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New TM Act ends UK reliance and allows service marks in Antigua and Barbuda

Antigua & Barbuda has enacted and put into force a new trade mark act, the country's first ever comprehensive trade mark law. The new Act and regulations (Trade Marks Act, 2003 and Trade Marks Regulations, 2006) took effect on 1 October 2006. A related act, the Intellectual Property Office Act, established an Intellectual Property Office and appointed a Registrar of Intellectual Property.

In order to comply with the Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS), the enactment of the new Trademarks Act was accompanied by new legislation to protect patents, copyright, industrial designs, geographical indications, and integrated circuits.

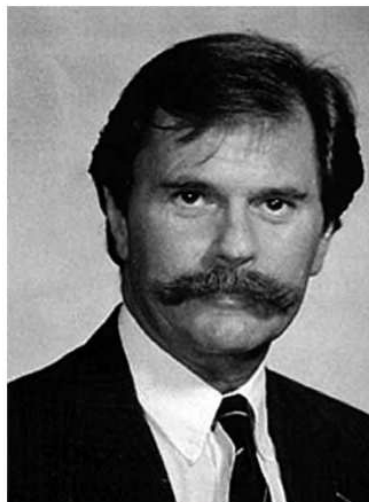
Antigua & Barbuda has now established an independent trade mark registration system and repealed its prior laws. Previously, a trade mark applicant was required to have a UK registration as a prerequisite to registration in Antigua & Barbuda or, alternatively, secure a local registration under the old British Classification system which made no provision for service marks.

The new legislation includes service marks and collective marks and adopts the International Classification of the Nice Agreement. Paris Convention priority has been established. Antigua & Barbuda is already a member of the Madrid Protocol, since accession in 1999.

Although a UK-based registration is no longer provided for nor possible under the new act, current UK-based and local registrations will continue under the new Act for their unexpired terms or 10 years from 1 October

2006, whichever occurs first. All new registrations will be for a term of 10 years, with renewals for further periods of 10 years.

The Act includes a grace period of six months following expiration to renew a registration. Interested parties may



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oppose new applications within three months from the date of publication of an application for opposition.

The Act confirms that common law "passing off" is still actionable. Also, the doctrine of "honest concurrent user" is still a valid defence to an allegation of trade mark infringement.

All applications will be examined and subject to absolute and relative grounds of refusal. Prior use in Antigua & Barbuda is unnecessary provided the applicant asserts an intent to use the mark in Antigua & Barbuda. A registration is subject to cancellation after three years of non-use following registration. However, a registrant may assert a defence of "good cause", which may excuse non-use.

Licenses of registered marks must be recorded and the registrant must exercise quality control over its licenced marks. Applications and registrations may be assigned with or without goodwill.

Consistent with TRIPS, the proprietor of a registered trade mark may give notice to Customs in Antigua & Barbuda to restrict importation of infringing goods, and the court may order the police to search for, seize and destroy infringing goods. Penalties for infringement include fines up to EC\$100,000 and imprisonment up to five years.

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