



DISTINCTIVENESS IN TRADEMARKS

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BELI[©]PO
BELIZE INTELLECTUAL PROPERTY OFFICE

INTRODUCTION

- ❖ The Belize Intellectual Property Office (BELIPO), which became operational on July 2, 2001, was established under Part II of the Patents Act (Chapter 253), Revised Edition 2000, and is the National Intellectual Property Registry for Belize, Central America.

MISSION STATEMENT

- ❖ To build a modern intellectual property system that values and protects the vibrant, creative culture of Belize.

DEFINITION OF A TRADEMARK

A trade mark may consist of words (including personal names and slogans), designs, letters, numerals, colors or the shape of goods or their packaging and is capable of distinguishing the goods/services of one undertaking from the other


EXAMPLE:

Word: BRAC - class 25 for bags

Name: Marie Sharp - cl. 29 for pepper

Slogan: It Pays to Get It Right! - Cl. 36 for insurance

Designs:  - cl 30 for rice

Colors:  - cl. 36 for banking services

PROCESSING OF TRADEMARK APPLICATIONS

- Check for use/non use statement (if mark is in use or if not in use, that the applicant has a bona fide intention of using the mark)
- Disclaimers - if necessary e.g. Belikin Beer for - cl 32 beer
- Translation or transliteration if mark is in a language other than the English language.
- Priority claim (priority claim of an earlier application, check if applicant has filed in another convention country and that his application is within 6 months of the earlier application).

TRADEMARK SUBSTANTIVE EXAMINATION

- Classification of goods/services
- Absolute grounds for refusal (inherent defects).
- Relative grounds (similarity objections).

ABSOLUTE GROUNDS FOR REFUSAL (Section 35)

- ▶ Does not satisfy the requirements of the definition of a trademark.
- ▶ Consist exclusively of signs or indications which 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.

- ▶ Specially protected emblems - e.g.



- ▶ The flag of Belize



- ▶ Application is made in bad faith.

MERELY DESCRIPTIVE

- ▶ The mark is considered merely descriptive if it merely describes in a significant way any aspect of the goods/services it is being applied for.
- ▶ It immediately describes something about the applicant's goods/services

EXAMPLE: PROTECT YOUR PORES! - cl 3 for facial creams

PURE PROTEIN - cl 5 for nutritional supplements

DECEPTIVELY MISDESCRIPTIVE TEST

1. Does the mark immediately misdescribes some aspect of the goods?
 2. Is there a chance that consumers will be likely to believe the misdescription?
- ▶ The misdescription must be plausible, but false. If not plausible, the mark is arbitrary, If not false, the mark is descriptive.
 - ▶ GLASS - for aluminum windows

MERELY DESCRIPTIVE TEST

- ▶ **Merely Descriptive: Laudatory terms:**
 - ▶ It claims excellence or attributes quality for goods/services, which on further scrutiny is equivalent to merely descriptive terms.

Example: Beautiful - for clothing

MERELY DESCRIPTIVE TEST

- ▶ Foreign Equivalents:

- ▶ A foreign word that in English is merely descriptive of the goods/services

Example: BEVIDA - fruit drinks

GELATO- for Ice cream

Kind, quality

- **LONGLIFE**

Wire steel braided rubber hose.

- ▶ "...a sign which may serve in trade to designate the quality of the goods e.g. long life hoses that have been especially designed to last longer.

- **SUPER LEAGUE SOCCER**

Sporting activities (class 41)

"...a sign which may serve in trade to designate the quality of the services e.g. the provision of a top quality football league or competition

Quantity, intended purpose

“...a sign which may serve in trade to designate the quantity of the goods

- e.g. 100 SHEETS - Loose leaf writing pads (class 16)

this clearly describes the quantity of writing pads containing 100 sheets of plain paper”

“...a sign which may serve in trade to designate the intended purpose of the goods

- e.g. LASH LIFT - Cosmetics (class 3)

this indicates that the cosmetics are designed to lift the wearer's eyelashes”

ARBITRARY WORDS

- ▶ It has a generally understood meaning, however when use does not suggest or describe the applicant's goods/services, e.g.:

EXAMPLE: BLUEBERRY for computers

INDEPENDENCE for cigarettes

SUGGESTIVE TERMS

- ▶ This gives a hint as to the goods/services, however imagination is required in determining the nature of goods/services

Examples: EVEREADY for batteries
SHARPWRITER for pen

So where there is a multi-step reasoning,
then it is suggestive

GENERIC TERMS

Either of, relates to, or indicates an entire class or category of goods/services.

- ▶ Are not trademarks since they are incapable of denoting origin in any one party

Examples:

stereo for radios

airworthy for aeroplanes

GENERIC TEST

- ▶ Would the general public have an understanding of the proposed mark solely referring to that type/category of goods/services?
- ▶ A generic term can be a noun or an adjective.
- ▶ Where a term is found to be generic for goods, it will also be generic for the services that are related to those goods.
- ▶ The phonetic equivalent of a generic term is also generic

GENERIC TEST

- ▶ *Generic can be for one type of goods and on the other hand arbitrary for another.*

EXAMPLE: IVORY for elephant trunk vs. IVORY for soap.

- ▶ *A mark that has been registered, can also become generic if the name of that mark is commonly used as the name of the goods.*

EXAMPLE: ESCALATOR, ASPIRIN

GEOGRAPHICAL DESCRIPTIVE TEST

- ▶ Some terms can also be refused since the sound is geographic and generically may indicate styles or designs.

EXAMPLE: Swiss for cheese, French for doors or pilsner for beer.

GEOGRAPHICAL DESCRIPTIVE TEST

- ▶ Under Section 35 (1) (c) a mark will be refused registration if:

The mark's significance is solely that it is geographic.

The goods/services of the mark originates in that geographic place as identified in the mark.

EXAMPLE: THATCH CAYE RESORTS - class 43

GEOGRAPHICAL DESCRIPTIVE TEST

- ▶ Sometimes the name of the mark is a geographical location, however if it is unlikely that the purchasers would believe that the goods originate from that location, then the mark is considered to be arbitrary.

EXAMPLE: SAHARA for bottled water

ALASKA for bananas

Determination as to distinctiveness (suggestive, arbitrary or coined/fanciful)

- ▶ Coined/fanciful terms are:

Words that are made-up having no meaning only the fact that it's used for a trademark.

The sole purpose of the creation of such a word is for the identification of a source

EXAMPLE: CLOROX for bleach

KODAK for film

DICTIONARIES, MISSPELLINGS AND OTHER MEANINGS

- ▶ Just because a term is not found in the dictionary does not mean that it is not merely descriptive.

EXAMPLE: MUSICINSTRUMENT for guitars

- ▶ Slightly misspelling a word will not eliminate the fact that it is merely descriptive.

EXAMPLE: MUSIK for guitars

RELATIVE GROUNDS FOR REFUSAL (Likelihood of Confusion) Sec. 37

- ▶ **Identical mark, identical goods.**

eg: – MOLSON and MOLSON – Cl. 32 for alcoholic beverages

- ▶ **Identical mark, similar goods.**

eg: CARIBBEAN PRIDE -cl 32 for fruit juices;

and CARIBBEAN PRIDE– cl 32 for non-alcoholic beverages;

- ▶ **Similar mark – identical or similar goods**

e.g.



and PIRATE BEER – Class 32 - beer

RELATIVE GROUNDS FOR REFUSAL (Likelihood of Confusion)

- ▶ Test for likelihood of confusion:-
 - (a) compare the marks as to sound, appearance and meaning.
 - (b) compare goods for similarity, use in marketing and channels of trade.
- ▶ The test is whether there is a likelihood of confusion, not confusion, but the likelihood of confusion.

RELATIVE GROUNDS FOR REFUSAL (Likelihood of Confusion) Sec. 37

- ▶ The likelihood of confusion must be assessed globally while taking note of all relevant factors, and the issue must be decided through the eyes of the average consumer (*Sabel BV v Puma AG*). The average consumer is deemed to be reasonably well informed and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). The latter case also held that the average consumer rarely has time to make direct comparisons between marks and must depend on the imperfect picture of the marks that he or she has stored in his or her mind.

SOUND, APPEARANCE OR MEANING

- ▶ **Similarity in sound:**

EXAMPLE: MENAVEN vs VENAMEN

or MEET vs MEAT

- ▶ **Similarity in appearance:**

EXAMPLE: MOTOROLA vs MOTOROLE

SOUND, APPEARANCE OR MEANING

- ▶ *Similar in meaning?*

EXAMPLE: AQUACARE vs WATERCARE

COMPARISON OF GOODS AND SERVICES

- ▶ If the marks are identical or similar - are the goods/services related?
- ▶ Are the goods and services the same?
- ▶ If not, are they so closely related that the average consumer would likely believe that the goods/services originate from the same source?
- ▶ In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, it was held that a lesser degree of similarity between the marks may be counter-balanced by a greater degree of similarity between the goods (or services), and vice versa.

SIMILARITY, USE & MARKETING

- ▶ **So we compare-**
 - ▶ **Similarity of the goods/services**
 - ▶ **Use of the goods/services together**
 - ▶ **Marketing channel of trade**

SIMILARITY, USE & MARKETING (CONT'D)

- ▶ Are the goods/services similar in nature?

Consider: watches & clocks

- ▶ Are the goods/ services used together?

Consider: Beers & peanuts or;
restaurant services & alcoholic beverages

SIMILARITY, USE & MARKETING (CONT'D)

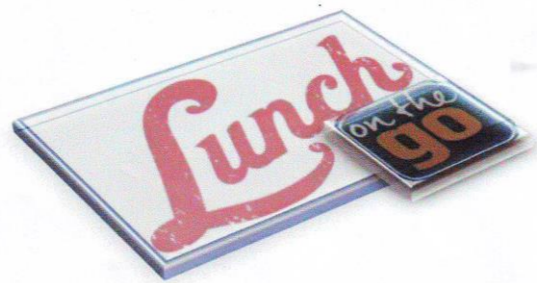
- ▶ **Are the goods and services marketed together?**

Consider: lotions & facial creams

REFUSED

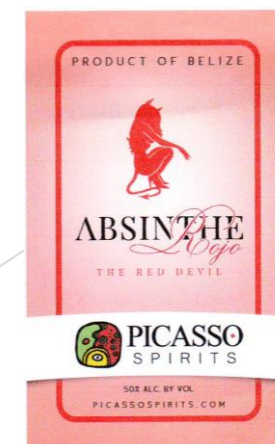
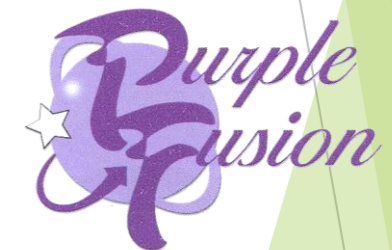


WASH N' WAX



YoGert

REGISTERED



THANK YOU!

