

Registering Trademarks in Belize

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Introduction

This article focuses on the procedural law governing the registration of trademarks in Belize. It starts by providing a definition of a trademark, then proceeds to travel through the provisions dealing with an application for registration of a trade mark, other grounds covered are provisions dealing with examination and publication of applications, opposition proceedings, amendment of applications and the registration of a trademark.

What is a Trademark?

Article 15(1) of the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) defines a trademark as -

‘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.’

In keeping with this international prescription, the Trade Marks Act of Belize (the Act) defines a trademark as a sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings and which is also capable of being represented graphically.¹ The definition also includes a collective mark or a certification mark.² This definition of a trade mark is in sync with those found in the legislations of most other countries. According to Paul Torremans and Jon Holyoak ‘... it is clear that no mark can be registered unless it satisfies the two vital, but related, factors of being capable of being represented graphically and also capable of distinguishing one trader’s products from those of others’.³

Application for Registration

An application for registration of a trademark shall be made to the Registrar of Intellectual Property.⁴ The application shall be in the form set out in Schedule II (FORM NO. 3) to the Trade Marks Rules (the Rules),⁵ and shall contain a request for registration of a trademark, the name and address of the applicant, a statement of the goods or services featured in the application and a representation of the trademark.⁶

The application must also contain a statement that the trademark is being used by the applicant or a licensee or that he has a *bona fide* intention to use the trademark.⁷ The applicant must demonstrate a definite and present intention to deal in the goods or services for which the trademark is registered.⁸ In the South African case of *Pfizer SA (Pty) Ltd. v. Robertsons (Pty) Ltd.*, it was held that it is insufficient for the proprietor to have a mere general intention to extend his business at some time in the future to anything which he considers desirable.⁹

The application is subject to payment of the application fee and other appropriate class fees prescribed in Schedule I to the Rules.¹⁰ Such payments shall be made in Belizean currency or in an equivalent amount in a convertible foreign currency.¹¹ The total fee for registration of a trade mark is BZ\$425 (including the single class fee of BZ\$75).¹² The filing date of the application is the date on which all the requirements highlighted earlier are furnished to the Registrar.¹³

There is a classification system for goods and services with regard to the registration of trademarks.¹⁴ Goods and services are classified for purposes of trademarks in accordance with Schedule III to the Rules. This classification is based on the International Classification of Goods and Services for the Purposes of the Registration of Trademarks under the Nice Agreement (8th Edition) administered by the World Intellectual Property Organisation, including the attached explanatory notes and alphabetical lists of goods and services.¹⁵

Under the Nice Classification, all goods and services fall under one of the 45 classes. The headings for these classes are set out in Schedule III to the Rules. The applicant should apply to register his trademark in one or more of these classes and he should also specify in his application those goods or services falling in the class or classes in which he applies and for which he claims protection.¹⁶

In the words of Professors Brian Rutherford and Roshana Kelbrick 'the correct specification is essential to protect trademark rights ... a badly drafted specification will make infringement proceedings more difficult to institute'.¹⁷ The Registrar possesses the final decision with regard to questions as to the class within which any goods or services fall.¹⁸

Examination of Application

Upon receipt of the application, the Registrar examines whether the application satisfies the provisions of the Act.¹⁹ This process involves a search of earlier registered trademarks.²⁰ The purpose of this search is to ascertain whether the trademark applied for is confusingly or deceptively similar to a trademark already on the Register or the subject of a pending application.²¹

Where the applicant fails to meet the requirements for registration, the Act protects the applicant's right to due process by prescribing that the Registrar should inform the applicant of his decision and give the applicant an opportunity to make representations and amendments.²²

The Registrar may require a disclaimer to be inserted in the application of any matter that is not independently capable of being registered.²³ Disclaimers have often become the subject of trademarks litigation. In the South African case of *Abdul M. Mayet Group (Pty) Ltd. v. Renasa Insurance Co. Ltd. and Another*,²⁴ the applicant who was the registered proprietor in South Africa of the trademark 'Reliance Insurance Brokers' in terms of the provisions of the South African Trade Marks Act, sought a final interdict in a Provincial Division Court restraining the respondent from infringing the registered trademark.²⁵

The applicant submitted that, as the trademark had been registered subject to a disclaimer of the words 'insurance' and 'brokers', the distinctive portion or dominant feature of the registered trademark was the word 'reliance'.²⁶ Consequently, the use of the words 'a Reliance Group Holdings Company' and 'Reliance National House' by the respondents constituted use of the trademark 'reliance'.²⁷ The respondents argued that, insofar as trade mark infringement was concerned, the registered trade mark was 'Reliance Insurance Brokers' and the applicant could not contend that the registered trademark was in the word 'reliance'.²⁸

In his ruling, Van Dijkhorst J. held *inter alia*-

'... The fact that the particular words were disclaimed did not mean that they were to be regarded as *pro non scripto* (as though they had not been written) as far as the registered trademark was concerned. When the true meaning of the registered trademark was considered, all the words comprising the trademark as registered had to be taken as an integrated whole ...'.²⁹

On the crucial question as to whether the applicant's trademark had been infringed, the learned justice ruled-

'... that the use by the applicant and the respondents of the word 'reliance' in conjunction with insurance brokers and an insurance group would, on the probabilities, lead the unsuspecting customer to conclude that they were all related companies working in the same field and to the same end, which would be confusing. The applicant had accordingly proved its case on the basis of trademark infringement."³⁰

If an applicant for registration of a trademark in Belize fails to rectify the defects in his application, the Registrar shall refuse to accept the application.³¹ On the other hand, if the requirements for registration are met, the Registrar shall accept the application.³²

Publication, opposition proceedings and observations

An accepted application shall be published in the Register and in the Journal of Intellectual Property and in any other prescribed manner.³³ Any person wishing to oppose the registration of a trademark may give a notice of opposition to the Registrar within the prescribed time after publication of the application.³⁴ The notice of opposition shall be written in the prescribed manner and shall include a statement of the grounds of opposition.³⁵ The form of a notice of opposition is that set out in Form No. 6 of Schedule II to the Rules. The prescribed fee for the submission of a notice of opposition to an application for registration of a trademark is BZ\$50.³⁶

Also, observations in writing may be made to the Registrar as to the merits of the application after publication of the application.³⁷ The Registrar shall inform the applicant of any such observations.³⁸ A person making such observations is not regarded as a party to proceedings on the application.³⁹

Withdrawal, restriction or amendment of application by applicant

The application may be withdrawn by the applicant at any time.⁴⁰ The goods or services covered by the application may also be restricted by the applicant.⁴¹ In the case of a published application, the withdrawal or restriction shall also be published.⁴² Where the correction does not substantially affect the identity of the trademark or extend the goods or

services covered by the application, the applicant may request the amendment of the application by correcting his name and address, errors of wording or copying, or obvious mistakes.⁴³

Registration

The Registrar shall register a trade mark, where no notice of opposition is given to an accepted application or where the opposition proceedings are withdrawn or ruled in favour of the applicant, “unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error.”⁴⁴

However, a trademark shall not be registered and shall be deemed withdrawn, if the prescribed registration fee is not paid within the prescribed period.⁴⁵ The prescribed fee for registration of a trademark is BZ\$75 (this fee was included the total fee of BZ\$425 referred to earlier).⁴⁶ After the registration of the trade mark, the Registrar shall then issue to the applicant a certificate of registration.⁴⁷ The certificate of registration shall be in the form set out in Form No. 10 of Schedule II to the Rules. The date of filing of the application for registration shall be deemed to be the date of registration.⁴⁸ The Registrar shall also publish a notice of the registration of the trademark in the Journal of Intellectual Property.⁴⁹

Conclusion

The Legislative Agenda of the three year Plan of Action for Improving the Administration of Justice in Belize, recommended the modernization of the intellectual property laws of Belize.⁵⁰ This legislative foundation has been laid in the area of trademarks by the Act and the Rules. These laws have also been examined by the World Trade Organisation’s TRIPS Review Council and found to be TRIPS compliant.

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1. Section 2 of CAP. 257.
 2. Ibid.
 3. Paul Torremans and Jon Holyoak, Intellectual Property Law, Second Edition, Butterworths, 350.
 4. Section 12 (1) of CAP 257.
 5. Rule 19 Trademarks Rules, 2001 (No. 8 of 2001).
 6. Section 12 (2) of CAP. 257.
 7. Ibid, Section 12 (3).
 8. Brian Rutherford and Roshana Kelbrick, Essential Trade Mark Law, University of South Africa/WIPO Worldwide Academy, 1.3.5.
 9. 1967 (3) SA 8 (T).
 10. Section 12 (4) of CAP. 257.

11. Rule 3 (2) of the Trade Marks Rules, 2001 (No. 8 of 2001).
12. Ibid., Rule 3, Schedule I.
13. Section 13 (1) of CAP. 257.
14. Ibid., Section 14 (1).
15. International Classification of Goods and Services, 2001 (8th Edition).
16. Brian Rutherford and Roshana Kelbrick, Essential Trade Mark Law, University of South Africa/WIPO Worldwide Academy, 1.4.7.
17. Ibid.
18. Section 14 (2) of CAP. 257.
19. Ibid., Section 15 (1).
20. Ibid, Section 15 (2).
21. Brian Rutherford and Roshana Kelbrick, Essential Trade Mark Law, University of South Africa/WIPO Worldwide Academy, 1.5.2.
22. Section 15 (3) of CAP. 257.
23. Rule 30 of the Trade Marks Rules, 2001(No. 8 of 2001).
24. *Trasvaal Provincial Division, 1999 June 17; July 21, Case No. 21447/98.*
25. Ibid, 1040 C – D.
26. Ibid., E.
27. Ibid., F.
28. Ibid., F – G.
29. Ibid., 1047 F/G – I.
30. Ibid., 1051 D –E.
31. Section 15 (4) of CAP. 257.
32. Ibid., Section 15 (5).
33. Ibid., Section 16 (1).
34. Ibid., Section 16 (2).
35. Ibid., Section 16 (3).
36. Rule 3, Schedule I.
37. Section 16 (4) of CAP. 257.
38. Ibid.
39. Ibid., Section 16 (5).
40. Ibid., Section 17 (1).
41. Ibid.
42. Ibid., Section 17 (2).
43. Ibid., Section 17 (3).
44. Ibid., Section 18 (1).
45. Ibid., Section 18 (2).
46. Schedule I to the Trade Marks Rules, 2001 (No. 8 of 2001).
47. Rule 37 of the Trade Marks Rules, 2001 (No. 8 of 2001).
48. Section 18 (3) of CAP. 257.
49. Ibid., Section 11.
50. Delivering Justice – A three year Plan of Action for Improving the Administration of Justice in Belize, October 1999, 26.