

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

**IN MATTER OF APPLICATION NO. 8019.11 BY LODESTAR ANSTALT TO
REGISTER TRADE MARK:**

AFTER HOURS

AND

**THE OPPOSITION THERETO BY BRITISH AMERICAN TOBACCO
CARIBBEAN S.A..**

T.M. RULING NO. 1/2014

The Registrar, Intellectual Property Office, Belize

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

In Matter of Application No. 8019.11 by Lodestar Anstalt to register trade mark:

AFTER HOURS

And the Opposition thereto by British American Tobacco Caribbean S.A.

BACKGROUND

- 1) This opposition relates to an application made by Lodestar Anstalt (hereinafter referred to as Lodestar), to register the above trade mark. The filing date of the application was August 5, 2011 and the application had the following specification:

Tobacco, cigarettes, cigars, cigar and cigarette holders not of precious metal, cigar and cigarette cases not of precious metal, ashtrays not of precious metal, lighters for smokers, pocket machines for preparing cigarettes, matchboxes not of precious metal, tobacco pipes, tobacco jars not of precious metal, tobacco pouches, pipe racks for tobacco pipes; pipe cleaner for tobacco pipes, cigar cutters, cigarette tips, 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) British American Tobacco Caribbean S.A. (hereinafter referred to BATCA) filed an opposition against the above application.
- 3) BATCA states that they have previously registered their “After Hours” mark in Guatemala and have launched various products in Guatemala using the aforementioned brand. BATCA also states that there has been no use of the BATCA “After Hours” mark in Belize but that they have made a decision to expand from Guatemala to the rest of the Central American countries, and therefore has a bona fide intention to use the said mark in Belize. BATCA claims that the said mark qualifies for protection under the Paris Convention for the Protection of Industrial Property, in particular article 6bis. BATCA also asserts that the Applicant’s mark contravene’s sections 37(1) and 37(2) of the Trade Marks Act and should not be registered by virtue of the fact that it is similar to the Applicant’s mark, as an earlier mark, and is to be registered for similar, or identical goods or services which would cause a likelihood of confusion on the part of the public, including a likelihood of association with the Applicant’s earlier mark. BATCA also claims that their mark is entitled to protection as a well known mark pursuant to section 38(1)(b) of the Trade Marks Act and therefore requests that the subject application be refused registration.
- 4) Lodestar answered the opposition by rejecting the assertion that bona fide intention to use the “BATCA” mark in Belize can be advanced/established by filing an application after that of the Applicant. The Applicant also argued that

the BATCA mark is not well known and entitled to protection under the Paris Convention nor section 38(1)(b) of the Trade Marks Act. Lodestar also rejected BATCA's assertion that the present application contravenes section 37(1) and 37(2) of the Trade Marks Act. Lodestar claimed to have registered and used its AFTER HOURS trade mark in various countries throughout the world and at least one other similar mark has been registered in Belize.

- 5) Lodestar argued for the dismissal of the opposition and that its trade mark should be allowed to proceed to registration.
- 6) Both sides filed evidence.
- 7) The case was heard on October 2, 2014. Lodestar was represented by Mr. Nicholas Dujon of Dujon and Dujon. BATCA was represented by Ms. Oneyda Flores of Morgan and Morgan Trust Corp. (Belize) Ltd.

EVIDENCE

Evidence of BATCA

- 9) This is furnished by way of a sworn affidavit by Amanda Cavill de Zavaley who is currently employed by BATCA. Ms. de Zavaley states that BATCA has been engaged in the manufacture, sale and distribution of cigarettes and tobacco products for over 100 years in over 180 countries. She states that although there has been no use of BAT's trade mark "After Hours" in Belize, BATCA made the decision of expanding the use of this mark from Guatemala to the rest of Central America including Belize, based on business strategy. Ms. de Zavaley asserts that part of the strategy of BATCA is to purchase all tobacco trade marks and other related intellectual property in the name of Caribbean Tobacco Company (CTC) of Belize and CTC's partner company, Marketing and Distribution Company (MADISCO), was appointed as BAT Caribbean's exclusive distributor for Belize. Ms. de Zavaley stated that their "After Hours" application was filed in order to show good faith not only to oppose but to proceed with the registration of its own trade mark. She further stated that BAT's trade mark "After Hours" is a well known BAT trade mark within the Central American region and is currently used in Guatemala. Ms. de Zavaley further stated that the goods and services of BAT have acquired goodwill/reputation in Belize market, as described in an affidavit from MADISCO.
- 10) Charles Wood, employee of MADISCO stated that in December 2010, MADISCO entered into a distribution agreement with the BAT group, which includes but is not limited to BATCA. He stated that under the terms of the distribution agreement, MADISCO was appointed as BAT's exclusive distributor for Belize regarding the sale and distribution of BAT's cigarettes and tobacco products. Mr. Woods stated that the sale and distribution of BAT's cigarettes and tobacco products would include the After Hours mark. Mr. Woods claims that the appointment of MADISCO as BAT's exclusive distributor for Belize provides the BAT group with a market leading position in Belize and will strengthen BAT's ability to continue providing the highest quality tobacco products in Belize, including goods bearing BAT's After

Hours trade mark. Mr. Woods asserts that the Opponent's After Hours application has been made in good faith.

Evidence of Lodestar

11) This is furnished by Amanda C. Young, Director of Mopan Directors Limited, the Director of Fender Tobacco Inc. who are the exclusive licensees on a worldwide basis, of the the "NARROW MARGIN AFTER HOURS" and "AFTER HOURS" trade marks belonging to Lodestar. She states that the first application for the mark NARROW MARGIN AFTER HOURS was filed in Liechtenstein on September 22, 2003, under application number 12991, for goods in Class 25 and 34 with applications filed across the world, including Belize, claiming priority from application number 12991. She submits that Lodestar also applied for the AFTER HOURS in respect of goods in Class 25 and 34 across the world, including Belize. She refutes that the BATCA AFTER HOURS mark is well known, or is sufficiently well known in Belize so as to prevent Lodestar from expanding their brand to Belize. She states that Lodestar has demonstrated that they too have an interest in the AFTER HOURS mark and have since applied for trade mark applications and registrations in a number of countries. She further submits that she does not have knowledge of whether the AFTER HOURS mark is easily recognisable or pronounceable by the population of Guatemala and therefore cannot pass comment on whether the mark is well known in the context of Belize trade mark law and practice.

DECISION

Relevant Law

12) Section 37(1), 37(2), 37(4)(a), 38 and 61 of the Belize Trade Marks Act (hereinafter referred to as "the Act"), and Article 6bis of the Paris Convention provides as follows:

Relative Grounds for Refusal of Registration

37.-(1) A trade mark shall not be registered if it is identical with an earlier trade 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 trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in

Belize is liable to be prevented:-

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

(5) A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an earlier right in relation to the trade mark.

(6) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Meaning of earlier trade mark

38.-(1) In this Act, an earlier trade mark. means:-

- (a) a registered trade mark or an international trade mark (Belize) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the 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.

(2) References in this Act to an earlier trade mark include 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 subsection (1) (a) or (b), subject to its being so registered.

(3) A trade mark within subsection (1) (a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the Registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry.

Protection of well known trade mark: Article 6bis of Paris Convention

61.-(1) References in this Act to a trade mark 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 mark begun before the commencement of this section.

Well known Marks

Article 6bis —(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 trade mark 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.

13) In order for relative absolute grounds for refusal to be applied to the Opponent's trade mark, the Opponent must show that the mark is identical to an earlier trade mark belonging to the Applicant for identical goods or services or is similar to an earlier trade mark belonging to the Opponent and is applied to similar goods or services. The Opponent must therefore prove that its mark qualifies as an earlier mark under section 38 of the Act. Where the Opponent proves that its mark qualifies for protection as an earlier trade mark and the Applicant's mark is identical or similar to the Opponent's mark, the Applicant's mark will not proceed to registration.

The leading authorities which guide me in this opposition are from the ECJ: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro- Goldwyn- Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, and *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04

Consideration of the case under section 37(1) and 37(2)

Comparison of goods

14) The goods in question are as follows:

Tobacco, cigarettes, cigars, cigar and cigarette holders not of precious metal, cigar and cigarette cases not of precious metal, ashtrays not of precious metal, lighters for smokers, pocket machines for preparing cigarettes, matchboxes not of precious metal, tobacco pipes, tobacco jars not of precious metal, tobacco pouches, pipe racks for tobacco pipes; pipe cleaner for tobacco pipes, cigar cutters, cigarette tips, matches.

15) It is clear that the identical specification, namely, cigarettes, satisfy the test for identical goods in sections 37(1) and 37(2) of the Act. Both proprietors seek to engage in cigarettes and other products related to tobacco and smokers.

16) I find that the respective goods are similar.

Comparison of trade marks

17) The trade mark to be compared is the following word mark:

AFTER HOURS

18) In assessing the similarity of trade marks, it must be noted that the average consumer usually regards a trade mark as a whole and does not conduct a detailed analysis of the trade mark. In conducting an assessment of the visual, aural and conceptual similarities of the trade marks, reference must be made to the overall impressions created by the trade marks while taking note of their distinctive and dominant components (*Sabel BV v Puma AG*).

The main elements of the mark are the words “AFTER HOURS”. There is no particular font, logo or styling attached to the mark in question. Both the Applicant and the Opponent are seeking to register the words “AFTER HOURS”.

19) I find that the respective marks are identical.

Likelihood of confusion

17) The likelihood of confusion must be assessed based on the fact that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. The average consumer would therefore be a member of the general public who would select the goods by primarily visual means, and is reasonably well informed and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*).

18) In view of the similarities between the goods and the mark highlighted above, I submit that the average consumer would likely be confused by both marks.

19) I find that there is a likelihood of confusion.

Consideration of the matter under section 38(1)(b)

20) 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.

21) 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.

22) 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.

23) In Hotel Cipriani SRL et al v Cipriani (Grosvenor Street) Limited et al [2008] EWHC 3032 (CH), Mr Justice Arnold commented that “Section 56 implements in domestic law Article 6bis of the Paris Convention and Article 16 of TRIPS. It provides a remedy for foreign traders whose marks are well known in the United Kingdom but do not own goodwill here.”

24) With the aforementioned decided cases in mind, I turn to consider the circumstances in these proceedings. While the Opponent has exhibited evidence of registration of the BAT’s AFTER HOURS mark in several Central American countries, no evidence was submitted to demonstrate knowledge of the BAT’s AFTER HOURS by a substantial number of the relevant consumers in Belize, including knowledge obtained as a result of advertisements and marketing of the mark in Belize. Furthermore, in the evidence by way of affidavit submitted by the Opponent, it is admitted that there has been no use of the BAT’s trade mark AFTER HOURS in Belize so far but rather an intention to expand the use of the mark to Belize. Therefore, the level of recognition needed to claim that the mark is well known in Belize and qualifies as an earlier trade mark has not been established.

25) I find that there is no evidence to support the claim that the Opponent’s mark qualifies for protection as a well known mark under the Paris Convention and thusly as an earlier trade mark under section 38(1)(b) of the Act.

CONCLUSION

24) Lodestar's application is allowed to proceed to registration because the Opponent's mark does not satisfy the definition of an earlier trade mark under section 38(1)(b), namely, a well known trade mark entitled to protection under the Paris Convention and is therefore not entitled to protection under sections 37(1) and 37(2) of the Trade Marks Act.

COSTS

26) Lodestar, having been successful, is entitled to a contribution towards its costs. I order BATCA to pay Lodestar 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 21st day of December, 2015.

***Candace Fisher
Deputy Registrar
of Intellectual Property***

APPENDIX
AWARD OF COSTS

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