



INTELLECTUAL PROPERTY SPECIAL JOURNAL

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

**IN THE MATTER OF APPLICATION NO. 4475.07
BY GREAT BELIZE PRODUCTIONS LTD.
TO REGISTER THE MARK:**



AND

**THE OPPOSITION THERETO
BY COCO PLUM ISLAND RESORT LTD.**

T.M. RULING NO. 1/2008

**The Registrar
Intellectual Property Office
Belize**

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

In the Matter of Application No. 4475.07 by Great Belize Productions Ltd., to register the trademark:

COCOPLUM A RESORT COMMUNITY



And the Opposition thereto by Coco Plum Island Resort Ltd.

BACKGROUND

1) This case concerns an application by Great Belize Productions Ltd. (hereinafter referred to as GBPL), to register the above trade mark. The application was filed on February 20, 2007, and was published for opposition purposes in the 'Intellectual Property Journal' on April 5, 2007, with the following specification:

International Class 35 for hotel business management;

International Class 36 for apartments (renting of); real estate agencies; real estate management; renting of apartments.

2) Coco Plum Island Resort Ltd. (hereinafter referred to as CPIRL), has filed an opposition against the above application. CPIRL is the owner of the Belize trademark registration No. 3446.05 for the trade mark COCO PLUM ISLAND RESORT.



This mark was registered on January 30, 2006, with the following specification:

International Class 39 for transport, packaging and storing of goods; travel arrangement; arranging of tours including bird watching and inland adventure tours;

International Class 41 for education; providing of training; entertainment; sporting and cultural activities; sport camp services including scuba diving, kayaking, snorkeling, fishing and water sports; rental of sports equipment; timing of sports events;

International Class 43 for services for providing food and drink; temporary accommodation; hotel and hotel reservation; restaurant, resort.

CPIRL claims the trade mark of GBPL resembles its mark registered for similar services resulting in the likelihood of confusion and or of association by the public (section 37(2) (b) of the Trade Marks Act). CPIRL argues that there exists visual and aural similarity between the above marks through their dominant components, namely identical words, colours, drawings and perceptual connotations when compared and taken as a whole.

CPIRL claims that it has prior to registration and at least for the past 7 years used the registered mark in its advertising and marketing of its business as can be evidenced on its website www.cocoplumcay.com.

Alternatively, CPIRL also opposes pursuant to section 37(3) on the ground that its mark has gained a reputation due to its long usage and that the use of GBPL's mark would be detrimental to the distinctive character or reputation of CPIRL's mark.

CPIRL states that COCOPLUM has been the name of the island for centuries making the name historical and highly distinctive. According to CPIRL, both businesses are located in one of the smallest districts of Belize, namely Stann Creek, and that GBPL's mark is already confused by a majority of residents and visitors in that locality.

CPIRL further claims that its business is incorporated and that the Companies Registrar has not given permission for the incorporation of any other entity with a similar name. Further, CPIRL claims that its business is registered with the Belize Tourism Board and remits due hotel accommodation taxes and licence fees.

CPIRL claims that classes 35 and 36 contain elements that it has secured protection for, namely hotel business and rentals, and are thus similar to the services featured in its registration, namely hotel and hotel reservation (Class 43).

CPIRL claims that its mark has gained an international reputation as one of the world's leading wedding destinations and as such is entitled to protection under the Trade Marks Act.

3) GBPL filed an answer to CPIRL's opposition. It denies that its mark is similar to CPIRL's mark. According to GBPL, the only common feature between the above marks is the use of the words 'COCO PLUM' and 'RESORT'. GBPL claims that registration of CPIRL's trademark did not grant CPIRL the exclusive right to the use of the words 'COCO' 'PLUM'.

GBPL claims that its trademark has gained both local and international recognition as a real estate development project situated on 224 acres on the mainland of the Placencia Peninsula, and that CPIRL's mark on the other hand is utilized exclusively as an island resort situated off the coast of Belize.

GBPL claims that it seeks protection in totally different classes from that of CPIRL. In particular, GBPL states that it seeks protection under International Class 35 for advertising; business management; business administration and office functions; and International Class 36 for insurance; financial affairs; monetary affairs; real estate affairs. GBPL further asserts that the only class under which CPIRL is protected is Class 43 for services for providing food and drink and temporary accommodation.

GBPL claims that it has, since the registration of CPIRL's mark, incorporated and registered COCOPLUM OWNERS ASSOCIATION LIMITED as a limited liability company comprised of all homeowners of GBPL's development project-COCOPLUM A RESORT COMMUNITY.

GBPL claims that there is no likelihood of confusion between CPIRL's mark and GBPL's mark which may mislead the public into thinking that the marks are associated and owned by the same company.

GBPL contends that there is no visual and/or aural similarity based on the dominant components of both marks. First, CPIRL's name comprises two words 'COCO PLUM' while GBPL's name comprises one 'COCOPLUM'. Second, the second word in CPIRL's mark 'ISLAND' automatically makes the distinction as that word is not used on GBPL's mark. Third, GBPL's mark 'COCOPLUM A RESORT COMMUNITY' draws a further distinction from CPIRL's mark as it indicates quite clearly that it is not an 'Island Resort' but rather a 'Resort Community'. Fourth, the font, design and perceptual connotations of both marks are easily distinguishable.

GBPL claims that there is no likelihood of passing off that would lead the public to believe that the services offered by GBPL are the services of CPIRL. First, GBPL does not by the use of its mark make a representation to the public, whether intentional or not, that would lead or is likely to lead the public to believe that the services offered by GBPL are the services of CPIRL. Second, GBPL's use of its mark or the registration thereof is not calculated to injure the business or goodwill of CPIRL. Third, GBPL's use of its mark will not cause any loss or damage to the business or goodwill to the business or goodwill of CPIRL. Fourth, CPIRL will not suffer any loss or damage to its business or goodwill due to any erroneous belief that GBPL's services or use of the mark are the services or mark of CPIRL.

GBPL does not admit that there is a distinctive character or repute of CPIRL's mark so as to prevent the registration of GBPL's mark. Alternatively, if there is a distinctive character or repute of CPIRL's mark, the use of GBPL's mark has not taken advantage of and has not been of detriment to the distinctive character or repute of CPIRL's mark and will not take advantage of or be of detriment to such character or repute.

4) Both sides filed evidence.

5) The case was heard on January 14, 2008. GBPL was represented by Mr. Kareem Musa of Musa and Balderamos. CPIRL was represented by Mr. Emil Arguelles of Arguelles and Co.

EVIDENCE

Evidence of CPIRL

6) This is furnished by way of a sworn affidavit by Emilio Zabaneh, Director of CPIRL. A copy of the certificate of incorporation is exhibited. Mr. Zabaneh states that he is the joint owner of Coco Plum Caye together with his wife. A copy of the land title is exhibited. He states that 'COCO PLUM' has been the name of island for centuries and as such, has gained by long usage and custom, a highly distinctive reputation exacerbated by recent marketing of the same.

Mr. Zabaneh states that prior to incorporation and for approximately seven years they have run the service business known as Cocoplum Island Resort from the above island for services including hotel, wedding and tourism related activities, as evidenced by their internet presence www.cocoplumcay.com.

Mr. Zabaneh states that they have used the trademark on all business dealings and correspondence. A copy of the certificate of registration is exhibited. He further states that he became aware of GBPL's application in the Intellectual Property Journal.

According to Mr. Zabaneh, customers of CPIRL find out about their services through the internet. He states that such customers have commented that the internet search results show both names appearing close together in search engines leading to further confusion, and that he has been asked whether he was expanding his operation.

Mr. Zabaneh states that he instructed his attorneys to write GBPL, long before GBPL's application for registration, to desist from using or marketing the name in order to minimize any additional costs it would incur based on our prior common law rights coupled with registration under the Trade Marks Act. A copy of the letter is exhibited.

He further states that GBPL had their attorneys respond to the above letter. A copy of the letter is exhibited.

CPIRL also submits evidence in the form of a sworn affidavit by Richard Beane who is the Managing Director and owner of Belize Internet Consultants, a professional and specialized business with expertise in internet and online based businesses, online statistics and markets (www.trustwsolutions.com).

Mr. Beane states that a resort's website is its lifeblood. According to him, the name of a resort is critical from an internet perspective due to the fact that many internet users type the name of a resort into search engines to find a resort's website. He states that he searched for 'COCO PLUM BELIZE' and returns listed Coco Plum Resort and Coco Plum Residential Community next to each other. A copy of the search result is exhibited. Mr. Beane states that although some users will be able to tell the difference between the two locations by the title and descriptions displayed, it is inevitable that some users will not notice the difference and become confused.

According to Mr. Beane, searching for 'COCO PLUM BELIZE' can also result in search engines suggesting the user search for 'COCOPLUM BELIZE'. A copy of the search result is exhibited. Mr. Beane states that the result of the first search lists the resort first and then the result of the second search lists the residential community.

I have not summarized certain claims made by Mr. Zabaneh and Mr. Beane in the affidavit. However, I will consider these claims in the decision part of the ruling. In *Academy* (BL O/169/00) Mr. Simon Thorley, acting as the appointed person stated that:

'It is important in proceedings before the Registry as in any other proceedings that a proper line be drawn between that which is truly evidence, which should be the subject of a...affidavit, statutory declaration or witness statement as the case may be, and submissions or arguments in relation to the matter in dispute which need not. To allow the two to be present in the same document is bound to lead to confusion and misunderstanding'.

Evidence of GBPL

7) This is furnished by way of a sworn affidavit by Stewart Krohn, Director of GBPL. Mr. Krohn states that coco plum is a well-known local fruit that may be found all over the Placencia Peninsula and it is in fact the dominant species on their 224 acre property, hence the reason for the development's name,

COCOPLUM A RESORT COMMUNITY. Photographs showing the abundance of coco plum trees on the property are exhibited.

Mr. Krohn states that for experimental purposes he conducted a random search on the internet utilizing the name of another fruit (BANANA) and the word 'BELIZE'. He further states that upon searching the words 'BANANA BELIZE', the returns listed two hotels located in Belize, namely Banana Beach Resort and Banana Bank Lodge, displayed respectively as number one and two on the return list. A copy of the search is exhibited.

I have not summarized certain claims made by Mr. Krohn in the affidavit due to the reasons outlined at the end of paragraph 6 of this ruling. These claims will be considered in the decision part of the ruling.

I have not summarized certain evidence (post-dating CPIRL's registration) brought to the hearing by Mr. Krohn due to the fact that it was never submitted during the evidence part of the proceedings. As was stated by David Kitchen et al '(t)he practice of introducing new evidence at hearings is to be discouraged and, it must be assumed, such evidence will only rarely be allowed and where it is unlikely to prejudice the other party' (*Kerly's Law of Trade Marks and Trade Names*, Thirteenth Edition).

Evidence in reply by CPIRL

CPIRL submitted evidence in reply by way of a sworn affidavit by Mr. Emilio Zabaneh, Director of CPIRL. I have also not summarized the claims made by Mr. Zabaneh in the affidavit because of the reasons stated at the end of paragraph 6 of this ruling. These claims will be considered in the decision part of the ruling.

DECISION

Relevant Law

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

'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'.

An 'earlier trade mark' is defined in section 38(1) (a) of the Act as:

'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'.

CPIRL's trade mark is an earlier trade mark under section 38(1) (a) of the Act and a valid one for purposes of this opposition. According to section 67 of the Act:

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

In determining the issues under section 37(2) (b) of the Act, I am guided by the cases *Sabel BV v Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] FSR 77. In determining the distinctiveness of CPIRL’s mark, I am also guided by the European Court of Justice’s judgment in *Sabel BV v Puma AG*.

9) There is no need to decide on the ground of opposition relating to section 37(3) (unfair competition with an identical/similar mark for dissimilar goods) because as shown below the services in this case are similar. There is no reason to decide on the ground of opposition relating to passing off because the relevant provision of the Act deals with passing off concerning an unregistered trade mark (section 37(4) (a)). The fact that CPIRL’s mark is a registered trade mark is beyond all reasonable doubt.

Comparison of services

10) The services of the GBPL application are:

International Class 35 for hotel business management;

International Class 36 for apartments (renting of); real estate agencies; real estate management; renting of apartments.

The services of the CPIRL earlier trade mark are:

International Class 39 for transport, packaging and storing of goods; travel arrangement; arranging of tours including bird watching and inland adventure tours;

International Class 41 for education; providing of training; entertainment; sporting and cultural activities; sport camp services including scuba diving, kayaking, snorkeling, fishing and water sports, rental of sports equipment; timing of sports events;

International Class 43 for provision of food and drink; temporary accommodation; hotel and hotel reservation; restaurant, resort.

11) Although both specifications cover different classes, it is a well known principle of trade mark classification that similar goods and services can fall in different classes. For instance tourists book into resorts (class 43), however, it is a well known fact that tourists also rent apartments-the renting of apartments falling under class 36.

It is also very telling that GBPL’s mark includes the word ‘resort’ and it is boldly stated on GBPL’s website (www.cocoplumbelize.net), that ‘negotiations are underway to establish an intimate boutique hotel on a 20-acre beachfront site. In addition to its quarter mile of spectacular Caribbean beachfront, the resort will also operate a small marina on the lagoon’.

Paragraph 14 of Mr. Krohn's affidavit states that '(i)ndeed, the development project as set forth by the Applicant (GBPL) does envisage the establishment of a hotel within the residential community, but the Applicant's (GBPL) board of directors made the decision long before the submission of this Application that the name of the hotel would not be the same as the registered mark so as to ensure that there would be no likelihood of confusion with the Opponent's (CPIRL) mark'. Unfortunately, no evidence is exhibited of the above decision.

12) I find that the respective services are similar.

Comparison of trade marks

13) The trade marks to be compared are:

Earlier CPIRL trade mark: **COCO PLUM ISLAND RESORT**



Trade mark of the GBPL application: **COCOPLUM A RESORT COMMUNITY**



14) The average consumer usually perceives a trade mark as a whole and does not analytically examine the various details of the trade mark (*Sabel BV v Puma AG*). The assessment of the visual, aural and conceptual similarities of the trade marks has to be done by reference to the overall impressions created by the trade marks while taking note of their distinctive and dominant components (*Sabel BV v Puma AG*).

I note that distinctive and dominant components of both marks are the words 'COCO', 'PLUM' and 'RESORT'. This fact gives a certain visual and aural similarity to both marks. Other visual similarities can be found in the use of the colours mauve, orange and green, and representations of waves and palm/coconut trees.

In the light of the above assessment, I believe that a global assessment of both marks reveals a visual and aural similarity between the marks. This global similarity is completed by the fact that both marks share a similar conceptual similarity by suggesting the concept of a tropical vacation.

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. As indicated in paragraph 11 above, it is clear that the services featured in the specifications of the CPIRL registration and the GBPL application satisfy the test for similar services under section 37(2) (b) of the Act.

15) I find that the respective marks are similar.

Likelihood of confusion

16) 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.

In view of the similarities between the services and marks highlighted in paragraphs 11 and 14 above, I submit that the average consumer would likely be confused by both marks, as evidenced by the fact that internet searches for 'COCO PLUM BELIZE' produce returns listing Coco Plum Resort and Coco Plum Residential Community next to each other.

17) I find that there is a likelihood of confusion.

Distinctive character of the earlier trade mark

18) CPIRL's mark is a valid trade mark under section 67 of the Act which states that:

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

Although GBPL does not admit that there is a distinctive character or repute of CPIRL's trade mark so as to prevent the registration of GBPL's trade mark, GBPL did not offer any evidence to counter the above legislative presumption of validity.

19) I find that CPIRL's trade mark is highly distinctive when applied to the services under consideration.

CONCLUSION

20) GBPL's trade mark is therefore refused because the mark is similar to CPIRL's valid and distinctive earlier trade mark and are applied for with respect to services that are similar with those for which the earlier trade mark is protected, thus there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark under section 37(2) (b) of the Act.

COSTS

21) CPIRL having been successful is entitled to a contribution towards its costs. I order GBPL to pay CPIRL 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 11th day of March, 2008.

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