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Anguilla Adopts Sweeping New Trademarks Act

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On August 12, 2002, Anguilla introduced a sweeping revision of its trademark laws. The Trade Marks Act 2002 establishes a TRIPS-compliant system that incorporates the latest version of the Nice International Classification System, permits the filing of multi-class applications and the registration of service marks and, at the same time, retains continuing recognition of a United Kingdom registered mark as an alternative basis for registration, along the modernized local application system.

The new Act recognizes and enforces the Community Trade Mark registrations if and when a reciprocal arrangement is established with the European Union (EU).

Anguilla is an English common law jurisdiction that, like other common law jurisdictions, accords priority to first use over first to file. The Trade Marks Act 2002 replaces a system that mirrored the 1938 U.K. Trade Marks Act and relied on the old British classification system, which did not provide for service marks. At the same time, Anguilla has modernized intellectual property laws to protect patents, copyrights, industrial and layout designs and trade names.

Another major change is the abandonment of the fee schedule that previously required official fees totaling more than US \$400 for registration of a mark in one local class. The official fee is now US \$250 for a single or multi-class application or US \$200 for a U.K.-based application. The new Act also dispenses with Statement A and Declaration forms that, in addition to a power of attorney, required the applicant's signature. The applicant need only sign an authorization with no witnessing, notarization or other legalization.

The Act provides for Paris Convention priority claims and recognition of well-known marks. The common law of "passing off" has been retained. All applications are subject to absolute and relative grounds of refusal. Prior use in Anguilla is unnecessary, provided that the applicant asserts an intent to use. Revocation of a registration for nonuse cannot be sought until three years

of nonuse following registration. The period of opposition is one month from the date of publication.

A U.K.-based registration in Anguilla will continue to require the filing of a local application in Anguilla and the duration of the resulting registration will continue to correspond with the underlying U.K. registration; that is, ten years initially and ten years for each renewal. Local registrations likewise will extend for a ten-year period with renewals for further ten-year periods. Existing registrations, which under the local system were granted a term of 14 years, are reduced under the new act to ten years. Late renewal is possible within the grace period of six months from the date of expiration.

Consistent with TRIPS, under the new Act, the proprietor of a registered trademark may give notice to customs in Anguilla to restrict importation of infringing goods, and the court may order the police to search for, seize and destroy infringing goods. Strong penalties are provided for offenders, both individuals and legal entities, for infringement, trademark-related misrepresentation and groundless threats of infringement proceedings.

The new Act also provides for registration of collective and certification marks, as well as distinctive shapes of products and packaging. An application to record a license must provide for quality control.

Applications can be filed by fax or electronic mail and the date of application will be the date of transmission, provided that the original documentation is filed within two months.

Although every effort has been made to verify the accuracy of items carried in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.