

TRADEMARK LAW IN BELIZE: IMPLEMENTATION OF GATT TRIPS IN A DEVELOPING COUNTRY

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I. INTRODUCTION

Intellectual property law in Belize has recently been completely modernized, with the enactment of new patent, trademark, copyright, and industrial property laws¹—all to fulfill Belize's obligations as a signatory to GATT TRIPs.² Although this article focuses on Belize, the general policies and provisions adopted can serve as a guide to other developing countries as they examine their own trademark laws and the need to comply with international treaties.

Trademark law in Belize was substantially revised by the enactment in the year 2000 of the Belize Trade Marks Act (BTMA)³ and the Trade Mark Rules adopted pursuant thereto.⁴

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1. See Chapters 253-56 of the Substantive Laws of Belize (Patents, Industrial Designs, Plant Varieties, and Layout Designs [Topographies] of Integrated Circuits, respectively). Texts of all the new laws, as well as related regulations, are available at the extensive and informative websites [belizelaw.org](http://www.belizelaw.org) and The Belize Intellectual Property Office, <http://www.belipo.bz>, respectively.

2. Annex 1C to the WTO Agreement, Agreement on Trade Related Aspects of Intellectual Property Rights. (April 15, 1994) (GATT-TRIPs). See Alhaji Tejan-Cole, Deputy Registrar, Belize Intellectual Property Office (BELIPO), "Registering Trademarks in Belize," p. 5 available at <http://www.belipo.bz/e-library>, and as Belize asserted in World Trade Organization, Council on Trade Related Aspects of Intellectual Property, <http://docsonline.wto.org/DDFDocuments/t/IP/Q4/BLZ1.doc>. 28 September 2000. See Statutory Instrument (SI) No. 116 of 2001—Protection of New Plant Varieties Regulations, 2001; SI No. 2 of 2002—Patents Regulations; SI No. 3 of 2002 Trade Marks Rules, 2002. SI No. 16 of 2000—Designs Regulations, 2001; SI No. 115 of 2001—Protection of Layout Designs (Topographies) of Integrated Circuits).

3. Chapter 257 of the Substantive Laws of Belize, Revised Ed. 2000.

4. Statutory Instrument (SI) No. 3 of 2002 as amended by SI No. 62 of 2002, hereafter collectively referred to as "the Rules." These Rules repealed and replaced the Trade Mark

The primary significance of the BTMA was the creation of a Belize national trademark and a trademarks registry, both of which are independent of the United Kingdom Trade Marks Registry under the now-repealed Registration of United Kingdom Trade Marks Act.⁵ Another significant highlight of recent law is the repeal of the Merchandise Marks Act.⁶ In addition, the modern law results in the new, effective enforcement of trademark rights in Belize. The implementation of the BTMA represents compliance with GATT-TRIPs and effectuation of the provisions of the International Convention for the Protection of Industrial Property (the Paris Convention), as last revised.⁷

The significance of the new law to a developing country such as Belize cannot be understated. While discharging Belize's international treaty obligations under the Paris Convention and GATT TRIPs, the BTMA also represents implementation of Belize's business and economic arrangements under the Caribbean regional treaty, the Treaty of Chaguaramas, discussed in more detail in Part VII below. The BTMA also represents anticipation of ratification of other international intellectual property instruments, including the Trademark Law Treaty, insofar as, for example, the Act provides for protection of color, 10-year duration or registration, and the like. There has been no indication, however, when Belize intends to ratify this latter treaty.

In sum, Belize's new law represents a significant step forward in promoting the exploitation of trademark-protected goods/services in Belize, while protecting economic and business interests vetted by regional obligations. As cited by the Attorney General, "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

Rules, 2000 (No. 8 of 2001), and were authorized under the BTMA § 71, wherein the Minister has the authority to make Rules (for the purpose of any provision of this Act authorizing the making of Rules with respect to any matter; and for prescribing anything authorized or required by any provision of this Act to be prescribed, and generally for regulating practice and procedure under this Act.) The Rules are available online at the Belize Intellectual Property Organization (BELIPO) website, http://www.belipo.bz/e_library/.

5. Registration of United Kingdom Trade Marks Act of 1985, Chapter 239 of the Laws of Belize, Revised Edition 1980-90.

6. Chapter 209 of the Laws of Belize, Revised Ed. (1980-90).

7. World Trade Organization, Council on Trade Related Aspects of Intellectual Property, <http://docsonline.wto.org/DDFDocuments/t/IP/Q4/BLZ1.doc>. 28 September 2000. Belize has notified the BTMA in accordance with Article 63.2 of TRIPs. World Trade Organization. Country Information: Belize. http://www.wto.org/english/thewto_e/countries_e/belize_e.htm.

emphasized.”⁸ In essence, the mark stimulates consumers by the creation of goodwill and guarantee of satisfaction.⁹ Trademark owners in Belize, at long last, have strong, effective means to enforce their trademark, while exploiting a stimulated market, in this thriving Caribbean country. Indeed, many famous mark owners, such as the owners of CLOROX, KOOL AID, DIAMOND INTERNATIONAL, and JUVENTUS, are bringing proceedings under the new law, and the trademark jurisprudence in Belize is rapidly developing.¹⁰

This article reviews in more detail the most important aspects of the new law, and provides an overview of the statutory formalities and procedures of trademark registration and enforcement in Belize. This article is not intended to provide a comprehensive comparison of the new law with the prior Colonial law, but rather highlights the major aspects of the new law. Copies of the law are available online.¹¹

II. GENERAL SYSTEM OF LAW

Belize has a common law system based largely on the laws of the United Kingdom.¹² Belize was a British colony (known as British Honduras) from 1862 until September 1981, when it gained independence. Pursuant to this independence, Belize adopted its own constitution, the supreme law of Belize; any law inconsistent with the Constitution is void.¹³ Insofar as Belize’s final court of appeal rests with the Judicial Committee of the Privy Council in England, English law and the law of other jurisdictions of the Commonwealth still, to a large extent, dictate Belize court rulings.¹⁴ Laws and regulations—including intellectual property laws and related laws of telecommunications—continue to be promulgated to effectuate this independence.

8. Elson Kaseke, “Trademarks: Fundamental Elements of the New Law”; first reprinted in *Belize Law Review*, Vol. 2 No. 1. 2002 at page 31. Now available online at <http://www.belipo.bz/e-library>. Page numbers herein reference online .pdf version.

9. *Id.*, citing Ivor Carryl, “Notes on the Operationalisation of the Single Market and Economy” in *Caribbean Court of Justice: Issues and Perspectives*, Vol. 1 2001 41-42, and David Cox, “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.

10. Email from Solicitor General Kaseke to author, dated October 31, 2003.

11. See <http://www.belipo.bz/e-library>.

12. Imperial Laws (Extension) Act, Chapter 2 of the Laws of Belize, Revised Edition 2000.

13. Belize Constitution Act, Chapter 4 of the Laws of Belize, Revised Edition 2000.

14. See 40 *St. Louis University Law Journal* 1333 (1996).

III. HISTORY OF BELIZE TRADEMARK LAW AND TREATIES

The first statutory regulation of trademarks in Belize under colonial rule was the Registration of United Kingdom Trade Marks Act (RUKTMA). An application to register under this Act was made to the Registrar General of Belize Supreme Court. There was no examination of a mark in Belize for possible conflicts with other marks on the register in Belize. Under this Act, all rights in the United Kingdom applied directly (with conforming geographical changes) to Belize.¹⁵ Although thousands of registrations were granted, no cases were ever tried under the RUKTMA.

Belize is a signatory to GATT-TRIPs, and became signatory to the International Convention for the Protection of Industrial Property in the year 2000 (Paris Convention).¹⁶ As noted by the Solicitor General, “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 of trade marks, and enacted the new law: the Trade Marks Act of 2000.”¹⁷ The BTMA incorporates all relevant statutory requirements of the Paris Convention, including national treatment, the six-month priority period, and the protection of well-known marks.¹⁸

Belize is not yet a signatory to the Madrid Agreement Concerning the International Registration of Marks, the Madrid Protocol,¹⁹ or the 1994 Trade Mark Treaty. As explained by the drafter of the BTMA, however, these laws constitute the international sources that informed the drafting of the BTMA.²⁰

IV. DEFINITION OF RIGHTS

A. Protectable Marks

1. Definition of Trademark

A trademark is defined as:

15. Elson Kaseke, “Trademarks: Fundamental Elements of the New Law”; first reprinted in *Belize Law Review*, Vol. 2 No. 1. 2002. Now available online at <http://www.belipo.bz/e-library.html#2>. Page numbers herein reference online .pdf version.

16. Kaseke, *id.* at 10.

17. *Id.* at 8.

18. *Id.*

19. *Id.* at 16.

20. *Id.* at 26.

[a]ny sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings, in particular, consisting of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.²¹

As stated by the Belize Solicitor General in charge of the Belize Intellectual Property Office (BELIPO), “[t]he expression ‘any sign’ . . . must be given a liberal and generous interpretation so as to include distinctive color, music, sound and smell signs capable of graphic representation.”²² This capability of graphical representation is of vital importance to registrability, however, to “enable the sign to be recorded in the register, which will in turn facilitate searches and examinations.”²³ For complex marks, “graphic representation is best achieved by negotiations between the [a]pplicant or his agent and the Belize Intellectual Property Office.”²⁴

The BTMA also protects certification marks and collective marks.²⁵

2. Non-distinctive, Descriptive and Generic Marks

Signs that do not satisfy the above-referenced definition are not protectable.²⁶ In addition, signs that are devoid of any distinctive character,²⁷ as well as signs that are descriptive²⁸ or generic²⁹ are not protectable under the BTMA. Finally, inherently necessary trade dress is not protectable.³⁰ Trade dress protection under the BTMA is discussed in more detail in Part IV.B. below.

3. Identical and Similar Marks

Under the BTMA, a trademark that is *identical* to an earlier trademark for services identical to those listed in connection with

21. BTMA § 1.

22. Tejan-Cole, *supra* n.2.

23. Kaseke, *supra* n.15, at 33.

24. *Id.*

25. *Id.*

26. BTMA § 35(1)(a).

27. BTMA § 35(1)(b).

28. Defined as, “to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services” *Id.* § 35(1)(c).

29. Defined as “trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.”

30. See also Part IV.B., *infra*.

the prior mark is non-registrable.³¹ In this instance, the statute does not require a showing of likelihood of confusion or association. In order to determine the identity of goods/services, “recourse per force must be made to the ‘core’ of the registered specification.”³²

Further, if a sign is *identical* to the registered trademark and is used in relation to goods/services *similar* to those for which the trademark is registered, such sign infringes the rights of the registered mark proprietor.³³ As recognized by the Act’s drafter, the Act does not define “similar”;³⁴ the drafter indicates that courts in other Commonwealth jurisdictions “holistically consider all the surrounding circumstances of each case, in particular the nature of the goods and their composition, their origin, channels of disposal in trade, and classes of customers.”³⁵

The right of the proprietor of a mark against a proprietor of an identical mark used on or in connection with similar goods/services is conditioned upon a showing of likelihood of confusion, which includes a likelihood of association, with the registered mark.³⁶

While there is no statutory language indicating whether confusion must be proved for an action under this provision to succeed, the Solicitor General indicates that a showing of confusion is required.³⁷ As stated by the Deputy Registrar, “where the mark and/or goods/services are not identical, my opinion is that in such cases, the onus lies on the plaintiff to prove the likelihood of confusion.”³⁸ Insofar as Belize asserts that it is fully in compliance with TRIPs,³⁹ it can be deduced that in the case of identical marks used in connection with identical goods/service, confusion can be presumed.⁴⁰

4. Intent to Use (ITU) Applications

A mark is also registrable, subject to the requirements mentioned in Part IV.A.3. above, if the proprietor has a bona fide intention to use the mark.⁴¹ The intention to use a mark must be

31. BTMA § 25(1).

32. Kaseke, *supra* n.15, at 45.

33. BTMA § 25(2).

34. Kaseke, *supra* n.15, at 45.

35. *Id.* at 45-46, citing, Danco Clothing (Pty) Ltd. v. Nu-Care Marketing Sales and Promotions Ltd. 1991 (4) SA 850(A) and British Sugar and Robertson [1996] RPC 281.

36. BTMA § 25(2)(b).

37. Kaseke, *supra* n.15, at 49.

38. Email from Deputy Registrar Tejan-Cole to author, dated June 24, 2003.

39. See World Trade Organization, Council on Trade Related Aspects of Intellectual Property, <http://docsonline.wto.org/DDFDocuments/t/IP/Q4/BLZ1.doc>. 28 September 2000.

40. TRIPs Art. 16(1).

41. BTMA § 12(3).

“definite and present.” “Abstract intention to use at a future unspecified date” is not sufficient to support an application.⁴² There need not be a statement of use filed prior to maturation of application into registration—a statement of use is required for a use-based application; a statement of intent to use for an ITU application will suffice.⁴³

5. Rights in Unregistered Marks

Unregistered marks are explicitly *not* protectable by way of trademark infringement proceedings under the BTMA.⁴⁴ However, unregistered marks are protectable under the common law of passing off. Solicitor General Elson Kaseke observes that “the proprietor of an unregistered trade mark cannot claim the benefits of the Act in cases where its trade mark is infringed, it can only avail itself of the common law action of passing-off, which is lengthy and expensive.”⁴⁵ Furthermore, the Act explicitly provides that “[n]othing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.”⁴⁶

In addition, an unregistered trademark is protected against conflicting registrations if the conflicting mark’s use in Belize is liable to be prevented by virtue of any rule of law (in particular the law of passing off) protecting an unregistered trademark or other sign used in the course of trade.⁴⁷

6. Trade Names

Trade names are registrable under the Registration of Business Names Act, Chapter 247 of the Laws of Belize, Revised Edition 2000, and the Companies Act, Chapter 250 of the Laws of Belize, Revised Edition 2000. The former act applies to unincorporated bodies, firms or individuals whereas the latter act applies to companies incorporated thereunder. Pursuant to Belize’s treaty obligations under the Paris Convention, however, trade names need not be registered to be protected.⁴⁸ There are restrictions upon the choice of name for a company (for example, a company name cannot include symbols of the crown or government entities). A company cannot change its name without the

42. Kaseke, *supra* n.15, at 83.

43. See email from Deputy Registrar Tejan-Cole to author, dated September 17, 2003.

44. BTMA § 23(1).

45. Kaseke, *supra* n.15, at 48.

46. *Id.*

47. BTMA § 37(4)(a).

48. Kaseke, *supra* n.15, at 74.

permission of the Minister responsible for companies (Attorney General's Ministry)⁴⁹ and a special resolution by the company's members.⁵⁰ When a company wishes to register a name, the Attorney General will conduct a search for identical and confusingly similar marks, and refuse to register a company name if it believes the proposed name will confuse or deceive the public.⁵¹

7. Certification Marks and Collective Marks

Certification marks and collective marks are protectable under the BTMA. As these types of marks are not utilized by a significant percentage of trademark holders, these types of marks are not covered in detail in this article. For the law in Belize regarding these types of marks, see BTMA §§ 57 and 58.

B. Trade Dress

As mentioned above, the definition of a trademark includes the shape of goods and their packaging.⁵² Thus included within the scope of protection are those forms of trade dress. The registrability of the shape of goods represents a new right not previously available under the RUKTMA.⁵³ However, inherently necessary trade dress is not protectable. As the statute states, "the shape of goods which results from the nature of the goods themselves, a shape that is necessary to obtain a technical result" and "the shape which gives substantial value to the goods,"⁵⁴ are not protectable as registered trademarks.

Trade dress infringement in relation to services, such as the distinctive color scheme used in McDonald's restaurants, would, however, likely be actionable under the law of passing off.

V. SCOPE OF RIGHTS IN MARKS

A. Prima Facie Evidence

A trademark registration constitutes prima facie evidence of the validity of the trademark, thus entitling the proprietor to the right to shift the burden of proof to the defendant to prove the mark is invalid.⁵⁵ In addition, recordal in the register constitutes

49. Companies Act § 9(3).

50. Companies Act § 9(2).

51. Companies Act § 9(1).

52. See Part IV.A.1., *supra*.

53. Kaseke, *supra* n.15, at 32.

54. BTMA §§ 35(b) and (c), respectively.

55. BTMA § 67.

prima facie evidence of any subsequent assignment or other transfer of the mark in all legal proceedings pertaining to the mark.⁵⁶

B. Acquired Distinctiveness

As discussed in this section, marks that are devoid of any distinctive character (generic marks), and “descriptive”⁵⁷ marks are not protected under the BTMA. Trademarks consisting exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade are not protectable under the BTMA.⁵⁸ Generic marks are not capable of fulfilling the “distinguishing” criteria in the Act, and thus cannot acquire distinctiveness.⁵⁹

In addition, trademarks that consist exclusively of signs or indications that may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services are not protectable.⁶⁰ A significant exception to these exclusions, however, is if, before the application date of the trademark, the mark in fact acquired a distinctive character as a result of the use made of it. Thus, acquired distinctiveness, or in alternative U.S. parlance, secondary meaning, has been incorporated into the new statutory law of Belize.

C. Famous Marks

Famous marks are granted broader protection under the Act against registration of marks that would dilute the distinctive character, or take unfair advantage, of a famous mark:

A trade mark which is identical with or similar to an earlier trade mark; and is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Belize, and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.⁶¹

56. Id. See Kaseke, supra n.15, at 36.

57. BTMA § 35(1)(b) and (c).

58. BTMA § 35(1)(d).

59. World Trade Organization, Council on Trade Related Aspects of Intellectual Property, <http://docsonline.wto.org/DDFDocuments/t/IP/Q4/BLZ1.doc>. 28 September 2000.

60. See Kaseke, supra n.15, at 85.

61. BTMA § 37(3).

Well-known marks are also protected under Belize's statutory ratification of the Paris Convention. Under the relevant BTMA provisions, a well-known mark is the mark of a person who:

is a national of a Convention country or 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 good will in Belize.⁶²

The proprietor of a well-known trademark under 6bis of the Paris Convention definition is entitled to restrain by injunction the use in Belize of a trademark which (or the essential part of which) is identical or similar to its mark, in relation to identical or similar goods/services, where the use is likely to cause confusion. Thus a foreign proprietor of a well-known mark may enforce such mark against use and registration in Belize.⁶³

This right, however, is subject to the effects of acquiescence by the mark proprietor,⁶⁴ as prescribed in § 48 of the BTMA. These effects include eliminating the right of the earlier mark owner to declare the later mark invalid, and eliminating its right to oppose the later trademark's use in relation to goods/services with which it has been used. An exception to this loss of rights is if the registration of the later trademark was made in bad faith.⁶⁵

It should be noted that even though the earlier trademark owner's rights are eliminated (as described above) against the later mark owner, the later mark owner does not, by virtue of this provision, obtain rights as against the earlier mark proprietor.⁶⁶

VI. DURATION OF RIGHTS

A. Right of Priority

A trademark's Belize application date, or as applicable, its international application (priority) date, is used to determine priority in registration and infringement proceedings.⁶⁷

The "priority date" of a mark means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention. Such a filing must be made within six months from the first filing date.⁶⁸

62. BTMA § 61(1).

63. See Kaseke, *supra* n.15, at 71.

64. BTMA § 61(1).

65. BTMA § 48(1).

66. BTMA § 48(2).

67. BTMA § 38(1)(a).

68. BTMA § 56(1).

An “earlier mark” is also defined as “a trade mark which, at the date of application for registration of the trade mark in question or, as applicable, of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.”⁶⁹ Subsumed in this definition are applied-for but non-registered marks, which, if registered, would fall within the above-mentioned definitions.⁷⁰

During the Registrar’s review of an application for registration, the marks defined as “earlier marks” (as above-mentioned) continue to be taken into account for a period of one year after expiry unless the registrar is satisfied that there was no bona fide use of the mark during the two years immediately preceding the expiry of the registration.⁷¹

B. Revocation of Registration and Lapse in Rights

A proprietor loses rights to enforce a registered mark against, respectively, opposing applications and infringements if, during the two years preceding expiry of the registration, no bona fide use of the mark has been made.

C. Duration and Renewals

A Belize trademark registration endures under the BTMA for a period of 10 years from the date of registration.⁷² The date of registration is deemed, upon maturity of the application into a registration, to be the filing date. The filing date is the date upon which the last of all of the filing requirements are filed with the Registrar.⁷³ A trademark may be renewed at the request of the proprietor for further 10-year periods,⁷⁴ indefinitely, subject to continued use. The applicant will, however, be required to make a statement that the mark is indeed still in use.

Before expiry of the registration, the Registrar is required to inform the proprietor of the impending expiration and of the manner in which the registration may be renewed. There is a six-month post-expiration grace period in which to renew a lapsed mark, subject to payment—also within that period—of an additional fee.

69. BTMA § 38(1)(b).

70. BTMA § 38(2).

71. BTMA § 38(3).

72. BTMA § 21(1).

73. BTMA § 13(1) and (2). See Part X, *infra*.

74. BTMA § 20(2).

D. Restoration of Lapsed Marks

The BTMA provides a statutory provision to enable the restoration of marks removed from the Register. The Rules provide that “[w]here a registered trade mark has completed its tenth anniversary of registration and at least 6 months thereafter no application has been made to renew it, the Registrar shall allow such trade mark to be re-registered on the Register, and the provisions of the Act and these Rules relating to the registration of trade marks, including the payment of the relevant fees, shall apply to such re-registration, which shall for all purposes be deemed to be a registration.”⁷⁵ As explained by the Deputy Registrar, “[t]his re-registration is effectively a restoration because the re-registered application retains the registration date of the lapsed registration.⁷⁶ Thus, the mark automatically lapses upon expiry of the six-month grace period. However, upon application for re-registration, (backed up by justifiable reasons, e.g. negligence of agent), the lapsed registration can be restored).”⁷⁷

VII. GEOGRAPHIC SCOPE OF RIGHTS

Belize is signatory to the Treaty of Chaguaramas, which created an economic region known as the Caribbean Community (CARICOM). The Treaty of Chaguaramas was originally signed by Barbados, Jamaica, Guyana and Trinidad and Tobago. In 1974, Belize (then British Honduras), and seven other countries—Antigua, Dominica, Grenada, St. Lucia, Montserrat, St. Kitts/Nevis, Anguilla, and St. Vincent—became full members.⁷⁸ The revised Treaty contains detailed intellectual property and dispute mechanism provisions governing conflicts between state parties, and provides for the establishment of a Caribbean Court of Justice, which is expected to handle a significant number of intellectual property disputes in CARICOM member countries.⁷⁹

A trademark in Belize will not be infringed by the use of the trademark in relation to goods that have been previously put on the market in the CARICOM Single Market and Economy (CSME) under the identical or a similar mark by the proprietor, or put on the CSME market with the proprietor’s consent (e.g., in the case of an authorized licensee or distributor); provided there are no legitimate reasons for the proprietor to oppose further dealings in

75. Rules 14A.

76. Email from Deputy Registrar Tejan-Cole to Author dated June 24, 2003.

77. Email from Deputy Registrar Tejan-Cole to Author dated September 18, 2003.

78. Treaty Establishing the Caribbean Community, opened for signature July 4, 1973, 947 U.N.T.S. 17 (entered into force Aug. 1, 1973) [hereinafter CARICOM].

79. Kaseke, *supra* n.15, at 29.

the goods because they have been impaired after they have been put on the market.⁸⁰ Thus, parallel importation from a CARICOM country, even of generic goods by a licensee, does not constitute infringement of a registered mark in Belize.⁸¹

VIII. EXCEPTIONS TO RIGHTS

A. Concurrent Use

An applicant may defeat a claim of “earlier right” to a mark if the applicant shows to the satisfaction of the Registrar that there has been honest concurrent use of the trademark for which registration is sought.⁸² “Honest concurrent use” means such use in Belize, by the applicant or with its consent, at the same time the use is made by the proprietor of the earlier trademark or with its consent under any law earlier to the current BTMA. This concurrent use is subject to the right of the proprietor of the earlier mark to commence opposition proceedings against the concurrent-use applicant.⁸³ The success of the opposition proceedings will depend upon a determination of the opposing marks’ merits on absolute grounds,⁸⁴ and whether the concurrent use applicant has prior consent to register the mark in Belize.⁸⁵ Although no commentary on these provisions exists, it would appear that the claimant with, for example, rights in an international mark, with no evidence of consent to a licensee’s registration in Belize, would be the successful party in concurrent use proceedings.⁸⁶

B. Disclaimers

The BTMA contains provisions for disclaimers in trademark applications, including a disclaimer of any right to the exclusive use of any specified element of the mark, and a disclaimer agreeing that the rights are territorially or otherwise limited.⁸⁷ These disclaimers are published.⁸⁸ A registered trademark will not

80. Id. at 47.

81. Id.

82. BTMA § 39(1).

83. BTMA § 39(2).

84. Section 35 encompasses the absolute refusal grounds of: failure to satisfy the requirements of a definition of a trademark, absence of distinctive character, representation consisting exclusively of kind quality, quantity, intended use, etc. or other characteristics of goods/services, and use of signs which have become customary in current language or bona fide and established practices of the trade.

85. BTMA § 47(2).

86. BTMA § 38(1)(a).

87. BTMA § 28(1).

88. BTMA § 28(2)

be infringed where it is used within the scope of a limitation, such as a disclaimer, entered on the Register.”⁸⁹

C. Fair Use

Belize law permits certain honest uses of trademarks. Use of a registered trademark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee, if made in accordance with honest practices in industrial or commercial matters, shall be treated as infringing the registered trademark only if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trademark.⁹⁰

IX. OWNERSHIP OF RIGHTS

A. Initial Ownership

A registered trademark is personal property, owned by the original registrant.⁹¹

B. Joint Ownership

A trademark registration may be granted to two or more persons jointly.⁹² Joint owners are, by statute, entitled to an equal undivided share in the registered mark; however this statutory right may be modified by agreement.⁹³ Therefore, as mentioned previously,⁹⁴ even generic goods made by a licensee in another CARICOM country, (so-called “grey goods”) do not constitute an infringement.⁹⁵

Each co-proprietor is entitled, by itself or its agents, to prevent any act that would constitute infringement⁹⁶ for its own benefit and without the consent of the co-owners.⁹⁷ However, consent of all co-owners is required to grant licenses and to assign or change a co-ownership share in the registered mark. Infringement proceedings may be brought by any proprietor, but the action may not proceed without joinder of the co-owners as co-plaintiffs or

89. Kaseke, *supra* n.15, at 52.

90. BTMA § 25(6).

91. BTMA § 29.

92. BTMA § 30(1).

93. *Id.*

94. See Part VII, *supra*.

95. *Id.*

96. See discussion at Part XII, *infra*.

97. BTMA § 30(2) and (3).

defendants, unless leave of the court is granted.⁹⁸ A co-proprietor may, however, proceed alone for interlocutory relief.⁹⁹ A co-proprietor added as a defendant in such manner will not be liable for any costs in the action unless it takes part in the proceedings.¹⁰⁰ That is, mere joinder to satisfy the Act's jurisdictional requirements will not obligate a joined co-proprietor defendant for costs in the action.

X. TRADEMARK REGISTRATION PROCEDURE

A. Marks Registered Under the Registration of United Kingdom Trade Marks Act and Certified for Belize

The Registration of United Kingdom Trade Marks Act (RUKTMA), under which marks registered in the United Kingdom could be certified as applicable in Belize, was repealed by the BTMA. Notwithstanding, all trademarks registered in Belize pursuant to the RUKTMA shall, subject to the limitations discussed below, be deemed to have been registered under the new BTMA.¹⁰¹ Accordingly, marks registered under the RUKTMA remain in force for the unexpired portion of the period of protection provided under this Act, subject to payment of the prescribed fees or renewal fees of BZ \$50.¹⁰²

B. Registration Under the BTMA

1. Registration Formalities

An application for registration of a trademark shall be made to the Registrar of Trade Marks and must include a request for registration, the name and address of the applicant, a statement of the goods or services in relation to which it is sought to register the mark, and a representation of the trademark.¹⁰³ The Applicant may be required to furnish evidence of use and, if applicable, distinctiveness.¹⁰⁴

The application must also include a statement of use by the applicant that the trademark is being used, by the applicant or with its consent, in relation to those goods or services, or that it

98. BTMA § 30(5).

99. *Id.*

100. *Id.*

101. BTMA § 82(2).

102. BTMA § 83(1).

103. BTMA § 12(1) and (2).

104. Rule 21.

has bona fide intention to so use the mark.¹⁰⁵ Thus, as discussed in Part XI below, the use by a licensee in Belize is sufficient to support an application for registration of the mark in Belize.¹⁰⁶

Marks that consist of foreign letters and/or words must be transliterated, or translated, as the case may be, into Roman letters and/or English words, as applicable.¹⁰⁷

Belize follows the International Classification of Goods and Services for the Purposes of the Registration of Trademarks under the Nice Agreement (8th Edition).¹⁰⁸ Notably the BTMA has subdivided Classes 42 through 45 in accordance with the amendments to the Nice Classifications.

An application for registration (and any other application, request or notice that is required or permitted by the BTMA of the Rules) may be made, signed or given through an agent of the applicant, who, by the Rules, shall be an attorney-at-law who is resident in Belize and practicing in Belize in accordance with the relevant law. Whether or not the application is made through an agent (Belize attorney-at-law), the BTMA requires that every applicant for the registration of a trademark, certification mark or collective mark in the register whose ordinary residence or principal place of business is outside Belize shall be represented by an attorney-at-law who is resident in Belize and practicing in Belize in accordance with the relevant law.¹⁰⁹ Furthermore, where an applicant, opponent or agent, or a registered owner or licensee of a mark does not reside or carry on business in Belize, he shall be required by the Registrar to give an address for service in Belize.

2. Falsification

It is an offense in Belize to make, or cause to make, a false entry in the register of trademarks, knowing or having reason to believe that it is false.¹¹⁰

3. Examination

Upon fulfillment of the application requirements, the Registrar will examine whether the mark satisfies the registration requirements, and if registration requirements are not met the

105. BTMA § 12(3). See discussion at Part IV.A.4., *supra*.

106. *Id.*

107. Rules 21(1) and (2), respectively.

108. International Classification of Goods and Services 2000 (8th Edition). Available at <http://www.wipo.org>. Schedule III of The Rules contains the Class Headings of the Nice Classifications.

109. BTMA § 76(1).

110. BTMA § 76(1).

Registrar is required to so inform the applicant and give it an opportunity, within such period as the Registrar may specify, to make representations or to amend the application. The Registrar is required to carry out a search, to the extent it considers necessary, of the Register to determine if any earlier trademarks that may conflict with the applied-for mark exist.¹¹¹ If necessary, the applicant may amend the application to accommodate any comments made by the Registrar.¹¹² In practice, this is most often necessary in the classifications and descriptions of goods/services. Statutory provision is also made for the division of an application into several applications,¹¹³ the merging of separate applications or registrations, or the registration of a series of trademarks.¹¹⁴

If the applicant fails to respond to any requested amendments, divisions or merging,¹¹⁵ within 60 days after receipt of the objection,¹¹⁶ the application will be refused.¹¹⁷

4. Publication, Opposition, and Observations

Once the Registrar accepts the application, amended as may be necessary, the mark will be published by the Registrar in the Register and the Journal of Intellectual Property.¹¹⁸ Any person may oppose the registration of the pending mark—in writing—stating the grounds of opposition.¹¹⁹ In addition, any person may during this time period make “observations in writing to the Registrar as to whether the trade mark should be registered,” which observations will be communicated to the applicant.¹²⁰ The Registrar takes such arguments (observations in writing) into account when deciding whether or not to register the pending mark. However, they are non-binding.¹²¹ Note that during the publication proceedings, withdrawals of and restrictions and amendments to applications may be made by the applicant.¹²² Withdrawal of and restrictions to pending, published applications will also be published.¹²³ The only amendments that are permitted

111. BTMA § 15(2).

112. BTMA § 15(4).

113. BTMA § 19(1).

114. *Id.*

115. BTMA § 19(1).

116. Rules 27(2).

117. *Id.*

118. BTMA § 16.

119. BTMA § 16(2) and (3).

120. BTMA § 16(4).

121. Email from Deputy Registrar Tejan-Cole to author dated September 18, 2003.

122. BTMA § 17(1) and (2).

to be made at the request of the applicant are amendments to the name or address of the applicant, and amendments to correct errors of wording or of copying, or obvious mistakes.¹²⁴

An appeal lies with the Supreme Court of Belize from any decision of the Registrar. Thus, if a mark has been finally rejected, the applicant may appeal directly to the Supreme Court.¹²⁵

5. Cancellation Proceedings

Trademarks may be declared invalid on the ground that the trademark was registered in breach of Section 35 or any of the provisions referred to in that section.¹²⁶ Section 35 encompasses the absolute refusal grounds of: failure to satisfy the requirements of a definition of a trademark, absence of distinctive character, representation consisting exclusively of kind, quality, quantity, intended use, or other characteristics of goods/services, and use of signs which have become customary in current language or bona fide and established practices of the trade.¹²⁷

6. Use of Altered Form of Mark

A registered trademark is not permitted to be altered during the period of registration or renewal;¹²⁸ however, the Registrar may allow the alteration of a registered mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark. It is anticipated that the Registrar may, upon renewals, permit other such alterations of the mark that do not affect the identity of the mark; however, the manner in which renewals involving altered marks will be handled under the BTMA remains to be seen.

7. Changed Goods/Services

When renewing a trademark, it is necessary to make a statement that the mark is in use in connection with the goods/services for which it is registered.¹²⁹ The Registrar may require amendment of the goods/services prior to renewal if it is

123. BTMA § 17(1) and (2).

124. BTMA § 17(3).

125. BTMA § 70.

126. BTMA § 47.

127. BTMA § 35.

128. BTMA § 22(1).

129. Rules 41.

not satisfied that the mark has been used in connection with all of the listed goods/services.¹³⁰

8. Use of ® and ™ Symbols

It is an offense in Belize to use any word or symbol of, or the word, “registered” unless it is shown that the mark is in fact registered in Belize.¹³¹

C. Statements of Use/Incontestability

There is no provision in the Act regarding separate statements of use/incontestability. However, when renewing a trademark, it is necessary to make a statement that the mark is in use in connection with the goods/services for which it is registered.¹³² There is no legal concept of incontestability in the statutes or rules. The statement that the mark is in use provides the support for the renewal of the trademark.¹³³

D. Abandonment

If the applicant cannot show that the mark has been used in connection with any of the goods/services, the Registrar may cancel the mark.¹³⁴

E. Statute of Limitations on Certain Remedies

The BTMA does not contain any specific statute of limitations within which infringement proceedings must be brought. Under the Civil Code, however, tort actions may not be brought after the expiration of six years after the cause of action accrued.¹³⁵

The BTMA contains a specific, shorter time-bar for one of the forms of relief available to a successful infringement plaintiff. An application for an order for delivery up of infringing goods, material or articles may not be made after the end of the period of six years from the date on which the mark was applied to the goods or their packaging or material, or in the case of infringing articles, the date on which they were made.¹³⁶ If the owner of the prior mark was under a disability, or was prevented by fraud or

130. Rules 41(1)(b).

131. BTMA § 77.

132. Rules 41.

133. Email from Deputy Registrar Tejan-Cole to author dated September 18, 2003.

134. Id.

135. Belize Limitation Act. Chapter 170 Revised Laws of Belize (2000).

136. BTMA § 53(1).

concealment from discovering the facts entitling it to apply for an order, however, this time-bar may be equivalently tolled.¹³⁷

XI. LICENSES AND ASSIGNMENTS

A. Validity/Formalities

In accordance with TRIPs, licensing under the BTMA promotes freedom of contract and is largely restriction-free, with the exception of TRIPs-permissible formalities.¹³⁸ A trademark license (which by definition includes sub-licenses)¹³⁹ in Belize must be in writing and signed by or on behalf of the grantor,¹⁴⁰ and may be granted in respect of all or part of the registered goods/services.¹⁴¹ Licenses may also be restricted to particular geographic locations in Belize.¹⁴² It is important to note that the use by a licensee in Belize is sufficient use to support an application for registration of the mark in Belize.¹⁴³ Exclusive licensees by statute have the same rights as the grantor,¹⁴⁴ and also have the statutory right to call upon the grantor to bring infringement proceedings, or to do so if the grantor refuses to do so, or does not do so within two months of being called upon to act.¹⁴⁵

Licensees may not, however, bring infringement proceedings unless the proprietor is either joined as a plaintiff or added as a defendant but this does not affect the granting of interlocutory relief on an application by a licensee alone.¹⁴⁶ In essence, if the license so provides, an exclusive licensee may take all of the rights of actions as if the license had been an assignment,¹⁴⁷ subject to:

- the concurrent rights of the proprietor; and the defendant's right to avail itself of any defense available to it had the action been brought by the proprietor.¹⁴⁸ Note that this

137. BTMA § 53(2)

138. See Kaseke, *supra* n.15, at 50.

139. BTMA § 41(5), “[R]eferences in this Act to a license or licensee include a sub-license or sublicensee.”

140. BTMA § 41(1).

141. BTMA § 41(1)(a).

142. BTMA § 41(1)(b).

143. BTMA § 12(3).

144. BTMA § 42.

145. BTMA § 43(2).

146. BTMA § 43(4).

147. BTMA § 44(1).

148. BTMA § 44(2).

joinder is not necessary if the licensor agrees that the licensee is entitled to bring actions in its own name.¹⁴⁹

- A proprietor who is added as a defendant is not liable for any costs in the action unless it takes part in the proceedings.

The court has discretion to determine, as between the proprietor and licensee, the apportionment of damages, taking into account: the terms of the license; and any monetary remedy already awarded or available to either of them in respect of the infringement.¹⁵⁰

Assignments constitute one of the transactions that must be registered against the mark to be valid against other parties in interest. “Registrable transactions,” and the formalities pertaining thereto, are discussed in Part XI.B. herein.

A registered trademark is transferable either in connection with the goodwill or independently.¹⁵¹ This is in accordance with TRIPS Article 21.¹⁵² Like licenses, assignments and other transmissions may be partial; grants of assignment may be made in relation to some but not all of the goods/services and/or in relation to use of the trademark in a particular locality.¹⁵³ An assignment is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.¹⁵⁴ As mentioned above, assignment of a trademark with more than one proprietor requires consent of all co-proprietors.

The BTMA does not affect the assignment or other transmission of an unregistered trademark.¹⁵⁵ Rights of priority are also assignable.¹⁵⁶

B. Recordal (“Registrable Transactions”)

Licenses and other “registrable transactions” must, under the BTMA, be recorded with the Registrar to be effective as against third parties. This section discusses the statutory law regarding the recordal of licenses and other registrable transactions.

Registrable transactions under the BTMA include:

149. BTMA § 43(7).

150. BTMA § 44(6).

151. BTMA § 31(1).

152. See Kaseke, *supra* n.15, at 72.

153. BTMA § 31(2).

154. BTMA § 31(3).

155. BTMA § 31(6).

156. BTMA § 56(6).

- an assignment of a registered trade mark or any right in it;
- the grant of a license under a registered trade mark;
- the granting of any security interest (whether fixed or floating) over a registered trade mark or any right in or under it;
- the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it;
- an order of a court of other competent authority transferring a registered trade mark or any right in or under it.¹⁵⁷

Any person claiming to be entitled to an interest in or under a registered trademark by virtue of a registrable transaction, or any other person claiming to be affected by such a transaction, must supply to the Registrar the prescribed particulars of the transaction.¹⁵⁸

An application for registration of the transaction must be made before the end of the period of six months beginning with the transaction's date, unless a court is satisfied that it was not practicable for such an application to be made, but in such case as soon as practicable thereafter. Unless such requirements are met, a plaintiff enforcing the subject mark is not entitled to damages or an account of profits in respect of any infringement of the registered trademark occurring after the date of the transaction and before the prescribed particulars of the transaction are registered.¹⁵⁹

Bankruptcy proceedings involving registered marks and licenses may also be affected by the recordation process.

The granting of any security interest (whether fixed or floating) over a registered trademark or any right in or under it constitutes a "registrable transaction" that must be registered in accordance with the law to be effective as against third parties.¹⁶⁰ As also mentioned above, amendment or removal from the Register of particulars relating to a security interest may be made on the application or with the consent of the secured party.¹⁶¹

Note that the registered particulars may be amended to reflect any amendments to the license, and the particulars may be removed from the Register upon expiration of the term of a fixed-

157. BTMA § 32(2).

158. BTMA § 32(1).

159. BTMA § 32(4).

160. BTMA § 32(2).

161. BTMA § 32(6).

term license.¹⁶² Otherwise, the Registrar may remove the particulars from the Register upon notification to the parties.¹⁶³

Amendment or removal from the Register of particulars relating to a security interest may be made on the application or with the consent of the secured party.¹⁶⁴

If such registration of details of any registrable transaction is not made, the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trademark in ignorance of it. Moreover, a person claiming to be a licensee by virtue of the unregistered transaction does not have the protection of the rights and remedies of licensee in relation to infringement.¹⁶⁵

XII. TRADEMARK INFRINGEMENT/LITIGATION

A. *Infringement*

The proprietor of a registered trademark has exclusive rights in the trademark, which are infringed by use of the trademark without its consent.¹⁶⁶ These rights accrue as of the date of registration.¹⁶⁷ No infringement proceedings may be begun prior to the registration date, and infringements occurring before the publication date are not actionable.¹⁶⁸

Use in the course of trade of a sign or mark that is *identical* to a prior trademark for identical goods or services constitutes infringement.¹⁶⁹ The evaluation of the identity of the goods/services is discussed at Part IV.A.3. above. “Trade” includes any business or profession.¹⁷⁰

“Use” is defined as:

- affixation to goods/packaging thereof;
- offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
- imports or exports goods under the sign; or

162. BTMA § 32(5)(i).

163. BTMA § 32(5)(ii).

164. BTMA § 32(6).

165. BTMA § 32(3).

166. BTMA § 24(2).

167. BTMA § 24(3).

168. BTMA § 24(4).

169. BTMA § 25(1).

170. BTMA § 2.

- uses the sign on business papers or in advertising.¹⁷¹

A special statutory right is available to proprietors of registered marks against parties who affix or apply a registered trademark to material intended to be used for labeling or packing goods, as a business paper (that is, business letterhead), or for advertising goods or services,¹⁷² if the defendant knew or had reason to believe that the application was not duly authorized by the proprietor or a licensee.¹⁷³

Note that in these cases of identical marks and identical goods/services there is no statutory requirement to demonstrate a likelihood of confusion.¹⁷⁴

Note that in Belize, an action may be brought against the trademark proprietor if the proprietor unjustifiably threatens infringement proceedings, unless the proprietor can demonstrate that the actions against which such threats were made indeed constituted an infringement of the registered trademark.¹⁷⁵

Use in the course of trade of an identical sign used in relation to goods or services *similar* to those for which the trademark is registered, or a sign *similar* to the trademark used in relation to identical goods/services, where there exists a likelihood of confusion which includes the likelihood of association with the registered trademark also includes actionable infringement.¹⁷⁶

B. Dilution

The BTMA also protects marks from dilution. The use in the course of trade of a sign that is *identical with or similar* to the trademark and is used in relation to goods/services that are similar to those of the registered mark with a reputation in Belize, without due cause, is actionable if such use takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the mark.¹⁷⁷ Thus, marks with a reputation in Belize are protected against such dilution, absent a showing of likelihood of confusion or a likelihood of association. All that is necessary is a demonstration that the distinctiveness is blurred or diluted, or that the second use disassociates the mark from the primary products for which the reputed mark was registered.¹⁷⁸

171. BTMA § 25(4).

172. BTMA § 25(5).

173. *Id.*

174. See discussion at Part IV.A.3. above.

175. BTMA § 55(2).

176. BTMA § 25(2).

177. BTMA § 25(3).

178. See Kaseke, *supra* n.15, at 54.

XIII. REMEDIES

Upon a finding of infringement, the proprietor of the trademark is entitled to:

- cause the offending sign to be erased, removed or obliterated from any infringing goods, materials or articles in its possession, custody or control; or
- if such erasure is not reasonably practicable for the offending sign to be so erased, to secure the destruction of the infringing goods, material or articles in question.¹⁷⁹

The proprietor may also apply for the delivery up of material or infringing goods, subject to certain time limitations.

A. Customs Orders

The proprietor of a registered trademark, as well as licensees, may give notice in writing to the Comptroller of Customs: that it is the proprietor/licensee, that infringing goods, material or articles are expected to arrive in Belize, and that it requests the Comptroller of Customs to treat them as prohibited goods.¹⁸⁰ The goods may then be seized and forfeited, except those for private and domestic use.¹⁸¹ Note that the Comptroller may impose specific requirements as a condition for seizure, including the form of notice, evidence that may be required, and payment of fees.¹⁸² The registrant may also be required to post security, and to indemnify the Comptroller of Customs.¹⁸³

XIV. CONCLUSION

In sum, the new trademark law in Belize, as given full force and effect under the Rules, effectuates a means of acquiring a Belize national trademark registration. The BTMA, combined with the Rules, provide trademark owners an effective new means of enforcing marks against infringements, including importation. The implementation of these laws represents a significant step forward for this developing country, and represents its compliance with the trademark provisions of GATT TRIPs.¹⁸⁴

The existence of a fully searchable database of trademarks registered in Belize, created pursuant to the BTMA and the Rules,

179. BTMA § 50.

180. BTMA §§ 74(1) and(2).

181. BTMA §§ 74(2)

182. BTMA §§ 74(3).

183. Id.

184. Supra n.2.

represents the first of many significant developments in favor of trademark owners in Belize. Next, the cost-effective and streamlined registration procedure eliminates the antiquated dependence of Belize trademarks on the United Kingdom registration procedure. Finally, the Act's new procedures for enforcement, including customs orders, interlocutory relief, injunctions, destruction of infringing goods, and damages all represent significant advances over the old regime, benefiting trademark owners wishing to market their goods and services in this actively developing country connecting the English-speaking Caribbean with the Spanish-speaking Central America.
