Philip Morris' goods (cigarettes etc) covered by its earlier trade mark and those covered by BAT's (cigarettes etc) was sufficient to give rise to the likelihood of confusion: **Canon Kabushiki Kaishe v Metro Goldwyn-Mayer Inc** (Case C 39/97 (1998) All E.R. (EC) 934.

25. However, what **section 37(3)** is aimed at preventing, in my view, even though the goods and services to which the earlier mark and the mark proposed for registration **are not similar** is **anti-dilution** of the earlier mark. It enables a proprietor of an earlier mark, with a reputation in Belize, to raise as a relative ground of objection to a mark which is identical or similar to his mark for goods and services which are not similar to his but where his **registered trade mark has acquired a reputation**. This provision caters for situations not covered by section 37(1) and (2) of the Act: it provides an **anti-dilution** protection for the earlier mark with a reputation. This is so because **sub-section 3** provides that registration of a later mark should be refused **when its use without due cause would**

take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark – **Davidoff & Cie SA, Zino Davidoff SA v Gofkid Ltd**, judgment of the European Court of Justice delivered on 9th January 2003, in particular paras. 19 to 21 of the judgment in explaining provisions of the European Community Council's Directive 89/104/EEC (in Article 5(2) which are analogous to section 37(3) of Belize's Trade Marks Act.

26. The ECJ in **Davidoff** went on to observe at para. 24 of its judgment *"that Article 5(2) of the Directive must not be interpreted solely on the basis of its wording,*

but also in the light of the overall scheme and objectives of the systems of which it is a part."

27. The Court concluded in that case that Articles 4(4)(a) and **5(2)** of the Council's Directive are to be interpreted as entitling specific protection for registered trade marks with a reputation in cases where a later mark or sign, which is identical with or similar to the registered mark, **is intended to be used or is used for goods or services identical with or similar to those covered by the registered mark**.

28. Mr. Dujon SC therefore trenchantly attacked the Registrar's decision for failing, in his submission, to take into account what he termed "additional protection' afforded by **subsection (3)** of section 37 of the Act. This protection, in my view, is against dilution of an earlier trade mark even where the goods and services for which the earlier trade mark and later trade mark areidentical.

29. However, in my view, to avail of this "additional" (anti-dilution) protection, **the proposed trade mark has to be identical with or similar to the earlier trade mark which has a reputation in Belize** (para. (a) of sub-

section (3)). Therefore, even though the goods and services to which the earlier trade mark and the later trade mark relate may **be similar**, there **must be found an identity or similarity between the two marks such as the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or the reputation of the earlier trade mark** to disentitle the later mark from registration.

30. However, another plank in the platform of Mr. Dujon's contention on behalf of Philip Morris is that the Registrar failed to have regard to **Article 6** *bis* of the Paris Convention, which affords, he claims, **added protection** to

Philip Morris' MARLBORO trade mark because it is well-known within the meaning of that Convention. The relevant provisions of the Convention are given effect in Belize by section 61 of the Trade Marks Act.

Article 6 *bis* of the Paris Convention protects **well-known trade marks** from trade marks which constitute a **reproduction**, **an imitation** or **a translation likely to create confusion**.

31. It is, on the other hand, contended for BAT, that the protection afforded to well-known marks under the Paris Convention applies to marks which have not yet been registered under the Act, but which enjoy significant reputation outside Belize, despite the fact that the proprietor of such mark may not carry on any business or have any goodwill in Belize.

32. I am unable to share this view of the operation and effect of the Paris Convention on the protection of well-known trade marks. It is too limited and does not appreciate the breath of protection it affords. In my view, a well-known trade mark which is entitled to protection under the Paris Convention can constitute an **earlier trade mark** as provided for in **section 38(1)(b)** of the Act and thereby provide a basis for a relative

ground for refusal of registration of a similar or identical mark pursuant to **section 37(1) or (2)** of the Act and even under subsection (3) if its conditions are satisfied.

Also, **the proprietor of a trade mark entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain by injunction** the use in **Belize of a trade mark which, or an essential part of which, is identical or similar to his marks in relation to similar goods or services, where the use is likely to cause confusion** (sub-section (2) of section 61 of the Act.

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33. However, in my view, the protection afforded by **Article 6** *bis* of the Paris Convention (which is incorporated by sections 60 and 61 of the Trade Marks Act) is **not additional** or **different** in nature from the protection afforded generally to trade marks. It especially addresses the case of internationally well-known trade marks. Section 61 of the Act extends the protective regime of trade marks law to proprietors of such trademarks.

34. At the centre of this protective regime is the proscription of registration of a mark which is identical to or similar with earlier trade mark and or the later mark is to be used for goods or services already covered by the earlier mark. The whole rationale of the protective regime of trade mark law is to protect against the **creation of confusion in the mind of the consumers (the public)** in relation to goods or services covered by an earlier trade mark such as to lead them to think that the goods and services covered by the earlier mark are the same as those to which the later mark relates or that they have a common origin.

35. This rationale is in the instant case captured in the words of **Article 6** *bis* in relation to well-known marks:

(The state parties to the Convention) … *undertake ex officio if*

their legislation so permits, ***or at the request of an interested party, to refuse or to cancel the registration and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this***

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Convention, and used for identical or similar goods. *These provisions* ***shall also apply when the essential part of the mark constitutes a reproduction of any such well- known mark or an imitation liable to create confusion therewith****,"* (Emphasis added).

36. The issue therefore always in the case of a well-known mark is: does the other mark (in this case BAT's application for its EMBASSY mark) constitute **a reproduction**, **an imitation** or **a translation likely to create confusion** with Philip Morris's admittedly well-known MARLBORO Mark? A subsidiary but important question as well is: **does the essential part of BAT's EMBASSY mark constitute a reproduction of Philip Morris' MARLBORO Mark or an imitation liable to create confusion with the latter?** That is to say, is BAT's trade mark identical to or similar to Philip Morris; in the instant case?

Comparison of the Parties' trade marks

37. For the purposes of this appeal, the present proceedings are by way of a rehearing. Therefore, Mr. Dujon correctly submitted that this court is not bound by findings of facts made by the Registrar. The Registrar at para. 17 of his decision made a specific finding that the respective marks of

Philip Morris and BAT are **not** similar. There is, of course, no dispute about the identity or the similarity of their respective goods: they are both purveyors of tobacco products, cigarettes, cigars, etc.

38. Therefore in order to resolve the issue of identity to or similarity with or lack thereof between their respective trade marks, I have had recourse to the respective affidavits filed before the Registrar, in support of BAT's application for registration of its mark and Philip Morris's in opposition

thereto. As it was opposition proceedings before the Registrar, I reproduce the salient paragraphs: first, of the affidavit for Philip Morris deposed to by Ms. Lucidi, Senior Counsel at Philip Morris International Management SA. She states as follows among other things:

> *History and use of the* ***MARLBORO LABEL Marks***
>
> *10. The* ***MARLBORO*** *cigarettes have been made and sold by Philip Morris (and various predecessor entities) since 1924. Philip Morris introduced MARLBORO cigarettes brand bearing the distinctive* ***ROOF design*** *trademark in the United States in 1955: The ROOF design is a five-sided figure with a horizontal top and two vertical sides with two upwardly and inwardly sloping diagonals.*
>
> *11. The worldwide commercialization of MARLBORO cigarettes brand bearing the* ***ROOF design*** *expanded at a steady pace throughout the 1960's, 1970's, 1980's, and 1990's, and have been used, and continues to be used, extensively worldwide by the Philip Morris, its affiliates and/or its licensees in over 160 countries.*

12. *Since the introduction of the* ***MARLBORO trade dress containing the ROOF design*** *in 1955 and through 2004, estimated worldwide sales figure for the* ***MARLBORO*** *brand cigarettes totaled more than then (10) trillion cigarette (sticks). Indeed, the* ***MARLBORO*** *brand has been the No. one selling brand of cigarettes in the*

world for at least the past 20 years. In this respect, we refer again to the Maxwell Report" in ***Exhibit D"*** *whereby from 1985 to 2004,* ***MARLBORO*** *is listed as the No. 1 cigarette brand in the world. The figures in "The Maxwell Report" are in respect of worldwide shipments.*

14. *The MARLBORO brand of cigarettes has therefore been the number one selling brand of cigarettes in the world for over a quarter of a century, and considered by many prominent authorities as being among the most famous trademarks ever created.*

15. *In addition to the sales of over 10 trillion (10,000,000,0000,000)* ***MARLBORO*** *cigarettes during the afore-said time period throughout the world, there has been extensive promotion for the* ***MARLBORO*** *brand, thus developing enormous notoriety and fame for the* ***MARLBORO LABEL*** *containing the famous* ***MARLBORN ROOD Device****.*

16. *On information and belief, the extensive sales of the* ***MARLBORO ROOF Device*** *branded cigarettes throughout the world, have been of a significant magnitude to generate fame, notoriety and reputation in the* ***MARLBORO ROOF Device*** *to accord it a broad scope of protection.*

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17. *By virtue of the long and extensive use of the* ***MARLBORO ROOF Device*** *on the* ***MARLBORO ROOF Device*** *is truly famous and notorious, indicating to consumers of tobacco products and others, that such designed brand originates from Philip Morris.*

18. *The* ***MARLBORO*** *and the* ***ROOF device*** *marks have also, by virtue of extensive use and publicity, as and where permitted by law, over the past several decades, acquired global goodwill and reputation. They are firmly embedded in the minds of traders and consumers worldwide, including Belize consumers, and are exclusively associated with PhilipMorris.*

21. *The opposed trademark is confusingly similar both visually and conceptually to the* ***MARLBORO ROOF Device****, and contains the notorious roof shape device, highly recognizable to consumers, including in Belize as the* ***MARLBORO LABEL****. The Applicant's mark further adopts similar colours as used by Philip Morris (including red). Furthermore, by looking at the design application no. 5082.07, filed by the Applicant below, it seems that the*

intention is to confuse consumers into thinking that the Applicant's products are an extension of Philip Morris's products, including for MARLBORO ROOF Device trademarks, or that there is a relationship between the Applicant and Philip Morris.

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22. *As identically described in paragraph 10 above, the Applicant makes use of a designed device in its label of a five-sided shape with a horizontal top and two vertical sides with two upwardly and inwardly sloping diagonals. There appears thereto to be a deliberate transition towards the use of a similar image to the Philip Morris* ***ROOF Device****, likely to cause confusion and strong mind association, in particular confusion to consumers that there is some link between the Applicant's mark and Philip Morris' notorious* ***MARLBORO LABEL****, resulting in the dilution of the goodwill in the* ***MARLBORO ROOF Device*** *and* ***MARLBORO LABEL.***

23. *By virtue of the similarities in the roof shape design, the positioning of the regal crest, the potential for use in similar colours (including red), the identity of the goods and the intent of the Applicant to trade on the fame and notoriety of Philip Morris' world-famous* ***MARLBORO ROOF Device*** *Label. Confusion between the Applicant goods and Philip Morris'* ***MARLBORO*** *cigarettes is highly likely, and the Applicant will unfairly derive the benefits of the goodwill and reputation Philip Morris has established over the years in the*

MARLBORO label, further causing damage to Marlboro's market share.

39. For BAT, Mr. Clyde Elliott Woods, Trade Mark manager, BAT Ltd, states as follows:

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Global Reputation and Goodwill of Marlboro

5. Philip Morris Products SA of Quai Jeanrenaud 3, 2000 Neuchatel, Switzerland (also referred to hereinafter as "the Opponent") has at length sought to establish that their MARLBORO brand has acquired a broader scope of protection by virtue of the fame, notoriety and reputation established through sales of their MARLBORO products. Indeed, paragraphs 5, 9-12 and 14-18 of the Opponent's Affidavit in Support of Opposition dated the 12th September, 2008 all directly attest to the use of the MARLBORO brand following adoption of the "five sided shape with a horizontal top and two vertical sides with two upwardly and inwardly sloping diagonals" (also referred to hereinafter as "ROOFTOP" or "the ROOFTOP design").

6. The Opponent has admitted that MARLBORO cigarettes have been sold since as early as 1924 prior to the adoption of the ROOFTOP design in the United States in 1955. therefore some of the goodwill, notoriety, fame and reputation would have been vested in the word "Marlboro" which is still the principal identifier, both aural and textual, used by consumers at the point of purchase and has been used together

with the Opponent's MARLBORO cigarettes and tobacco products for over 85 years.

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7. Because of the fame, notoriety, reputation and goodwill relied upon by the Opponent and the strength upon which it rests, it is highly unlikely or virtually impossible that consumers of tobacco products would be confused or deceived as to the identity or origin of the products bearing the individually and separately distinctive elements of the EMBASSY and MARLBORO brands. As the key identifier of both the EMBASSY and MARKBORO brands is the word itself, any potential for visual confusion is reduced by the consumer asking for the product by name and thus not identifying the products by virtue of the designs alone.

Alleged Similarity of the Marlboro Roof and Embassy Ribbon Designs

8. The words themselves are entirely dissimilar both phonetically and visually containing only common letters M, B and A. The letters of either word are ordered and pronounced in such a way that there is absolutely no possibility of confusion by speakers of the English or Spanish language.

9. The main device of the Applicant's EMBASSY design, which shall include but not be limited to the present trade mark Application No. 5082.07 as the subject of these Opposition proceedings, is a vertical ***ribbon*** *extending from the top of the label to the bottom of the label being interrupted*

only by the positioning of the EMBASSY word. The ribbon comprises one third of the middle section of the label with the

white background comprising the remaining two thirds on either side of the ribbon. The main ribbon itself is dissected in terms of colour with the left hand side of the ribbon being coloured burgundy while the right hand side of the ribbon is coloured dark red. Further, there is a gold coloured line which borders the entire outside of the ribbon save for the bottom part of the top of the ribbon and the top part of the bottom of the ribbon as caused by the interruption of the ribbon for the placement of the EMBASSY word element. The top of the ribbon is flat and the bottom or tail of the ribbon is inverted

10. *In contrast the Opponent's earliest Belize registered MARLBORO trademark, as submitted in their Affidavit in Support of Opposition, being identified as No. 1089 contains a five sided roof device that is positioned only in the upper half of the design extending from the top of the label that also covers the entire width from left to right. The positioning of the word MARLBORO is at the bottom of the design together with the words "LONG SIZE". The Opponents other registered MARLBORO trademark, as submitted in their Affidavit in Support of Opposition, being identified as No. 3984.06 is ostensibly the same formative trademark with some minor modifications or alterations to the overall design.*

11. In each design, there are clear overall visual and conceptual differences between the designs. These differences, such as the

location of the words EMBASSY and MARLBORO, the position and style of the crest and the colour variations of the Applicant's ribbon device together with distinct word identifiers make for no chance of confusion of consumers or deception by the Applicant.

40. Additionally, I have had to examine closely the respective marks of the parties reproduced at para. 14 of this judgment to make a determination of this issue.

41. I am helped in this exercise by the respective descriptions given on behalf of each side regarding its own mark. For Philip Morris, Ms. Lucidi deposed at para. 10 of her affidavit as follows in describing the mark for its brand MARLBORO:

> ***"Philip Morris introduced MARLBORO cigarettes brand bearing the distinctive ROOF design trade mark in the United States in 1955: The ROOF design is a five-sided figure with a horizontal top and two vertical sides with two upwardly and inwardly sloping diagonals."***

Apart from the omission of any reference to the crest just beneath the two upwardly and sloping diagonals and the word "**MARLBORO"** this is an accurate description of Philip Morris's MARLBORO mark reproduced along side BAT's EMBASSY mark at para. 14 above.

42. For BAT, Mr. Woods deposed at para. 9 of his affidavit as follows in describing its mark:

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> ***9. The main device of the Applicant's EMBASSY design, … trade mark Application No. 5082.07 … is a vertical ribbon extending from the top of the label to the bottom of the label being interrupted only by the positioning of the EMBASSY word. The ribbon comprises one third of the middle section of the label with the white background comprising the remaining two thirds on either side of the ribbon. The main ribbon itself is dissected in terms of colour with the left hand side of the ribbon being coloured burgundy while the right hand side of the ribbon is coloured dark red. Further, there is a gold coloured line which borders the entire outside of the ribbon save for the bottom part of the top of the ribbon and the top part of the bottom of the ribbon as caused by the interruption of the ribbon for the placement of the EMBASSY word element. The top of the ribbon is flat and the bottom or tail of the ribbon is inverted.***

43. *Findings from a comparison of the respective marks*

From my visual inspection and study of BAT's mark (which is reproduced
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at para. 14 of this judgment as **Fig. 1**) I find that:

i) it comprises a vertical **ribbon**, extending from the top of the label to almost the bottom of the label;

ii) the ribbon is intersected at near the half-way mark of its length by the prominent text element **EMBASSY** (not however in capital letters) rendered in red;

iii) on the top half of the ribbon is a regal crest in goldcolour;

iv) the ribbon has a multiple colour composition being dissected with its left side coloured burgundy and the right side coloured dark red, with a gold border on the entire outside of the ribbon including at the bottom tail of the ribbon which isinverted;

v) the top of the ribbon is flat and its bottom end stretching towards the end of the label is inverted;

vi) the ribbon comprises breath-wise about one-third of the middle section of the entire label with the white background comprising the remaining two-thirds on either side of the ribbon.

44. The Philip Morris' mark I find contains the following (I have reproduced it along-side BAT's mark as **Fig. 2** at para. 14 above. I have also left out of account the very salutary admonition on top of both marks):

i) it contains a five-sided **roof device** that is positioned at the top half of the design;

ii) the five-sided roof device extends at the top of the label to cover the entire width from left to right;

iii) the five sided roof design has a flat or horizontal top with two vertical sides with two upwardly and inwardly slopingdiagonals;

iv) just beneath the point at which the two upwardly and inwardly sloping diagonals meet is a regal crest in gold with the legend "Philip Morris";

v) beneath the regal crest is the prominent text element **MARLBORO** (again not in capital letters like BAT's textual description in its own mark) rendered in black at the bottom of thedesign;

vi) the predominant colour scheme is red (on the roof top device) and white at the bottom half (with the word MARLBORO in black) and the regal crest in gold.

45. Having had the benefit of the affidavits filed for both Philip Morris and BAT and having carefully examined and analyzed their respective marks, I am ineluctably driven to conclude that I find neither identity nor similarity between them. Mr. Dujon SC for Philip Morris however plausibly urged on its behalf that BAT in its mark which is the subject of the application for registration *"is slowly making a deliberate transition closer and closer to the famous Roof device belonging to Philip Morris. This transition most certainly concerns* (Philip Morris) *and begs the question why the shift if not to take unfair advantage of* (Philip Morris') *Roof device which has a reputation in Belize."*

46. From my examination of the marks, I am unable to accept this, as I find nothing in BAT's mark that is remotely identical or similar to the well-known Roof device of Philip Morris. The inverted tail-end of the ribbon in BAT's mark even if it were to be transitioned to the very top of its mark would not, I find, bear the slightest resemblance, identity or similarity with a roof that is inverted.

47. The purpose of assessing the respective marks to see if there is identity or similarity between them so as to preclude registration of the later mark is no doubt central to the protective regime of trade mark law: if there is identity or similarity between the two marks, the earlier trade mark should prevail and the later denied registration. This is so where, because of the later mark, **there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark: Section 37(2)**; or if an earlier trade mark has a reputation in Belize and the use of a later mark (which is proposed for registration such as the mark of BAT's application in the instant case) **without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of earlier mark, then the later mark shall not be registered**: **section 37(3)**; also under **Article 6** *bis* of the Paris Convention, an interested party such as Philip Morris in the instant case, may request the Registrar to cancel the registration, and to **prohibit the use of a trade mark which constitutes a reproduction, an imitation or a translation, liable to create confusion with a mark considered to be well-known** as the mark of the interested party (Philip Morris in this case) and **used for identical or similar goods**. This prohibition on registration of the other mark shall also apply when the **essential part of such a mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith**.

48. In all of these instances, it is manifest that the intent and design of the scheme whether under **section 37(2) or (3)** of the Act or **section 61** and **Article 6** *bis* of the Paris Convention **is to avoid the likelihood of confusion on the part of the public regarding the respective marks** or **to prevent the use of a later mark without due cause which would result in unfair advantage of or be detrimental to the distinctive character or repute of an earlier mark**.

49. In assessing the similarity of the trade marks in question in this case and based on my own analysis, I am satisfied that the Registrar came to the correct and only conclusion opened to him when he found, after a correct appreciation and application of the leading case law in this area, namely **Sabel SV v Puma AG** (decided by the ECJ on 11th November 1997), at para. 17 of his decision that the respective marks are not similar.

50. Therefore, guided by the statement of the ECJ in **Sabel v Puma** at para. 23:

> *"That global appreciation of the visual aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components."*

I am satisfied and convinced that the two marks in issue here are not identical or similar. I am satisfied that the **dominant and distinctive component of Philip Morris' trademark is its Roof device, whereas that of BAT is its horizontal ribbon**.

51. I am also satisfied and convinced that because of the distinct marks of each of the parties, there does not exist any likelihood of confusion between their marks so as to impact on the sales of their similar goods, or that the use of BAT's mark would take unfair advantage of or be detrimental to the distinctive character (the Roof device) or the repute of Philip Morris' trade mark. I am also persuaded that given the nature of the goods both parties sell and as denominated by their respective trade marks, the average consumer does not engage in any detailed analysis of their marks, but rather commonly requests the product he wants by name: either MARLBORO or EMBASSY. There is surely a phonetic and aural

world of difference between the two. I am convinced the two marks can co-exist in Belize

52. I am fortified in the conclusion I have reached in this appeal by the many foreign Intellectual Property decisions given in favour of BAT in disputes with Philip Morris regarding its EMBASSY mark or similar ones. The learned attorney for BAT helpfully brought to the court's attention three decisions in particular, one from **Australia** in **Philip Morris Products inc v NV Sumatra Tobacco Trading Co** decided on 30 December 1998; one from **Colombia** by that country's Superintendency of Industry and Commerce in **Resolution 36398** of 23rd July 2009 and the other from the Korean Intellectual Property Tribunal in Korean Trade Mark Application No. 40-2008-0001382, decided on 30th September 2009. In all of these cases application to register trade marks were opposed by Philip Morris. because of its earlier brand MARLBORO, two of the trade marks were for EMBASSY mark, but registration was approved in all three in favour of BAT, including its HERO mark in Australia.

Conclusion

For the reasons stated in this judgment, I am satisfied that the Registrar's decision that BAT's trade mark proceed to registration because the mark is nor similar to Philip Morris' earlier trade mark, and that there exists no likelihood of confusion on the part of the public, nor does there exist the likelihood of association with the earlier Philip Morris' trade mark under section 37(2)(b) of the Act should not be disturbed.

That the Registrar did not advert to sections 37(3), 61 and Article 6 bis of the Paris Convention do not, I find in the event, undermine his decision or make it untenable. I am satisfied that he came to the right conclusion on the application before him.

In the result, the Registrar's decision stands and the appeal is dismissed with prescribed costs to BAT.

A. O.
CONTEH
Chief
Justice

DATED: 28th July 2010.

APPENDIX VII

OPPOSITION FILE CHECKLIST

Trademark Application # Opposition by:				Filed in Time		Extension of Time		
Documents Filed(in duplicate):	Yes	No	Date	Yes	No	Yes	No	Date
Publication:	X		May 21st '08					
Notice Of Opposition (including Statement of Grounds): Form TM#5 (within 3 months of publication date ***s21(1) TMA & Rule 40 & 41 TMR***)	X		Aug 19th '08	X				
Counter Statement by Applicant (including Grounds in Support): Form TM#6 (to be filed within 1 month of the receipt of the Notice of Opposition ***s21(2) TMA & Rule 42 TMR***)	X		Notification Date of Opp: Nov 14th '08 Filing Date: Nov 27th '08	X				
Opponent's Statutory Declaration supporting Opposition (to be filed within 1 month of the receipt of the Counter Statement ***Rule 43 TMR***)		X	Notification Date of C/S: Dec 5th '08 Filing Date:					
Applicant's Statutory Declaration supporting original Application (to be filed within 1 month of receipt of Opponent's Statutory Declaration ***Rule 44 TMR***)			Notification Date of Opp's S/D: Filing Date:					
Opponent's Declaration strictly in Reply to the Applicant's Declaration (to be filed within 1 month of receipt Applicant's Statutory Declaration ***Rule 45 TMR***)			Notification Date of App's S/D: Filing Date:					
Further Evidence Filed (with leave of Controller ***Rule 46 TMR***)								
Hearing Date (***Rule 48 TMR***)								

APPENDIX VIII

REVISED PRACTICE NOTICE
RE: TRADITIONAL KNOWLEDGE
AND TRADITIONAL CULTURAL EXPRESSIONS

1. The Public Policy

The Public Policy of the Government of Jamaica is to preserve and protect the traditional knowledge (TK) and traditional cultural expressions (TCEs) of Jamaica and of the indigenous, traditional and local communities in Jamaica. This policy is in keeping with Jamaica's CARICOM obligations under Article 66 of the Revised Treaty of Chaguaramas:

"Protection of Intellectual Property Rights
COTED shall promote the protection of intellectual property rights within the Community by, inter alia:
(c) the identification and establishment, by the Member States of mechanisms to ensure:
(ii) the preservation of indigenous Caribbean culture; and
(iii) the legal protection of the expressions of folklore, other traditional knowledge and national heritage, particularly of indigenous populations in the Community;"

2. JIPO Practice Notice dated April 30, 2012

The Jamaica Intellectual Property Office (JIPO) therefore issued a Practice Notice dated April 30, 2012 regarding the consideration and protection of TK and TCEs in the examination of applications received by JIPO for the registration of trade marks.

JIPO hereby revises said Practice Notice to inform and guide applicants that the said consideration and protection of TK and TCEs that currently applies to the examination of trade mark applications also applies to the examination of design and geographical indication applications. This Revised Practice Notice is therefore supplemental to and is to be read in conjunction with the Practice Notice dated April 30, 2012.

3. Examination of applications

All trade mark, design and geographical indication applications received by JIPO will be examined to determine *inter alia* whether they contain protected TK or TCEs, including traditional words, signs, symbols, designs, imagery, colours, styles, or shapes or their derivatives.

Applications for the registration of trade marks, designs and geographical indications which contain protected TK or TCEs, including traditional words, signs, symbols, designs, imagery, colours, styles, or shapes or their derivatives, will be refused, unless the applicant shows that he is sufficiently connected to or has the authorization from the relevant source community.

JIPO may request of the applicant any information, documentation or evidence as is reasonably required to aid the examination process.

This revised Practice Notice comes into force immediately.

Registrar of Industrial Property
Jamaica Intellectual Property Office
February 4, 2015

Jamaica Intellectual Property Office

PRACTICE NOTICE
RE: TRADITIONAL KNOWLEDGE
AND TRADITIONAL CULTURAL EXPRESSIONS

1. The Law

Section 11(4) of the Trade Marks Act 1999 provides that:

"A trade mark is not registrable if-

(a) it is contrary to public policy or to accepted principles of morality;

(b) it is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services or otherwise;

…

(f) it is of such a nature as to-

(i) disparage persons (living or dead) or institutions or beliefs; or

(ii) falsely suggest a connection with such persons, institutions or beliefs."

2. The Public Policy

The Public Policy of the Government of Jamaica is to preserve and protect the traditional knowledge (TK) and traditional cultural expressions (TCEs) of Jamaica and of the indigenous, traditional and local communities in Jamaica. This policy is in keeping with Jamaica's CARICOM obligations under Article 66 of the Revised Treaty of Chaguaramas:

"Protection of Intellectual Property Rights

COTED shall promote the protection of intellectual property rights within the Community by, inter alia:

(c) the identification and establishment, by the Member States of mechanisms to ensure:

(ii) the preservation of indigenous Caribbean culture; and

(iii) the legal protection of the expressions of folklore, other traditional knowledge and national heritage, particularly of indigenous populations in the Community;"

In 1999 Jamaica was one of the countries which participated in a fact-Finding Mission by the World Intellectual Property Organization (WIPO) to the Caribbean to ascertain the intellectual property needs and expectations of traditional knowledge holders in the region. The Public Policy of the Government of Jamaica to preserve and protect the TK and TCEs of Jamaica and of the indigenous, traditional and local communities in Jamaica has also been expressed by Jamaica's active participation since 2008 in the WIPO Caribbean Technical Working Group on Traditional Knowledge, Traditional Cultural Expressions and Genetic Resources (GRs). The Working Group was formed in 2008 to devise a harmonised approach for the Caribbean in relation to the preservation and protection of the TK, TCEs and GRs of the indigenous, traditional and local communities in the Caribbean.

To that end, several meetings of the Working Group have been held in Jamaica, where extensive consultations with indigenous, traditional and local communities, particularly the Maroon and 2

Rastafari communities, have been undertaken. This work is being facilitated by WIPO and aims to ensure that in respect of the TK and TCEs of the relevant communities that are used, (1) the prior informed consent of the relevant communities is obtained; (2) the communities have full and effective participation in projects or programmes utilizing their TK and TCEs; and (3) any benefits derived from the utilization of their TK and TCEs are shared with the relevant communities.

The Jamaica Intellectual Property Office (JIPO) is therefore entitled to examine trade mark applications to assess their compliance with the Government of Jamaica's public policy as outlined above and to refuse applications which do not comply with the said public policy.

3. Identification of relevant TK and TCEs

All trade mark applications received by JIPO will be assessed to determine whether they contain any elements of TK or TCEs of Jamaica or of any of the indigenous, traditional or local communities in Jamaica, including traditional words, signs, symbols, designs, imagery, colours, styles, or shapes or their derivatives.

Through the consultations already held under the WIPO Caribbean Technical Working Group, as well as ongoing consultations between JIPO and the Maroon and Rastafari communities in particular and the African Caribbean Institute of Jamaica/Jamaica Memory Bank (ACIJ/JMB), JIPO examiners are in a position to identify relevant TK and TCEs.

The fact that a word, of any other language, is recognised in Jamaica as a TCE attributable to, associated with or derived from a relevant community will mean that it will be treated as such, even if it has some other meaning or derivation outside of Jamaica.

The same applies to imagery, style and design. The fact that a sign, symbol or design is recognised as a TCE in Jamaica, will mean that it will be treated as such, even if it has some other meaning or derivation outside of Jamaica.

4. Examination of trade marks containing TK and or TCEs

In examining such applications, examiners will draw from the general knowledge of TK and TCEs in Jamaica, as well as from reference material that is publicly available and also that may be provided to JIPO by the relevant communities and by the ACIJ/JMB.

Where an examiner is unsure whether or not the trade mark under consideration is covered by this Practice Notice, the examiner will consult and seek the advice of the leadership or recognised representatives of the relevant communities, particularly those which have been actively involved with JIPO in the protection of TK and TCEs through the WIPO Caribbean Working Group on TK. Examiners may also consult and seek the advice of the ACIJ/JMB. 3

If the mark is found to contain TK or TCEs of Jamaica or of any of the indigenous, traditional or local communities in Jamaica, the application for registration may be refused or where appropriate, accepted with disclaimer or limitation.

In considering whether the mark is disparaging under section 11(4)(f)(i) the examiner will consider whether a substantial section of the referenced community would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging or offensive.

In considering whether the mark falsely suggests a connection with a person, an institution or belief under section 11(4)(f)(ii), the examiner will consider whether:

(1) the mark is the same, similar to, or includes a word, sign, symbol, design, imagery, colour, style, or shape commonly used by or attributable to one of the relevant communities;
(2) the mark would be recognized as such, in that it identifies or identifies with the particular community, or the mark is such that a connection with the community could be reasonably inferred; and
(3) the community that is referenced by the mark is not connected with the activities performed by the applicant under the mark.

The question is whether, as used on the goods or services in question, consumers could possibly view the mark as identifying or identifying with a particular community or as being clearly attributable to or associated with the particular community.

If it is unclear whether the relevant community is connected to the goods sold or services performed by the applicant, the Registrar may request of the applicant any information, documentation or evidence as is reasonably required pursuant to Rule 45 of the Trade Marks Rules 2001.

If it is found upon examination that a mark falsely suggests a connection with a particular community, then it may also be deemed to be of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services and may be refused on that basis also. If it is found by virtue of use of Jamaican TK or TCEs in a trade mark that the mark may deceive the public as to the nature, quality or geographical origin of the goods or services, it may also be refused on that basis.

5. Transitional provisions/existing trade marks using TK or TCEs
Existing/prior registered trade marks which use relevant TK or TCEs will not be affected by this Practice Notice.

Trade Marks Registry
Jamaica Intellectual Property Office
April 30, 2012

MINISTRY OF LEGAL AFFAIRS
INTELLECTUAL PROPERTY OFFICE
PRACTICE DIRECTION NO. 1 OF 2008
EXTENSIONS OF TIME

In order to promote an efficient and improved system for the registration of Trademarks, I issue the following Practice Direction, with effect from May 1st, 2008:

1. Please be advised that extensions of times will no longer be granted for any reason that this Office may consider frivolous and vexatious including but not limited to the following circumstances:

    a) The firm is in the process of compiling information from the client;
    b) The client is away on vacation and cannot be located;
    c) The high volume of work in the firm has caused an inability to meet the required deadline;
    d) The client is in the process of accumulating evidence to support the present application;
    e) The firm is awaiting the client's instructions;
    f) The firm is in the process of clarifying the client's queries;
    g) The firm is unable to locate some of the correspondence; and
    h) The relevant Attorney was not in office.

2. Please note:

    (i) An extension of time will only be granted if I am satisfied that the circumstances justify the extension and the application for the extension of time must be made well in advance of the prescribed deadline date because extensions will no longer be granted as of rote.

    (ii) I will no longer grant multiple extensions of time in relation to one application, particularly where the requests have delayed the processing of the application in excess of six months.

The examples cited at paragraph 1 (a) to (h) above are not to be considered as an exhaustive list of the types of reasons that I consider inadequate.

I will maintain my discretion to determine each application for an extension of time on its own merit.