

**TRADE MARKS ACT, CAP 257  
LAWS OF BELIZE, REVISED EDITION 2000**

**IN THE MATTER OF APPLICATION NO. 7271.10 BY BRITISH AMERICAN  
TOBACCO (BRANDS) LIMITED TO REGISTER TRADEMARK:**

**CLICK**

**AND**

**THE OPPOSITION THERETO BY PHILLIP MORRIS PRODUCTS, S.A.**

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**T.M. RULING NO. 1/2013**

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**The Registrar, Intellectual Property Office, Belize**

**Trade Marks Act, CAP. 257, Laws of Belize, Revised Edition 2000**

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**In the Matter of Application No. 7271.10 by British American Tobacco (Brands) Limited to register trademark:**

**CLICK**

**And the Opposition thereto by Phillip Morris Products, S.A.**

**BACKGROUND**

- 1) This opposition relates to an application made by British American Tobacco (Brands) Limited (hereinafter referred to as BAT), to register the above trademark. The filing date of the application was November 16, 2010 and the application had the following specification:

*Cigarettes, cigars, cigarillos, tobacco, lighters for smokers, matches.*

The above goods are in Class 34 of the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks (hereinafter referred to as the Nice Agreement).

- 2) Phillip Morris Products S.A. (hereinafter referred to as Phillip Morris) filed an opposition against the above application.
- 3) Phillip Morris claims that the BAT trademark is devoid of any distinctive character. Phillip Morris also claims that the BAT trademark is descriptive as it consists exclusively of a sign in or indication which may serve in trade to designate/describe the kind and or intended purpose and or other characteristics of some of the goods for which it is intended to be registered. Phillip Morris further claims that to the best of their knowledge, information and belief, the BAT trademark cannot and in fact has not acquired any distinctive character as a result of the use thereof.
- 4) BAT answered the opposition by submitting that its trademark falls within the meaning of “trade mark” in accordance with the Trade Marks Act, Chapter 257 of the Laws of Belize, Revised Edition 2000 (hereinafter referred to as “the Act”) and further does not offend against any of the provisions of the Act. BAT claims that its trademark has distinctive character in relation to its goods. According to BAT, the mark is an original and contrived trademark and is fanciful in connection with its goods. BAT claims that the mark does not consist of signs or indications that may serve in trade to designate the characteristics of its goods and that the mark does not consist of signs or indications that have become customary in the current language or in the bona fide and established practice of trade. Furthermore, BAT states that the mark would be regarded by consumers and traders as a trademark, intended to be a trademark and as something distinctive and could not be mistaken as having a descriptive quality. Finally, BAT claims that Phillip Morris has no rights, whether of a trademark nature or otherwise, such as to be capable of preventing the BAT trademark from being registered.

- 5) BAT argued that a refusal to register the BAT trademark as advertised would unfairly prejudice its legitimate business interests.
- 6) BAT argued for the dismissal of the opposition and that its trademark should be allowed to proceed to registration.
- 7) Both sides filed evidence.
- 8) The case was heard on February 27, 2013. Phillip Morris was represented by Mr. Nicholas Dujon of Dujon and Dujon. BAT was represented by Ms. Oneyda Flores and Mr. Rishi Mungal of Morgan and Morgan Trust Corp. (Belize) Ltd.

## **EVIDENCE**

### **Evidence of Phillip Morris**

- 9) This is furnished by way of a sworn affidavit by Maximilien Yaouanc, Senior Counsel at Phillip Morris International Management S.A. He states that the term “click” is neither original, contrived nor fanciful but rather a common word of the English language defined as a “slight or sharp sound as of a switch being operated.” He states that the term “click” is primarily descriptive of the characteristics of the goods and is virtually omnipresent in any user manual whenever a product feature or component produces a ‘click” when activated or engaged as a signal to the user that it is activated or engaged. He states that tobacco products, and in particular cigarettes are no exception. He exhibited a copy of the relevant entry of the Oxford English Reference Dictionary for the term “click” and also images which depict certain tobacco products sold by various tobacco companies, including BAT, making use of the term “click” to describe the sound made by a plastic capsule inserted in the filter of cigarettes when the same is crushed by the smoker. He further states that the term “click” is also descriptive of lighters as it describes how the good is to be used by consumers.

### **Evidence of BAT**

- 10) This is furnished by Mr. Clyde Elliott Woods, Trade Mark Manager, British American Tobacco (Brands) Limited of Globe House. He states that the BAT trademark is distinctive and not descriptive in respect of International Class 34 goods. He also states that the BAT trademark is inherently distinctive and can be registered in other jurisdictions. He exhibited copies of registration certificates issued by other relevant Intellectual Property Offices, publication notices and copies of receipts for filing in Trinidad, Barbados and Jamaica. He also submits that the BAT trademark is currently in use in a number of jurisdictions around the world. He exhibited an example of the proposed cigarette pack design incorporating the BAT trademark in combination with elements, asserting that the exhibit shows that the BAT trademark is clearly being used in a trade mark manner to denote the origin of the goods to which it is affixed.

## DECISION

### Relevant Law

- 11) Section 35 of the Belize Trade Marks Act (hereinafter referred to as “the Act”) provides as follows:

#### *Grounds for Refusal of Registration*

35.-(1) The following shall not be registered:-

- (a) signs which do not satisfy the requirements of the definition of a trade mark;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the **bona fide** and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c), or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

- 12) In order for absolute grounds for refusal to be applied to the Applicant’s trademark, the Opponent must show that the mark is devoid of any distinctive character or is descriptive, generic or characteristic of the class of good being sold. Where the Opponent shows that the Applicant mark is not distinctive, the burden shifts on the Applicant to show that the mark has acquired distinctive character through use, which would give rise to the application of the proviso in paragraph 2 of section 35(1) of the Act.

Relevant cases for determining the issues under section 35(1) of the Act are *Case 89/104/EEC, Societe des Produits Nestle SA v. Mars UK Ltd. [2003] ETMR*; *Case C-53-01*; *Case -54/01, Winward Industries Inc. v. Rado Watch Ltd. (RPC (45) 803)*; *Joined Cases C-108&109/97 Windsurfing Chiemsee [1999] ECR I-2779*; *Sabel v. Puma (AG C-251-95)*; *C-191/01 P Wrigley v. OHIM*; and *W and G Du Cros Ltd’s Applications (1913) 30 RPC 660*.

## RULING

### Examination of distinctiveness

- 13) 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*.

- 14) 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*.
- 15) The applicant's mark has been applied for in respect of tobacco products namely cigarettes, cigars, cigarillos, tobacco, lighters for smokers, and matches. It is not a specialist or technical area and the average consumer will therefore be the general public. The question I must ask therefore is whether the mark would serve to indicate, when encountered by a member of the general public, that the goods provided under it originate from a particular trader and thus, distinguishes their services from those of other traders.
- 16) I find that in relation to the goods applied for by the Applicant, "CLICK" is likely to be taken as referring to the innovative technique to enhance tobacco cigarettes through the addition of flavored ampules that allows the user to release the flavors contained therein and therefore descriptive rather than distinctive. The relevant class of persons is likely to take "CLICK" as a reference to clicking a capsule in the filter of the cigarette to switch from the conventional flavour to the other flavour contained in the capsule, making the term "CLICK" lacking in distinctiveness for some of the goods in International Class 34.
- 17) According to the Opponent's evidence, various tobacco companies sell cigarettes that incorporate these flavored ampules and also use the term "CLICK" to describe the release of these ampules. While the Opponent's evidence does not establish the use of such cigarette products in Belize, it points to the likeliness of various tobacco companies wishing to use the term "CLICK" to describe the ability to release flavored ampules within a cigarette.
- 18) As stated by Lord Parker in *W and G Du Cros Ltd's*, the relevant query is: are other traders likely, in the course of their business and without any improper motive, to desire to use the same or a similar word (or sign) upon or in connection with their own goods? In the present case, I find that it is likely that other traders will desire to use the word "CLICK" in connection to the goods in International Class 34 and thus, by allowing the Applicant to register the word "CLICK", may hinder other traders who wish to aptly describe the action to release flavored ampules within their cigarettes.
- 19) **I find that the Applicant's mark is not distinctive.**

#### **Examination of descriptiveness**

- 20) A word cannot be registered as a trademark if it designates a characteristic of some of the goods or services concerned in one of its possible meanings. Therefore, in determining whether or not a mark is descriptive, it is not necessary that the mark actually be in use at the time of the application for registration in a way that is descriptive of the goods or services to which the application is filed. It is sufficient that such mark could be used for such purposes. A sign must therefore be refused registration if at least one of its

possible meanings designates a characteristic of the goods or services concerned. *Wrigley v. OHIM*

21) From the above therefore, descriptiveness must be assessed on whether the mark *may* be descriptive of the goods to which the application is filed. In consideration of the evidence provided, I find that the term “CLICK” may be descriptive of a characteristic of some of the goods applied in International Class 34 as traders may use it to describe the actions required to release the flavoured ampules within cigarettes or the action of using a lighter. Where a mark describes some function, intended purpose, or characteristics of some of the goods or services applied for, it cannot be registered.

22) By registering the term “CLICK”, traders would be inhibited in using the word “CLICK” to describe this feature in relation to those goods. The word is thus not inherently distinctive to distinguish the goods of BAT from those of any other trader.

**23) I find the Applicant’s mark to be descriptive.**

## **CONCLUSION**

**24) I therefore conclude that the mark applied for is devoid of any distinctive character under the meaning of 35(1)(b) of the Act and that the mark is descriptive within the meaning of 35(1)(c) of the Act.**

25) In this decision, I have considered all the documents filed by the Applicant and all the arguments submitted to me in relation to this application and, for the reasons given, the mark is refused registration under the terms of Section 37(1) of the Act.

## **COSTS**

26) Phillip Morris, having been successful, is entitled to a contribution towards its costs. I order BAT to pay Phillip Morris the sum of \$1,225.00 (see Annex). This sum is to be paid within seven days of the expiry of the appeal period of twenty-one days, or within seven days of the final determination of this case if any appeal against this decision is unsuccessful,

Dated this 14<sup>th</sup> day of May, 2013.

Candace Fisher  
Deputy Registrar  
Of Intellectual Property

**APPENDIX**  
**AWARD OF COSTS**

<b>ITEM</b>	<b>\$BZ</b>
<b>Filing Notice of Opposition</b>	<b>175.00</b>
<b>Preparing and filing evidence in support</b>	<b>200.00</b>
<b>Receiving and perusing evidence in answer</b>	<b>100.00</b>
<b>Preparation of case for hearing</b>	<b>350.00</b>
<b>Attendance at hearing by Attorney-at-Law</b>	<b>400.00</b>
<b>Total Costs</b>	<b>1,225.00</b>