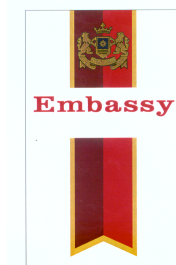


**TRADE MARKS ACT, CAP. 257
LAWS OF BELIZE, REVISED EDITION 2000**

**IN THE MATTER OF APPLICATION NO. 5082.07 BY BRITISH
AMERICAN TOBACCO (BRANDS) LIMITED TO REGISTER THE
TRADEMARK:**



AND

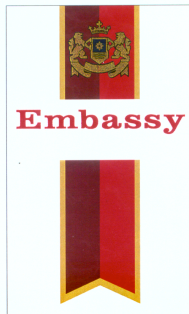
**THE OPPOSITION THERETO BY PHILIP MORRIS PRODUCTS
S.A.**

T.M. RULING NO. 1/2009

The Registrar, Intellectual Property Office, Belize

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

In the Matter of Application No. 5082.07 by British American Tobacco (Brands) Limited, to register the trademark:



And the Opposition thereto by Philip Morris Products S.A.

BACKGROUND

1) This opposition relates to an application made by British American Tobacco (Brands) Limited (hereinafter referred to as BAT), to register the above trademark. The filing date of the application was December 10, 2007, and the application had the following specification:

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

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

2) Philip Morris Products S.A. (hereinafter referred to as Philip Morris), filed an opposition against the above application.

Philip Morris is the owner of Belize trademark registration No. 4388.07, under Class 34 of the Nice Agreement for:

Tobacco, raw or manufactured; tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek, tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays not of precious metals, their alloys or coated therewith; pipes, pocket apparatus for rolling cigarettes, lighters; matches.

Philip Morris claims that the BAT trademark is substantially identical to or deceptively similar to Philip Morris' registered trademark, and that the goods of the BAT application are identical with or similar to those for which Philip Morris' earlier trademark is protected. Philip Morris claims that its trademark has acquired a reputation in Belize and that the use of BAT's EMBASSY trademark would be likely to deceive or cause confusion in Belize. Also, Philip Morris claims that the BAT trademark is confusingly similar because a similar design to Philip Morris' earlier trademark appears at the bottom of the BAT trademark. Philip Morris further claims that this confusion is also reinforced by the facts that the targeted consumers are identical or substantially similar because they are cigarette buyers, and that the trade channels are also identical or substantially similar.

3) BAT answered to the opposition by submitting that its trademark is neither substantially identical nor deceptively similar to Philip Morris' registered trademark, and is therefore not likely to deceive or cause confusion in Belize. According to BAT, the design, colour and word elements of the above trademarks allow consumers to distinguish between the trademarks. Although BAT conceded that Philip Morris' trademark may have acquired a reputation in Belize, BAT argued its various trademarks have peacefully coexisted with Philip Morris' registered trademark in several markets in the world. BAT also conceded that targeted consumers and trade channels are identical and substantially similar.

4) BAT argued for the dismissal of the opposition and that its trademark should be allowed to proceed to registration.

6) Both sides filed evidence.

7) The case was heard on September 14, 2009. Philip Morris was represented by Mr. Nicholas Dujon of Dujon and Dujon. BAT was represented by Mr. Rishi Alain Mungal of Morgan and Morgan Trust Corp. (Belize) Ltd.

EVIDENCE

Evidence of Philip Morris

8) This is furnished by way of a sworn affidavit by Irina Lucidi, Senior Counsel at Philip Morris International Management S.A. She states that the

MARLBORO ROOF DEVICE was first registered in International Class 34 in Belize on June 27, 1956, and was last renewed on June 27, 2005. A copy of the registration certificate is exhibited. She also exhibited copies of the two other MARLBORO ROOF DEVICE registrations (including trademark registration No. 4388.07). She states that the fame and presence of the MARLBORO ROOF DEVICE trademarks is shown in the exhibited list of over 345 worldwide registrations. She exhibited a copy of “The Maxwell Report” and states that it shows that “MARLBORO” is the “top world brand” for tobacco products. This report ranks “MARLBORO” as the No.1 cigarette brand in the world for the period 1985 to 2004. She further attached a copy of the “2008 BRANDZ Top 100 Most Powerful Brands” report by Millward Brown Optimor, which ranks “MARLBORO” 10th among the top 100 international brands.

Evidence of BAT

10) This is furnished by way of a sworn affidavit by Mr. Clyde Elliott Woods, Trade Mark Manager, BATMark Limited. He exhibits copies of what he considered to be similar BAT trademark registrations in Belize and states that Philip Morris never filed oppositions to those trademarks. Mr. Woods states that BAT has secured over 220 trademark registrations in about 119 countries for its EMBASSY trademark. A report from BAT’s internal records detailing the aforementioned registrations is exhibited. Further, BAT has secured over 900 trademark registrations for its DERBY, MONTANA, WINFIELD and LOOK brands which BAT argues contain similar or varied designs like its EMBASSY trademark. A report from BAT’s internal records detailing the aforementioned registrations is also exhibited.

DECISION

Relevant Law

11) Section 37(2) (b) of the Trade Marks Act (hereinafter referred to as ‘the Act’) states that a trademark shall not be registered if:

‘it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.’.

According to section 38(1) (a) of the Act, an ‘earlier trade mark’ is:

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

I find that Philip Morris’ trade mark is an earlier trademark in terms of section 38(1) (a) of the Act and is a valid trademark for purposes of this opposition. According to section 67 of the Act:

‘In all legal proceedings relating to a registered trademark....the registration of a person as proprietor of a trade mark shall be *prima facie* evidence of the validity of the original registration....’.

Relevant cases for determining the issues under section 37(2) (b) of the Act are *Sabel BV v Puma AG* [1998] RPC 199; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77.

12) This ruling does not cover Philip Morris’ allegations that its trademark is well known in Belize and that targeted consumers and trade channels are identical and substantially similar. This omission is based on the fact that these grounds of opposition are not in dispute.

Comparison of goods

13) The goods of BAT’s EMBASSY application are:

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

Philip Morris’ trademark registration No. 4388.07 is registered for:

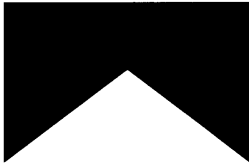
Tobacco, raw or manufactured, tobacco products, including cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek, tobacco substitutes (not for medical purposes); smokers’ articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays not of precious metals, their alloys or coated therewith; pipes, pocket apparatus for rolling cigarettes, lighters; matches.

14) **I find that the respective goods are identical.**

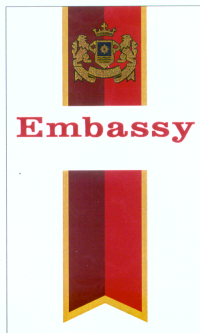
Comparison of trademarks

15) The trademarks to be compared are:

Earlier Philip Morris trademark:



BAT's trademark:



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

The main design element of the BAT trademark is the vertical ribbon extending from top to bottom and interrupted only by the positioning of the dominant word element EMBASSY. On the other hand, the main design element in the Philip Morris trademark is the five sided roof design that covers the entire width from left to right. I submit that these designs are visually and conceptually dissimilar. This visual difference is reinforced by the differences in the colours of the above trademarks.

It must also be noted that the emblems in the BAT trademark and Philip Morris' trademark registration No. 1089 are also visually dissimilar. To round it up, the word element of the BAT trademark ("EMBASSY") and the word elements of Philip Morris' trademark registration Nos. 1089 and 3984.06 (MARLBORO) do not share any visual, aural or conceptual similarity.

17) I find that the respective marks are not similar.

Likelihood of confusion

18) A global assessment must also be done when examining the concept of the likelihood of confusion while taking note of all relevant factors (*Sabel BV v Puma*). The deciding factor is the perception of the average consumer of the relevant goods (*Sabel BV v Puma AG*). Although the average consumer is deemed to be reasonably well informed and observant, he or she rarely makes direct comparisons between trademarks (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*).

As a result of the global assessment I have outlined on paragraph 16 above, I must submit that the average consumer will likely not confuse BAT's trademark for Philip Morris' trademark, nor will the average consumer likely associate the BAT trademark with the earlier Philip Morris trademark.

19) I find that there is no likelihood of confusion.

CONCLUSION

20) BAT's trademark is allowed to proceed to registration because the mark is not similar to Philip Morris' earlier trademark. Also, there exists no likelihood of confusion on the part of the public, nor does there exist the likelihood of association with the earlier Philip Morris trademark under section 37(2) (b) of the Act.

COSTS

21) BAT, having been successful is entitled to a contribution towards its costs. I order Philip Morris to pay BAT, the sum of \$1,425.00 (See Annex). This sum is to be paid within seven days of the expiry of the appeal period

of twenty-one days, or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of October, 2009.

Alhaji Tejan-Cole
Deputy Registrar
for Registrar of Intellectual Property

APPENDIX
AWARD OF COSTS

<u>ITEM</u>	<u>\$BZ</u>
Filing Notice of Opposition	175.00
Preparing and filing evidence in support	200.00
Receiving and perusing evidence in answer	100.00
Preparation of case for hearing	350.00
Attendance at hearing by Attorney-at-Law	<u>600.00</u>
Total Costs	1,425.00