

TRADE MARKS: FUNDAMENTAL ELEMENTS OF THE NEW LAW

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INTELLECTUAL PROPERTY LAW: PROBLEMS OF DEFINITION

The grandiloquent and esoteric phrase "intellectual property" is inexact in definitional terms, possibly because its content and subject matter are in a transitory evolutionary stage impacted upon by information technology, on the one hand, and the globalisation of trade, on the other hand. Also, the subject matter of intellectual property itself, transverse disparate fields of law, whose purpose, principles and content have no filial nexus. Maybe that explains why before the 1960s, the term "industrial property" was in much usage in the common law world to describe the system of law that regulated the registration, management, administration and maintenance of patents, trademarks, industrial designs, utility models, and so on. However, it is axiomatic that this term inadequately described creations of the intellect proper, those like the literary, artistic and musical creations of authors and artists, and the related rights of performers, composers, broadcasters and producers flowing therefrom.

These definitional polemics were to some extent laid to rest by the Convention Establishing the World Intellectual Property Organization¹ which in Article 2 thereof, defined "intellectual property" as *including* rights relating to literary, artistic and scientific works, performances of performing artists, phonograms, and broadcasts, inventions in all fields of human endeavour, scientific discoveries, industrial designs, trademarks, service marks, and commercial names and designations, protection against unfair competition, and all other rights

¹ Signed at Stockholm on 14 July, 1967, and amended on 28 September, 1979.

resulting from intellectual activity in the industrial, scientific, literary or artistic fields.

Recent international events, however, highlight that the above definition, although non-exhaustive in formulation, may have become overtaken by time, for, as already pointed out above, areas like traditional knowledge and biodiversity have claimed a prominent position in discussions on intellectual property. The above discourse perhaps demonstrates the inexactitude of the field of intellectual property, its connections to all sorts of human creation and pro-creation, and this Paper endeavours to inform only on fundamental aspects of trademarks law in Belize following the enactment of the Trade Marks Act,² Chapter 257 of the Substantive Laws of Belize, Revised Edition 2000 and the Trade Mark Rules,³ 2002, which repealed the Registration of United Kingdom Trade Marks Act of 1938 and the Trade Marks Rules which gave effect to that Act.

HISTORICAL ORIGINS OF TRADE MARKS: A BRIEF CONSPECTUS

The modern trademark has two historical roots: firstly the "proprietary mark"⁴, which was optionally but usually fixed to goods by the owner of the goods bearing the mark, either for the benefit of illiterate clerks, or in order that in cases of shipwreck, piracy or where the goods were lost in transit, they might be identified and reclaimed by the owner. This mark, therefore, was essentially a merchant's rather than a producer's mark, and did not serve to identify the origin or source of production of the goods; and secondly, the "regulatory production mark" or the "hallmark" whose genesis can be traced to the medieval guild system, where it was compulsorily affixed to goods, so that

² The Act was originally enacted as "The Trade Marks Act (No. 17 of 2000) and will hereafter be referred to as "the Act" or "the new law".

³ No. 3 of 2002, hereafter referred to as "the Rules". These Rules repealed and replaced the Trade Mark Rules, 2000 (No. 8 of 2001).

⁴ This is what the Roman-Dutch law called "*the signa mecatorium*"

defective goods, or goods of inferior craftsmanship, could be traced back to the errant craftsman, whereafter the guild warden would then discipline the craftsman either by the imposition of fines or by expelling him from the guild. Also, the hallmark served to identify goods smuggled into an area over which a guild had a monopoly, and upon discovery of the smuggling, the goods were confiscated. As such, this mark served to indicate the source of production or the origin of the goods, and might be described as the historical antecedent to the modern trademark⁵.

The European industrial revolution which occurred in the latter half of the 19th century, introduced and witnessed an increase in the production of goods, an increase in the distribution of goods facilitated by cheap methods of transportation through the recent inventions of railway trains and the construction of canals, and the introduction of the concept of advertising. As a commercially valuable asset, therefore, the incidence of modern trademarks owe their origin in large measure to the industrial revolution. In the words of Cornish, "the demand for general legal protection against unfair imitation of marks and names is a product of the commercial revolution that followed upon factory production and the growth of canals and railways. That demand has swelled immensely with the development of modern advertising and large scale retailing. Most advertising reached the consumer to buy by product mark or house name and it keeps reiterating its message in the hope of stopping buyers from defecting to rivals. Trade marks and names have become nothing more or less than the fundament of most market-place competition"⁶.

Postulated conversely, the industrial revolution introduced a paradigm shift in a craftsman's reputation; whereas in the medieval age the reputation was personal based on the hallmark,

⁵ Schechter, Frank, "*The Rational Basis of Trade Mark Protection*" (1925) Harvard Law Review. See further Schechter, Frank, "*The Historical Foundations of the Law Relating to Trade Marks*" (1925), Cap. 6. See also Rutherford, Brian and Kelbrick, Rohanna, University of South Africa, "Essential Trade Mark Law", Chapter 1.

⁶ Cornish, "Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights" (1999), 599.

during the industrial revolution and subsequently thereafter it became nonpersonal, symbolized by the trademark.

On the base of the industrial revolution was in turn built two legal superstructures, by the first of which producers of goods were allowed to sue their competitors upon unfair, deceitful or false representations that their goods were those of their rivals, and the second of which tried to rationalize the use of trade marks through a system of registration.

Under the rubric of the first legal superstructure, both the courts of common law and equity in England fashioned a remedy to protect a manufacturer from the “passing off” by another of his goods as those of the manufacturer. The basis of legal intervention was founded on the reputation that the manufacturer has acquired in his trade mark. Although the courts realized it was the public rather than the proprietor of the trade mark who was deceived, as James LJ stated in the 1880 case of *Singer Manufacturing Co. v Logo*⁷, “what ever name is used to designate goods, anybody may use that name to designate goods: always subject to this, that he must not, as I said, make, directly or through the medium of another person, a false representation that his goods are the goods of another person”. And in 1896, Lord Halsbury had opined that “nobody has any right to represent his goods as the goods of somebody else⁸”. Equity, on the other hand, acting in “aid of” and “ancillary to” what it deemed to be a “legal right” to have a particular trade mark, at first assumed jurisdiction in such cases to protect the proprietor’s “title” to a trade mark, regardless of the question of deceit⁹. The position of the Courts of Equity was eloquently stated in 1838 by Lord Chancellor Cottenham when he observed that “having previously come to the conclusion that there was sufficient in the case to show the plaintiffs had a title to the

⁷ [1880] 18 Ch. D. 395, 412.

⁸ *Reddaway v Banham* [1896] A.C., 199, 209.

⁹ *Mottley v Downnan*, 3 Myle & C1. 14 (1837).

marks in question; they undoubtedly had a right to the assistance of a Court of Equity to enforce that title".¹⁰

The historical conspectus above shows that the genesis of trade marks as a marketing tool, by and large, was essentially a part of the private manufacturing sector, attracting legal protection through *adoption and use*, rather than through any formal intervention by the state. This had serious ramifications for a society that was industrializing and virtually changing its production methods, and it became clear that a more formal system, regulated through central state authority, was required to assist the development of the trade mark system through registration. From this realization arose the second legal superstructure identified above - the system of trade mark registration still in use today, albeit in a modified form to suit the circumstances of our time. This system was based on statute law, which provided for a register of trade marks and for the registration of trade marks as a means of establishing, at least *prima facie*, a right of title in and to a trade mark¹¹.

HISTORICAL DEVELOPMENTS IN BELIZE: THE UNITED KINGDOM TRADE MARKS ACT

The genesis of statutory regulation of trade marks in Belize was introduced on the 17th February, 1939, by the Registration of United Kingdom Trade Marks Act¹². This Act was a "received" law, since its basic purpose was to enable the re-registration in Belize of Trade Marks registered in the United Kingdom under the 1938 United Kingdom Trade Marks Act, as amended.

Under this Act, any person who was the proprietor of a trade mark registered in the United Kingdom under the United Kingdom Trade Marks Act, 1938, as amended, or any person who

¹⁰ Millington v Fox, 3 Myl & C338 (1838), 352.

¹¹ See Torremans and Holyoak, *Intellectual Property Law*, 1998. 5. In England, the first statute regulating trade marks was the 1875 Trade Marks Regulations Act, which was followed by the Patents Designs and Trade Marks Act of 1883.

¹² The United Kingdom Trade Marks Registration Act of 1875.

was an assignee of such a proprietor, or who was entitled to the transfer to himself of the trade mark by some other mode of transfer, was entitled to apply for the registration of such mark in Belize in respect of some or all of the goods comprised in the United Kingdom registration, during the existence of the registration in the United Kingdom¹³. The application for registration was made to the Registrar General of the Supreme Court¹⁴, accompanied by a certified representation of the trade mark and a certificate from the United Kingdom Registrar of Trade Marks giving full particulars of the registration of the trade mark in the United Kingdom¹⁵. Upon receipt of the application and all the relevant documents, the Registrar General of the Supreme Court was enjoined to issue a certificate of registration to the applicant, who then became the registered proprietor in Belize of the trade mark in respect of the goods entered in the register. This system of registration of trade marks was deficient in that it precluded any form of examination by the Belize Registry Office, whether as to registrability (absolute grounds) or as to possible conflicts with earlier marks (relative grounds).

Registration conferred on the proprietor of a trade mark registered in Belize such privileges and rights in the use of the trade mark in respect of the goods entered in the register as *mutatis mutandis* would have been conferred on him by the law in force in the United Kingdom¹⁶. Put differently, the purpose of registering trade marks under the registration of United Kingdom Trade Marks Act was to extend the principle of territoriality (whereby the registration of a trade mark applies in the territory to which it is registered) to Belize, conferring on the proprietor in Belize all the rights, benefits and privileges he enjoyed in the United Kingdom. Such privileges and rights were conferred from the date of the registration of the trade mark in the United

¹³Chapter 213, Revised Edition 1980 – 1990. Formerly Chapter 220, Revised Laws of Belize, 1958.

¹⁴Section 3, Chapter 213.

¹⁵Section 4, Chapter 213.

¹⁶ Section 5, Chapter 213.

Kingdom and subsisted for so long as the registration in the United Kingdom remained in force in respect of the goods for which the trade mark was registered in Belize¹⁷. A fundament of such right was the conferment of registration privileges on the registered proprietor indefinitely for periods of fourteen years, subject to renewal¹⁸. The registration procedure was regulated by Rules made by the Registrar General of the Supreme Court, and this power included the prescribing of fees to be paid in respect of proceedings under the Act¹⁹. The Registrar General of the Supreme Court was also required to maintain a register of trade marks, wherein was entered all registered trade marks with the names, addresses, and descriptions of their proprietors and registered users; notifications of assignments and transmissions, and other prescribed matters related to registered trade marks²⁰. The register of trade marks was a public document, open to inspection by the public, and it was *prima facie* evidence of matters directed by the Act to be entered therein. The Registrar General of the Supreme Court was also authorized to correct the register by cancelling unrenewed trade marks, or by correcting clerical errors connected with any application, or by entering any change in the name, description or address of the person registered as a proprietor or user of a registered trade mark²¹.

Effect to the Registration of United Kingdom Trade Marks Act was given in the Trade Marks Rules²². These Rules contained six rules, and a Schedule. The said Rules required each application for the registration of a trade mark under the Registration of United Kingdom Trade Marks Act, and each application for an assignment, transmission or other instrument affecting the title to, or giving any interest in respect of, the privileges and rights conferred by registration, to be in writing and signed by the applicant, and to be addressed to the Registrar

¹⁷ Section 6, Chapter 213.

¹⁸ Section 7, Chapter 213.

¹⁹ Section 13, Chapter 213.

²⁰ Section 14, Chapter 213.

²¹ Section 15, Chapter 213.

²² Section 16, Chapter 213.

General of the Supreme Court²³. The Registrar General of the Supreme Court was required to issue certified copies of, or certificates in connection with, documents or records kept under the Act, upon payment of the fees that were prescribed in the Schedule to the Rules²⁴. The public was also authorized to search the register of trade marks and documents maintained in the Registry upon payment of the prescribed fees²⁵. Fees were payable to the Registrar General by means of adhesive postage and revenue stamps²⁶.

THE NEED FOR REFORM: THE RATIONAL BASIS OF THE NEW LAW

Notwithstanding the age-old adage that old laws, like matured wine, have the virtue of strength, and like a long-established marriage, have the advantages of certainty and clarity, in 2000, the Belizean legislature, by one fell swoop of the pen, severed the colonial umbilical cord that tied Belize to the United Kingdom through the Registration of United Kingdom Trade Marks Act and Rules made thereunder in the registration

²³Subsidiary Legislation of Belize 1991 Edition, Volume V, Chapter 213, p.p. 2 – 3. Initially enacted as Statutory Instrument No. 23 of 1973.

²⁴ Rule 2 and Rule 5

²⁵ Rule 2 and Rule 5

²⁶ The fees that were prescribed were as follows:

<u>SCHEDULE OF FEES</u>		
	\$	c
On filing every application for registration of a Trade Mark (including the certified representations of the Trade Mark and the certificate of the Comptroller General of the United Kingdom Patent Office)	25	00
On every certificate	8	00
On every application under section 10 of the Act (including filing certified copy of the document).....	20	00
On every renewal under section 15 of the Act	20	00
On every application under section 16 of the Act (including Filing certified copy of the document	20	00
On every search	2	00
On every extract	3	00
On an office copy of any record per folio or part thereof	1	00'

of trade marks, and enacted the new law: The Trade Marks Act of 2000.

Events, both within and without Belize, informed the paradigmatic nature of the new law, for it was shaped in the context of the obligations of Belize under international trade and intellectual property rights conventions, premised on the need to discharge such obligations, at the same time placing the regime of trade mark protection firmly within a Belizean milieu, and regionally, within the legal framework of the Caricom Single Market and Economy ushered in by amendments to the Treaty of Chaguaramas. As such, any rational basis for the new law must of necessity involve an examination not only of business and other economic arrangements within Belize, but of developments at the international for a, and of these, the latter will be examined first.

Rutherford and Kelbrick rationalized the need for international agreements to regulate the field of trade marks law by pointing out that although "trade marks enjoy protection only in the territory within which they are registered (the principle of territoriality), they are rarely only found within that territory, and international arrangements which protect marks are of immense importance, as they can enable a proprietor to protect his mark outside his own national borders. If a proprietor wishes to trade outside the borders of his country, he must ensure that his mark is protected in those territories. Failure to do this can result in the adoption by other traders of his mark, or allegations by rival traders that his mark infringes other marks"²⁷.

Holyoak and Torremans²⁸ described the necessity of international conventions from a background which realizes that "intellectual property is not necessarily exploited at a national level, it is in fact exploited at a global level. The CocaCola trade mark is found on cans and bottles all over the world. Inventors and creators would under these circumstances lose out if

²⁷ Rutherford and Kelbrick, *Trade Marks Law*, University of South Africa, 1.1.6 – 1.7.7.

²⁸ Holyoak and Torremans, *Intellectual Property Law*, 1998.

intellectual property regimes were completely different in each country. They would not get adequate protection and they would not be adequately rewarded for their work if intellectual property rights, based on the same principles and equally applicable to inventions and creations made abroad, were not available in each country in which the trade mark is exploited. The whole economic justification theory would collapse in such a case. A global economy presupposes a global intellectual property system".

In 2000, Belize became signatory to the International Convention for the Protection of Industrial Property²⁹. This Convention was concluded at Paris in 1883, from whence it draws its acronym as "the Paris Convention" and has been revised six times, the last revision having taken place in Stockholm in 1967. The Paris Convention is the principal international legal instrument regulating inter-state cooperation in intellectual property matters, including trademarks.

In its introductory Article, the Paris Convention declares that the states parties to the Convention are constituted into a Union for the protection of industrial property, which term is defined to include "patents, utility models, industrial designs, trade marks, service marks, trade names, indications of source or appellations of origin, and the repression of unfair competition³⁰", and the Convention further expressly declares that "industrial property" should be "understood in the broadest sense" as applying not only to industry and commerce *stricto sensu*, but as extending to agricultural and extractive industries, to all manufactured or natural products like wines, grain, tobacco leaf, fruit, cattle, minerals, mineral waters, beer, flowers and flour.

The Paris Convention then proceeds to enjoin states parties to accord to nationals of other states parties the same advantages, rights, privileges and legal remedies as regards the

²⁹ Hereafter "the Paris Convention".

³⁰ Article 1 (1).

protection of trademarks as they accord to their own nationals. This principle is commonly known as the principle of *national treatment*. Also, the Paris Convention declares that where a trade mark application is filed in a state party to the Convention, the applicant of the trade mark application is thereby given a six-month *priority period* in any other state party to the Convention to file the same application over everyone else who wishes to register the same trade mark³¹. A trade mark Applicant wishing to rely on the priority of a previous filing is required by the Paris Convention *to make a declaration indicating the date of such filing and the country in which it was made, and such declaration shall be mentioned in publications issued by the relevant Intellectual Property Registry of each state party in relation to the trade mark application*, and for this purpose the relevant Intellectual Property Registry of each state party may, in respect of an application for which priority is claimed, require the person making a declaration of priority *within ninety days of the first filing date* to produce a copy of the first application previously filed, certified as correct by the Intellectual Property Registry which first received such application, accompanied by a certificate from the Intellectual Property Registry which first received such an application showing the date of filing, and any translation, if applicable.

The Paris Convention then proceeds to provide that if in any state party to the Convention, *use of a registered trade mark is compulsory*, such mark may be cancelled only after a reasonable period of non-use and only in circumstances where the registered proprietor of the mark does not justify such non-use. For this purpose, use of a trade mark in a form differing in elements which do not change the distinctive character of the mark does not amount to non-use of the trade mark entailing its invalidation³².

³¹ Article 4 (1), (3) C (1) and (2) . In computing the priority period, the date of filing the first application is not included in the period, and if the last day of the period falls on a public or bank holiday, it is to be extended equally to the next working day.

³² Article 6.

The Convention also allows domestic legislation to provide for concurrent use of the same trade mark on identical or similar goods by industrial or commercial establishments considered as co-proprietors, provided such use does not mislead the public or is not contrary to the public interest³³.

The Paris Convention additionally provides that an indication or mention of the registration of a trade mark is not required upon the goods as a condition of recognition of the right of protection of such trade mark³⁴. Article 5bis of the Paris Convention, which deals with periods of grace for the payment of fees for the maintenance of trade mark rights, provides that a period of grace of not less than six months shall be allowed in each state party to the Convention for the payment of the fees prescribed for the maintenance of trade mark rights, subject to the payment of a surcharge³⁵.

Conditions for the registration of marks are expressly left to domestic legislation by the Paris Convention, subject, however, to the qualification that a mark first filed by a national of a state party to the Convention in any country which is a member to the Convention may not be refused, nor may registration be invalidated, on the ground that no filing, registration or renewal, has been effected in the country of origin. Registered marks in one state party to the Convention are to be regarded as independent of marks registered in other states parties, including the country of origin³⁶.

In terms of Article 6bis of the Paris Convention, member states undertook to protect well-known marks owned by nationals of other member countries. In essence, the aim of this Article is to provide that a mark owned by a proprietor who is not a Belizean (i.e. a foreign proprietor) may not be used and registered by someone other than the foreign proprietor if it is

³³ Article 6bis.

³⁴ Article 5 (5) D.

³⁵ Article 5bis.

³⁶ Article 6.

well-known under the Convention in Belize and the proposed use of the mark in Belize is on similar goods, where such use is likely to cause deception or confusion³⁷.

As a party to the Paris Convention, Belize is enjoined to refuse or invalidate the registration, and to prohibit the use, as trade marks or elements of trade marks, of the flags and other state emblems of the countries to the Convention, and of other official signs and hallmarks indicating control and warranty adopted by them, and any imitation of such flags, armorial bearings, official signs and hallmarks³⁸. Such prohibition, refusal to register and invalidation of registration shall *mutatis mutandis* extend to the armorial bearings, flags, other emblems, abbreviations, and names of intergovernmental organizations to which one or more member states to the Convention are members³⁹. In respect of intergovernmental organizations, the obligation to prohibit use, or to refuse or invalidate the registration of an armorial bearing, etc., in Belize, does not apply to use or registrations effected before Belize became a party to the Convention, or where the use or registration is not of such a nature as to mislead the public or suggest the existence of a connection in the public eye between the organization concerned and the armorial bearings either used or registered as trademarks⁴⁰. To give effect to Article 6ter, member states are required to reciprocally communicate *inter se*, through the International Bureau of WIPO, the list of state emblems, official signs and hallmarks which they desire to fall within the purview of the protection offered by Article 6ter. Following upon such communication, each member state is required to compile a list of the emblems, etc., so communicated, which will be a public document⁴¹. Belize has not, to date, communicated the emblems it desires to be protected under Article 6 ter⁴². Where a

³⁷ Article 6bis.

³⁸ Article 6ter (1) (a).

³⁹ Article 6ter (1) (b).

⁴⁰ Article 6ter (1) (c).

⁴¹ Article 6ter (3) (a).

⁴² The communication is not obligatory in respect of flags of states in the terms of the proviso to Article 6ter (3) (a).

communication is made, a state party has a period of twelve months from the receipt of the communication to make objections to the source of the communication, through the International Bureau of WIPO⁴³.

In respect of assignments of trade marks, the Convention provides that where the law of a member state to the Convention recognizes the validity of an assignment of a trade mark *only* if it is effected contemporaneously with the transfer of the business or its good will, then an assignment is valid for the purposes of such law, if *only* a portion of the business or goodwill located in that country is transferred to the assignee, together with the exclusive right to manufacture in that country, or to sell therein, the goods bearing the mark assigned⁴⁴.

Marks registered in the country of origin are required to be accepted for filing and registration as is in other member states to the Convention, but before final registration is effected, countries are allowed to require an unauthenticated certificate of registration from the country of origin⁴⁵. The expression "country of origin" refers to a member state to the Convention where the Applicant has a real and effective industrial or commercial establishment, or where the Applicant has his domicile, or the country of which the Applicant is a national⁴⁶. The nature of the goods to which a trade mark is to be applied should not form an obstacle to the registration of the mark⁴⁷. Trade names, however, are eligible to protection in all member countries without the need to file or register them, whether or not they form part of a trade mark⁴⁸. If a trade mark or a trade name is unlawfully affixed to goods, such goods are liable to seizure on importation⁴⁹, or in the country where the unlawful

⁴³ Article 6ter (4).

⁴⁴ Article 6 quarter.

⁴⁵ Article 6 quinquies A (1).

⁴⁶ Article 6 quinquies A (2).

⁴⁷ Article 7.

⁴⁸ Article 8.

⁴⁹ Article 9 (1).

affixation occurs⁵⁰, or in the country where such goods were imported (if already imported), at the request of the prosecuting authorities or an interested party⁵¹. Goods bearing a false indication as to their source of origin, manufacturer, or merchant are likewise also liable to seizure⁵². For the purposes of such seizure, any producer, manufacturer or merchant engaged either in the production, manufacture or trade of such goods and having an establishment in the locality, region or country falsely indicated on the goods shall be an interested party in any case involving the goods⁵³.

Lastly, Article 12 of the Paris Convention enjoins member states to establish a special industrial property service and central office for the communication of intellectual property rights, including trade marks⁵⁴. The special industrial property office is required to regularly publish an official periodical journal on intellectual property matters, including, in respect of trade marks, the reproductions of registered trade marks⁵⁵. The Belize Intellectual Property Office is a direct progeny of this international legislative provision.

The major disadvantage of the Paris Convention is that it makes provision for the substantive elements, rather than the procedural elements, of trade mark registration, the latter of which it mainly leaves to the domestic legislation of member states. As such, an Applicant under the Paris Convention has to comply with the procedural requirements of registration in each member state where he seeks protection. Such Applicant cannot file a single multi-national or international application effective in each member state to the Convention designated in the application. As international trade grew, and more and more traders found themselves selling their goods in foreign countries, the need for a uniform international registration procedure which

⁵⁰ Article 9 (2).

⁵¹ Article 9 (3).

⁵² Article 10 (1).

⁵³ Article 10 (3).

⁵⁴ Article 12 (1).

⁵⁵ Article 12 (2).

would allow traders to file a single application and designate countries in which protection was sought gained momentum and resulted in the conclusion of several conventions, none of which Belize is yet a party. It may be necessary to briefly state these conventions here, and explain their salient provisions, just in case consideration is given by Belize at a later stage to ratify or accede to them.

One of such conventions is the Madrid Agreement Concerning the International Registration of Marks⁵⁶, which was concluded in 1891, and the Protocol Relating to the Madrid Agreement of 1989, which entered into force, replete with supporting Regulations, on 1 December, 1995, and came into operation on 1 April, 1996⁵⁷. The Madrid Agreement and the Madrid Protocol comprise what is commonly called the Madrid Union, administered by the International Bureau of WIPO, which maintains the international register of marks and publishes the *WIPO Gazette of International Marks*.

The Madrid Agreement is a special agreement under the Paris Convention⁵⁸. The Madrid Union currently has about fifty signatories. Any state which is a party to the Paris Convention may become a party to the Madrid Agreement or the Madrid Protocol, or to both the Agreement and the Protocol.

From the standpoint of the trader selling goods on the international market and desiring to protect his mark thereat, the Madrid Agreement and the Madrid Protocol offer some advantages. Firstly, the Madrid Agreement provides that a trader who is the proprietor of a mark registered in his home country can use the national registration as the basis of an international registration. From the date of the international registration the protection of the mark in each designated Madrid Union member state is the same as if the mark had been the subject of an application for registration filed direct with the national

⁵⁶ Hereafter "the Madrid Agreement".

⁵⁷ Hereafter "the Madrid Protocol".

⁵⁸ Article 19, Paris Convention.

intellectual property registry of such member state. If no refusal to register is notified to the International Bureau of WIPO within twelve (12) months for Madrid Agreement applications and eighteen (18) months for Madrid Protocol applications, then protection of the mark takes effect as if it had been registered by the national intellectual property registry of each member state. This equates a single international registration with a bundle of national registrations. The Madrid Union system also significantly simplifies the renewal, assignment, change of registered address and associated procedures which are effected by a single application and takes effect in all designated member states. Also, an international application may claim priority under Article 4 of the Paris Convention.

From the standpoint of national registries, the Madrid Union system has several advantages. The Agreement provides that an international mark will be accorded the same protection in each designated state in the same way as a national trade mark. National intellectual property registries are allowed to examine such international applications designating their countries in the same way as national applications, which is an important safeguard for pre-grant examinations and the refusal of registration where there are conflicting registrations.

Also, the fees payable under the Madrid Union system are largely centrally fixed and collected by the International Bureau of WIPO, although the Madrid Protocol allows national registries to charge international Applicants the difference between national and international fees where the international fees are less than the fees charged for national applications. The proceeds of the fees are shared among the member states of the Madrid Union system.

The Madrid Protocol has another further advantage to both Applicants and national registries, in that it provides a time limit of eighteen months for each member state to notify a refusal to register a mark, and provides further that a refusal to register a

mark based on opposition proceedings may be notified even after the expiry of this eighteen months period.

The Madrid Union system, however, has its shortcomings, which explains in part why some of the industrialized countries have not joined the Union. Firstly, it restricts the people qualified to file an international application only to natural and legal persons with a real and effective industrial or commercial establishment in, or are domiciled in, or are nationals of, a member state to the Madrid Union. Put conversely, the Madrid Union system of international trade mark registration cannot be used by a person who does not have the filial nexus, through a commercial or industrial enterprise, or through domicile or nationality, with a member state of the Madrid Union.

Secondly, although the Madrid Union system has as its focal point the simplification of international trade mark applications, the entire system cannot be triggered by an Applicant who has not filed an initiating application through a national intellectual property office known as "the office of origin". As such, an Applicant who presents an international application direct to the International Bureau of WIPO, bypassing the national intellectual property office, will have his application returned by the International Bureau of WIPO without consideration.

Additionally, although most commentaries describe the Madrid Union system as comprising a single international application, a closer scrutiny of both the Agreement and the Protocol reveals that there are three species of applications loosely categorized as "international applications". In the first category of international applications fall those applications which are governed by the Agreement and not the Protocol. For this category of applications, the application is required to be in French, which is an inhibiting factor to countries using English or Spanish as the official medium of communication. In the second category of international applications fall those applications governed only by the Protocol, in which case the designations

made by an Applicant should relate only to member states to the Protocol, and the application should either be in English and French. This, of course, may be a disincentive to Spanish, Japanese, Chinese, Russian or Arabic speaking Applicants. Lastly, an international application may be governed by both the Madrid Agreement and the Madrid Protocol and designations made under this route relate to member states of both the Agreement and the Protocol.

The system of designating countries under the Madrid Agreement and the Madrid Protocol might appear complex and cumbersome, especially to Applicants from developing countries who are new to the system. It requires an Applicant to designate member states in which protection is sought. The problem lies in that where the office of origin which initially receives an international application is for a country which is a member to the Madrid Agreement but not the Madrid Protocol, the Applicant's choice of designation is limited only to those countries which are members of the Madrid Agreement, and, likewise, where the office of origin is for a country which is a member to the Madrid Protocol but not the Madrid Agreement, the Applicant can only make designations effective in Madrid Protocol member states. However, where the office of origin is for a country which is a party to both the Agreement and the Protocol, any other member state to the Madrid Union can be designated.

It must also be noted that under the Madrid Union system, the international registration will be dependent on the registration granted by the office of origin for its survival for a period of five years from the initial date of registration. This has major significance because if the registration is for any reason cancelled in the office of origin, or withdrawn, the entire international registrations effected as a result of such application collapse. Groves⁵⁹ advances the view that this disadvantage of the Madrid Union system makes it open to

⁵⁹ P. J. Groves, Source Book On Intellectual Property Law, 1997, 630.

"central attack", and posits the view that "under the pre-protocol Madrid system, central attack was a major disincentive to international applications, and the United Kingdom membership. It meant that a successful challenge to the national registration which lay at the root of a proprietor's international registrations would bring down the whole edifice, not just the basic national registration. The protocol amends this position, providing that such an attack will transform the international registrations into national applications".

Although the amendment introduced by the Madrid Protocol goes a long way towards ameliorating the central attack, it runs counter to the whole objective of the Madrid Union system to provide a uniform and simplified international trade mark registration system. This is so because a central attack has the boomerang effect of converting an international registration into a national application. Also, the five-year period within which an international application remains vulnerable to central attack seems too long, and creates uncertainty to the trader whose mark will be seeking international protection. Indeed, Cornish comments that the Madrid Agreement and the Madrid Protocol seem to be strange bed fellows, and to give effect to the Madrid Union system "some bravura drafting has been necessary in order to continue the original arrangements [between parties to the Madrid Agreement] while giving the Protocol effect between the old set and the new joiners".^{59a}

In order to address some of the problems associated with the Madrid Union system, the 1973 Trade Mark Registration Treaty was concluded. It provided for the filing of a single initiating application directly to the International Bureau of WIPO, which would in turn secure a bundle of national registrations in the designated countries. To date, however, this treaty has not been widely ratified by the member states of WIPO.

^{59a} Cornish, W.R., Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights, 4th Edn., 1999

In 1994, the Trade Mark Law Treaty was concluded. Its aim was to simplify procedures relating to the registration of trade marks. The treaty allows member states to require that an application to register a trade mark contain a request for registration, the name and address of the Applicant, the name of the state where the Applicant is domiciled or has nationality status, the name and address of the Applicant's representative, if any, an address for service, any declaration claiming priority under Article 4 of the Paris Convention, statements relating to distinctive colours in a trade mark, if any, the classification system, a declaration of intention to use the mark or of actual use of the mark, and a signature by the Applicant or his representative⁶⁰.

According to the Treaty, the filing date to be accorded to an application is the date of receipt by the national intellectual property registry of a duly completed application requesting the registration of the trade mark, and showing the identity of the Applicant or his representative, and a graphic representation of the mark to be registered, together with the classes of the goods and/or services for which registration is sought⁶¹. Where goods and services belonging to several classes of the Nice Classification have been included in one application, such an application results in one registration⁶². As such, the Treaty provides for multi-class applications, which are accepted by the Belize Intellectual Property Office. The Treaty also allows for the division of an application into two or more separate applications before registration during any opposition proceedings, or during the course of an appeal against the decision to register the mark⁶³. Also, the Treaty permits the division of a registration into two or more registrations where the validity of a registration is challenged by a third party, or during any appeal proceedings⁶⁴.

⁶⁰ Article 3, Trade Mark Law Treaty.

⁶¹ Article 5, Trade Mark Law Treaty.

⁶² Article 6, Trade Mark Law Treaty.

⁶³ Article 7 (1) Trade Mark Law Treaty.

⁶⁴ Article 7 (2) Trade Mark Law Treaty.

Goods and services in an application should be indicated by their names grouped according to their classes in the Nice Classification, and each group should be preceded by the number of the class of the classification to which that group of goods or services belong, and should be presented in the order of the classes of the said classification system⁶⁵.

In respect of assignments to effect changes of ownership in trade mark rights, the Treaty allows countries to require applications to record the changes to show the name and address of the old owner, the name and address of the new owner, the name and address of the representative, if any, the address of service of the new owner, and to be accompanied by the requisite fees. The request for the recordal of the change of ownership should be signed by the old owner or the new owner, or their representatives. Where the change of ownership results from a contract, the Treaty allows member states to require notarized or certified copies of the contract. Where the change of ownership arises from a corporate merger, the request for recordal may be accompanied by a copy of the document effecting the merger, extracted from the relevant companies or corporate register. If the change of ownership is the result of the operation of the law or a court decision, the request may be accompanied by a copy of a document evidencing the change, certified in conformity with the original document⁶⁶.

The Treaty provides that the duration of the initial period of registration for a trade mark, and for each renewal period, shall be ten years. Applications for renewal should usually be in writing indicating that renewal is sought, and should include the name and address of the Applicant or his authorized representative, and be accompanied by the appropriate fees⁶⁷.

In considering whether to ratify this Treaty, Belize might be interested to note that all the member states of the European

⁶⁵ Article 9 (1) Trade Mark Law Treaty.

⁶⁶ Article II, Trade Mark Law Treaty.

⁶⁷ Article 13, Trade Mark Law Treaty.

Union, the United States of America, Russia and China, among others, are signatories to the Treaty.

Again, at the international stage, one of the factors which greatly influenced the development of the new Trade Marks Act was the Uruguay round of multilateral trade negotiations held under the legal framework of the General Agreement on Tariffs and Trade (GATT), which was concluded on 15 December, 1993. The agreement embodying the results of those negotiations, the Agreement Establishing the World Trade Organization (WTO) was adopted on 15 April, 1994, in Marrakech, Morocco. Those negotiations included, for the first time within the GATT, discussions on aspects of intellectual property rights which impacted on international trade. The results of those negotiations, contained in Annexure 1C to the WTO Agreement, was the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) ⁶⁸. The WTO Agreement, including the TRIPS Agreement, is binding on all WTO member states, including Belize, and entered into force on 1 January, 1995. When Belize became a signatory to the WTO Agreement, it agreed to provide minimum effective measures for the protection of intellectual property rights, including trade marks, as set out in the TRIPS Agreement.

Apart from reiterating the obligations of member states to observe the principle of national treatment in respect of trade mark matters as provided in the Paris Convention, the TRIPS Agreement⁶⁹ introduces the principle of *most favoured nation treatment*⁷⁰ which for our purpose, simply means that any advantage, favour, privilege or immunity granted by a WTO member state to the nationals of any other country shall be accorded immediately and unconditionally, subject to certain stated exceptions, to the nationals of all other WTO member states⁷¹. Article 1 through 12 of the Paris Convention, already

⁶⁸ Hereafter "the TRIPS Agreement".

⁶⁹ Article 3, TRIPS Agreement.

⁷⁰ Article 4, TRIPS Agreement.

⁷¹ Article 4, TRIPS Agreement.

referred to, are referentially incorporated into the TRIPS Agreement, and WTO member states are also obliged to observe Article 19 of the Paris Convention⁷². The rational basis of intellectual property protection and enforcement, according to the TRIPS Agreement, is to "contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations⁷³". The TRIPS Agreement then proceeds to define the goods and services capable of being registered as trade marks, including requirements which member states may adopt as conditions *sine qua non* for registration⁷⁴. It then proceeds to delineate the scope of rights conferred by registration⁷⁵, and limited exceptions which member states may impose to such rights⁷⁶. Registration and renewal periods for trade marks are pegged for a term in each instance of not less than seven years, indefinitely⁷⁷. Where use of a trade mark is a condition *sine qua non* to the maintenance of registration, cancellation of registration for non-use may only be made *after an uninterrupted period of three years of non-use*, and only in circumstances where the trade mark proprietor cannot advance good and cogent reasons establishing that the non-use was due to circumstances beyond his control, such as importation restrictions or other governmental or administrative measures restricting the circulation of the goods in the channels of commerce⁷⁸. Use by another person with the authority of the

⁷² Article 2, TRIPS Agreement.

⁷³ Article 7, TRIPS Agreement.

⁷⁴ Article 15 of the TRIPS Agreement provides that "any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trade mark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs shall be eligible for registration as trade marks. Where signs are not inherently capable of distinguishing the relevant goods or services, Members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.

⁷⁵ Article 16, TRIPS Agreement.

⁷⁶ Article 17, TRIPS Agreement.

⁷⁷ Article 18, TRIPS Agreement.

⁷⁸ Article 19 (1) TRIPS Agreement.

trade mark proprietor constitutes use for the purpose of maintaining registration⁷⁹. Requirements in national legislation of member states for use as a condition for registration should not unjustifiably encumber the use of the trade mark in the course of trade. Such unjustified interference due to requirements for use in national legislation occurs where use is allowed *only* when the trade mark is required to be used concurrently with another trade mark, or to be used in a special form, or in a manner which makes it fail to perform its functions of distinguishing goods or services of one undertaking from those of other undertakings⁸⁰.

The TRIPS Agreement specifically reserves to member states the conditions under which trade mark licensing shall be allowed: However, it specifically prohibits compulsory trade mark licensing. It also specifically allows a proprietor of a trade mark the right to assign the trade mark "with or without the transfer of the business to which the trade mark belongs"⁸¹.

In respect of the enforcement of trade marks, the TRIPS Agreement calls for enforcement regimes in member states that are "fair and equitable", not unnecessarily complicated or costly, or entailing unreasonable time-limits or unwarranted delays. The overall thrust is to provide effective relief "including expeditious remedies to prevent infringements" and by offering "remedies which constitute a deterrent to further infringement, while at the same time ensuring that the enforcement regimes themselves do not turn to be obstacles to trade and provide safeguards against abuse⁸². Remedies provided include injunctions, damages, orders for accounts of profit, payment of appropriate attorney's fees by infringes, orders for seizure and destruction of infringing

⁷⁹ Article 19 (2) TRIPS Agreement.

⁸⁰ Article 20.

⁸¹ Article 21, TRIPS Agreement.

⁸² Articles 41, 42, 43 and 48 of TRIPS Agreement identifies the need for fairness and equality, avoidance of undue costs, complexity, limited time limits, undue delays, right to be heard and to give evidence, right to prompt written reasoned judgments, availability of judicial review, right to legal representation and right to discover evidence held by the other side as integral process requirements.

articles outside the channels of commerce, orders to pay reasonable royalties, and orders for the delivery up of implements and materials used to provide the infringing articles. These TRIPS provisions are usually complemented domestically by Anton Pillar⁸³ orders, comprising an *ex parte* order in the form of a mandatory injunction coupled with an inspection order and an order for delivery up or disclosure, particularly suitable for acquiring or conserving information for purposes of a subsequent action on the ground of trade mark infringement. It is also permissible to require information about the source and distribution of infringing goods or services⁸⁴. To prevent overzealous latter day Hampdens from abusing the enforcement regime, member states are allowed to order adequate compensation to defendants wrongfully joined, including the defendant's expenses⁸⁵. It is mandatory for each state party to have in place provisional measures for preventing infringement of trade mark rights and preserving relevant evidence⁸⁶. Where counterfeited trade mark goods are to be imported, member states are obliged to have arrangements for seizure by the Department of Customs⁸⁷. Infringements are also to be treated by member states as serious violations attracting criminal penalties, including seizure, forfeiture and destruction of infringing goods under the criminal process, "in particular where they are committed willfully and on a commercial scale"⁸⁸.

These international legislative instruments constitute the international sources which informed the drafting of the new Trade Marks Act of Belize, and generous recourse will be made to these international instruments in showing how Belize is discharging its obligations to protect trade marks not only under the Paris Convention and the TRIPS Agreement, but also how Belize's laws measure up to the other legislative instruments which it may contemplate to ratify in the future.

⁸³ Anton Piller KG v Manufacturing Processes Ltd [1976] Ch. 66.

⁸⁴ Article 47, TRIPS Agreement.

⁸⁵ Article 48, TRIPS Agreement.

⁸⁶ Article 50, TRIPS Agreement.

⁸⁷ Articles 51 – 60, TRIPS Agreement.

⁸⁸ Article 61, TRIPS Agreement.

However, before discussing the aspects of the new law proper, it may be necessary, for the sake of clarity and completeness, to give a brief bird's eye view of the International (Nice) Classification of Goods and Services for the Purposes of the Registration of Marks⁸⁹, which was established by an Agreement concluded at the Nice Diplomatic Conference, on 15th June, 1959, and was revised at Stockholm, in 1967 and at Geneva, in 1977.

The importance of the Nice Classification, especially for trade mark agents and the intellectual property registry, is that it obliges member states to apply its classification system in connection with the registration of trade marks, either as the principal classification system or as a subsidiary classification system, and enjoins intellectual property registries to include in official trade mark documents and publications the number of classes of the classification system to which the goods or services for which the marks are registered belong⁹⁰.

For our purpose, we need only mention that the Nice Agreement operates on the basis of a Committee of Experts, where each member state is represented. The major function of the Committee of Experts is to decide on changes to the Nice Classification, based on proposals for changes from intellectual property authorities of member states, invited observers and the International Bureau of WIPO, among others. Any changes made are notified to the competent authorities of member states by the International Bureau of WIPO, and enter into force six months after the dispatch of such notification.

The latest classification, which is the one on which trade mark applications are processed by the Belize Intellectual

⁸⁹ Hereafter "the Nice Classification".

⁹⁰ For a comprehensive discussion, see International *Classification of Goods and Services for the Purpose of the Registration of Marks* (Nice Classification) 8th Edition, which entered into force on 1 January, 2002.

Property Office, is contained in the 8th Edition, which became effective on 1 January, 2002⁹¹.

The 8th Edition of the Nice Classification has forty-five (45) classes for goods and services. The classes for goods run from class (1) one through class thirty-four (34). The classes for services run from class thirty-five (35) through class forty-five (45). The 8th Edition then proceeds to provide a list of classes, with explanatory notes for the goods and services which fall or are to be excluded, from each class. It also contains a guidance for users which provides, *inter alia*, that the class headings indicate in a general manner the fields to which the goods and services in principle belong, and that the alphabetical list of goods and services and the explanatory notes thereto, relating to the various classes, *should* be consulted. The alphabetical list of goods and services is produced in two sets of five columns each, which for each product or service indicates:-

- 1st column:** the number of the class to which the product or service belongs;
- 2nd column** the serial number of the indication of the product or service, in English;
- 3rd column** the indication of the product or service, in English;
- 4th column** the serial number of the corresponding French indication of the product or service;
- 5th column** the basic number of the indication of the product service.⁹²

⁹¹ The Nice Classification appears as Schedule III to the Trade Mark Rules, Statutory Instrument 3 of 2002. However, the said Schedule does not provide useful information which is of great value to trade mark agents in processing trade mark applications. The 8th Edition of the Nice Classification can be ordered from WIPO, 34, Chemin des Colombettes, P. O. Box 18, CH-1211 Geneva 20.

⁹² Below is an example (sample) of the first goods in the alphabetical list

C1	Serial No. (E)	Indication of Goods	Serial No. (F)	Basic No.
09	A0001	Abacuses	B0727	090627.

Trade marks agents and officers of the intellectual property registry are informed in the 8th Edition that a given product or service may appear in the Alphabetical List in more than one place; that is, the product or service is described with different indications, so-called cross-references. For trade mark agents who want to be meticulous in their work, the Nice Classification should be a companion and a guide.

On the regional level, developments in commerce and industry, and the impact of imported goods and services from Belize's neighbours, means that there is serious competition not only between the products and services of our local industry *inter se* , but also between the local industry and industries who export products and services to Belize. In this milieu is added the Caricom Single Market and Economy, which allows the movement of goods, services and labour within the intra-market with the minimum of trade and other technical barriers. Indeed, the Caribbean Community Free Movement of Skilled Persons Act⁹³ bears prophetic testimony to the trade hegemony underway in the region, and the Revised Treaty of Chaguaramas itself now contain detailed provisions on the movement of capital and services, of trade in goods and services, and on intellectual property, together with dispute resolution mechanisms where there is conflict between state parties. Of course, the soon-to-be establishment of the Caribbean Court of Justice will give greater enforcement impetus to the new arrangement. As observed by Ivor Carryl:

"The applied notion of the Caribbean Single Market and Economy include the equal right of access to any market by natural and juridical persons whether as buyers or sellers irrespective of nationality or the location of the good

⁹³ Act 45 of 1999.

without reiteration except as authorized by or specified in the Treaty as negotiated by the contracting parties".⁹⁴

David Cox distilled the essence of the regime behind the Caribbean Single Market and Economy when he opined that "in order to fully comprehend the symbiotic relationship between the Caribbean Court of Justice and the CSME, it is of course necessary to have at least a basic understanding of what we mean when we refer to a 'single market and economy'. Prime Minister Owen Arthur of Barbados has highlighted the importance of the CSME to the very economic survival of the region as a whole, noting that prosperity in the Region depends upon the removal of those restrictions impinging upon the free movement of the factors of production. Effectively, the underlying philosophy of the CSME rests upon the principle that the free movement of capital, people, services and enterprise between CARICOM states, will lead to a situation in which various actors in the economic process can maximize their talents and resources, thereby leading to greater efficiency and increased profits and prosperity".⁹⁵

When brought home to Belize, and applied to the field of trade marks, the views of both Carryl and Cox echo the role assigned to trademarks by Groves when he observed that "The true function of trade marks are, then, to identify a product as satisfactory and thereby to stimulate further purchases by the consuming public. The fact, that through his trade mark the manufacturer or importer may 'reach over the shoulder of the retailer' and across the latter's counter straight to the consumer cannot be over emphasized, for therein lies the key to any effective scheme of trademark protection. To describe a trade mark merely as a symbol of goodwill, without recognizing in it an agency for the actual creation and perpetuation of goodwill,

⁹⁴ Carryl, Ivor, "*Notes on the Operationalisation of the Single Market and Economy*" in Caribbean Court of Justice: Issues and Perspectives, Vol. 1, 2001, 41 – 42.

⁹⁵ Cox David, "*The Original Jurisdiction of the Caribbean Court of Justice and Its Role in the Successful Implementation of the CSME*", in Caribbean Court of Justice: Issues and Perspectives, Vol. 1, 2002, 58 – 59.

ignores the most potent aspect of the nature of a trade mark and that phase most in need of protection. To say that a trademark is merely the visible manifestation of the more important business goodwill, which is the "property" to be protected against "invasion" or that 'goodwill is the substance, the trade mark merely the shadow', does not accurately state the function of a trade mark today and obscures the problem of its adequate protection. The signboard of an inn in stage coach days, when the golden lion or the garden cuckatoo actually symbolized to the hungry and weary traveller a definite smiling host, a tasty meal from a particular cook, a favourite brew and a comfortable bed, was merely 'the visible manifestation' of the goodwill or probability of custom of the house; *but today the trademark is not merely the symbol of goodwill but often the most effective agent for the creation of goodwill, imprinting upon the public mind an anonymous and impersonal guarantee of satisfaction, creating a desire for further satisfactions. The mark actually sells the goods. And, self-evidently, the more distinctive the mark, the more effective is its selling power*".⁹⁶

Domestically therefore, the objective of the new law was to create a legal framework which was modern and relatively easy to use, to enable and stimulate the expansion of economic activity in the context of the Caricom Single Market and Economy. This is why the reform of intellectual property laws occupied a prominent place in the Attorney General's legislative calendar.

SALIENT ELEMENTS OF THE NEW LAW

The Trade Marks Act, Chapter 257 ("the new law") is divided into six Parts for easier reading, and consist of eighty-four (84) sections, and two Schedules. The Act is complemented by the Trade Mark Rules, embodied in Statutory Instrument No. 3 of 2002, as amended.

⁹⁶ Groves, Source Book on Intellectual Property Law, 1997, 515-516.

The basic definition of a trade mark is given in section 1 (1) of the new law and it appears disarmingly straightforward. A trade mark is simply defined as "any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings and it may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging". This definition follows the approach found in Article 15 (1) of the TRIPS Agreement, and section 1 (1) of the United Kingdom Trade Marks Act, 1994, and it takes as its basic premise that if a sign is capable of distinguishing the goods or services of one undertaking from those of another undertaking then it may be registered as a trade mark, so long as the sign is capable of being represented in a form which can be recorded and published, that is, it must be capable of graphic representation. The definition, as can be seen, is non-exhaustive of what can constitute a trade mark. It simply enumerates that a trade mark "*may, in particular, consist of words....*". This section therefore neither excludes, nor makes specific reference to, signs like colours, sounds, slogans or smells, which, if they are distinctive and capable of graphic representation, may be registered as trade marks.^{96a}

Shapes of goods were not previously registrable under the United Kingdom Trade Marks Act, already referred to, and their inclusion in the new definition stems from a realization that the consuming public may recognize specific goods by their distinctive shape or packaging.⁹⁷

Section 1 (1) of the new law also defines the term "trade marks" to embrace both marks used to distinguish goods from those used to distinguish services, thereby facilitating the establishment and maintenance of a unitary register of trade marks.

^{96a} Compare with Article 15 TRIPS Agreement, footnote 74, supra.

⁹⁷ The introduction of the registrability of marks based on the distinctive shape of goods or their packaging overrides the decision of the House of Lords in *Re Coca-Cola Co's Application* [1986] 2 All ER 274, which held that the shape of a coca cola bottle could not be registered.

The expression "any sign" occurring in the definition of the word "trade mark" must be given a liberal and generous interpretation so as to include distinctive colour, musical, sound and smell signs capable of graphic representation. Sound signs, for example, can be graphically represented by musical notation, or simply by describing the sound, for example, "the barking of a dog" such as is often heard on the airwaves when Byron Lee is playing the popular song "Who let the dogs out", and when that sound is used as a trade mark.

The need for graphic representation is quite obvious. It is to enable the sign to be recorded in the register, which will in turn facilitate searches and examinations. For most trade marks, this requirement is pretty straight forward, but for complex marks, graphic representation is best achieved by negotiations between the Applicant or his agent and the Belize Intellectual Property Office.

The sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings. This means goods or services which the undertaking produces or sells, not merely, in the case of goods, those goods which the undertaking repairs or delivers. In respect of services, this phrase should be interpreted to mean services provided in the course of trade, such as banking, insurance, repairing, delivery or hospitality services.⁹⁸

The United Kingdom White Paper on the Reform of Trade Marks Law, in providing argument for the registration of distinctive shapes and the packaging of goods, observed that allowing the registration of shapes would be merely recognizing that a *de facto* monopoly already exists, and would not amount to conferring a monopoly. It stated that "the fact that a shape is protectable or has been protected by a registered design or by copyright does not of itself mean that it should not be registrable

⁹⁸ See Para 2.22, Chapter 2, United Kingdom White Paper entitled "Reform of Trade Marks Law" (CM1203).

as a trade mark. The question is one to be determined by the facts of the case – does the shape serve primarily to distinguish it from rival products or (to turn the question around) would a main motive of a competitor in using that shape be to mislead purchasers as to its origin".⁹⁹ Primarily, the shape of goods is derived from the *container* of the goods, and we are speaking here of containers like tins, bottles, boxes, cartons or packets used to package the goods. It should be stressed, however, that the rights conferred by registration is not for the packaging or the shape *per se*, but is in respect of the goods contained in the container. Put differently, it is the contents, not the shape or the container, which are the subject of trade mark protection.

The law has provided broad categories for trade marks which are capable to distinguish the goods or services of one undertaking from those of other undertakings.. The categorisation stems from a realization that whether or not a mark is capable of distinguishing is a question of fact to be determined in the light of all relevant circumstances. Proceeding from this realization, the law then recognizes that some marks are inherently capable of distinguishing goods or services of undertakings, basically because of the inherent characteristics of the marks, or by reason of prior use, which renders them easily recognizable in the market place.

The category of marks with inherent capabilities to distinguish goods or services of undertakings include *invented words marks*, also known as *fanciful marks*, like KODAK, EXXON or XEROX. These marks are different from words in common usage. Secondly, there are the *arbitrary marks*, like APPLE for computers, and INDEPENDENCE for cigarettes. *Suggestive marks* allude in some way to the goods or services in connection with which they are used, such as SUNTAN for body lotion. *Descriptive marks* are not registrable because they refer directly to the goods in connection with which they are used and thus lack the quality of inherent capability to distinguish. Examples,

⁹⁹ Ibid, Para. 2.21

of course, are trade marks like 'ORANGE' to refer to oranges or 'APPLE' to refer to apples. *Common laudatory words*¹⁰⁰ like "excellent" "excellency" "perfection" or "essence" lack inherent capability to distinguish in just the same way as geographical names like CAYO, STANN CREEK, COROZAL¹⁰¹ are incapable of distinguishing, unless they have acquired such a characteristic through prior use in the market place. Common surnames are not capable of distinguishing. If there are one hundred and fifty thousand people in Belize with the surname JONES, this will not be capable of distinguishing the goods or services of one Jones from another Jones, but a surname like KASEKE in a country like Belize, being an uncommon surname, may well be capable of inherently distinguishing the goods of one Kaseke from another, and thus may be registrable as a mark. Combinations of letters and numerals, like C76Z, or combinations of letters, numerals and colours, or combination of letters and words, SAVE-U, are capable of inherently distinguishing, and are therefore registrable. It should be noted and emphasised, however, that a mark which is not capable of inherently distinguishing may still be registrable due to prior use, hence the need to declare either use by an Applicant, or intention to use, in any trade mark registration application.

The new law provides for a Registrar of Intellectual Property appointed in terms of the Patents Act¹⁰², and assisted by a Deputy Registrar, Assistant Registrars and other officers¹⁰³. The Registrar is enjoined to maintain a Register of Trade Marks¹⁰⁴, on which shall be entered registered trade marks, certification marks and collective marks, and particulars of registrable transactions affecting a registered trade mark, including other matters relating to registered trade marks, as may be prescribed in Rules. The Register is required to be kept in the prescribed manner, and is open to inspection by the public

¹⁰⁰ *Joseph Crosfield & Sons Ltd's Application* (1909) 26 RPC 561. *ITT Continental Baking Co v Registrar of Trade Marks* 1980 (2) SA 127 (T).

¹⁰¹ *Cambridge Plan AG v Moore* 1987 (4) SA 821 (D).

¹⁰² Chapter 253 of the Substantive Laws of Belize, Revised Edition 2000, section 4.

¹⁰³ Section 3, Trade Marks Act, Chapter 257.

¹⁰⁴ Section 3 (1), *ibid*.

upon payment of a fee, and certified or uncertified copies of or extracts from, the Register can be made, upon payment of a fee.

The Act confers wide powers and imposes several duties upon the Registrar in respect of matters relating to trade marks. He is empowered to require the use of "such forms as he may direct for any purpose relating to the registration of a trade mark or any proceedings before him, so long as such forms are published as Regulations in the Gazette."¹⁰⁵ Any person may request from the Registrar, after the publication of an application for the registration of a trade mark, information relating to such application, or may request from him permission to inspect any document relating to the application, or to any registered trade mark resulting from it, subject to any restriction which may be prescribed in Rules, and to the payment of the requisite fee¹⁰⁶. Inspection of "documents" has been judicially determined as including the inspection of a letter¹⁰⁷, and a tape recording of a conversation relating to the trade mark application¹⁰⁸, and even a cinematographic film¹⁰⁹.

Requests for information relating to a trade mark application, or to documents related thereto before they are published, are primarily aimed at and are allowed only in respect of, persons who have been notified of the existence of such an application and of the fact that if the application is granted, the Applicant will bring proceedings against them in respect of acts done by them after publication of the application, otherwise the Registrar is enjoined not to communicate or publish such application or documents before publication in the Gazette, except in cases allowed by the Rules, or with the consent of the Applicant¹¹⁰.

¹⁰⁵ Section 4, *ibid.* For the meaning of the word "Regulations", section 3 (1) of the Interpretation Act, Chapter 1, defines same as including "any rule, by-law, order, form or notice, issued or made under the authority of any law". See also Rule 4 of Trade Marks Rules (No. 3 of 2002).

¹⁰⁶ Section 5 (1), *ibid.*

¹⁰⁷ *Carlish v East Ham Corporation and Edwards* [1948] 2 KB 380 [1948] 2 All ER 550.

¹⁰⁸ *Grant v Southwestern and County Properties Ltd* [1975] Ch. 185, [1974] 2 All ER 465.

¹⁰⁹ *Senior v Holdsworth, ex p. Independent Television News Ltd.* 2 All ER 1009 (CA).

¹¹⁰ Section 5 (3) and (4), *ibid.*

Any person with a sufficient interest in respect of a matter affecting a registered trade mark may apply to the Registrar to rectify or correct an error or omission in the Register, so long as the rectification or correction does not affect the validity of the registration of a mark¹¹¹. The effect of a rectification or correction of the Register under section 6 of the new law is that the error or omission is to be deemed as never having been made. Also, the Registrar is empowered, on request by the proprietor of a registered trade mark, or a licensee, to change the proprietor or licensee's name and address as recorded in the register. This is of immense utility to corporate proprietors or licensees, who may change their names and/or addresses through operation of the law or otherwise¹¹².

The register is *prima facie* evidence of the validity of the original registration of a trade mark and of any later assignment or transmission of it in all legal proceedings relating to a registered trade mark, including proceedings for the rectification of the register¹¹³.

For the purposes of the registration of trade marks, goods and services are to be classified according to a prescribed system of classification, which really is the latest Nice classification¹¹⁴. Questions relating to the proper classification of goods are determined by the Registrar, and his decision thereon is final. Additionally, the Registrar is empowered to make entries in the Register which may be necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of marks¹¹⁵. Rules may empower the Registrar, in any proceedings before him, to

¹¹¹ For the grounds on which a trade mark may be declared invalid and as to applications for a declaration of invalidity, see section 47 of the new law. The registration of a person as proprietor of a trade mark is *prima facie* evidence of the validity of the original registration, see section 67.

¹¹² Section 6, *ibid*.

¹¹³ Section 67, *ibid*.

¹¹⁴ Section 14, *ibid* and Schedule II of the Trade Marks Rules (No. 3 of 2002). See also footnotes 89 to 92, *supra*.

¹¹⁵ Section 7, *ibid*.

award costs¹¹⁶, or to require a party to give security for costs, and Rules may specify the manner of giving evidence before the Registrar¹¹⁷. The liability of the Registrar for official acts done under the Act are specifically limited. The Registrar is required each year in the month of December to make a report to the Minister about the operations of the Intellectual Property Office, and the discharging of his duties under the relevant international treaties to which Belize is a party¹¹⁸. The Registrar is also required to publish in the Intellectual Property Journal and Gazette a notice concerning the registration of a trade mark, or containing particulars of any application for the registration of the mark (including a representation of the mark), and other matters related to trade marks¹¹⁹.

Applications for the registration of trade marks are to be made to the Registrar, and should contain a request for registration of the trade mark, the name and address of the Applicant, a statement of the goods and services in respect of which application for registration is made, a representation of the mark, and a statement that the trade mark is being used, by the Applicant or with his consent, in relation to those goods or services, or that the Applicant has a *bona fide* intention to use the mark¹²⁰. The application should be accompanied by the appropriate fees, including class fees for multi-class applications¹²¹.

Applications should be on strong durable A-4 white paper typed or printed with ½ or double spacing on one side only, with the short sides at the top and bottom of the sheet, numbered consecutively, preferably at the top of the page, with

¹¹⁶ Section 8 (1) and (3), *ibid.*

¹¹⁷ Section 8 (4). Generally, evidence shall be by affidavit or statutory declaration.

¹¹⁸ Section 10.

¹¹⁹ Section 11, *ibid.*

¹²⁰ Section 12. Compare with Article 6 of the Trade Mark Law Treaty of 1994, which also allows multi-class applications. See footnote 62, *supra*.

¹²¹ The appropriate fees are set out in Schedule 1 to the Trade Marks Rules (No. 3 of 2002), as amended.

approximately 2 cm page margins¹²². Applications should be in the English language¹²³, and documents in any other language may be refused unless accompanied by a duly authenticated translation. Where an application is made by a partnership, the application documents must be signed by all the partners, or by a partner designated for that purpose, or by any other person who satisfies the Registrar that he is authorized to sign on behalf of the partnership¹²⁴. Addresses of Applicants and of service must be complete, including physical addresses (i.e. the name of the street and the number or name of the premises having that address)¹²⁵. Applicants who reside outside Belize, or their licensees or agents, or who do not carry on business in Belize, should give an address of service in Belize, which may be treated as the actual address of the Applicant, agent or licensee for all purposes connected with the trade mark in question¹²⁶. However, Rule 10 is qualified by Rule 11, which allows registered owners, licensees or Applicants to give an address for service outside Belize, and vests in the Registrar a discretion to enter such address in the Register¹²⁷. Applications for service will be in the form set out as Form No. 1, and must be signed by the Applicant, or by a duly authorized agent¹²⁸. Correct addresses of service are integral to the proper functioning of the trade marks system, because any written communications dispatched by the Belize Intellectual Property Office to the address of service is deemed to be valid and properly dispatched¹²⁹.

The application to register the trade mark itself should be in the form set out as Form 3¹³⁰. A representation of the mark to be registered should be fixed in the appropriate space of Form 3, and the application should be accompanied by four graphic

¹²² Rules 5 and 6, Trade Marks Rules (No. 3 of 2002).

¹²³ Rule 7, *ibid.*

¹²⁴ Rule 8, *ibid.*

¹²⁵ Rule 9, *ibid.*

¹²⁶ Rule 10, *ibid.*

¹²⁷ Rule 11, *ibid.*

¹²⁸ Schedule II, *ibid.*, and Rule 12.

¹²⁹ Rule 14, *ibid.*

¹³⁰ Rule 19 and Schedule II, Form 3.

representations of the mark. A specification of the goods or services for which application is made should be provided in sufficient detail in Form 3, together with the relevant indications of classifications under the Nice Classification, which should be routinely consulted. The full name, description, nationality and residence of the Applicant should also be given, and any trading styles or names of the Applicant. If the application is claiming priority under section 56 of the Act and pursuant to Article 4 of the Paris Convention, this should be stated in the appropriate place, and the date the initial application was filed in the Paris Convention country should be stated, with the number of the convention application, the country in which the convention application was filed, and the name of the Applicant in the said convention country¹³¹. Applications which contain letters or words in characters other than Roman characters should have a sufficient transliteration or translation of the letters or words, and the endorsement must indicate the language to which the words or letters belong, and be signed by the Applicant or his agent¹³². Changes of the name of address of an Applicant, or his address for service, must be notified to the Registrar. Form 4 should be used for this purpose.

Section 12 (3) of the Act provides that an Applicant should declare in the application for registration that he intends to use the mark or is using the mark or the mark is being used with his consent. This may properly be viewed as the axon of the application. This provision requires the Applicant to have some definite and present intention to deal in the goods or services for which the trade mark is registered. An abstract intention to use at a future unspecified date does not satisfy the requirement¹³³. However, the requirement is satisfied when the person intending

¹³¹ Rule 22, *ibid*. The application should be submitted within six (6) months of the making of the earlier application. The copy of the earlier application must be submitted to the Registrar within ninety (90) days from the date of the application. It must be in the English language, or accompanied by an authenticated translation compare with Article 4 of Paris Convention.

¹³² Rule 21, *ibid*.

¹³³ *Pfizer SA (Pty) Ltd v Robertsons (Pty) Ltd* 1967 (3) SA 8 (i). Section 12 (3) gives effect to Article 15 (3) of the TRIPS Agreement, and to Article 3 (1) (a) (xvii) of the Trade Mark Law Treaty, 1994.

to use the mark is a body corporate to be formed in the near future, and in such cases registration of the mark is made possible after an assignment of the mark from the Applicant to the recipient body corporate after incorporation. Use of a trade mark is to be given a wide and generous interpretation, so that where a representation of the mark appears on a television screen when a video is being played, this amounts to use¹³⁴. The use should be upon, or in physical or other relation to, the goods, and for services, the use should relate to performances associated with the service. As such, for goods, use extends to use on wrappers, tags, tins, boxes, cartons and other containers¹³⁵, and in advertisements or on invoices or other documents related to the goods or services¹³⁶. Services extend to the retail or wholesale trade, enabling trade marks like **BRODIES** or **CAVE SHEPERD** to be registered. In respect of services, however, the use contemplated by section 12 (3) of the Act is use in the course of trade, not use in respect of services for charitable, philanthropic, or noncommercial purposes.

It is important that all relevant papers are included in the application, as this affects the filing date, which begins to run from the date *all* the information required of an application is received by the Belize Intellectual Property Office¹³⁷.

When preparing a trade mark application, due care, diligence and fidelity should be paid by the trade mark agent to the specifications and classification of the goods or services constituting the application. According to Rutherford and Kelbrick this is "the most important aspect of any trade mark application"¹³⁸. The new law simply provides that goods and services shall be classified for the purposes of registration of trade marks according to a "prescribed system of classification".¹³⁹ This classification, as has already been

¹³⁴ *Esquire Elections Ltd v Executive Video* 1986 (2) SA.

¹³⁵ *Shalom Investments (Pty) Ltd v. Dan River Mills Inc.* 1971 (1) SA 689 (A).

¹³⁶ *Berman Brothers (Pty) Ltd v Sodastream Ltd* 1986 (3) SA 209.

¹³⁷ Section 13 of the Trade Marks Act.

¹³⁸ Rutherford and Kelbrick, *Essential Trade Mark Law*, UNISA, 1.4.7.

¹³⁹ Section 14 of the Trade Marks Act

pointed out, is the 45 class Nice Classification, the class headings of which are set out in Schedule III to the Trade Marks Rules¹⁴⁰.

The correct specification is necessary to protect trade mark rights, since a registered mark is only protected against infringement by use of the same or a similar mark in relation to goods or their packaging bearing a sign which is identical or similar to the registered trade mark, or in respect of goods or services which are so similar to the goods or services in respect of which the mark is registered, that in use there exists the likelihood of deception or confusion¹⁴¹. As such, badly drafted specifications make infringement proceedings difficult to prove and prosecute.

It is prudent that an Applicant conducts a search of the Register before launching his trade mark application to determine if it conflicts with earlier marks. In any event, upon receipt of an application, the Registrar is required to conduct an examination as to whether the application for registration satisfies the requirements of the Act and the Rules, and for this purpose the Registrar has to conduct a search, to the extent that he considers necessary. The search carried out by the Registrar relates to "registered marks and pending applications of record in the Belize Intellectual Property Office to ascertain whether there is recorded therein, in respect of the same goods or services or description of goods or services, any mark identical with the mark applied for, or so nearly resembling it that it would likely mislead the public".¹⁴² The examination also extends to examination as to the registrability of the mark on absolute and relative grounds. If the Registrar finds the mark not registrable, he is required to so inform the Applicant, and to give the Applicant an opportunity within a specified time to make representations or to amend the application. If the Applicant fails to amend the application or to make the representations

¹⁴⁰ Statutory Instrument No. 3 of 2002.

¹⁴¹ Section 49 – 53, Trade Marks Act.

¹⁴² Section 15 of the Trade Marks Act, and Rule 25 of the Trade Marks Rules.

within the specified time, the Registrar is obliged to refuse the application. Once the Registrar is satisfied that the application meets the conditions of registration specified in the Act and the Rules, he must accept the application.

It will be seen from the foregoing that Belize's system of trade mark registration follows that of the United Kingdom, which is called an "examination system".¹⁴³ Under this system, the Registrar examines an application for compliance with the formal or procedural requirements for registration, as well as for absolute grounds resulting in non-registrability, and for conflicts with earlier marks; the so-called relative grounds for non-registrability. The other system of trade mark examination obtaining in the world today is called "the deposit system" whereby the Registrar examines an application as to the formal or procedural requirements only, and where objects based on absolute or relative grounds of registrability do not arise at the examination stage, and may only be properly raised in opposition, cancellation or invalidation proceedings.

The application having been accepted, the Registrar is required to publish it in the Intellectual Property Gazette and Journal. Any person may, thereafter, in the prescribed manner and within the prescribed time from the date of the publication of the application, give written notice of opposition to the application, and include in such notice the grounds of opposition, which ordinarily relate to either absolute grounds, or relative grounds, or both. In the alternative, a person may opt for the more informal route of providing observations only, as to why the trade mark should not be registered, and the Registrar is required to inform the Applicant of those observations. A person making observations does not become a party to proceedings in respect of the application¹⁴⁴.

¹⁴³ The United Kingdom is currently debating whether to continue searching for and raising objections based on earlier rights, and the basis of the debate can be found in the UK Patent Office publication "Future of Official Examination on Relative Grounds: Consultation Document by the Trade Marks Registry" found online at www.patent.gov.uk

¹⁴⁴ Rules 32 and 33, and Schedule II, Forms 6 and 7, Trade Marks Rules.

A person opposing an application for registration has to use Form No. 6, which he submits to the Registrar with the requisite fee. If the basis of the opposition is that the mark applied to be registered resembles a mark already on the register, the number and registration date of that mark must be specified in the notice of opposition. The Applicant's answer to the notice of opposition should be submitted to the Registrar in Form No. 7, together with the prescribed fee, and the answer must indicate the grounds on which the applicant relies and any facts alleged in the notice of opposition that the applicant admits^{144a}.

The Registrar may accept an application absolutely, or subject to conditions like amendments, or representations containing any modifications, conditions or limitations like disclaimers. Representations may also properly be made at this stage for the division of an application into two or more applications, as provided under the Trade Mark Law Treaty¹⁴⁵.

The Applicant, however, is allowed to withdraw his application at any time before registration, or to restrict the goods or services covered by the application. If the application has been published at the time of making the withdrawal or restriction, such withdrawal or restriction *has to be published*, and the appropriate publication fees are required. Amendments of applications are allowed at the request of the Applicant, *only to correct the name or address of the Applicant, errors of wording or of copying, or obvious mistakes, and only in cases where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application*¹⁴⁶.

¹ 44a Section 16, *ibid*. See also Article 15 (5) of TRIPS Agreement for the requirement to advertise the application. The period of opposition is three months from the date of advertisement of the application in the United Kingdom under the Trade Marks Act 1994 Rules, Rules 13 and 14

¹⁴⁵ Section 15 (3), *ibid*. See also Rule 26 of the Trade Marks Rules, giving the Registrar the discretion to accept the application either absolutely or subject to conditions.

¹⁴⁶ Section 17, *ibid*. In accordance with section 22 of the Trade Marks Act, it is not possible to amend a mark already on the register, with the limited exception for the alteration of the name or address of the proprietor if it does not substantially affect the mark.

Withdrawal of an application is to be deemed to have been effected in certain specified circumstances, as more fully set out in the Rules¹⁴⁷. If the Registrar gives written objections to the Applicant as to the registrability of his application, and the Applicant fails to reply to the Registrar's written notice of the objections within sixty (60) days of receipt of the notice, the Applicant shall be deemed to have withdrawn his application. Likewise, an Applicant informed by the Registrar in writing that his application for registration has been conditionally accepted subject to any condition, amendment, disclaimer, modification or limitation has thirty (30) days after receipt of the notification to inform the Registrar of his acceptance of the notification, or sixty (60) days after the receipt of such notification to furnish objections, failure of which will result in the application being deemed to have been withdrawn. An applicant who is aggrieved by a decision of the Registrar in respect of any objection, amendment, disclaimer, modification or limitation has a right to appeal to the Supreme Court against the Registrar's decision within fourteen (14) days of the making of the decision, and if the Applicant does not appeal, he shall be deemed to have withdrawn his application.

If the application has been accepted and advertised, and has not been opposed, or has been opposed and then granted, the Registrar registers the mark, unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error¹⁴⁸. Registration is not effected before the fees prescribed in the Rules are paid¹⁴⁹ within the prescribed period, and if the fees are not paid within that time, the application shall be deemed to have been withdrawn. The date of registration will be the date of filing of the

¹⁴⁷ Rules 27 – 29, Trade Marks Rules (No. 3 of 2002).

¹⁴⁸ Section 18 (1), Trade Marks Act.

¹⁴⁹ Section 18 (2), Trade Marks Act, as read with Rule 3 and Schedule 1, Trade Marks Rules (No. 3 of 2002).

application for registration, which "shall be deemed for the purposes of the Act to be the date of registration".¹⁵⁰

The Act also allows for the division of an application for the registration of a trade mark into several applications, and the merger of separate applications or registrations, and the registration of services marks¹⁵¹. The procedure relating thereto is specifically left to be regulated by Rules.

Registration is for periods of ten years from the date of registration¹⁵², with consecutive renewals after every ten years, indefinitely, subject to the payment of renewal fees¹⁵³. Requests for renewal should be made by the proprietor or his agent before the expiry of the registration, and failing this, the request should be made within six months after the expiration date, in which event the Applicant has to pay renewal fees and "additional renewal fees" as late registration fees; that is, double the renewal fees¹⁵⁴. Renewal takes effect from the expiry of the previous registration. Failure to renew a trade mark after the six months grace period results in the striking-off of the mark from the Register. A trade mark which is struck-off the Register for non-renewal may only be restored upon re-registration, which will be subjected to the same procedures as a registration commenced *ab initio*.

Ideally, applications for renewal should be made within twelve (12) months before the expiry date of the trade mark, on Form No. 11, and should contain a statement that the trade mark has been used by the registered owner or a licensee in respect of all, some or any of the goods or services specified in the registration. Where use is restricted to some of the goods or services specified in the registration, the renewal application should also state good and cogent reasons beyond the control of

¹⁵⁰ Section 18 (3), *ibid*.

¹⁵¹ Section 19, *ibid*. Note that Article 6series, Paris Convention, does not require countries to register service marks.

¹⁵² Section 20 (1), *ibid*.

¹⁵³ Section 21 (1), *ibid*.

¹⁵⁴ Section 21 (3), *ibid*. This provision implements Article 5 bis (1) of the Paris Convention.

the owner or licensee that excuses the non-use in respect of the remaining goods or services during the previous registration period. Late renewal applications should be made on both Forms No. 11 and 12, together with the prescribed fee¹⁵⁵.

Where the proprietor or licensee of the trade mark indicates in the application to renew a trade mark that it has been used on all the goods or services specified in the previous registration, or has been used on some of the goods or services specified in the previous registration, and advances good and cogent reasons for the non-use of the remaining goods or services during the previous registration, the Registrar is obliged to renew the registration of the mark without amendment. Otherwise the Registrar is empowered to remove from the renewed mark those goods or services which were not in use during the previous registration, for which good and sufficient reasons explaining the non-use were not advanced. If the mark has not been used in respect of any of the goods or services specified in the previous registration, the Registrar may refuse to renew the mark if good and sufficient reasons for such non-use are not advanced¹⁵⁶.

Alteration of a registered trade mark during the period of registration or renewal is expressly prohibited by the new law, save and except to incidences relating to formalities, like amendments of the name or address of the proprietor not affecting the identity of the mark, provided such amendment is published in the Intellectual Property Gazette and Journal on payment of the appropriate fees¹⁵⁷.

Registration confers on the proprietor or licensee of a trade mark an exclusive moveable and personal property right in the trade mark, giving rise in cases of infringement in Belize to a statutory infringement action, where it will not be necessary for the proprietor or licensee to prove public deception or confusion

¹⁵⁵ Rules 39 and 40, Trade Marks Rules.

¹⁵⁶ Rule 41, *ibid*.

¹⁵⁷ Section 22, Trade Marks Act.

for the action to be successful¹⁵⁸. Put differently, the proprietor of an unregistered trade mark cannot claim the benefits of the Act in cases where his trade mark is infringed; he can only avail himself of the common law action of passing-off, which is lengthy and expensive. On the other hand, the registration of a trade mark is *prima facie* proof of title in and to the mark, and is a convenient and inexpensive way to obtain a proprietary right in a trade mark in use or proposed to be used in the definite future.

Infringement under the Act occurs where a person uses a registered trade mark of another, or some confusingly similar sign, as a trade mark to indicate the source of goods or services. In a market of competitors, if this conduct is not prevented, not only will the proprietor lose out, but consumers will distrust the marks they see as the possibilities of differentiating product quality and origin becomes blurred in the public eye. Preventing such public confusion therefore remains a prime fundament given legislative effect in the new law.

The Act therefore extends infringement rights to include the use of a mark in relation to goods or services which are similar to those for which the mark is registered where there exists a likelihood of confusion on the part of the public, and, in the case of a mark having a reputation in Belize, extends infringement rights to non-similar goods or services where the use of the mark takes unfair advantage of, or is detrimental to, the distinctive character or repute of the mark. The Act similarly extends use of a mark to include the acts of offering for sale, putting goods on the market, or stocking them for the purposes of sale under a mark similar to the registered mark, as well as affixing the sign to the goods and importing goods with such sign affixed to them. The objective of such extended meaning of use in respect of infringement rights seems to close any desiderata of traders using signs resembling a registered trade mark as business names dealing in goods or services similar to those for which the trade mark is registered¹⁵⁹.

¹⁵⁸ Section 23, 24 (1) and 29, *ibid*.

¹⁵⁹ Section 25, *ibid*

For purposes of expatiation, a close reading of the Act reveals four exiguous categories of infringement. Within this typology runs a distinct thread relating to the identity or similarity of marks and of goods or services, which, as will be shown later, is for the most part parallel with the relative grounds on which trade mark registration may be refused.

The first category relates to infringement which occurs through use, in the course of trade, of a sign or mark identical to the trade mark in respect of goods or services specified in the registered specification¹⁶⁰. Under this category, it is not necessary to show any confusion. The only questions of fact to be determined in this type of infringement are whether the marks are identical, and whether the goods or services for which the purported infringers is using the mark fall within those specified in the registered specification. To resolve the latter factual question, recourse per force must be made to the “core” of the registered specification.

The second category of infringement is where there is only a similarity, rather than Chinese identity, between goods or services, or the signs or marks, of the purported infringer and the proprietor of the mark, in which case the proprietor has the onus of proving that “there exists a likelihood of confusion on the part of the public, which includes likelihood of association with the trade mark”.¹⁶¹

This category, though, seems casuistic upon closer scrutiny, for it does not define what precisely is meant by the word ‘similar’, which, in terms of the provision, is qualified by the requirement that there should exist the likelihood of confusion in the public eye. To give effect to the provision, courts in other Commonwealth jurisdictions have tended to holistically consider all the surrounding circumstances of each case, in particular the

¹⁶⁰ Section 25 (1), *ibid.*

¹⁶¹ Section 25 (2), *ibid.* See also Article 16 (1) TRIPS Agreement.

nature of the goods and their composition, their origin, use, channels of disposal in trade and classes of customers.¹⁶²

The third category in the typology occurs where a trade mark has a “reputation” in Belize, and a sign identical or similar to such mark is used for dissimilar goods or services, “and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark¹⁶³. This third type of infringement is commonly called “dilution” and occurs where a well-known mark (like Coca cola) is used to promote goods or services which are different to those for which it is registered.

The last category is provided in section 25 (6), which makes it an infringement to use a trade mark to identify goods or services as those of the proprietor or a licensee, “otherwise than in accordance with honest practices in industrial and commercial matters”, when “the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute” of the trade mark. This category is aimed to strike down dishonest comparative advertising, while on the obverse side shielding honest uses of trade marks to actually identify the goods or services of the proprietor or a licensee.

The new law then proceeds to specify circumstances where use of a registered trade mark does not amount to infringement. These include use by a person of his *bona fide* name or address, but this does not extend to the name of a juristic person incorporated after the registration of the trade mark, and the use by a person of any *bona fide* description or indication of the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of the goods or of rendering of the services, or other characteristics of the goods or services, provided the use is consistent with honest practices in

¹⁶² Danco Clothing (Pty) Ltd v Nu-Care Marketing Sales and Promotions Ltd. 1991 (4) SA 850(A). See also British Sugar and Robertson [1996] RPC 281.

¹⁶³ Section 25 (3), *ibid.* See also Article 16 (3) TRIPS Agreement.

industrial or commercial matters¹⁶⁴. As explained by Corbett JA in respect of a similar legislative provision, “the legislature intended to safeguard by means of the provision use by a trader, in relation to his goods, of words, which are fairly descriptive of his goods, genuinely for the purpose of describing the character or quality of the goods; the use of the words must not be a device to secure some ulterior object, as for example where the words are used in order to take advantage of the goodwill attaching to the registered trade mark of another”.¹⁶⁵

Again, a trade mark is not infringed where it is genuinely used in relation to goods or services where it is reasonable to indicate the intended purpose of such goods, including spare parts and accessories; provided such use is in accordance with honest practices in commercial or industrial matters¹⁶⁶. Under this defence, a writer may legitimately use the expression “Byron Lee and the Dragoniers” as the title to a book giving the life history of the famous Caribbean calypsonian, “Byron Lee” and his socca music band “The Dragoniers”.

Also, a registered trade mark will not be infringed by the use of the trade mark in relation to goods which have been put on the market in the Caricom Single Market and Economy under that trade mark by the proprietor or with his consent; provided there are no legitimate reasons for the proprietor to oppose further dealings in the goods because they have been changed or impaired after they have been put on the market. This defence to infringement makes it pellucidly clear that the parallel importation into the Caricom Single Market and Economy of even generic goods made by a licensee, the so-called ‘grey goods’ does not amount to infringement.¹⁶⁷

¹⁶⁴ Section 26, *ibid*.

¹⁶⁵ *Plascon - Evans Paints (Pty) Ltd v Van Riebeeck Paints 1984 (3) SA 623 (A)*.

¹⁶⁶ Section 26 (2) (c).

¹⁶⁷ Section 27, *ibid*. See also *Protective Mining and Industrial Equipment Systems (Pty) Ltd .(formerly Hampo Systems (Pty) Ltd) v Audiolens (Cape) (Pty) Ltd, 1987 (2) SA 96 (A)*. See also European Community Trade Mark Regulation, Article 13, and European Community Trade Mark Directive, Article 7.

A registered trade mark will not be infringed where it is used within the scope of a limitation entered on the register, such as a disclaimer¹⁶⁸. The rational basis of disclaimers proceeds from a realisation that trade mark registration confers on the proprietor of the registered trade mark an indefinite monopoly in the mark, so long as it is renewed after every ten years. In this environment, where a trade mark is made up of a number of elements which, when viewed alone, are not capable of distinguishing the goods or services of one undertaking from those of another undertaking, yet when viewed as a combination, are capable of discharging this function, the proprietor as a policy reason cannot obtain a monopoly in respect of the non-distinguishing elements of the trade mark. In order to limit the monopoly rights of the proprietor of such a mark, and to dispel any misconception as to the scope and extent of the proprietor's rights, provision is made in the new law for the entry in the Register by the Registrar of a disclaimer in respect of matter which is not capable of distinguishing. It is then made clear, *ex abuntante cautela*, through the Register, that the registered proprietor has no rights in the exclusive use of the disclaimed features. In the trade mark "Marie Sharpe's Belize Hot Pepper Sauce", disclaimers may easily be specified by providing in the application and subsequently in the Register that "Registration of this mark shall not give rise to the exclusive use of the words "Belize Hot Pepper Sauce" or "Hot Pepper Sauce" separately and apart from the mark". Consequently, the Registrar is empowered to require of an Applicant "at any time before a mark for which registration has been applied is recorded in the register, to insert in his application a disclaimer of any matter that is not independently capable of being registered so that if the mark is registered the public will understand the extent of the Applicant's rights after registration"¹⁶⁹. The new law provides for the transmission of rights in a registered trade mark by assignment, testamentary disposition or operation of the law in the same way as other personal or moveable property. The transmission may be connected with the goodwill of the

¹⁶⁸ Section 28, *ibid*.

¹⁶⁹ Rule 30, Trade Marks Rules (No. 3 of 2002).

business¹⁷⁰. The mark may be assigned wholly or partially, for all or some of the specified goods or services, or for the use of the trade mark in a particular locality within Belize¹⁷¹. The formal incidences of an assignment are extremely liberalized under the new law: all that is required to assign, or to make an assent in relation to, a trade mark is that it should be in writing and signed by or on behalf of the assignor, which for juristic persons means the affixation of the corporate seal¹⁷². The procedure for an ordinary assignment of a mark relates equally to an assignment by way of security¹⁷³, and the new law provides that a mark may be charged as any other personal or moveable property, which means a mark may be mortgaged by assignment¹⁷⁴. The new law also saves the effects of assigning an unregistered trade mark under the common law as part of the goodwill of a business. It should be remembered that under the common law, a trade mark is protected as part of the goodwill of the business in the goods for which it is used and can be transferred only in conjunction with such goodwill. An assignment “in gross”, that is, without the associated goodwill, is under the common law invalid because it is presumed that it results in public deception¹⁷⁵. Assignments, licence contracts, grants of security interests, assents by personal representatives in relation to a registered trade mark, and orders of the court transferring a registered trade mark or any right in or under it, are all transactions registrable by the Registrar in the Register upon proper application¹⁷⁶, but notices of any express, implied or constructive

¹⁷⁰ Section 31 (1), Trade Marks Act. Article 6quarter of the Paris Convention required state parties to require that a mark be assigned with the associated goodwill of a business, and proceeded to specify that this requirement is met if only that portion of the goodwill in the state party is transferred to the assignee. Article II (4) (iv) of the Trade Mark Law Treaty, 1994, pertinently provides that the simultaneous transfer of goodwill may not be a requirement for the registration of an assignment. Likewise, Article 21 of the TRIPS Agreement specifies that an assignment may be effected “with or without the transfer of the business to which the trade mark belongs”.

¹⁷¹ Section 31 (2), *ibid.*

¹⁷² Section 31 (3), *ibid.*

¹⁷³ Section 31 (4), *ibid.* This now allows for marks to be imported by a deed of security (pledged as security).

¹⁷⁴ Section 31 (5), *ibid.* The deed has to be lodged with the Registrar, see footnote 175, *post.*

¹⁷⁵ Section 31 (6), *ibid.*

¹⁷⁶ Section 32, *ibid.*

trusts are not so registrable¹⁷⁷. It can also be argued that in terms of the new law, a registered trade mark may be attached to found or confirm jurisdiction, and likewise may be attached and sold in execution of a court order.

In accordance with the TRIPS Agreement¹⁷⁸, the new law largely provides for a system of unfettered licensing to keep abreast of practices in industry and commerce¹⁷⁹. In principle, then, the new law permits licences, just like assignments, to be general or limited as to the goods or services covered, the manner of use and the locality¹⁸⁰. The licence must be in writing, signed by or for the grantor, and unless specifically provided otherwise, is binding on his successors in title¹⁸¹. Licensees have the right to call on the proprietor of the mark to take action for infringement¹⁸², but express provision may be made in the licence contract to contract out of this right. If the proprietor either refuses to do so or fails to do so within two months after being called upon, the licensee is entitled to bring proceedings in his own name, as if he is the proprietor. However, for the infringement proceedings to continue, the licensee must, unless he has previously obtained the leave of the court, either join the proprietor as a plaintiff or add him as a defendant¹⁸³. A proprietor joined as a plaintiff is only liable for costs if he takes part in the proceedings¹⁸⁴. Where the proprietor brings infringement proceedings, account has to be taken of any loss suffered by the licensee, and the court may give such directions as it thinks fit regarding the extent to which the plaintiff is to

¹⁷⁷ Section 33.

¹⁷⁸ Article 21, TRIPS Agreement provides that state parties may regulate conditions for the licensing of marks, but expressly prohibits compulsory licensing. The Paris Convention makes no mention of licensing.

¹⁷⁹ See Sections 41 to 44, Trade marks Act.

¹⁸⁰ Section 41 (1), *ibid*.

¹⁸¹ Section 41 (2) and (3), *ibid*.

¹⁸² Section 43 (2), *ibid*.

¹⁸³ The requirement to join the proprietor of the mark as a plaintiff or defendant does not apply in applications for interlocutory relief, where the licensee, without the proprietor being joined may be granted appropriate relief. See section 43 (3) and (4), *ibid*.

¹⁸⁴ Section 43 (5), *ibid*.

hold the proceeds of any pecuniary remedy on the licensee's behalf.

Exclusive licensees enjoy extended rights under the new law. An exclusive licence is defined in the Act as a licence conferring on the licensee, to the exclusion of all other persons, *including the licensor*, the right to use the trade mark¹⁸⁵. If the mark which is the subject of an exclusive licence is transferred to a new proprietor, any exclusive licensee of that mark will continue to have the same rights against a new proprietor as against the old one if the new proprietor is bound by the terms of the licence. As such, unless the licence specifically provides that the new proprietor is not bound by the exclusive licence, he will be so bound¹⁸⁶.

An exclusive licence may provide for the licensee to have the same rights and remedies for matters occurring after grant of the licence as if the licence had been an assignment¹⁸⁷. The provision should be construed as being only permissive: applying only to the extent specified in the licence contract. As such, the licensee's rights are in *pari passu* with those of the proprietor. Defences available to a defendant in actions brought by a proprietor are also extended to actions brought by an exclusive licensee. Where the proprietor and the licensee have concurrent rights of action, neither may proceed, except with the leave of the court, unless the other is joined as a party, but a party so joined is not liable for costs. In cases of concurrent rights of action, either the proprietor or licensee have *locus, mere motu*, to apply for, and obtain, interlocutory relief¹⁸⁸.

Where the proprietor and the exclusive licensee have, or had, concurrent rights of action, the court must take into account the terms of the licence and any pecuniary remedy already awarded or available when it comes to assess the

¹⁸⁵ Section 42 (1), *ibid*.

¹⁸⁶ Section 42 (2), *ibid*.

¹⁸⁷ Section 44 (1), *ibid*.

¹⁸⁸ Section 44 (2) to (4).

damages to be awarded. If an award of damages has been made or an account of profits directed, no account of profits will be directed in favour of the other; and if an account of profits is directed, the court will apportion the profits between the proprietor and the licensee as it thinks just, subject to any agreement between the parties, regardless of whether both the proprietor and the licensee are parties to the action. If they are not, the court may give such directions as it thinks fit regarding the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other¹⁸⁹.

Before applying for an order for delivery up, the proprietor of a registered trade mark must notify any exclusive licensee. In such a case, the court is empowered, on the application of the licensee, to make such order as it thinks fit, having regard to the terms of the licence contract. These legislative provisions, however, are to be applied “subject to any agreement to the contrary between the exclusive licensee and the proprietor”¹⁹⁰.

To be recorded in the Register, a licence contract should be in Form No. 13, accompanied by the appropriate prescribed fee and a copy of the licence contract. Upon receipt of Form No. 13, the licence contract and the appropriate fee, the Registrar is enjoined to examine the licence contract to determine whether it complies with the requirements of the new law; and if it does, the Registrar is required to record in the Register the particulars of the licence contract as set out in the application, and to advise the Applicant in writing of the action taken. If the licence contract does not comply with the requirements of the Act, the Registrar shall refuse to record the licence contract in the Register and shall advise the Applicant in writing accordingly¹⁹¹.

Application for cancellation of a licence contract from the Register should be in Form No. 14, accompanied by evidence satisfactory to the Registrar that the licence contract has been

¹⁸⁹ Section 44 (6), *ibid*.

¹⁹⁰ Section 44 (7) and (8), *ibid*.

¹⁹¹ Rule 42, Trade Marks Rules (No. 3 of 2002).

terminated, and the appropriate fees. If the Registrar is satisfied that the licence contract has terminated, he then cancels it from the Register and advise the Applicant in writing of the cancellation¹⁹². Likewise, when a licence-contract that authorises the licensee to transfer the contract has been transferred, the transfer may be recorded in the Register upon the submission of an application in Form No. 15, together with the prescribed fee, and evidence satisfactory to the Registrar that the licence contract has been transferred; and if the Registrar is satisfied of the transfer, he then records it in the Register¹⁹³.

Sub-licences granted by a licensee pursuant to a licence contract may be recorded in the Register upon the submission of an application in Form No. 16, together with the prescribed fee and a copy of the sub-licence contract. The Registrar is enjoined to examine applications for recordals of sub-licences upon receipt in order to ensure that they comply with the Act. The Registrar is also required to record particulars of the sub-licence as set out in the application if it complies with the Act, and to advise the Applicant in writing; but if it does not comply with the Act, the Registrar is directed to refuse to record it in the Register, and to advise the Applicant accordingly in writing¹⁹⁴.

Trade Marks may be refused registration on two grounds, which are broadly given the labels ‘absolute grounds for refusal of registration’ and ‘relative grounds for refusal of registration’.¹⁹⁵

A sign which do not satisfy the requirements of the definition of a trade mark is not registrable. Non-distinctive marks too are not registrable. Non-distinctive marks too are not registrable. Also, 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,

¹⁹² Rule 43, *ibid*.

¹⁹³ Rule 44, *ibid*.

¹⁹⁴ Rule 45, *ibid*.

¹⁹⁵ Sections 35, 36, 37, 39 and 40, Trade Marks Act.

the time of production of goods or rendering of services, or other characteristics of goods or services are not registrable. Generic trade names are also not registrable¹⁹⁶. Additionally, signs which consist exclusively of the shape which results from the nature of the goods themselves, that is, shapes dictated by functionality or other technical features, or which give substantial value to the goods, are not registrable. Likewise, marks which are contrary to public policy, or accepted principles of morality, or which tend to deceive the public, are not registrable¹⁹⁷.

Section 36 of the new law gives effect to the Paris Convention by prohibiting the registration of the flag, armorial bearings, insignia or devices resembling the Belize flag or any such armorial bearing, or insignia used by State Departments and Ministries, or words, letters or devices likely to lead persons to think that an Applicant has the patronage of the Government of Belize¹⁹⁸.

Signs which conflict with earlier marks, that is, signs which are identical to earlier registered marks and used in respect of similar goods and services for which the earlier marks are registered are themselves refused registration on relative grounds. Also, signs identical to earlier registered marks and used in respect of goods and services which are not similar to the goods and services for which the earlier marks are registered are not registrable on the relative ground that they dilute the distinctiveness of the earlier registered mark, blur the distinctiveness, and dissociate it from the primary products for which the marks are registered, on to the products of the person seeking registration. This is the typical case of trying to register the mark “roll royce” for watches, or clothes¹⁹⁹.

A registered trade mark may be surrendered, in respect of either some or all of the goods or services for which it is

¹⁹⁶ Section 35, *ibid*, which deals with absolute grounds for refusal of registration.

¹⁹⁷ Section 35 (2) and (3), *ibid*.

¹⁹⁸ Section 36, *ibid*.

¹⁹⁹ Section 37, *ibid*.

registered, and provision is made in the Rules for the legal effect of a surrender and how the interests of third parties are to be protected consequent upon a surrender²⁰⁰. An application to surrender a trade mark should be in Form No. 19, accompanied by the prescribed fee. Upon receipt of the application to surrender, the Registrar records the surrender in the Register in respect of all or part of the goods or services which are surrendered from registration, and advises the Applicant in writing of the action taken by him. Trade marks which are encumbered by a licence contract can only be surrendered with the consent of the licensee under the licence-contract, and the application to surrender should contain a statement that the consent of the licensee to the surrender has been obtained, unless the licence contract expressly waives the right of the licensee under the licence contract to prevent the recording of a surrender without his consent²⁰¹.

A Belize registered trade mark is open to attack on two major grounds, notably, by way of revocation proceedings or by way of invalidation proceedings²⁰².

Revocation proceedings may be brought by any person, not only by persons interested in the mark, to the Registrar or to the court. If other proceedings are already pending in court in a matter relating to the trade mark, the application for revocation is to be made to the court, otherwise it is made to the Registrar. If a revocation application is made to the Registrar, he is given a discretion to refer the application to the court, and he may do this at any stage of the proceedings before him. Revocation proceedings may be brought in respect of grounds which have arisen since the registration - notably because of non-use, or because the mark has become misleading or descriptive.

A revocation order operates from the date of the application to revoke, or on the date on which the ground of

²⁰⁰ Section 45, Trade Marks Act.

²⁰¹ Rule 50, Trade Marks Rules (No. 3 of 2002).

²⁰² Sections 46 and 47, *ibid* .

revocation existed, if earlier. Revocation may be partial, relating to only some of the goods or services for which the mark is registered, in which case the mark will remain registered for the goods or services which are not the subject of the revocation order.

Proceedings may also be instituted, before the Registrar or in court (if any other proceedings concerning the mark in question are pending in court, the application should be made to the court) for the invalidation of a trade mark after registration. The proceedings may be made on the basis of absolute or relative grounds which existed at the time of registration and which cannot be excused by subsequent events. If the invalidation proceedings succeed, their effect is that the registration will be deemed never to have been made.

The Act specifically allows Applicants to claim priority in trade mark applications²⁰³, and it gives full force and supremacy to any international treaty in respect of trade marks, collective marks and certification marks to which Belize is party, including the Paris Convention²⁰⁴. The Act also protects well-known marks pursuant to Article 6bis of the Paris Convention²⁰⁵, and prohibits the registration of the national emblems of Paris Convention countries pursuant to Article 6ter of the Paris Convention²⁰⁶. Likewise, the emblems of certain intergovernmental organizations are protected under the Act pursuant to Article 6ter of the Paris Convention²⁰⁷, and the Act specifies the notification procedure required by Article 6ter of the Paris Convention²⁰⁸. Belizean courts are specifically required to take judicial notice of international treaties relating to trade marks to which Belize is a party²⁰⁹.

²⁰³ Section 56, *ibid.*

²⁰⁴ Sections 59 and 60, *ibid.*

²⁰⁵ Section 61, *ibid.*

²⁰⁶ Section 62, *ibid.*

²⁰⁷ Section 63, *ibid.*

²⁰⁸ Section 64, *ibid.*

²⁰⁹ Section 66, *ibid.*