

**TRADE MARK ACT, CAP. 257  
LAWS OF BELIZE, REVISED EDITION, 2011**

**IN THE MATTER OF APPLICATION NO. 7120.10 BY  
REPUBLIC TECHNOLOGIES (NA) LLC TO REGISTER  
TRADEMARK:**

**ZIG ZAG**

**AND**

**THE OPPOSITION by NORTH ATLANTIC OPERATING  
COMPANY, INC.**

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**T.M. RULING NO. 1/ 2017**

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**The Registrar, Intellectual property Office, Belize**

**Trade Marks Act, CAP. 257, Laws of Belize, Revised Edition 2011.**

## **INTRODUCTION**

By application No. 7120.10 filed on September 23, 2010, the Applicant, Republic Technologies (NA) LLC (hereinafter referred to as “RTL”), represented by Marine Parade Chambers, applied for mark Zig Zag to be registered as a trademark in Belize. This application which was published for opposition purposes in the Intellectual Property Journal was opposed by North Atlantic Operating Company, Inc (hereinafter referred to as “NAOC”) represented by the law firm of Arguelles & Company LLC who filed its opposition on February 27, 2011.

Zig Zag is a trademark for cigarette and its accessories and registered in numerous countries throughout the world under class 34 by both the Applicant and the Opponent. Class 34 under the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks is specified as follows: *Tobacco; smokers' articles; matches.*

## **OPPOSITION**

The NAOC claims that the Applicant is not the owner of the Zig Zag mark which is similar to their mark “Zig-Zag” and that in fact they are outright owners in the United States and that such ownership stems from an Exclusive Distribution Agreement that was amended and restated in 1997 & 2002 as between Bollore and NAOC. The Opponent’s Zig-Zag mark is not registered in Belize but it is registered in the United States of America and other Convention countries.

According to NAOC, the Zig Zag brand, in particular, the cigarette rolling papers and accessories has been on the international market since as early as the late 19<sup>th</sup> century. NAOC further states that the right to distribute Zig Zag cigarette paper in the USA and the entire North America was obtained by the United States Tobacco Company from French manufacturer Bollore S.A. since 1838. According to NAOC, they obtained Zig Zag distribution rights in 1992 from United States Tobacco Company which assigned those rights to them through corporate transaction; a Distribution Agreement which gives it exclusive distribution rights in USA and Canada for Zig Zag cigarette papers & accessories, product defined as cigarette paper, booklets and filter tubes, injector’s machines and filter tips. According to them the rights acquired included cigarette, cigar smoking, tobacco chewing, tobacco roll-your own cigarette tobacco, and snuff (collectively “Tobacco Products”). Additionally, NAOC advanced that Bollore agreed not to contest registration in the USA and other countries outside of North America and they have applied for registration in Canada, Nicaragua, Haiti, Honduras, Guatemala and Dominica.

NAOC further asserts that the Zig Zag brand is notorious in the USA due to the significant sales and advertisement of the products in various publications and industry trade magazine which are all attributable to them and that such fame and notoriety is not due to the Applicant, RTL, which does not own the mark in the USA. According to them, since 1997 their affiliated company has been the exclusive distributor for NAOC of Zig Zag branded cigarette papers in the USA, Canada and other international markets.

The Applicant, RTL submissions are not set out herein as the one submitted by them was inadvertently destroyed during flooding caused by Hurricane Earl and upon a request for them to resubmit those submissions they indicated that they were no longer interested in the registration of the mark. This led me to the apparent misconceived assumption that the Applicant would be withdrawing their Application which would render a decision on the matter unnecessary. However, since no such withdrawal was forthcoming, it is only proper that a decision be made on the matter.

### **APPLICABLE PRINCIPLE**

Under Art 6bis Paris Convention, a *“peregrine trademark owner whose trademark, even though not registered within the local jurisdiction, is well known locally may:*

- *Object to the registration*
- *Claim cancellation, or*
- *Prohibit the use*

*of a trademark that constitutes:*

- *A reproduction*
- *An imitation, or*
- *A translation,*

*which is liable to create confusion of his trademark*

This convention has been incorporated in our laws by section 61 of the Trade Mark Act, Revised Edition, 2011. The applicable provision in this case is S 61 (1) & (2) which reads as follows:

*“61 (1) Reference in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark are to a mark which is well-known in Belize as being the mark of a person who:-*

*(a) Is a national of a Convention Country; or*

*(b) Is domiciled in, or has a real and effective industrial or commercial establishment in a Convention Country,*

*Whether or not that person carries on business, or has any goodwill, in Belize, and references to the proprietor of such a mark shall be construed accordingly.*

*(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known is entitled to restrain by junction the use in Belize of a trade mark which or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion, but this right is subject to section 48 (effect of acquiescence by proprietor of earlier trademark)''.*

The issue therefore, is whether the Opponent's trademark is entitled to protection. It is clear that the marks are similar and liable to create confusion. Furthermore, the Opponent has established that they acquired rights to the Zig Zag Mark since 1992; many years earlier than any rights the Applicant may have acquired which appears to be sometime in 2000. Finally, given the evidence by the Opponent of the extensive marketing of its mark via magazine and the internet which the relevant segment of the Belizean society has access to and given that there exist no evidence to refute the Opponent's assertion that their mark is well known locally; I conclude that the mark is indeed well known locally. I find the case of **MCDONALD'S CORP V JOBURGERS DRIVE-INN RESTAURANT (PTY) LTD** 1997 (1) SA I {South Africa} instructive.

## **CONCLUSION**

In view of the above, I find that in accordance with section 61(1) & (2) of the Trade Mark Act, the Opponent's mark, Zig-Zag is entitled to protection and hence, the Applicant's trademark, Zig Zag is refused.

## **COSTS**

Given that the Applicant decided not to proceed with this matter; no order as to costs is hereby made.

Dated this 20<sup>th</sup> day of September, 2017.

***Velda Flowers***  
***Registrar General***  
***Of Intellectual property***