



*Shelves to Up in  
Flames": One  
Attorney's  
Experience with  
Counterfeit Goods*

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Note 14 of the Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement provides the following definitions:

## *Definitions*

*'For the purposes of this Agreement:*

**“counterfeit trade mark goods” shall mean any goods, including packaging, bearing without authorisation a trade mark which is identical to the trade mark validly registered in respect of such goods, or which cannot be distinguished in its essential aspects from such a trade mark, and which thereby infringes the rights of the owner of the trade mark in question under the law of the country of importation;**

**“pirated copyright goods” shall mean any goods which are copies made without the consent of the right holder or person duly authorised by the right holder in the country of production and which are made directly or indirectly from an article where the making of that copy would have constituted an infringement of a copyright or a related right under the law of the country of importation.”**

# Counterfeit's Stakeholders



IP Rights  
Holder



Manufacturer of Infringing  
Good(s)



Distributor



Customs Department &  
Police



Wholesaler/  
Retailer



Consumer

# Common Arguments for and Against 'Everyday' Counterfeit

FOR	AGAINST
"victimless crime"	<p>The victims are the IP rights holders behind the goods, some of whom are individuals and some are companies.</p> <p>Particularly with health products and products for human consumption, the consumers are the victims.</p>
Enforcement takes "food out of the 'small' man's mouth"	<p>The small man is generally a retailer; but, the manufacturer and wholesale supplier of the goods often have strong financial backing from criminal elements</p>
Particularly in relation to fashion products and toys, they are "overpriced and out of reach to the average person"	<p>The brand is strategically placed to be considered "luxury" and/or overhead costs demand the listed price. The sale of counterfeit goods dilutes the value of the brand.</p>

## *One Year's Worth of Court-Ordered Destructions- Jamaica (2014)*



Annual destruction exercise is done during IP week (highly confidential operation due to security risks)

# Case Study:

Registered Mark: RICHMAN ROYAL {label & design}



Unregistered Mark: Produced by Global Tobacco FZCO



Benzer International's trade mark registered since 2012. Benzer created mark and Global Tobacco was manufacturer from 2011-2018. Relationship broke down in late 2018. Global Tobacco applied for invalidation of Benzer's mark which was granted due to lack of answer by Benzer, having not been notified of proceedings. Registrar voided invalidation ruling in June 2019, a decision currently under appeal by Global Tobacco.

## *Initial Detention of Shipment of Global's Goods*



Benzer v. Global Tobacco infringement claim is also underway, but relies on the resolution of the validity issue before being determined. Injunction required selling of goods outside of jurisdiction, and was later discharged.

# *Enforcement in Belize*

## Issues:

- Separate shipment of trade mark paraphernalia and 'blank goods'
- Becoming aware of the incoming infringing goods in time to take action at the port of entry

## Actions:

- Whether a rights holder uses the Customs detention process or not, court action for infringement is necessary
- "prohibited goods" can be detained by request to Comptroller of Customs by a registered TM holder under s. 74 of Belize's TM Act. Requires:
  - Request Letter to Comptroller with details of shipment.
  - Deed of Indemnity
  - TM Certificate of Registration
  - Security may be required by Comptroller (cash, insurance bond)



## *Corruption is a Contributor to Counterfeiting*

- Bribery of customs officers often facilitates the initial entry to market of counterfeit goods.
- Once the goods pass through the port of entry, the likelihood of enforcement becomes very slim, for various reasons:
  - Lack of police resources and attention on stores and points of distribution;
  - Goods may quickly make their way to other jurisdictions by land or water (as is the case in Belize);
  - Other than criminal enforcement as permitted by law, eradication of counterfeit relies on the rights holder: (1) knowing about the infringement(s); (2) being able to locate the importer(s); (3) taking swift action with customs department and pursuing legal action.

# Questions I get asked about Counterfeit (and Piracy) and now I am asking you:

1

How are we going to stop it if some of the biggest economies in the world dominate production of counterfeit goods?

2

Why is it such a big deal?  
All [counterfeit] does is reduce profits of huge rich companies and brands.

3

Will I ever be able to 'rest easy' with my trade mark? I can't afford to enforce every time something happens!

Thank you for your  
attention!

Questions? Comments?

Contact me at: [marissa@cilglobalip.com](mailto:marissa@cilglobalip.com) and [marissa@godfreylaw.net](mailto:marissa@godfreylaw.net)