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“Here be pirates...” a survey of Caribbean trade mark woes

Change of address causes problems for
O2 distiller as registration goes astray

Adidas three stripes beat-off
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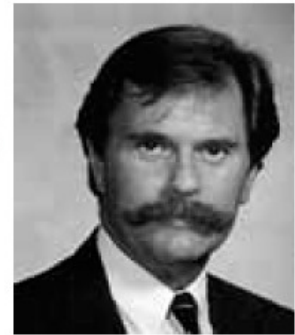
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“Here be pirates...” a survey of Caribbean trade mark woes

A compendium or wish list of don't-want nuisances and annoyances by George CJ Moore



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If you happen to find that your Caribbean trade mark matter is taking much longer than you anticipated or are encountering unusual difficulty, it may have fallen into one of the traps which abound in the application of human ingenuity and sometimes contrariness to statutory and regulatory specifications, a number of which are described below in what, for me, amounts to a Caribbean Trade Mark Wish List – or compendium of what I don't want, including the following:

Antigua & Barbuda - The registry has invented a new requirement that every application for registration requires a separate Declaration of Use signed by the proprietor – despite the absence of any such requirement within the act or regulations. This is also unlike everywhere else in the Commonwealth Caribbean, where no such notarially endorsed and often expensive declaration is needed. Indeed, if an application is to be based upon priority that, too, calls for a separate and additional notarised declaration. Another nuisance is having to supply, at the time of renewal, a certified copy of a UK Certificate showing renewal in the UK despite the fact that Antigua, in its TM Act of 2003, long ago abandoned dependence upon UK registrations.

Anguilla - Although the TM Act of 2002 established Paris Convention priority, the registry is not accepting applications which fully comply and rejecting them for an erroneous reason. Also, the requirement for a special request signed by an assignee to record an assignment, in addition to a power of attorney which specifically authorises this, is duplicative and burdensome.

Bahamas - The antique of the Caribbean amongst the Commonwealth Caribbean nations is the Bahamas trade marks statute, which dates from 1905. It obviously nowhere contemplates service marks and furthermore pre-dates the International Classification system. Getting old, too, are the many applications which await publication and processing, the latest publication

of the Gazette in January 2008 being of applications filed in August 2004. As one can imagine, this also impedes the efficacy of trade mark searching in the Bahamas. Registering high on the nuisance list also is the Bahamas' unique requirement that an applicant supply a separate signed authorisation for every separate class application, as well as a separate signed authorisation from each party to a recordable transaction even when a party has expired.

Barbados - If you're wondering why the effective date of your registration is not the same as the date the application was filed (which is the rule everywhere else), it is because of the unique practice in Barbados of according an effective date only at the time of payment of the registration fee, after notification by the registry – which one can never be sure will come when, nor in what order in relation to other applications. Renewal, too, presents a hassle, for it is only in Barbados (and Belize) within the Commonwealth Caribbean that a statement confirming use is required.

Belize - Expect to get rebuffed on classification if you have included any mention of words, such as “clothing”, which appear in the class definition. Even “flour” and “salt” were treated as insufficiently specific; among the sub-specifications for salt, you will be told are “salt for cattle,” “salt for preserving other than foodstuffs” and “salt, raw.” And be sure to hurry with your response to an official action since the registry often allows only 30 days – which, if not sufficient, will put you to the nuisance of having to

apply for an extension and pay for that too, which makes for lots of hurried international communications and obviously bumps up the costs. Upon renewal, if one is not able to assert use within Belize during the past year, there had better be a good reason; otherwise, thumbs down.

Bermuda - The anachronism of Part B continues to rear its head, in official action dictates, often confounding both proprietors and practitioners. Also, at time of renewal, instant death awaits those who failed to seek renewal in advance – there is no grace period and renewal is available only upon pain of costly restoration, with official fees that total \$475.

British Virgin Islands - Here, too, the trade mark legislation is extraordinarily dusty, dating from 1887 and the rules from 1937 which, like in the Bahamas, means no service mark protection. You must also cope with the old British classification system which predates almost everything modern and focuses extensively on such topics as cloth, for which there are 13 different classes – out of a total of 60 – and uses such terminology as “carriages” (rather than vehicles) and “horological instruments”. Here, too, a separate signed authorisation is needed for every separate class which, as with the Bahamas, is bad for the trees. Another anachronism is having to deal with and pay for printing blocks which disappeared long ago elsewhere.

Cayman Islands - Annual government maintenance fees are the bane (and gravy) of trade marks

in Cayman where, still, one must have either a UK or CTM registration to register a mark, no matter how irrelevant a European or British mark might be to one's business plans for this Caribbean territory. And keep your calculator handy, since US dollars differ slightly from Cayman dollars which, with their fixed exchange rate, now share in the plunge of Uncle Sam's.

Dominica - Back to its bad habit of insisting on a "raised" seal on any UK certificate which is presented to support an application there, the registry in Dominica continues to ignore the UK-IPO's assertions that it does not apply raised seals – although upon special plea it continues to do so, just to overcome the insistence in Roseau – where the law is so old and the processing so slow that one can only hope that some Rip Van Winkel will suddenly wake up and rouse the government to reform. The lessons of an INTA sub-committee's sponsored trip of a Dominican official to London for training and a session at the UK IPO seem to have evaporated.

Grenada - The lone ranger of the Caribbean, devoid of any local trade mark registration system and still 100% reliant and insistent upon a UK registration, Grenada continues to struggle with lost files. Fortunately, however, it has very low official fees.

Guyana - The cheapest official fees in the Caribbean do not make up for the pre-global warming glacial pace of official processing, nor the lack of provision for service marks, nor the nuisance of having to supply Statements A and Declarations to support each and every application.

Montserrat - Reduced to one-third of its pre-volcanic size, tiny Montserrat has a new but now old trade mark act which it somehow has never managed to put into effect. Pity, since it overcomes the present shortcomings those being the old British classification system, antiquated forms and no services marks except by way of transplant of a UK registered service mark.

St. Kitts & Nevis - Save Our Trees needs to focus here to purge continued insistence on Statements A and sworn Declarations to support

every application – while these relics of the past are extinct virtually everywhere else, on top of which one is charged the highest official fees anywhere in the Caribbean.

St. Lucia - Substance over form needs to triumph here, to curb the registrar's nitpickety rejection of powers of attorney which, for example, inadvertently insert the proprietor's address next to the proprietor's name at the top rather than at the bottom of the page far below. Also, the number of documents needed to record an assignment needs to be pared and the surgeon needs also to gut the opposition chapter to remove some apparently minor but operationally major notice provisions, non-compliance with which will irreversibly doom any opposition.

“Substance over form needs to triumph here, to curb the registrar's nitpickety rejection of powers of attorney...”

St. Vincent - Documentation which was supplied, for example, six years ago and was correct and sufficient the time of submission – but was shelved at the registry and thus remains pending – should be deemed sufficient still, without requiring re-preparation, re-execution and re-submission of everything, even from no longer existing parties. Also, the registry's unauthorised insistence upon duplicate, notarised powers of attorney – which compounds the sometimes sizeable costs – is unique within the Caribbean and should cease and desist.

Trinidad & Tobago - Personnel changes at the registry seem to have reduced the proliferation of official actions although they still continue, focusing now especially on technical modifications of specifications and

still too frequent pushing of applications onto Part B of the register – which remains a mystery to most. You have no A4 size paper? Better get some, since all powers of attorney printed onto US letter size paper will be rejected. And dare not leave out the consideration on a deed of assignment; absent that, you must disclose the consideration on a separate Declaration of Value – but, alas, the amount does not matter that much: you can state a nominal consideration on either form.

Turks & Caicos Islands - Effective 8 October 2007 – but still not effective, the new Trade Marks Ordinance imports the toxic (and heretofore unique within the Commonwealth Caribbean) scheme of the Cayman Islands to tax all trade mark registrations yearly with an annual maintenance fee. Furthermore, the new act contains a section 60 which imports UK and European trade mark regulations into Turks & Caicos trade mark law to override the Turks & Caicos statutory provisions which are left with virtually no place at all – except for the section 60 shot in the foot substitution clause which renders the act unworkable – which might be one of the reasons why the effective date of October 8, 2007 is not yet effective after all.

All this said, let us not lose sight of the fact that however annoying or old fashioned some of the Caribbean trade mark environment may in certain places be, tremendous strides have been made of late, almost all across the board so that, overall, Caribbean trade marks are actually in quite good health and only need the above sort of prickly prodding to bring most of their eccentricities, antiquities and cowlicks into line.

The eagle-eyed reader will of course notice that one country not mentioned in the Caribbean Wish List above is Jamaica, thanks to its already humming as an agreeable and finely tuned system for registering and protecting trade marks. Three cheers for Jamaica – but, take heed: a number of the other jurisdictions are not far behind!

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