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Caribbean Legislation

Update on Trademark Legislation in the Caribbean

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Recently, the Caribbean islands have been a hotbed of trademark law activity. Sweeping new trademark laws were put into force in 2003 in St. Kitts-Nevis and St. Lucia, while new trademark laws went into effect in 2002 in Anguilla. In 2001, new trademark regimes were put into operation in both Belize and Jamaica. Currently, draft trademark acts are circulating in St. Vincent and Turks & Caicos Islands. In addition, the latter recently amended its laws to permit registration of service marks.

Service Marks

Service marks can now be registered in numerous Caribbean jurisdictions, owing to enactment of service mark provisions in all of the new trademark acts as well as long-standing provisions in other jurisdictions for registration of service marks. The Caribbean jurisdictions that now allow independent applications for service marks are Anguilla, Barbados, Belize, Jamaica, St. Kitts-Nevis, St. Lucia, Turks & Caicos Islands, and Trinidad & Tobago.

On the other hand, service marks can be registered in the following jurisdictions only if the subject service mark has already been registered in the United Kingdom: Antigua & Barbuda, British Virgin Islands, Cayman Islands, Dominica, Grenada, Guyana, Montserrat and St. Vincent. It is only in the Bahamas that service marks cannot be registered in any way.



U.K. Registrations

Recent changes in trademark legislation in Belize, St. Kitts-Nevis and St. Lucia dictate that a U.K. registration can no longer be used as the basis for a trademark application. For many years, it has been impossible to use a U.K. registration as the basis for a trademark application in Bahamas, Barbados, Jamaica and Trinidad.

On the other hand, a U.K. registration can be used as an alternative to filing a local application to register a mark in Anguilla, Antigua & Barbuda, British Virgin Islands, Dominica, Guyana, Montserrat and Turks & Caicos Islands.

Furthermore, a U.K. registration must be used as the only basis for registering a mark in the Cayman Islands, Grenada and St. Vincent.

The only exception to the above is the Cayman Islands, where a Community Trade Mark (CTM) or U.K.-registered mark can be used as the basis for applying to register a mark. Cayman is the sole jurisdiction in the Commonwealth Caribbean, thus far, to recognize a CTM as the basis for applying to register a mark, although Anguilla has established a framework within its new trademark act for CTM recognition, once regulations have been adopted.

Paris Convention Priority

Paris Convention priority is now available in Anguilla, Bahamas, Barbados, Belize, Dominica, Grenada, Jamaica, St. Kitts-Nevis, St. Lucia and Trinidad & Tobago. However, Dominica has not yet enacted implementing legislation.

Classification System

The British classification system of 1938 still applies to local trademark applications, that is, applications that are not based on U.K. registrations, in Antigua & Barbuda, Bahamas, British Virgin Islands, Dominica and Montserrat. In all of the other jurisdictions, where the Nice Convention classification has been adopted, the 8th Edition now applies, except in Trinidad & Tobago and Turks & Caicos Islands.

Madrid Protocol

Thus far, only Antigua & Barbuda has joined the Madrid Protocol. Implementation is still in process.

Use and Renewal

In the Commonwealth Caribbean, renewal of a trademark registration does not require any declaration regarding use – except in Barbados and now in Belize, both of which require a specific assertion as to use. In none of the Caribbean jurisdictions is prior use necessary to register a mark, and all of the countries and territories retain the doctrine of according priority of right to the first to use,

rather than the first to file. The common law right to bring an action for “passing off” has been retained in all of the Commonwealth Caribbean jurisdictions.

Reform and Processing

Most extensive in reforming and modernizing its trademark and IP laws has been Belize. The Belize Intellectual Property Office launched its official website on February 13, 2003, with publication at www.belipo.bz of all of Belize’s trademark and IP legislation, the biweekly *Intellectual Property Journal*, articles on various IP topics and an FAQ section.

Barbados’ registry has made great strides in clearing up its trademarks backlog, but still lagging are the Bahamas, whose trademark legislation dates from 1906 and whose registry continues to insist, for example, on receiving a separate signed authorization from both the assignor and the assignee for every separate class registration. Amazingly efficient, on the other hand, is Montserrat, which continues to function well despite hosting an active volcano – the most dynamic geological phenomenon in the hemisphere.

Another “challenged” jurisdiction is Dominica, which retains an outdated system and is backlogged. However, in November 2003 Dominica obtained specialized training in London for its principal trademark official, for whom arrangements were made and financed by the Technical Assistance Subcommittee of INTA’s External Affairs Committee. The training in London was provided by Keith Farwell, a trademark partner of Phillips & Leigh, member of the CIPA Publications Committee and editor of the CIPA/ITMA trademark training manual series. (CIPA, the Chartered Institute of Patent Agents, and ITMA, the Institute of Trade Mark Attorneys, are the two U.K. professional bodies representing trademark attorneys in the United Kingdom.)

Caribbean Court of Justice, Caribbean Union, and FTAA

On the judicial horizon it is proposed to abolish appeals to the Privy Council in London and to replace that court of final appeal with a new Caribbean Court of Justice. Eight common law nations have now ratified the treaty to establish the court, which was provoked in part by the Privy Council’s record of overturning controversial death penalty judgments.

Commonwealth Caribbean leaders have also agreed to work toward establishing a European Union-style commission to oversee what they envision may become a 15-member single market economy, allowing the free movement of goods, services and professional workers. Also on these nations’ international agenda is the matter of FTAA, the Free Trade Agreement of the Americas, which, theoretically, will debut in 2005.
