No. 9 of 2013

VIRGIN ISLANDS

TRADE MARKS ACT, 2013

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No. 9 of 2013 **TRADE MARKS ACT, 2013** **Virgin Islands**

I ASSENT

(Sgd.) Boyd McCleary, CMG, CVO,
Governor.
8th May, 2013

VIRGIN ISLANDS

No. 9 of 2013

An Act to repeal and replace the Trade Marks Act (Cap. 158) and to make new provision for the registration and protection of trade marks, the institution of legal proceedings in trade mark issues and other matters relevant to intellectual and industrial property as they relate to trademarks and for connected matters:

[Gazetted 23rd May, 2013]

ENACTED by the Legislature of the Virgin Islands as follows:

PRELIMINARY

Short title and commencement.

1. This Act may be cited as the Trade Marks Act, 2013 and shall come into force on such date as the Governor may, by Proclamation published in the *Gazette*, appoint.

Interpretation.

2. (1) In this Act, unless the context otherwise requires,

"applicant" means a person who has applied for the registration of a trade mark, and includes

(a) the assignee of an application, if the assignment is effected under section 79; and

(b) a registered trade mark agent appointed under section 33 who has applied for the registration of a trade mark on behalf of another person;

"application" means an application for the registration of a trade mark under this Act and includes an application for the registration of a series of trade marks;

"certification trade mark" means a sign that is capable of

(a) being represented graphically; and

(b) distinguishing, in the course of trade,

(i) goods that are certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods that are not so certified; or

(ii) services that are certified by any person in respect of quality, accuracy, performance or other characteristic from services that are not so certified;

"classification of goods or services" means goods or services that are classified by the Commission pursuant to an Order published in the *Gazette* or, in the absence of such a classification by the Commission, the classification of goods and services in accordance with the Nice Agreement concerning the international classification of goods and services for the purposes of the registration of marks of June 15, 1957 as subsequently amended or revised;

"collective association" means a body of persons, whether incorporated or not, that has or is able to have members and

(a) is constituted for the joint benefit of its members; and

(b) is so constituted that its membership can always be ascertained;

"collective trade mark" means a sign that is capable of

(a) being represented graphically; and

(b) distinguishing the goods or services of members of the collective association that is the owner of the sign from those persons who are not members of the collective association;

"Commission" means the Financial Services Commission established under section 3 of the Financial Services Commission Act, 2001;

No. 12 of 2001

"Commissioner of Customs" means the Commissioner of Customs appointed pursuant to section 4 of the Customs Management and Duties Act, 2010 and section 92 of the Virgin Islands Constitution;

No. 6 of 2010
UK S.I. 2007
No. 1678

"Court" means the High Court;

"Customs" bears the same meaning as that provided in section 2 of the Customs Management and Duties Act, 2010;

"distinctive", in relation to a trade mark, means a trade mark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish;

"geographical indication" means, in respect of a wine or spirit, an indication that

(a) defines the wine or spirit as originating in the territory of a WTO Member , or a region or locality of that territory, where a quality, reputation, or other characteristic of the wine or spirit is essentially attributable to its geographical origin; and

(b) is protected by the laws applicable to that WTO Member;

"infringement proceedings", in relation to a registered trade mark, includes proceedings under section 112 and section 114;

"infringing article" means an article that is

(a) specifically designed or adapted for making copies of a sign that is identical or similar to a registered trade mark; and

(b) in the possession, custody or control of a person who knows or has reason to believe that the article has been or is to be used to produce infringing goods or material;

"infringing goods" means goods that bear, or goods the packaging of which bears, a sign that is identical with or similar to a registered trade mark and

(a) the application of the sign to the goods or their packaging is ~~a~~ an infringement of the registered trade mark; or

(b) the sign has been used in relation to the goods or their packaging in a way that infringes the registered trade mark;

"infringing material" means material that bears a sign that is identical with or similar to a registered trade mark and either the sign is

(a) used for labelling or packaging the goods as a business paper, or for advertising goods or services, in a way that infringes the registered trade mark; or

(b) intended to be used in a way that would infringe the registered trade mark;

"infringing sign" means a sign that is

(a) identical with a trade mark in respect of which a notice has been given under section 122 and is used on or in physical relation to goods that are identical with goods in respect of which the trade mark is registered;

(b) identical with such a trade mark and is used on or in physical relation to goods that are similar to goods in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or

(c) similar to such a trade mark and is used on or in physical relation to goods that are identical with or similar to goods in respect of which the trade mark is registered, if such use would be likely to deceive or confuse;

"owner" means,

(a) in relation to a registered trade mark that is not a certification trade mark or a collective trade mark, the person whose name appears in the register as the owner of the trade mark;

(b) in relation to a collective mark that is registered, the collective association whose name appears in the register as the owner of the trade mark;

(c) in relation to a certification trade mark that is registered, the person who certifies the goods or services to which the certification trade mark relates; and

(d) in relation to an unregistered trade mark, the person who owns the right in the trade mark;

"Paris Convention" means the Convention for the Protection of Industrial Property signed in Paris on 20th March 1883, as revised or amended from time to time;

"Paris Convention country" means

(a) a country that is specified by the Commission in an Order published in the *Gazette* as being a country that has ratified or acceded to the Paris Convention; and

(b) a United Kingdom overseas territory, a Crown Dependency or any other territory or geographical area that is subject to the authority or under the suzerainty of a country referred to in paragraph (a), or any territory or geographical area that is administered by such country on behalf of which the country has acceded to the Paris Convention;

"prescribed" means prescribed by or under the rules;

"register" means the register of trade marks kept and maintained by the Registrar under section 89;

"registered trade mark" means a trade mark that is on the register;

"Registrar" means the Registrar of Trade Marks, Patents and Copyright referred to in section 96;

"rules" means rules made by the Cabinet pursuant to section 134;

"series of trade marks" means a number of trade marks for the same goods or description of goods or the same services or description of services, as the case may be, that

(a) resemble each other in their material particulars; and

(b) differ only in respect of

(i) statements of the goods or services for which they are, or are proposed to be, used;

(ii) statements of number, price, quality or names of places;

(iii) other matters of a non-distinctive character that do not substantially affect the identity of the trade mark; or

(iv) colour;

"sign" includes

(a) a brand, colour, device, figurative element, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word and "numeral" and "word" in this regard shall be construed to include a foreign numeral and foreign script or word; and

(b) any combination of signs;

"trade" includes a business or profession;

"trade mark" means any sign that is capable of

(a) being represented graphically, and

(b) distinguishing the goods or services of one person from those of another person, and

includes a certification trade mark and collective trade mark, unless otherwise specifically excepted;

"trade mark agent" means a person who is approved by the Commission as a trade mark agent in accordance with section 33;

"TRIPs Agreement" means the Agreement on Trade-related Aspects of Intellectual Property Rights 1994, as revised or amended from time to time;

"WTO Agreement" means the Agreement Between the World Intellectual Property Organisation and the World Trade Organisation signed in Geneva on 22nd December 1995, as revised or amended from time to time; and

"WTO Member" means any country, territory or geographical area that is identified by the Commission as such in an Order published in the *Gazette*, but until such an Order is made this shall be construed to mean any member to the Marrakesh Agreement Establishing the World Trade Organisation.

(2) For the purposes of this Act, a sign or trade mark is construed to be applied to goods, material or any other thing if the sign or trade mark is woven in, impressed on, worked into, affixed or annexed to, or in any manner marked on or incorporated with, the goods, material or thing.

(3) Where under this Act any

(a) authorisation, consent or notice is required to be given, or

(b) application is required to be made,

the authorisation, consent or notice, or application (as the case may be) shall, unless the context requires otherwise, be given or made in writing.

(4) In this Act, any reference to the term

(a) "infringing goods, material or articles" shall be construed in accordance with the definitions of "infringing goods", "infringing material" and "infringing article" under subsection (1); and

(b) "a person who is aggrieved" or an "aggrieved person" includes a person who has an interest in an application or other matter to which the term relates in this Act.

(5) Where a reference is made in this Act to the publication of any matter in the *Gazette*, the matter may, in addition to such publication, be published in such other manner as may be prescribed.

References to use of sign.

3. For the purposes of this Act,

(a) a sign may constitute a trade mark although it is used in relation to a service that is ancillary to the trade or an undertaking and whether or not the service is provided for money or money's worth; and

(b) any use of a sign with respect to goods or services shall be construed to include a reference to the audible use of the sign in relation to those goods or services.

References to use of trade mark.

4. For the purposes of this Act, a reference to "use" in relation to a trade mark, shall be construed to include, unless the context requires otherwise,

(a) use in a form differing in elements that do not alter the distinctive character of the trade mark in the form in which it was registered;

(b) applying the trade mark to goods or services or to materials for the labelling or packaging of goods or services in the Virgin Islands for export purposes;

(c) the application in the Virgin Islands of a trade mark to goods or services to be exported from the Virgin Islands, and any other act done in the Virgin Islands in relation to those goods or services that, if done in relation to goods or services to be sold or otherwise traded in the

Virgin Islands, would constitute use of a trade mark in relation to those goods or services for which the use is material in accordance with this Act or at common law;

(d) the use of the trade mark by

(i) the owner or by another person with the consent of the owner;

(ii) a member of a collective association where the owner is the collective association; or

(iii) any person who otherwise has authority to use a collective trade mark or certification trade mark; and

(e) the use of any registered component part of the trade mark that is registered in the name of the same owner.

Reference to use likely to cause confusion.

5. (1) For the purposes of determining whether the use of

(a) a sign is likely to cause confusion on the part of the public, the Registrar or the Court, as the case may be, may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with a registered trade mark; and

(b) a trade mark is likely to cause confusion on the part of the public, the Registrar or the Court, as the case may be, may take into account all factors relevant in the circumstances, including whether the use is likely to be associated with an earlier trade mark.

(2) Without limiting subsection (1), the factors relevant in any circumstance in relation to a sign or trade mark may include

(a) the inherent distinctiveness of the sign or trade mark and the extent to which it has become known;

(b) the length of time the sign or trade mark has been in use;

(c) the nature of the goods or services to which the sign or trade mark relates; and

(d) the degree of resemblance between the sign or trade mark in appearance or sound or in the ideas suggested by them.

References to earlier trade mark.

6. (1) For the purposes of this Act, a reference to “earlier trade mark” with respect to another trade mark shall be construed to

(a) mean a registered trade mark that has a date of the application for registration earlier than that of the other trade mark, taking into account the priorities that are claimed in respect of each trade mark;

(b) mean a trade mark which, at the date of the application for registration of the other trade mark or, where appropriate, at the date of the priority claimed in respect of that application for registration, was entitled to protection under the Paris Convention or other international treaty or arrangement which, in accordance with the constitutional arrangements of the Virgin Islands, applies to the Virgin Islands as a well-known trade mark; and

(c) include a trade mark in respect of which an application for registration has been made under this Act and which, if registered, would constitute an earlier trade mark by virtue of paragraph (a).

(2) A trade mark that is an earlier trade mark by virtue of subsection (1) (a) shall continue to be taken into account in determining the registrability of a later trade mark for a period of one year after the date on which the registration of the earlier trade mark expires, unless the Registrar is satisfied that the earlier trade mark has not been used in good faith, whether in the Virgin Islands or otherwise, during the three years immediately preceding that date.

References to well-known trade marks.

7. (1) A reference in this Act to a trade mark that is entitled to protection under the Paris Convention as a well-known trade mark shall be construed as a reference to a trade mark that

(a) is well known in the Virgin Islands; and

(b) is the trade mark of a person who

(i) is a national of, or is domiciled or ordinarily resident in, a Paris Convention country or WTO member;

(ii) is a belonger or resident in the Virgin Islands; or

(iii) has a real and effective commercial or industrial establishment in a Paris Convention country, a WTO member or the Virgin Islands, whether or not that person carries on business in the Virgin Islands or owns any goodwill in a business in the Virgin Islands.

(2) In order to assist the Registrar or the Court to make a determination under subsection (1) as to whether a trade mark is well known in the Virgin Islands, the Commission may issue such guidelines as it considers fit, and

(a) the guidelines shall be published in the *Gazette*; and

(b) the Registrar and the Court shall have regard to the guidelines in dealing with any such determination.

(3) For the purposes of subsection (1) (b) (ii),

(a) a "belonger" has the meaning provided under section 2 (2) of the Virgin Islands Constitution Order 2007; and

UK S.I. 2007 No. 1678

(b) the term "resident" means a person

(i) to whom a certificate has been granted under section 18 of the Immigration and Passport Act and has not been revoked pursuant to section 19 of that Act; or

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(ii) who does not qualify under subparagraph (i), but has resided in the Virgin Islands for a continuous period of not less than ten years, excluding any period of absence of not more than ninety days in a calendar year or for medical reason or for reason of pursuing tertiary education overseas.

Act binds the Crown.

8. This Act binds the Crown.

PART I

REGISTRABILITY OF TRADE MARKS

Nature of and Rights Accruing to a Registered Trade Mark

Nature of registered trade mark.

9. (1) A registered trade mark is personal property that is acquired by the registration of the trade mark under this Act.

(2) No proceedings lie to prevent, or recover damages for, the infringement of an unregistered trade mark, but nothing contained in this Act shall be construed to affect the law relating to passing off.

Rights that accrue to a registered trade mark.

10. (1) The owner of a trade mark has, in relation to all or any of the goods or services in respect of which the trade mark is registered, the rights and remedies provided by this Act and, where not provided by this Act, as provided by or under the common law.

(2) In particular, the owner of a registered trade mark has the exclusive right to

(a) use the registered trade mark;

(b) authorise any other person to use the registered trade mark;

(c) assign or transmit the registered trade mark, either in connection with the goodwill of a business or otherwise; and

(d) give a valid receipt for any consideration for any assignment or transmission.

(3) For the purposes of subsection (2) (a), a member of a collective association that owns a collective trade mark that is registered in respect of goods or services

(a) has, along with the collective association, the exclusive right to use the trade mark in respect of those goods or services; and

(b) does not have the right to exclude any other member from using the trade mark in respect of goods produced or services provided by the other members.

Matters relative to the rights referred to in section 10.

11. Subject to any restriction on the commencement of proceedings for infringement of a registered trade mark contained in this Act, the rights that accrue to a registered trade mark under section 10

(a) are subject to any condition that is entered on the register with respect to the registered trade mark;

(b) accrue from the date of application to the Registrar for the registration of the trade mark;

(c) are conferred in respect of each of the registered trade mark's component parts that are registered as separate trade marks; and

(d) are to be exercised by joint owners, if any, of the registered trade mark as if they were the rights of a single person.

Qualifications for Registration of a Trade Mark

When a trade mark may be registered.

12. Where, in respect of a trade mark,

(a) an application for the registration of the trade mark is filed in accordance with the requirements of this Act and the rules,

(b) the Registrar is satisfied that no grounds exist to prevent the registration of the trade mark, and

(c) the fees prescribed have been paid,

the trade mark is registrable under this Act in respect of the particular goods or services within one or more classes, or the particular goods and services within one or more classes.

When a certification trade mark may be registered.

13. (1) A certification trade mark in respect of goods or services may

(a) be registered in the name, as owner, of the person who certifies the goods or services; but

(b) not be registered in the name of a person who carries on a trade in goods or services of the kind certified.

(2) The provisions of this Act apply to certification trade marks in the manner and to the extent provided in Schedule 1.

Schedule 1

When a collective trade mark may be registered.

14. (1) A collective trade mark may be registered in the name of a collective association, as owner, in respect of goods that are produced by its members, services that are provided by its members, or both.

(2) The provisions of this Act apply to collective trade marks in the manner and to the extent provided in Schedule 2.

Schedule 2

Disqualifications for Registration of Trade Marks

Grounds for refusal of registration generally.

15. (1) The Registrar shall not, subject to subsection (2), register

(a) a sign that is not a trade mark;

(b) a trade mark that is devoid of any distinctive character;

(c) a trade mark that consists exclusively of a sign or indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of goods or services;

(d) a trade mark that consists exclusively of a sign or indication which has become customary in the current language or in the *bona fide* and established practices of trade;

(e) a trade mark if or to the extent that the use of the trade mark is prohibited in the Virgin Islands by virtue of any enactment or rule of law or would otherwise be disentitled to protection in any court; and

(f) a trade mark if the application to which it relates is, in the opinion of the Registrar, made in bad faith.

(2) The Registrar shall not refuse to register a trade mark by virtue of subsection (1) (b), (c) or (d) if, before the date of application for registration, the trade mark has in fact acquired a distinctive character as a result of either the use made of it or of any other circumstance.

(3) For purposes of determining the distinctive character of a trade mark, the Registrar or the Court, as the case may be, shall consider whether or not the trade mark is, or is to be, limited in whole or in part to one or more specified colours.

(4) A trade mark that is, or is to be, registered without limitation of colour is, or will be, registered for all colours.

Refusal of registration in relation to shapes, numbers or numerals.

16. The Registrar shall not register a sign as a trade mark if the sign consists exclusively of

(a) the shape

(i) which results from the nature of the goods themselves;

(ii) of goods which is necessary to obtain a technical result; or

(iii) which gives substantial value to the goods; or

(b) letters, numerals or numbers or a combination of letters, numerals or numbers which are not defined in any manner as to give them a distinctive character.

Refusal of registration on public policy grounds, etc.

17. (1) The Registrar shall not register a trade mark if registration of the mark would

(a) be contrary to public policy or to accepted principles of morality; or

(b) be of such a nature as to deceive the public (for instance with regard to the nature, quality or geographical origin of the goods or services).

(2) Where the Registrar considers that the registration of a trade mark may be contrary to

(a) public policy, he shall refer the matter to the Commission for its consideration and the Commission's opinion on the matter shall be conclusive; or

(b) accepted principles of morality, his opinion on the matter shall be conclusive.

Refusal of registration in relation to geographical indications.

18. (1) The Registrar shall not register a trade mark that

(a) contains a protected geographical indication; and

(b) relates to specified goods that do not originate from the place indicated in the protected geographical indication.

(2) For the purposes of subsection (1), the reference to "protected geographical indication" with respect to specified goods means the list of geographical indications kept and maintained by the Registrar under section 90.

(3) The rules may specify the goods that fall to be treated under subsections (1) (b) and (2).

Refusal of registration of state flags, state emblems, etc.

19. (1) The Registrar shall not, without the authorisation of the competent authority concerned, register a trade mark that contains a representation of

(a) the flag of a Paris Convention country, unless the Registrar considers that the use of the flag in the manner proposed is permitted without that authorisation;

(b) the armorial bearings or any other state emblem of a Paris Convention country that is protected under the Paris Convention or the TRIPS Agreement; and

(c) an official sign or hallmark

(i) adopted by a Paris Convention country;

(ii) that includes control and warranty in relation to goods or services of the same, or a similar, kind as those goods or services in relation to which the trade mark is to be registered; and

(iii) that is protected under the Paris Convention or the TRIPS Agreement.

(2) The provisions of this section in relation to national flags, other state emblems and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates that flag, other emblem or sign or hallmark.

(3) The reference in subsection (1) to "the competent authority concerned" refers to the relevant authority of a Paris Convention country that has the authority to permit the use of its flag, armorial bearing or other state emblem or official sign or hallmark.

(4) Nothing contained in this section shall prevent the registration of a trade mark on the application of a national of a country who is authorised to make use of a state emblem, or official sign or hallmark, of that country, notwithstanding that it is similar to that of another country.

Refusal of registration of armorial bearings, etc. of intergovern-mental organisations.

20. (1) Subject to subsection (2), the Registrar shall not, without the authorisation of the international organisation concerned, register a trade mark that contains a representation of the armorial bearing, flag or other emblem, or the abbreviation or name, of an international intergovernmental organisation of which one or more Paris Convention countries are members if the armorial bearing, flag or other emblem, or the abbreviation or name, of the international organisation concerned is protected under the Paris Convention or the TRIPS Agreement.

(2) The Registrar may register a trade mark where it appears to him that the use of the armorial bearing, flag or other emblem, or the abbreviation or name, of the international organisation concerned in the manner proposed is not likely to

(a) suggest to the public that a connection exists between the organisation and the trade mark; or

(b) mislead the public as to the existence of a connection between the user and the organisation.

(3) The provisions of this section in relation to emblems of an international organisation apply equally to anything which from a heraldic point of view imitates that emblem.

Notifications in relation to sections 19 and 20.

21. (1) For the purpose of section 19, the state emblem of a Paris Convention country (other than the national flag), and official signs or hallmarks, shall be regarded as protected under the Paris Convention only if, or to the extent that,

(a) the country in question has notified WIPO, the Government of the Virgin Islands or the Government of the United Kingdom acting on behalf of the Virgin Islands, in accordance with Article 6*ter* (3) of the Paris Convention that it desires to protect that emblem, sign or hallmark;

(b) the notification remains in force; and

(c) no objection to the notification has been transmitted to WIPO, the Government of the Virgin Islands or the Government of the United Kingdom acting on behalf of the Virgin Islands, on behalf of the Virgin Islands in accordance with Article 6*ter* (4) of the Paris Convention or any such objection has been withdrawn.

(2) For the purpose of section 20, the emblems, abbreviations and names of an international intergovernmental organisation shall be regarded as protected under the Paris Convention only if, or to the extent that,

(a) the organisation in question has notified WIPO, the Government of the Virgin Islands or the Government of the United Kingdom acting on behalf of the Virgin Islands, in accordance with Article 6*ter* (3) of the Paris Convention that it desires to protect that emblem, abbreviation or name;

(b) the notification remains in force; and

(c) no objection to the notification has been transmitted to WIPO, the Government of the Virgin Islands or the Government of the United Kingdom acting on behalf of the Virgin Islands**,** in accordance with Article 6*ter* (4) or any such objection has been withdrawn.

(3) A notification under Article 6*ter* of the Paris Convention shall have effect only in relation to an application for registration made more than two months after the receipt of the notification.

(4) The Registrar shall keep and make available for public inspection by any person, during the normal business hours of his office and free of charge, a list of

(a) the state emblems and official signs or hallmarks, and

(b) the emblems, abbreviations and names of international intergovernmental organisations,

which are for the time being protected under the Paris Convention by virtue of notifications under Article 6*ter* (3) of that Convention.

(5) A reference in this section to

(a) Article 6*ter* of the Paris Convention shall be construed as including a reference to that Article as applied by the WTO Agreement; and

(b) "WIPO" means the World Intellectual Property Organisation.

Refusal of registration of Royal arms, etc. in relation to the United Kingdom.

22. (1) The Registrar shall not, subject to subsection (2), register a trade mark which, in relation to the United Kingdom, consists or contains

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for the Royal arms or the principal armorial bearings thereof;

(b) a representation of the Royal crown or any of the Royal flags;

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation.

(2) Where it appears to the Registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family, he may register the trade mark.

(3) Where any issue or doubt arises as to whether consent has been given by the relevant member of the Royal family, the Registrar shall refer the matter to the Governor whose opinion on the matter shall be conclusive.

Refusal of registration of national flag of Virgin Islands and United Kingdom.

23. The Registrar shall not register a trade mark which consists of or contains a representation of the national flag of the Virgin Islands or the United Kingdom if it appears to him that the use of the trade mark would be misleading or offensive.

Refusal of registration on grounds of identity, similarity or confusion.

24. (1) The Registrar shall not register a trade mark if

(a) the trade mark is identical to an earlier trade mark; and

(b) the goods or services for which the application for registration is made are identical to those for which the earlier trade mark is protected.

(2) The Registrar shall not register a trade mark if

(a) the trade mark is identical to an earlier trade mark;

(b) the goods or services for which the application for registration is made are similar to those for which the earlier trade mark is protected; and

(c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.

(3) The Registrar shall not register a trade mark if

(a) the trade mark is similar to an earlier trade mark;

(b) the goods or services for which the application for registration is made are identical or similar to those for which the earlier trade mark is protected; and

(c) the use of the trade mark in relation to those goods or services is likely to cause confusion on the part of the public.

(4) Subject to subsection (6), the Registrar shall not register a trade mark which

(a) is identical or similar to an earlier trade mark, and

(b) is proposed to be registered for goods or services that are not identical or similar to those for which the earlier trade mark is protected,

if, or to the extent that, the earlier trade mark is entitled to protection under the Paris Convention as a well-known trade mark and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

(5) Subject to subsection (6), the Registrar shall not register a trade mark if, or to the extent that, its use in the Virgin Islands is liable to be prevented by virtue of

(a) any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade or business; or

(b) an earlier right other than any of those referred to in paragraph (a) or in subsections (1) to (4) , in particular by virtue of the law of copyright or registered design.

(6) The Registrar may refuse to register a trade mark on any one or more of the grounds mentioned in subsections (4) and (5) only if an objection on those grounds is raised in opposition to the registration under this Act by the owner of the earlier trade mark or other earlier right.

(7) Where the grounds for the refusal of registration exist in respect of only some of the goods or services for the application for registration is made, the refusal shall apply to those goods or services only.

(8) Nothing in this section prevents the registration of a trade mark where the owner of the earlier trade mark or other earlier right consents to the registration.

(9) A person who is entitled to prevent the use of a trade mark by virtue of subsection (5) (b) is referred to in this Act as the owner of an “earlier right” in relation to the trade mark.

Registrability of Trade Marks in Certain Cases

Trade marks containing certain words.

25. (1) The Registrar may register a trade mark that contains the words "copyright", "layout design", "patent", "patented", "plant variety right", "registered", "registered design", or "trade mark" or any derivative or abbreviation of those words.

(2) Where an application for the registration of a trade mark contains a word other than a name specified in subsection (1), the Registrar may register the trade mark if the Commission approves the word.

(3) Where under subsection (2) the Commission does not approve a word contained in a trade mark, the Registrar shall

(a) not register the trade mark containing the name; and

(b) inform the applicant in writing, or through such other medium as the Commission may determine, of the Commission's refusal of approval and the reason for the refusal.

(4) For the purposes of this section, the Commission may by an Order published in the *Gazette* approve words that may be contained in a trade mark in addition to the words specified in subsection (1), and any word approved pursuant to subsection (2) may be included in the Order.

Trade marks containing a person's name.

26. Where a person applies for the registration of a sign as a trade mark and the sign contains the name or representation of a person, the Registrar may, as a condition of registration of the trade mark, require the written consent of

(a) that person to whom the trade mark relates, unless the person died ten years or more prior to the date of making of the application; or

(b) the legal representative of the person to whom the trade mark relates if

(i) the person died within ten years prior to the date of making of the application; or

(ii) the Registrar considers that the person's consent cannot for any other reason be obtained.

Honest concurrent use, etc.

27. (1) Nothing contained in section 24 prevents the registration of a trade mark where the Registrar or the Court, as the case may be, is satisfied that

(a) there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right; or

(b) by reason of other special circumstances it is proper for the trade mark to be registered.

(2) The registration of a trade mark by virtue of subsection (1) shall be subject to such limitations and conditions as the Registrar or the Court considers fit to impose.

(3) Nothing contained in this section prevents the Registrar from refusing to register a trade mark on any of the grounds mentioned in sections 15 to 24.

PART II

INFRINGEMENT OF REGISTERED TRADE MARK

Acts of Infringement of Registered Trade Marks

Infringement of rights of owner.

28. For the purposes of this Act, a reference to the infringement of a registered trade mark is to be construed as a reference to any infringement of the rights of the owner.

Infringing a registered trade mark.

29. (1) A person infringes a registered trade mark if he uses, in the course of trade, an infringing sign.

(2) A person also infringes a trade mark if

(a) the trade mark is entitled to protection under the Paris Convention as a well-known trade mark; and

(b) the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

(3) For the purposes of this section, a person uses an infringing sign if, in particular, he

(a) applies the sign to goods or the packaging of goods;

(b) offers or exposes goods for sale under the sign;

(c) puts goods on the market under the sign;

(d) stocks goods under the sign for the purpose of offering or exposing them for sale or of putting them on the market;

(e) offers or supplies services under the sign;

(f) imports or exports goods under the sign; or

(g) uses the sign on business papers or in advertising.

(4) A person who applies a registered trade mark to material intended to be used

(a) for labelling or packaging goods,

(b) as a business paper, or

(c) for advertising goods or services,

shall be treated as a party to any use of the material that infringes the registered trade mark if, when the person applied the mark, he knew or should have reason to believe that the application of the trade mark was not authorised by the owner or a licensee of the trade mark.

(5) Subject to subsection (6), nothing contained in subsection (4) shall be construed as preventing the use of a registered trade mark by a person for the purpose of identifying goods or services as those of the owner or licensee of the trade mark.

(6) The use of a trade mark otherwise than in accordance with honest practices in industrial or commercial matters (such as comparative advertising) shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

Exceptions to Infringement of Registered Trade Marks

Exceptions to infringement.

30. (1) Without prejudice to section 29, a registered trade mark is not infringed by the use of another trade mark in relation to goods or services for which the latter is registered.

(2) A registered trade mark is not infringed by the use

(a) by a person of his own name or address or the name of his place of business;

(b) by a person of the name of his predecessor in business or the name of the predecessor's place of business; or

(c) of a sign which serves to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods or rendering of services, or other characteristics of goods or services; or

(d) of the trade mark where it is necessary to indicate the intended purpose of goods or services (for instance, as accessories or spare parts), if the use is in accordance with honest practices in industrial or commercial matters.

(3) A registered trade mark is not infringed by the use by a person in the course of trade in the Virgin Islands of an unregistered trade mark or other sign in relation to goods or services if the unregistered trade mark or other sign has been so used in the Virgin Islands by that person or a predecessor in title continuously from a date preceding the earlier of

(a) the date of first use in the Virgin Islands of the trade mark which is registered; and

(b) the date of registration in the Virgin Islands of that trade mark.

Exhaustion of rights conferred by registered trade mark.

31. (1) Notwithstanding the provisions of section 29, a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market anywhere in the world under that trade mark by the owner or with his consent, whether express or implied or conditional or unconditional.

(2) Subsection (1) does not apply where

(a) the condition of the goods has been changed or impaired after they have been put on the market; and

(b) the use of the registered trade mark in relation to those goods is detrimental to the distinctive character or repute of the trade mark.

Exception in relation to use in advertising, etc.

32. (1) Subject to subsection (2), nothing contained in section 29 shall be construed as preventing the use by a person of a registered trade mark for the purpose of identifying goods or services as those of the owner of the registered trade mark or a licensee thereof.

(2) The use by a person of a registered trade mark for the purpose outlined in subsection (1) which is otherwise than in accordance with honest practices in industrial or commercial matters shall be construed as infringing the registered trade mark.

(3) In making a determination for the purpose of subsection (2) whether the use by a person of a registered trade mark is in accordance with honest practices in industrial or commercial matters, the Court may consider such factors as it considers relevant, including, in particular, whether the use

(a) takes unfair advantage of the registered trade mark;

(b) is detrimental to the distinctive character or repute of the registered trade mark; or

(c) is such as to deceive the public.

(4) The application of this section is without prejudice to the operation of section 31.

PART III

APPLICATION FOR REGISTRATION OF TRADE MARKS

Appointment, Qualifications and Functions of Trade Mark Agents

Requirement for appointment of a registered trade mark agent, payment of fees, etc.

33. (1) Every application for the registration of a trade mark shall be effected by a registered trade mark agent.

(2) Subject to section 34, the Commission may, upon

(a) the receipt of a written application in the prescribed manner, and

(b) payment of the prescribed fee,

approve or refuse to approve a person to act as a registered trade mark agent.

(3) Where the Commission refuses to approve a person as a registered trade mark agent, the Registrar shall communicate that fact in writing to the person concerned outlining the Commission's reason for its refusal.

(4) A person who is approved to act as a registered trade mark agent under subsection (1) may at any time apply to the Commission to cancel or revoke the approval.

(5) The Commission may on its own motion suspend, cancel or revoke the approval of a person to act as a registered trade mark agent if it is satisfied that the person is no longer qualified under section 34 or it is in the public interest to do so.

(6) The payment of the prescribed fee referred to in subsection (2) (b) is valid for one year and is subject to an annual renewal for the continued validity of the approval of a registered trade mark agent.

Qualification for a registered trade mark agent.

34. (1) A trade mark agent may be an individual, a partnership or a legal person.

(2) Where an applicant for approval as a registered trade mark agent is an individual, the Commission shall satisfy itself that

(a) the individual

(i) is fit and proper in accordance with Schedule 1A of the Regulatory Code, 2009;

S.I. No. 60 of 2009

(ii) meets any additional requirement prescribed in the

Commission's Guidelines for the Approved Persons Regime in respect of a senior officer or such other guidelines as the Commission may issue from time to time;

(iii) has an appreciable knowledge of trade mark law; and

(iv) is competent to perform the duties of a registered trade mark agent, having regard to his qualifications and experience; and

(b) it is not against the public interest to grant approval to the individual.

(3) Where an applicant for approval as a registered trade mark agent is a partnership, the Commission shall satisfy itself that

(a) the partnership

No. 5 of 1996

(i) is registered under the Partnership Act, 1996;

(ii) is fit and proper in accordance with Schedule 1A of the Regulatory Code, 2009;

(iii) has at least one individual within the partnership who

(aa) is fit and proper in accordance with Schedule 1A of the Regulatory Code, 2009 and has an appreciable knowledge of trade mark law; and

(bb) meets any additional requirement prescribed in the Commission's Guidelines for the Approved Persons Regime in respect of a senior officer or such other guidelines as the Commission may issue from time to time;

(iv) is competent to perform the duties of a registered trade mark agent, having regard to the qualifications and experience of its staff; and

(b) it is not against the public interest to grant approval to the partnership.

(4) Where an applicant for approval as a trade mark agent is a legal person, the Commission shall satisfy itself that

(a) the person

(i) is licensed by the Commission as a registered agent under

No. 9 of 1990

the Banks and Trust Companies Act, 1990; or

No. 16 of 2004

(ii) is incorporated or continued as a company under the BVI Business Companies Act, 2004 for the purpose of performing the functions of a trade mark agent; and

(iii) is fit and proper in accordance with Schedule 1A of the Regulatory Code, 2009;

(iv) has at least one individual within the legal person who

(aa) is fit and proper in accordance with Schedule 1A of the Regulatory Code, 2009 and has an appreciable knowledge of trade mark law; and

(bb) meets any additional requirement prescribed in the Commission's Guidelines for the Approved Persons Regime in respect of a senior officer or such other guidelines as the Commission may issue from time to time; and

(v) is competent to perform the duties of a registered trade mark agent, having regard to the qualifications and experience of its staff; and

(b) it is not against the public interest to grant approval to the person.

(5) For the purposes of subsections (2) (a) (iii) and (iv), (3) (a) (iii) (aa) and (iv) and (4) (a) (iv) (aa) and (v), the question as to whether an individual has an appreciable knowledge of trade mark law or a person is competent to perform the duties of a trade mark agent shall be determined by the Commission.

Functions of a registered trade mark agent.

35. (1) The functions of a registered trade mark agent, in relation to a trade mark owner, are

(a) to act as the intermediary between the trade mark owner and the Commission and Registrar;

(b) to file applications to the Registrar, pay application fees and perform related duties on behalf of the trade mark owner;

(c) to accept service of notice or process or other documents on behalf of the trade mark owner;

(d) to respond to any inquiries from the Commission or Registrar in relation to a trade mark owner or an application on behalf of a trade mark owner and any related matters; and

(e) to keep in the trade mark agent's office in the Virgin Islands such records or copies of such records as may be prescribed.

(2) Regulations made under this Act may prescribe such additional functions in respect of a trade mark agent as may be considered necessary.

Application to Register a Trade Mark

Application for registration of a trade mark.

36. (1) An application to register a trade mark shall be filed with the Registrar in the prescribed form.

(2) The application referred to in subsection (1) shall include the following:

(a) a request for registration of the trade mark;

(b) the name and address of the applicant;

(c) a statement of the goods or services in relation to which it is sought to register the trade mark;

(d) a representation of the trade mark; and

(e) such other information, document or matter as may be prescribed.

(3) The application shall state whether

(a) the trade mark is being used, by the applicant or with his consent, in relation to the goods or services in respect of which it is sought to be registered; or

(b) the applicant honestly intends to use the trade mark, or to allow it to be used, in relation to the goods or services concerned.

(4) Subject to subsection (5), the application shall be filed in the English language.

(5) Where a representation of the trade mark is accompanied or described by words or numerals other than English words or numerals and form part of the trade mark sought to be registered, the application shall be accompanied by a certified translation into, or equivalent meaning or transliteration in, the English language of those words or numerals.

(6) The rules may prescribe

(a) the number of representations of a trade mark that must be submitted along with the application;

(b) the acceptance of words or numerals that are in a language other than the English language and which are not capable of translation or attributing an equivalent meaning to; and

(c) the representation and acceptance of a trade mark accompanied or described by a symbol, irrespective of the origin of the symbol but subject to the restrictions provided in this Act with respect to the registration of trade marks.

Joint applications.

37. An application for the registration of a trade mark may be made by two or more persons if either or any of them is entitled to use the trade mark only on behalf of both or all of them, or in relation to goods or services with which both or all of them are connected in the course of trade.

Filing date of application.

38. (1) The date of filing of an application for registration of a trade mark is the date on which documents containing all the requirements outlined in section 36 are filed with the Registrar.

(2) Where the documents are filed on different dates, the date of filing is the last of those dates.

(3) A reference in this Act to the date of application for registration of a trade mark shall be construed as a reference to the date of filing of the application for registration.

Classification of Goods and Services

Classification of goods and services.

39. (1) The registration and any publication effected by the Registrar in relation to any goods or services shall indicate the goods or services by their names grouped according to the class of classification of goods or services and each group shall

(a) be preceded by the number of the class of that classification to which that group of goods or services belongs; and

(b) be presented in the order of the classes of the classification of goods or services.

(2) Goods or services may not be considered to be similar to each other on the ground that, in any registration or publication by the Registrar, they appear in the same class of the classification of goods or services.

(3) Goods or services may not be considered to be dissimilar from each other on the ground that, in any registration or publication by the Registrar, they appear in different classes of the classification of goods or services.

Single registration for goods or services in several classes.

40. Where goods or services that belong to several classes of the classification of goods or services are included in the same application, the acceptance of the application shall result in the registration of the same goods or services comprised in the application.

Division of application and registration.

41. (1) An application for the registration of a trade mark listing goods or services may,

(a) until the Registrar makes a decision on the registration of the trade mark,

(b) during any opposition proceedings against the registration of the trade mark, or

(c) during any appeal proceedings against any decision with respect to the registration of the trade mark,

be divided by the applicant into two or more applications by distributing among the latter applications goods or services listed in the initial application.

(2) The division of an application under subsection (1) shall preserve the filing date of the initial application and the benefit of the right of priority, if any.

(3) Subsections (1) and (2) apply with respect to a division of a registration the same way as it applies in relation to an application, during any opposition proceedings or appeal concerning the validity of the registration.

Priority of Applications

Priority of applications in respect of identical or similar trade marks.

42. (1) Where different persons apply for the registration of trade marks that

(a) are identical or similar to each other, and

(b) are in respect of identical or similar goods or services,

the first application received by the Registrar shall have priority over all the other applications and may be dealt with accordingly.

(2) Where different persons separately apply for the registration of trade marks

(a) that are identical or similar to each other,

(b) that are in respect of identical or similar goods or services, and

(c) whose applications are received by the Registrar at the same time,

each application has equal priority and may be dealt with accordingly and the Registrar shall notify each applicant of each other's application.

(3) For the purposes of subsection (2), two or more applications that are received by the Registrar on the same day shall be treated as if they were received at the same time.

(4) The application of this section is subject to section 43.

Claim to priority.

43. (1) A person who has duly filed an application for the registration of a trade mark in a Paris Convention country (the "Convention application") or WTO member (the "WTO application"), or his successor in title, has a right of priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

(2) Where the application for registration under this Act is made within the six-month period referred to in subsection (1),

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application or WTO application, as the case may be; and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the Virgin Islands in the period between that date and the date of the application for registration under this Act.

(3) Any filing of an application for registration of a trade mark in, or in respect of, a Paris Convention country or WTO member which, under the laws of that country or member or under any bilateral or international agreement to which it is a party, is equivalent to a regular national filing, shall be treated as giving rise to a right of priority.

(4) A subsequent application for registration of a trade mark that was the subject of a previous application and that is filed in a Paris Convention country or WTO member, shall be considered as the first application for the purpose of determining priority if, on the date of filing of the subsequent application,

(a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and

(b) it has not yet served as a basis for claiming a right of priority.

(5) The previous application referred to in subsection (4) may not thereafter serve as a basis for claiming a right of priority.

(6) The rules may provide the manner of claiming a right to priority on the basis of a Convention application or WTO application, as the case may be.

(7) A right to priority that arises as a result of a Convention application or WTO application, as the case may be, may be assigned or otherwise transmitted, either with the application or independently, and the reference in subsection (1) to the person's "successor in title" shall be construed accordingly.

(8) The reference in subsection (3) to "a regular national filing" means a filing of an application for registration of a trade mark in a Paris Convention country or WTO member that establishes the date on which the application was filed, whatever the outcome of the application may be.

Obligation to inform applicants without priority.

44. The Registrar shall

(a) notify an applicant of his order of priority where the applicant's application does not have

(i) priority over all other applications under section 42 (1) or 43; or

(ii) have equal priority under section 42 (2); and

(b) determine, according to its order of priority, each application.

Procedure for Registration of a Trade Mark

Examination of application.

45. (1) Upon receipt of an application for the registration of a trade mark, the Registrar shall examine the application in order to ensure that the requirements for registration under this Act have been satisfied, including any requirements that may be prescribed.

(2) For the purposes of subsection (1), the Registrar shall carry out a search of earlier trade marks to such extent as he considers necessary.

Acceptance or otherwise of an application.

46. (1) Where the Registrar is satisfied that the requirements for registration of a trade mark are met, he shall, subject to any condition he considers fit to impose, accept the application.

(2) Where it appears to the Registrar that the requirements for the registration of a trade mark are not met, he shall, by notice, inform the applicant

(a) of his opinion regarding the requirements that are not met;

(b) to take any necessary measures the applicant considers fit to comply with the outstanding requirements;

(c) that, where the applicant considers that the application meets all the requirements, to make written representations to the Registrar to that effect;

(d) that the applicant may amend the application so as to meet the outstanding requirements; and

(e) of the provisions of section 47 (1).

(3) For the purposes of subsection (2) (b), (c) and (d), the Registrar shall specify such period as he considers appropriate, being not less than fourteen days and not more than sixty days from the date of the notice, within which the applicant must meet the outstanding requirements.

(4) Notwithstanding subsection (3), where it appears reasonable to the Registrar that the applicant should be given a period greater than sixty days to meet the outstanding requirements, he may, upon application of the applicant, grant the applicant an extension of time for such additional period not exceeding sixty days as the Registrar considers appropriate in all the circumstances.

Abandonment of application.

47. (1) Where in respect of an application for the registration of a trade mark, the applicant

(a) fails to respond to the notice within the period specified pursuant to section 46 (3) or, if an extension had been granted pursuant to section 46 (4), within the period of the extension, or

(b) fails, before the end of the period referred to in paragraph (a), to satisfy the Registrar that the outstanding requirements for registration are met or to amend the application so as to meet those requirements,

the application shall, subject to subsection (2), be treated as abandoned and the Registrar shall refuse to accept the application for registration of the trade mark.

(2) The Registrar shall not treat an application as abandoned under subsection (1) if the application is awaiting the outcome of

(a) opposition proceedings in respect of a prior application; or

(b) cancellation, revocation or invalidity proceedings in respect of a prior application,

and therefore in either case any period specified in section 46 (3) or (4) shall be subject to the outcome of those proceedings.

(3) The Registrar shall notify the applicant of any decision made by him under subsection (1).

Publication of application.

48. Where the Registrar accepts an application for registration of a trade mark under section 46 (1), he shall cause the application to be published in the *Gazette*.

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Withdrawal and amendment of application.

49. (1) An applicant for registration of a trade mark may at any time

(a) withdraw the application or restrict the goods or services covered by the application; or

(b) request the Registrar in writing to amend the application by correcting

(i) the name or address of the applicant;

(ii) an obvious mistake; or

(iii) an error or omission if, in the opinion of the Registrar, the correction of the error or omission does not materially alter the meaning or scope of the application.

(2) Where the application has been published pursuant to section 48, the withdrawal or alteration shall also be published in the manner prescribed in that section.

(3) The rules shall provide for

(a) the publication of particulars of any amendment which affects the representation of the trade mark, or the goods or services covered by the application; and

(b) the making of objections by any person claiming to be affected by the amendment.

Power to rescind an application.

50. (1) The Registrar may rescind the acceptance by him of an application under section 46 (1) before the trade mark to which the application relates is registered, if he is satisfied

(a) that, having regard to matters coming to his notice since he accepted the application, the application was accepted in error; or

(b) another application that relates to the trade mark concerned has priority under this Act.

(2) Where the Registrar rescinds an application under subsection (1),

(a) the application shall be treated as if it had not been accepted;

(b) the Registrar shall notify the applicant of the fact of the rescission and the reason therefor; and

(c) sections 45 to 49 apply afresh in relation to the application.

Opposition to an Application

Notice of opposition.

51. (1) Where the Registrar publishes an application under section 48, any person with interest may, within the prescribed period from the date of publication of the application, give notice to the Registrar in the prescribed form indicating his opposition to the registration of the trade mark to which the application relates.

(2) A notice of opposition under subsection (1) shall include a statement of the grounds of opposition, and no notice of opposition shall be considered by the Registrar if it fails to state the grounds of the opposition.

(3) For the purposes of subsection (1), a person may be considered to have interest in an application for the registration of a trade mark if he

(a) claims to be the owner of the trade mark;

(b) is the holder of a licence in respect of the trade mark;

(c) establishes some connection with the trade mark as convinces the Registrar that he has a legitimate interest to protect;

(d) is the owner or a licensee of a prior trade mark which is identical or similar to the trade mark that is the subject of the application and any registration of the latter trade mark is likely to confuse or mislead the public;

(e) claims that the registration of the trade mark will not be in the public interest and provides the reason for that claim which the Registrar accepts as reasonable;

(f) establishes that the registration of the trade mark will violate a provision of this Act or any rule, regulation or Order made thereunder; or

(g) establishes any other reason that is prescribed.

Observations in relation to an application.

52. (1) Where an application has been published under section 48, any person may, at any time before the trade mark to which the application relates is registered, make observations in writing addressed to the Registrar as to whether the trade mark should be registered.

(2) The Registrar shall inform the applicant of any observations received by the Registrar under subsection (1).

(3) A person who makes observations under subsection (1) does not, as a result of making those observations, become a party to any proceedings in respect of the application.

Applicant's opportunity to respond to opposition.

53. (1) Where the Registrar receives a notice of opposition under section 51 (1) which includes a statement of the grounds of opposition, he shall transmit a copy of the notice of opposition to the applicant inviting the applicant to provide, within such period as the Registrar shall specify, a counter-statement of the grounds on which the applicant relies for his application.

(2) If the applicant fails to provide a counter-statement to the Registrar within the period specified by the Registrar, the applicant shall be deemed to have abandoned his application.

(3) Where the applicant submits a counter-statement to the Registrar within the period specified by the Registrar, the Registrar shall send a copy of the counter-statement to the person who gave notice of opposition.

(4) The period to be specified by the Registrar for the purposes of subsection (1) shall be not less than twenty-one days and not more than sixty days from the date a copy of the notice of opposition is transmitted to the applicant.

(5) Notwithstanding subsection (4), where it appears reasonable to the Registrar that the applicant should be given a period greater than sixty days to provide a counter-statement of the grounds on which the applicant relies for his application, the Registrar may, upon application of the applicant, grant the applicant an extension of time for an additional period not exceeding thirty days as the Registrar considers appropriate in all the circumstances.

Determination of opposition.

54. (1) Where the Registrar receives a notice of opposition and a counter-statement, he

(a) may rely on the notice of opposition and the applicant's counter-statement, including the application, to make his decision; or

(b) may give the parties the opportunity to make oral presentations before him and consider the evidence presented to him; and

(c) shall determine whether, and subject to what conditions (if any), the trade mark is to be registered.

(2) A person who gives a notice of opposition may at any time before the determination of the opposition by the Registrar withdraw in the prescribed form his opposition to the application.

PART IV

REGISTRATION OF TRADE MARKS

Registration, Duration, Renewal and Alteration of a Trade Mark

Duty to register trade mark.

55. (1) Where an application has been accepted by the Registrar under section 46 (1) and

(a) the disabilities outlined in sections 47 (2) and 50 (1) do not apply,

(b) no notice of opposition is given within the prescribed period referred to in section 51 (1),

(c) all opposition proceedings, if any, are withdrawn or decided in favour of the applicant under section 54, and

(d) the required fees for registration have been paid,

the Registrar shall register the trade mark by entering the prescribed particulars in the register, unless section 50 (1) applies.

(2) The Registrar shall, upon registration of a trade mark under subsection (1),

(a) issue to the applicant a certificate of registration in the prescribed form; and

(b) cause to be published in the *Gazette* a notice indicating the registration of the trade mark.

Issuing a duplicate certificate of registration.

56. (1) The Registrar may issue a duplicate certificate of registration if

(a) he receives an application for that purpose in the prescribed form;

(b) the prescribed fee has been paid; and

(c) he is satisfied that the certificate of registration in respect of which a duplicate certificate of registration is being requested has been lost or

destroyed or in any other case in which he thinks it is expedient to do so.

(2) A duplicate certificate of registration issued by the Registrar shall have the same effect as the certificate of registration that was originally issued by him.

Date of registration.

57. A trade mark shall be registered as of the date of filing of the application for registration and that date shall be deemed, for the purposes of this Act, to be the date of registration of the trade mark.

Duration of registration.

58. A trade mark shall be registered for a period of ten years from the date of registration and may be renewed for further periods of ten years in accordance with section 59.

Renewal of registration.

59. (1) The owner of a registered trade mark may request the renewal of registration of the trade mark which shall

(a) be made in such form as may be prescribed; and

(b) be subject to the payment of renewal fees as may be prescribed.

(2) Where the Registrar receives a request which complies with subsection (1), he shall renew the registration of a trade mark which shall take effect from the date of expiry of the previous registration.

(3) Where, at least one month prior to the expiry of a registered trade mark, the owner of the trade mark has not made a request under subsection (1), the Registrar may, in the prescribed manner, send to the owner of the trade mark a notice outlining

(a) the date on which the registration of the trade mark will expire;

(b) the requirement for payment of renewal fees; and

(c) that the registration of the trade mark will be removed from the register at the expiry of the period of ten years unless renewed.

(4) If the registration of a trade mark is not renewed in accordance with subsection (2), the Registrar shall, without prejudice to subsection (5), remove the trade mark from the register.

(5) The rules may make provision for the restoration of the registration of a trade mark that has been removed from the register under subsection (4), subject to such conditions as may be prescribed.

(6) A failure by the Registrar to send a notice under subsection (3) shall not

(a) make the Registrar or the Commission liable to any act or omission of the owner of the registered trade mark or his licensee or registered trade mark agent;

(b) prohibit the Registrar from acting in accordance with subsection (4); or

(c) limit the liability of the registered trade mark owner to any obligation under this Act or the rules or regulations or any Order made under this Act.

(7) The Registrar shall cause the renewal or restoration of the registration of a trade mark to be published in the *Gazette*.

Alteration of registered trade mark.

60. (1) Subject to subsection (2), the Registrar shall not, during the period of registration or on renewal of registration, alter a registered trade mark.

(2) The Registrar may, at the request of an owner of a registered trade mark which contains or consists of the name or address of the owner or any previous owner, alter that name or address but only to the extent that the alteration does not substantially affect the identity of the trade mark.

(3) The rules may make provision with regard to

(a) the effect of an alteration made under subsection (2);

(b) the publication of the particulars of an alteration in the *Gazette*; and

(c) the making of objections by any person claiming to be affected by the alteration.

Variation, Division, Merger, Cancellation, etc. of Registered Trade Mark

Variation or cancellation of registration.

61. (1) Any person may make an application to the Registrar or the Court for the variation or cancellation of the registration of a trade mark.

(2) The registration of a trade mark may, subject to section 62, be varied or cancelled only on the ground that there has been a contravention of, or a failure to observe, any condition entered in the register in relation to the trade mark.

Cancellation by trade mark owner.

62. (1) The owner of a registered trade mark may apply to the Registrar in the prescribed form for the registration of his trade mark to be cancelled, and the Registrar shall, subject to subsection (3), cancel the registration.

(2) An application under subsection (1) may relate to some or all of the goods or services for which the trade mark is registered.

(3) The Registrar shall not cancel the registration of a trade mark under subsection (1), unless the certificate of registration in respect of the trade mark has been surrendered to the Registrar.

(4) The rules may provide for the protection of the interests of other persons who have a right in the trade mark.

Variation or cancellation of registration of certification trade mark.

63. (1) The Registrar may, either on his own motion or on the application of an aggrieved person, vary or cancel an entry in the register that relates to a certification trade mark on the ground that

(a) the owner is no longer competent to certify any goods or services in respect of which the certification trade mark is registered;

(b) the owner has not complied with a condition of the certification trade mark;

(c) it is not in the public interest for the certification trade mark to continue to be registered; or

(d) it is in the public interest that the certification trade mark be varied.

(2) The Registrar shall not make any variation or cancellation under subsection (1) unless he has given the owner of the certification trade mark at least thirty days notice

(a) indicating the Registrar's intention to vary or cancel the entry in the register;

(b) indicating the ground on which the Registrar relies for his decision; and

(c) giving the owner the opportunity to make representation to the Registrar as to why the Registrar should not carry out his intended decision.

(3) Where the Registrar takes a decision under subsection (1), he shall inform the owner of the certification trade mark and, where the decision was taken pursuant to an application by an aggrieved person, inform that person as well, of his decision and the reason for the decision.

Variation or cancellation of registration of collective trade mark.

64. (1) The Registrar may, either on his own motion or on the application of an aggrieved person, vary or cancel an entry in the register that relates to a collective trade mark on the ground that

(a) the collective association concerned is an unlawful association by virtue of any enactment;

(b) the collective association has ceased to exist;

(c) it is not in the public interest for the collective trade mark to continue to be registered; or

(d) it is in the public interest that the collective trade mark be varied.

(2) The Registrar shall not make any variation or cancellation under subsection (1) unless he has given the owner of the collective trade mark at least thirty days notice

(a) indicating the Registrar's intention to vary or cancel the entry in the register;

(b) indicating the ground on which the Registrar relies for his decision; and

(c) giving the owner the opportunity to make representation to the Registrar as to why the Registrar should not carry out his intended decision.

(2) Where the Registrar takes a decision under subsection (1) (a), (c) or (d), he shall inform the owner of the collective trade mark of his decision and the reason for the decision and, where the decision was taken pursuant to an application by an aggrieved person, inform that person as well, of his decision and the reason for the decision.

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Opinion of the Commission to be sought.

65. The Registrar shall not take a decision under section 63 (1) (c) or (d) or section 64(c) or (d) unless he first seeks the opinion of the Commission and he shall be guided by that opinion in making his determination.

Division, merger and registration of series of trade mark.

66. (1) The rules may make provision for

(a) the division of an application for the registration of a trade mark into several applications with equal protection under this Act;

(b) the merging of separate applications for registration of a trade mark with equal protection under this Act;

(c) the merging of separate registrations with equal protection under this Act; and

(d) the registration of a series of trade marks.

(2) The rules made under subsection (1) may include provision with regard to

(a) the circumstances in which, and conditions subject to which, the division of an application for registration, the merging of separate applications or registrations, or the registration of a series of trade marks, is permitted;

(b) the effect of a division of an application for registration of a merger of separate applications or registrations; and

(c) the purposes for which an application for the registration of a trade mark is to be treated as a single application and those for which it is to be treated as a number of separate applications.

Revocation and Invalidity

Revocation of registration.

67. (1) A person who is aggrieved may make an application either to the Registrar or the Court for the revocation of registration of a trade mark.

(2) The Registrar or the Court may revoke the registration of a trade mark on the ground that

(a) the trade mark has not, since its registration, been put to genuine use by the owner or by another with his consent, in relation to the goods or services for which it is registered, for a continuous period of at least three years, and there is no valid reason for non-use;

(b) the trade mark consists of a sign that, in consequence of the acts or inactivity of the owner,

(i) has become the common name in the trade for goods or services for which the trade mark is registered; or

(ii) has become generally accepted within the trade as the sign that describes goods or services for which the trade mark is registered;

(c) in consequence of the use made of it by the owner or by another with his consent, in relation to the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as

to the nature, quality or geographical origin of those goods or services; or

(d) there has been a contravention of, or a failure to observe, a condition entered in the register in relation to its registration.

(3) Subject to subsection (4), the registration of a trade mark shall not be revoked on the ground mentioned in subsection (2) (a) if

(a) the use described in that subsection is commenced or resumed after the expiry of the three-year period and before the application for revocation is made; or

(b) there are circumstances that have arisen independently of the will of the owner which constitute an obstacle to the use of the trade mark.

(4) A commencement or resumption of the use described in subsection (2) (a) after the expiry of the three-year period but within the period of three months before the making of the application for revocation shall be disregarded, unless preparation for the commencement or resumption began before the owner of the registered trade mark became aware that the application might be made.

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the owner shall be deemed to have ceased to that extent as

(a) from the date of the application for revocation; or

(b) from, if the Registrar or the Court is satisfied that the grounds for revocation existed at an earlier date, that earlier date.

(7) For the purposes of

(a) subsection (2), use of a trade mark includes use in a form which differs in elements which do not alter the distinctive character of the trade mark in the form in which it was registered; and

(b) subsection (3) (b), the rules may provide the circumstances that are to be recognised as valid reasons for non-use of a trade mark.

Proof of use in opposition.

68. (1) A person who makes an application under section 67 (1) for the revocation of registration of a registered trade mark shall serve a notice of the application on the owner and, where there is a licensee, on the licensee as well.

(2) Where an owner or a licensee intends to oppose an application for the revocation of the registration of a trade mark under section 66 (2) (a) or (b), the owner or licensee, as the case may be, shall, within such period as may be prescribed,

(a) provide proof of the use of the trade mark if the grounds outlined in section 67 (2) (a) or (b) form the basis of the application; or

(b) raise and specify the circumstances that justify the non-use of the trade mark where section 67 (7) applies.

Declaration of invalidity.

69. (1) A person who is aggrieved may make an application either to the Registrar or the Court for a declaration of invalidity of the registration of a trade mark, save that if

(a) proceedings in respect of the trade mark are pending before the Court, the application shall be made to the Court; and

(b) in any other case the application is made to the Registrar, the Registrar may at any stage of the proceedings before him refer the application to the Court for determination.

(2) Where the Registrar forms the opinion that there has been a case of bad faith in the registration of a trade mark, he may make an application to the Court for a declaration of the invalidity of the registration.

(3) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 15, 16 or 17.

(4) Where the trade mark was registered in contravention of section 15 (1), (b), (c) or (d), it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(5) Subject to subsections (6) and (7), the registration of a trade mark may also be declared invalid on the ground that there

(a) is an earlier trade mark in relation to which the conditions outlined in section 24 (1), (2) or (3) apply; or

(b) is an earlier right in relation to which the condition outlined in section 24 (4) or (5) is satisfied.

(6) The registration of a trade mark may not be declared invalid under subsection (5) if the owner of the earlier trade mark or other earlier right has given his consent to the registration.

(7) Where a trade mark has been registered on the ground that there has been an honest concurrent use of the trade mark and the earlier trade mark or other earlier right as provided for under section 27, the registration of a trade mark may not be declared invalid under subsection (5) unless the Registrar or the Court, as the case may be, is satisfied that in fact there has been no honest concurrent use of the trade mark and the earlier trade mark or other earlier right.

(8) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid only in respect of those goods or services.

Effect of declaration of invalidity.

70. Without prejudice to transactions past and closed, where the registration of a trade mark is declared invalid to any extent,

(a) the registration shall to that extent be deemed never to have been made; and

(b) the Registrar shall amend the register as appropriate.

Acquiescence in use of registered trade mark.

71. (1) Subject to subsection (2), where the owner of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the Virgin Islands, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right

(a) to apply for a declaration that the registration of the later trade mark is invalid; or

(b) to oppose the use of the later trade mark in relation to the goods or services in respect of which it has been so used.

(2) The disentitlement referred to in subsection (1) shall not apply where it is established that the later trade mark was applied for in bad faith.

(3) Where subsection (1) applies, the owner of the later trade mark is not entitled to oppose the use of the earlier trade mark or the exploitation of the earlier right, as the case may be, notwithstanding that the earlier trade mark or earlier right may no longer be invoked against his later trade mark.

Disclaimer of Use of a Trade Mark

Voluntary disclaimer of part of trade mark.

72. The owner of a registered trade mark may disclaim any right to the exclusive use of any part of the trade mark.

Disclaimer as condition of non-revocation.

73. Where the grounds outlined in section 67 (2) (b) exist, the Registrar or the Court, as the case may be, may, as a condition of the registration of a trade mark not being revoked and where considered feasible, require the owner of the trade mark to disclaim any right to the exclusive use of a word or other item in relation to any goods or services.

Disclaimer on public interest grounds.

74. (1) Where, in determining whether a trade mark is to be registered or is to remain on the register, the Registrar or the Court forms the view that there are public interest reasons for doing so, the Registrar or the Court, as the case may be, may require, as a condition of the trade mark being on the register, that the owner

(a) disclaims any right to the exclusive use of any part of the trade mark; or

(b) makes any other disclaimer considered necessary for the purpose of defining the owner's rights under the registration.

(2) Any disclaimer made under this section, or section 72 or 73, shall affect only those rights of the owner of the trade mark that arise out of the registration of the trade mark in respect of which the trade mark is made.

Defensive Trade Marks

Registration of defensive trade mark.

75. (1) Where a registered trade mark has been used so much in relation to all or any of the goods or services for which it has become exceptionally well-known in the Virgin Islands and, as a result, its use in relation to other goods or services would be likely to detract from its distinctive character with regard to the goods or services for which it has been so used, the trade mark may, on the application of the owner of the registered trade mark made to the Registrar, be registered as a defensive trade mark in respect of any or all of those goods or services.

(2) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if

(a) the owner of the registered trade mark does not use or intend to use the trade mark in relation to those goods or services; or

(b) the trade mark is already registered (otherwise than as a defensive trade mark) in the name of the applicant in respect of those goods or services.

(3) A trade mark that is registered as a defensive trade mark in respect of particular goods or services may be subsequently registered (otherwise than as a defensive trade mark) in the name of the owner of the registered trade mark in respect of the same goods or services.

(4) The Registrar shall refuse an application made under subsection (1) if

(a) the trade mark is not registered as such in the name of the applicant; or

(b) the extent to which the registered trade mark is being or has been used does not accord with the circumstances described in that subsection.

Revocation of registration of defensive trade mark.

76. (1) Any aggrieved person may apply to the Registrar or the Court for the revocation of the registration of a trade mark as a defensive trade mark on the ground that

(a) the trade mark is not otherwise registered in the name of the owner of the registered defensive trade mark; or

(b) the extent to which the registered trade mark is being or has been used does not accord with the circumstances described in section 73 (1).

(2) A revocation effected pursuant to subsection (1) may be in respect of all or any of the goods or services in relation to which the registered trade mark is registered as a defensive trade mark.

(3) Sections 36 (3) and 67 (2) (a), (b) and (c) and such other provisions of this Act as may be inconsistent with this section shall not apply in relation to defensive trade marks.

PART V

CO-OWNERSHIP, ASSIGNMENT AND LICENSING OF REGISTERED TRADE MARK

Co-ownership of Trade Mark

Entitlement as regards joint registration.

77. Where a registered trade mark is granted to two or more persons jointly, each of those persons is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

Rights as between co-owners.

78. (1) This section applies where two or more persons are co-owners of a registered trade mark, whether by virtue of section 77 or otherwise.

(2) Subject to subsection (3) and to any agreement to the contrary, each co-owner of a registered trade mark is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to any other co-owner, any act which would otherwise constitute an infringement of the registered trade mark.

(3) One co-owner may not, without the consent of each other co-owner,

(a) grant a licence to use the registered trade mark; or

(b) assign or charge his share in the registered trade mark.

(4) A co-owner of a registered trade mark may commence infringement proceedings, but he may not, without leave of the Court, proceed with the action unless each other co-owner is joined as a plaintiff or added as a defendant.

(5) A co-owner who is added as a defendant under subsection (4) shall not be liable for any costs in the infringement proceedings, unless he takes part in the proceedings.

(6) Nothing in this section or section 77 affects

(a) the granting of interlocutory relief on the application of a single co-owner or more than one co-owner; and

(b) the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

Assignment or Transmission

Registered trade mark transmissible by assignment, etc.

79. (1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property.

(2) A registered trade mark is transmissible in the manner provided in subsection (1) either in connection with the goodwill of a business or independently.

(3) An assignment or other transmission of a registered trade mark may be partial and thus limited so as to apply in relation

(a) to some but not all of the goods or services for which the trade mark is registered; or

(b) to use of the trade mark in a particular manner or a particular locality.

(4) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is

(a) made in writing; and

(b) signed by or on behalf of the assignor or his personal representative.

(5) The requirement in subsection (4) may be satisfied, in a case where the assignor or personal representative is a body corporate, by the affixing of the seal of the corporate body.

(6) This section applies to an assignment by way of security as in relation to any other assignment.

Registered trade mark chargeable.

80. (1) A registered trade mark may be the subject of a charge in the same way as other personal or moveable property.

(2) Nothing contained in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

Registrable transactions.

81. (1) Where the Registrar receives an application from

(a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction, or

(b) any other person claiming to be affected by a registrable transaction,

the Registrar shall enter in the register the prescribed particulars of the transaction.

(2) The following shall constitute registrable transactions:

(a) an assignment of a registered trade mark or any right in it;

(b) the grant of a licence under a registered trade mark;

(c) the granting of any security interest, whether fixed or floating, over a registered trade mark or any right in or under it;

(d) the making by a personal representative of an assent in relation to a registered trade mark or any right in or under it; and

(e) an order of a court, or any authority recognised by the Commission as a competent authority, transferring a registered trade mark or any right in or under it.

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction,

(a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of the transaction; and

(b) a person claiming to be a licensee by virtue of the transaction does not have the protection provided in section 116, 117 or 118.

(4) Where a person becomes the owner or a licensee of a registered trade mark by virtue of a registrable transaction, then unless

(a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months from the date of the transaction, or

(b) the Court is satisfied that it was not practicable for such an application to be made before the end of the six-month period and that an application was made as soon as practicable after the end of that period,

he shall not be entitled to damages or an account of profits in respect of any infringement of the registered trade mark that occurs after the date of the transaction and before the prescribed particulars of the transaction are registered.

(5) The rules may make provision for

(a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence; and

(b) the removal of particulars from the register

(i) where it appears from the registered particulars that the licence was granted for a fixed period which has expired; or

(ii) where no such fixed period is indicated and, after such period as may be prescribed, the Registrar has notified the parties of his intention to remove the particulars from the register.

(6) The rules may also make provision with respect to the amendment or removal from the register of particulars relating to a security interest upon the application, or with the consent, of the person entitled to the benefit of that interest.

Trusts and equities.

82. (1) No notice of any trust, whether express, implied or constructive, shall be entered in the register, and the register shall not be affected by any such notice.

(2) Subject to the provisions of this Act, equities in respect of a registered trade mark may be enforced in like manner as in respect of other personal property.

(3) For the avoidance of doubt, nothing contained in this section prevents the registration of a trade mark, or the registration of particulars of a registrable transaction, in the name of a person as a trustee of a trust.

Registration of trade mark as object of property: application and references.

83. (1) Sections 79 to 82 apply, with necessary modification, in relation to an application for the registration of a trade mark as in relation to a registered trade mark.

(2) In sections 77 and 78 as they apply in relation to an application for registration, the reference in section 77 to the registration of a trade mark shall be construed as a reference to the making of the application.

(3) In section 81 as it applies in relation to a transaction affecting an application for the registration of a trade mark, the references to the entry of particulars in the register, and to the making of an application to register particulars, shall be construed as references to the giving of notice to the Registrar of those particulars.

Licensing of Registered Trade Mark

Definitions.

84. In this Part and Part VII, unless the context otherwise requires,

"exclusive licence" means a licence, whether general or limited, which authorises the licensee to the exclusion of all other persons, including the person that granted the licence, to use a registered trade mark in the manner authorised by the licence, and the expression "exclusive licensee" shall be construed accordingly; and

"licence" means a licence issued or held in accordance with the provisions of this Part, and "licensee" shall be construed accordingly; and

Nature and effect of a licence.

85. (1) A licence to use a registered trade mark may be general or limited.

(2) A limited licence may, in particular, apply in relation

(a) to some but not all of the goods or services for which the trade mark is registered; or

(b) to use of the trade mark in a particular manner or a particular locality.

(3) A licence issued under this Act is not effective unless it is in writing and signed by or on behalf of the person who grants it ("the grantor").

(4) The requirement outlined in subsection (3) for the effectiveness of a licence may be satisfied, in a case where the grantor is a body corporate, by the affixing of the seal of the body corporate.

(5) Unless the licence provides otherwise, the licence is binding on a successor in title to the grantor's interest, and any reference in this Act to doing anything with, or without, the consent of the owner of a registered trade mark shall be construed accordingly.

(6) A licence may authorise a licensee to grant a sub-licence.

Scope of exclusive licence.

86. (1) An exclusive licence may provide that the exclusive licensee shall, to such extent as may be provided in the licence, have the same rights and be entitled to the same remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

Application to register licensee.

87. (1) The Registrar shall, where all the requirements for the grant of a licence in respect of a registered trade mark have been fulfilled, register a licensee in accordance with the terms, and conditions (if any), of the licence.

(2) Where a trade mark has not been registered but an application has been made to the Registrar for its registration, any person may, with the consent of the owner of the trade mark, be registered as a licensee in respect of any of the goods or services to which the application relates.

(3) The rules may make provision for the form and manner of effecting an application under this section and any conditions relating to the application.

Cancellation of licensee's trade mark.

88. The Registrar may cancel the registration of a person as a licensee of a trade mark if

(a) the trade mark is no longer registered;

(b) the application for registration of the trade mark as outlined in section 87 (2) is abandoned, withdrawn or rejected;

(c) the owner or licensee, in accordance with any licence agreement, applies for such cancellation;

(d) he is satisfied that the owner or licensee misrepresented, or failed to disclose, some fact material to the application for registration, or that the circumstances have materially changed since the date of the registration; or

(e) he is satisfied that the registration should not have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which the applicant is interested.

PART VI

ADMINISTRATIVE PROVISIONS

The Register

Registrar to maintain a register of trade marks.

89. (1) There shall be a register of trade marks to be kept and maintained by the Registrar.

(2) The register may be in such form and divided into such parts as the Registrar considers appropriate, having regard to the requirements under this Act and any rules, regulations or Orders made thereunder.

(3) The register may be maintained in a documentary or electronic form, or both.

Registrar to maintain a list of geographical indications.

90. (1) The Registrar shall keep and maintain a list of geographical indications which shall be recorded in such form as the Registrar considers appropriate.

(2) The list of geographical indications may be maintained in a documentary or electronic form, or both.

(3) The provisions of sections 91 to 94 shall apply in relation to a list of geographical indications as if any reference in those sections to the register is a reference to the list of geographical indications.

Entries in the register.

91. (1) There shall be entered in the register the following:

(a) particulars relating to applications for registration of trade marks, including the filing dates and dates of priority;

(b) particulars relating to the actual registered trade marks, including the names and addresses of owners of the trade marks;

(c) assignments and transmissions;

(d) the names and addresses of all licensees, including sub-licensees;

(e) disclaimers and any conditions required or attached to any matter;

(f) notices issued pursuant to the requirements of this Act or the rules;

(g) transactions, instruments or events affecting the rights in or under registered trade marks and applications for registration; and

(h) such other matters as the Registrar, subject to subsection (2), considers fit.

(2) The rules may make provision for additional matters that may be entered in the register.

Inspection of register.

92. (1) The register shall, subject to subsection (4), be open to public inspection during normal business hours.

(2) In relation to any portion of the register that is kept otherwise than in a documentary form, the right of inspection conferred by subsection (1) is a right to inspect the material on the register.

(3) Regulations may provide for the payment of fees for any inspection of the register under this section or the issuing of a copy of an entry in the register under section 93.

(4) The rules may provide for restricted hours within which the register may be inspected.

Application for copies of entries in the register.

93. (1) Any person may apply for

(a) a certified copy of an entry in the register or a certified extract from the register, or

(b) an uncertified copy of an entry in the register or an uncertified extract from the register,

and the Registrar shall, upon payment of the prescribed fee, issue such copy or extract.

(2) In relation to any portion of the register that is kept otherwise than in a documentary form, the right to a copy or extract conferred by subsection (1) is a right to a copy or extract in a form in which it is visible and legible and can be taken away.

Rectification, correction, etc. of register.

94. (1) Subject to subsection (2), a person having an interest may apply to the Registrar or the Court for the rectification of an error or omission in the register.

(2) An application under subsection (1) may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(3) Where an application is made to the Registrar under subsection (1), he may, if he considers it necessary, refer the application to the Court for a decision.

(4) Except where the Registrar or the Court directs otherwise, the effect of a rectification of the register is that the error or omission in question is deemed never to have been made.

(5) The Registrar may, on request made by the owner of a registered trade mark or a licensee, or by any person having an interest in or a charge on a registered trade mark the particulars of which have been entered in the register under section 81, enter any change in his name or address, or in any other particulars identifying such person, as recorded in the register.

(6) Subject to subsection (7), where the Registrar is satisfied that an error or omission in the register is attributable to him or a member of his staff, he may on his own initiative correct the error or omission in the register.

(7) The Registrar shall, in respect of a correction under subsection (6), give notice of the proposed correction to any person who appears to him to be connected with the subject matter of the proposed correction.

(8) The Registrar may remove from the register any matter appearing to him to have ceased to have effect.

Power to make amendments to accord with new classifications.

95. (1) The rules may empower the Registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks, including the amendment of existing entries on the register so as to accord with the new classification.

(2) Where the rules empower the Registrar to amend existing entries in the register, provision shall also be made by the rules for

(a) the giving of notice to any owner of a registered trade mark who may be affected by an amendment proposed to be made by the Registrar;

(b) the publication in the *Gazette* of the particulars of the proposed amendments;

(c) the making of objections, within such time as may be prescribed, by any owner of a registered trade mark claiming to be affected; and

(d) the filing of oppositions, within such time as may be prescribed, by any other person claiming to be affected.

(3) The rules may also empower the Registrar

(a) to require the owner of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of entries in the register so as to accord with any amended or substituted classification of goods or services; and

(b) to cancel or refuse to renew the registration of the trade mark in the event of the owner failing to do so.

(4) A power of amendment given to the Registrar shall not be exercised in a manner as to extend the rights conferred by the registration, except where it appears to the Registrar that compliance with this requirement would involve undue complexity and that any extension would not be substantial and would not adversely affect the rights of any person.

Establishment of Office of Registrar and Powers and Duties of Registrar

Establishment of office of Registrar of Trade Marks, Patents and Copyright.

96. (1) There is established the office of Registrar of Trade Marks, Patents and Copyright and, unless otherwise specified in another enactment, that office shall also be responsible for the administration of patents, copyrights and other intellectual property legislation.

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(2) The Registrar of Corporate Affairs appointed pursuant to section 229 (1) of the BVI Business Companies Act, 2004 shall act as, and perform the functions and exercise the powers of, Registrar under this Act.

(3) The Registrar shall be assisted in the performance of his functions by one or more Deputy Registrars of Trade Marks, Patents and Copyright and one or more Assistant Registrars of Trade Marks, Patents and Copyright and such other staff as may be appointed by the Commission.

(4) Subject to the control of the Registrar, a Deputy Registrar and an Assistant Registrar appointed under subsection (3) has and may exercise the powers and perform the duties and functions of the Registrar under this Act, and the fact that a Deputy Registrar or Assistant Registrar so acts is conclusive evidence of his authority to do so.

Power to issue forms.

97. (1) Unless otherwise provided by the rules, the Registrar may require the use of such forms as he may consider necessary for any purpose relating to the registration of a trade mark or the conduct of any proceedings before him.

(2) Where the Registrar requires the use of a form under subsection (1), he shall cause the form to be published in the *Gazette*.

Power to issue opinion.

98. (1) The Registrar may give to a person who proposes to apply for the registration of a trade mark his opinion as to whether the trade mark concerned appears to the Registrar *prima facie* to be capable of distinguishing goods or services of one undertaking from those of other undertakings within the meaning of section 2 (1) with respect to the definition of a “trade mark”.

(2) A person who wishes to receive the opinion of the Registrar pursuant to subsection (1) shall submit a request to the Registrar in such manner as may be prescribed.

(3) Where the Registrar forms the view that a request made under subsection (1) is not sufficiently clear, or does not contain sufficient information, he may decline to provide any opinion unless the request is made sufficiently clear or contains sufficient information.

(4) An opinion issued by the Registrar under subsection (1)

(a) shall not be construed as binding on the Registrar or be considered as holding the Registrar to any legal liability; and

(b) may be withdrawn or substituted by another opinion if, prior to the filing of the application for registration of a trade mark, facts come to the attention of the Registrar which make a withdrawal or substitution of the opinion reasonable.

Immunity from liability.

99. Neither the Commission or any member of its staff nor the Registrar or any member of his staff shall

(a) be taken to warrant the validity of the registration of a trade mark under this Act;

(b) be liable

(i) by reason of, or in connection with, any examination required or authorised by the Act, or any report or other proceeding consequent on any such examination; or

(ii) for any other thing done or omitted in good faith in the discharge of any function or exercise of any power under this Act.

PART VII

LEGAL PROCEEDINGS AND APPEALS

General

Register as *prima facie* evidence of validity.

100. In any proceedings relating to a registered trade mark, including proceedings for rectification of the register, the registration of a person as owner of a trade mark shall be *prima facie* evidence of the validity of the original registration and of any subsequent

assignment or transmission of it.

Register as *prima facie* evidence of contents.

101. (1) The register shall be *prima facie* evidence of anything required or authorised by this Act or the rules to be registered.

(2) A certificate purporting to be signed by the Registrar and certifying that an entry in the register which he is empowered by this Act, the rules or any regulation or Order to make, has or has not been made, or that any other thing which he is so empowered to do, has or has not been done, shall be *prima facie* evidence of the matter so certified.

(3) Each of the following documents which purports to be a certified copy or certified extract shall be admitted in evidence in all courts, and in all proceedings, without further proof and without production of any original:

(a) a copy of an entry in the register or an extract from the register which is provided under section 93 (1);

(b) a copy of

(i) a document kept in the Registry;

(ii) an extract from any such document; or

(iii) an application for registration of a trade mark.

Option to apply to Registrar or Court.

102. (1) Unless otherwise provided in this Act, where a person has an option to make an application either to the Registrar or the Court on a question concerning a registered trade mark or an application for registration of a trade mark, then

(a) if any proceedings concerning the registered trade mark or the application for registration in question is pending before the Court, the application shall be made to the Court; and

(b) if in any other case the application is made to the Registrar, he may, at any stage of the proceedings, refer the application to the Court instead of determining the question himself.

(2) The application of subsection (1) is without prejudice to the power of the Court, apart from this section, to determine any question referred to in that subsection.

Burden of proof re use of trade mark.

103. Where, in any proceedings under this Act in which

(a) the owner of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with the owner; and

(b) a licensee of a registered trade mark is a party, a question arises as to the use to which the trade mark has been put, the burden of proving that use shall lie with

(i) the owner of the trade mark, where he is a party to the proceedings; or

(ii) the licensee, where the owner is not a party to the proceedings.

Proceedings Before the Registrar

Registrar not bound by rules of evidence.

104. Unless otherwise provided in this Act, the Registrar is not bound by the rules of evidence in any proceedings before him under this Act and may inform himself of any matter that is before him in any way he reasonably believes to be appropriate.

Application of natural justice rules.

105. (1) Without prejudice to any rule of law or to any provision of this Act requiring the Registrar to hear any party to proceedings before him, or to give any such party an opportunity to be heard, the Registrar shall, before taking any decision on any matter under this Act or the rules or any regulation or Order which may be adverse to any party to the proceedings, give that party an opportunity to make such representations to the Registrar as the party deems fit.

(2) A representation under subsection (1) may be in writing addressed to the Registrar or be in person before the Registrar, except that where a party requests a hearing before the Registrar the Registrar shall grant the request.

(3) The Registrar shall give the party referred to in subsection (1) at least fourteen days' notice to make his representations.

Powers in relation to witnesses, etc.

106. (1) For the purposes of proceedings before him under this Act, the Registrar may

(a) summon witnesses;

(b) receive written or oral evidence on oath or affirmation;

(c) require the production of documents or articles for inspection and provide for the manner of inspection; and

(d) hear and rely on the evidence of any expert that the Registrar considers fit to consult.

(2) The Registrar may make such order as he thinks fit as regards any matter referred to in subsection (1).

(3) Any order made by the Registrar under this section shall, unless successfully appealed against to the Court, be enforceable in like manner as an order of the Court.

Power to award costs.

107. (1) The Registrar may, in proceedings before him under this Act, by Order award to any party such costs as he may consider reasonable and direct how and by what parties they are to be paid.

(2) Any costs awarded under this section shall, if the Court so orders, be recoverable by execution issued from the Court as if the costs were payable under an order of the Court.

(3) The rules may make provision

(a) empowering the Registrar, in such cases as may be prescribed, to require a party to any proceedings before him to give security for costs in relation to those proceedings; and

(b) with respect to the consequences of failure to give security for costs.

Proceedings Before the Court

Application of Civil Procedure Rules.

108. Unless otherwise specified in this Act, in all proceedings before the Court under this Act, the provisions of the Civil Procedure Rules, 2000 shall apply.

Certificate of validity.

109. (1) Where, in proceedings before the Court, the validity of the registration of a trade mark is contested and the Court makes a finding that the trade mark is validly registered, it may give a certificate to that effect.

(2) Where the Court gives a certificate under subsection (1) and in any subsequent proceedings, either before the Court or the Registrar,

(a) the validity of the registration of the trade mark is again questioned on the same or substantially the same grounds, and

(b) the owner of the registered trade mark obtains a final order, judgment or decision in his favour,

the owner is entitled to his costs on an indemnity basis, unless the Court or the Registrar, as the case may be, directs otherwise.

(3) Subsection (2) does not extend to the costs of an appeal in any such proceedings.

Registrar's right to appear before the Court.

110. (1) Where proceedings before the Court involve an application for

(a) the revocation, cancellation or variation of the registration of a trade mark,

(b) a declaration of the invalidity of the registration of a trade mark, or

(c) the rectification of the register,

the Registrar is entitled to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar may instead of appearing, submit to the Court a statement in writing signed by him, giving particulars of

(a) any proceedings before him in relation to the matter in issue;

(b) the grounds of any decision given by him;

(c) the practice of the Registrar or his office in like cases, if any; and

(d) such matters relevant to the issues involved in the proceedings and within his knowledge as the Registrar thinks fit.

(3) A statement submitted by the Registrar under subsection (2) shall be deemed to form part of the evidence in the proceedings before the Court.

(4) The Registrar's entitlement to appear and be heard under subsection (1) includes representation of the Registrar by a legal practitioner.

Infringement Proceedings

Infringement of trade mark actionable by owner.

111. (1) An infringement of a trade mark is actionable by the owner of the trade mark.

(2) In proceedings for an infringement of a trade mark, all relief by way of damages, injunctions, accounts or otherwise is available to the owner of the trade mark as is available in respect of the infringement of any other property right.

(3) Notwithstanding section 57, no infringement proceeding may be commenced before the date on which the trade mark infringed is in fact entered in the register.

Application for delivery up of infringing goods, etc.

112. (1) The owner of a registered trade mark may apply to the Court for an order for the delivery up to him, or such other person as the Court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a trade or business.

(2) An application under subsection (1) shall not be valid if it is made after the end of the period specified in section 113.

(3) Where the Court makes an order under subsection (1), it shall also make an order pursuant to section 114, unless it determines that there are grounds for not making such an order.

(4) A person to whom any infringing goods, material or articles are delivered up pursuant to an order made under subsection (1) shall, if an order is not made under section 114, retain the goods, material or articles pending the making of an order under that section or the decision not to make such an order.

(5) Nothing contained in this section shall be construed as affecting any other power that the Court may properly exercise.

Restrictions on order for delivery up.

113. (1) Subject to subsection (2), an application for an order under section 112 may not be made after the end of the period of six years from,

(a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;

(b) in the case of infringing material, the date on which the trade mark was applied to the material; or

(c) in the case of infringing articles, the date on which they were made.

(2) Where, during the whole or part of the period of six years, the owner of the registered trade mark

(a) is under a disability, or

(b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order under section 112,

he may make an application at any time before the end of the period of six years from the date on which he ceased to be under a disability or, could with reasonable diligence have discovered those facts, as the case may be.

(3) In subsection (2) (a), the reference to “disability” has the same meaning as that provided in section 2 (2) of the Limitation Act.

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Application for further orders.

114. (1) Where infringing goods, material or articles have been delivered up pursuant to an order made under section 112, an application may be made to the Court for

(a) an order that the goods, material or articles

(i) be forfeited to such person as the Court considers fit;

(ii) be destroyed in such manner as the Court considers fit;

(iii) be otherwise dealt with as the Court considers fit; or

(b) a decision that no such order as outlined in paragraph (a) should be made.

(2) For the purpose of making an order pursuant to subsection (1) (a) (iii), the Court may, where considered reasonably practicable, require the person found to have infringed the registered trade mark to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control.

(3) Where there is more than one person interested in the goods, material or articles, the Court may make such order as it thinks just in all the circumstances, and it may, in particular, direct that the goods, material or articles be disposed of and the proceeds be divided among them as the Court thinks fit.

(4) In considering what order, if any, should be made under subsection (1), the Court shall

(a) take into account the need for proportionality between the seriousness of the infringement of the registered trade mark and the remedy sought;

(b) take into account the interests of third parties; and

(c) consider whether other remedies available in proceedings in respect of the infringement of the registered trade mark would be adequate to compensate the owner of the registered trade mark and any licensees and to protect their interests.

(5) Where the Court does not make an order under subsection (1) (a), the person who had possession, custody or control of the goods, material or articles before they were delivered up pursuant to an order made under section 112 is entitled to their return.

(6) A reference in this section to a person having an interest in goods, material or articles includes any person in whose favour an order could be made under this section or who is identified as such under the rules.

(7) Where an order is made by the Court under subsection (1) (a), the order shall not take effect until the end of the period within which notice of an appeal may, as provided by the Civil Procedure Rules, 2000 be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

Action against threats of infringement proceedings.

115. (1) Where a person threatens to commence proceedings against another person for infringement of a registered trade mark in respect of any use other than

(a) the application of the trade mark to goods or their packaging, or

(b) the supply of services under the trade mark,

the person who is aggrieved by the threat may bring proceedings before the Court for relief under this section.

(2) The aggrieved person may apply for any one or more of the following reliefs:

(a) a declaration that the threat is unjustifiable;

(b) an injunction against the continuance of the threat; and

(c) damages in respect of any loss he has sustained as a result of the threat.

(3) The aggrieved person is entitled to the relief claimed under subsection (2), unless the defendant shows that the act in respect of which infringement proceedings were threatened constitute, or if done would constitute, an infringement of the registered trade mark concerned.

(4) If the defendant shows that the act in respect of which infringement proceedings were threatened constitute, or if done would constitute, an infringement of a registered trade mark, the aggrieved person is nevertheless entitled to the relief claimed under subsection (2) if he establishes that the registration of the trade mark is invalid or liable to be revoked in a relevant respect.

(5) The mere notification that a trade mark is registered, or that an application for registration of the trade mark has been made, does not constitute a threat to commence proceedings for infringement for the purposes of this section.

(6) No proceeding for relief under this section shall be commenced, or if commenced may not proceed, if

(a) the registered owner of the trade mark, or

(b) a licensee having power to bring proceedings for infringement of the trade mark,

commences proceedings for infringement of the trade mark against the aggrieved person within thirty days after the threat was first made to him and pursues those proceedings with diligence.

Infringement proceedings.

116. (1) This section has effect with respect to the rights of a licensee as they relate to the infringement of a registered trade mark, but shall not apply where and to the extent that by virtue of

(a) section 117 (2), the licensee has a right to commence infringement proceedings in his own name; or

(b) section 118 (2), a sub-licensee has the right to call on the exclusive licensee to commence infringement proceedings in respect of any matter which affects the sub-licensee's interests.

(2) A licensee is entitled, unless his licence or any licence through which his interest is derived provides otherwise, by notice served on the owner of the registered trade mark, to call on the owner to commence infringement proceedings in respect of any matter which affects the licensee's interests.

(3) Where the owner of the registered trade mark

(a) refuses to commence infringement proceedings, or

(b) fails to commence infringement proceedings within one month after being called upon to do so,

the licensee may, unless the licence or any licence through which he derives his interest provides otherwise, commence the proceedings in his own name as if he were the owner of the registered trade mark.

(4) Where a licensee commences infringement proceedings by virtue of this section, he may not, without the leave of the Court, proceed with the action unless the owner of the registered trade mark is

(a) joined as a plaintiff to the proceedings; or

(b) added as a defendant to the proceedings.

(5) The owner of a registered trade mark who is added as a defendant to any infringement proceedings by virtue of subsection (4) shall not be liable for any costs unless he takes part in the proceedings.

(6) Nothing contained in subsection (4) shall affect the granting of an interlocutory relief by the Court on the application of a licensee alone.

(7) In infringement proceedings brought by the owner of a registered trade mark, any loss suffered or likely to be suffered by a licensee shall be taken into account, and the Court may give such directions as it thinks fit as to the extent to which the owner is to hold the proceeds of any pecuniary remedy on behalf of the licensee.

Rights in relation to exclusive licensee.

117. (1) This section applies in relation to an exclusive licensee if, or to the extent that, by virtue of section 86 (1), the exclusive licensee has the same rights and is entitled to the same remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) The exclusive licensee is entitled, subject to the licence and this section, to commence infringement proceedings in his own name against any person other than the owner of the registered trade mark.

(3) The rights of the exclusive licensee and the remedies to which he is entitled are concurrent with those of the owner of the registered trade mark, and a reference to the owner of a registered trade mark in this Act relating to infringement shall be construed accordingly.

(4) In infringement proceedings commenced by an exclusive licensee by virtue of this section, a defendant may avail himself of any defence which would have been available to him if the proceedings had been commenced by the owner of the registered trade mark.

(5) Where proceedings for infringement of a registered trade mark commenced by the owner of the registered trade mark or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the owner or the exclusive licensee, as the case may be, may not, without the leave of the Court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

(6) A person who is added as a defendant pursuant to subsection (5) shall not be liable for any costs unless he takes part in the proceedings.

(7) Nothing contained in subsection (5) shall affect the granting of interlocutory relief by the Court on the application of the owner of the registered trade mark or an exclusive licensee alone.

(8) Where proceedings for infringement of a registered trade mark are commenced which relate wholly or partly to an infringement in respect of which the

owner of the registered trade mark and an exclusive licensee have or had concurrent rights of action,

(a) the Court shall, in assessing damages, take into account

(i) the terms of the licence; and

(ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;

(b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and

(c) the Court shall, if an account of profits is directed, apportion the profits between them in such manner as the Court considers just.

(9) Subsection (8) applies whether or not the owner of the registered trade mark and the exclusive licensee are both parties to the proceedings, and if they are not both parties, the Court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(10) The owner of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 112, and the Court may, on the application of the exclusive licensee, make such order under that section as it thinks fit, having regard to the terms of the licence.

(11) The application of subsections (5) to (10) is subject to any agreement to the contrary between the owner of the registered trade mark and the exclusive licensee.

Rights of sub-licensee.

118. (1) This section applies in relation to a sub-licensee of an exclusive licensee if, or to the extent that, by virtue of section 117 (2), the exclusive licensee has a right to commence infringement proceedings in his own name.

(2) A sub-licensee is entitled, unless his sub-licence or any licence through which his interest is derived provides otherwise, by notice served on the exclusive licensee, to call on the exclusive licensee to commence infringement proceedings in respect of any matter which affects the sub-licensee's interests.

(3) Where the exclusive licensee

(a) refuses to commence infringement proceedings, or

(b) fails to commence infringement proceedings within one month after being called upon to do so,

the sub-licensee may, unless the sub-licence or any licence through which he derives his interest provides otherwise, commence the proceedings in his own name as if he were the exclusive licensee.

(4) Where a sub-licensee commences infringement proceedings by virtue of this section, he may not, without the leave of the Court, proceed with the proceedings unless both the exclusive licensee and the owner of the registered trade mark are either

(a) joined as plaintiffs to the proceedings; or

(b) added as defendants to the proceedings.

(5) A person who is added as a defendant pursuant to subsection (4) shall not be liable for any costs unless he takes part in the proceedings.

(6) Nothing contained in subsection (4) shall affect the granting of interlocutory relief by the Court on the application of the sub-licensee alone.

Appeals

Appeal from order of the Registrar.

119. (1) Notwithstanding any rule of court to the contrary, an appeal lies to the Court from any decision or order of the Registrar under this Act.

(2) In an appeal under this Act, the Registrar

(a) is entitled to appear and to be represented and heard in support of his decision or order; and

(b) shall appear if he is directed by the Court to do so.

(3) In this section, the reference to "decision" includes any act of the Registrar that is made in exercise of a discretion vested in him by or under this Act.

General powers of the Court.

120. The Court may, for the purpose of determining any question in the exercise of its original or appellate jurisdiction under this Act, make any order or exercise any other power which the Registrar has power to make or exercise in determining that question.

Power of Court to award costs.

121. (1) In all proceedings before the Court under this Act, the Court may award to any party such costs as appears reasonable to the Court.

(2) If in any such proceedings the Court directs that any costs of one party shall be paid by another party, the Court may settle the amount of the costs in such manner as may be prescribed by rules of court.

PART VIII

MISCELLANEOUS PROVISIONS

Importation of Infringing Goods, Materials and Articles

Notice of infringing goods, articles, etc.

122. (1) The owner of a registered trade mark, or a licensee, may give notice in the prescribed form to the Commissioner of Customs

(a) indicating that he is the owner or licensee, as the case may be, of the registered trade mark;

(b) that, at a time and place specified in the notice, goods, material or articles which are, in relation to the registered trade mark, infringing goods, material or articles have arrived or are expected to arrive in the Virgin Islands; and

(c) requesting that the Commissioner of Customs detains the infringing goods, material or articles.

(2) A notice under subsection (1) shall

(a) provide particulars

(i) which the owner of the registered trade mark or the licensee, as the case may be, considers relevant in support of the request; and

(ii) as may be prescribed;

(b) specify, subject to any regulations made under this Act, the period for which the notice is to be in force; and

(c) be subject to the payment of such fees as may be prescribed.

(3) Where a licensee gives a notice under this section, he shall, unless agreed otherwise, serve a copy of the notice on the owner of the registered trade mark.

(4) The reference in this section to

(a) "infringing goods, material or articles" shall be construed to include goods, material or articles on or in relation to which an infringing sign is used; and

(b) "licensee" includes a sub-licensee.

Duty of Commissioner of Customs to investigate.

123. (1) Where the Commissioner of Customs receives a notice under section 122, he shall conduct an investigation in an expeditious manner and, in any case, within a reasonable period in order to establish whether or not the goods, material or articles in the custody of Customs relate to those mentioned in the notice.

(2) For the purposes of subsection (1), the Commissioner of Customs may require the person who gave the notice or any other person who appears to the Commissioner to have an interest in the goods, material or articles to provide the Commissioner with such information and within such period as the Commissioner considers to be reasonably necessary to aid his investigation.

Determination by Comptroller of Customs.

124. (1) Where the Commissioner of Customs, after the conclusion of his investigation, determines that the goods, material or articles referred to in a notice given under section 122

(a) are the infringing goods, material or articles, he shall detain the goods, material or articles and notify the party or parties concerned; and

(b) are not the infringing goods, material or articles, he shall not detain those goods, material or articles and, where he has already detained the goods, material or articles, he shall release them from the custody of Customs.

(2) Where the Commissioner of Customs

(a) receives a notice under section 122 which does not comply fully with all the requirements of that section or any regulations made under this Act, or

(b) requires information under section 123 (2) which has not been provided to him,

he shall not act on the notice to detain any goods, material or articles that are the subject of the notice or to which his inquiry under section 123 (2) relates.

Forfeiture of goods, articles, etc. to the Crown.

125. Notwithstanding anything to the contrary contained in this Act, where any goods, material or articles are detained by the Commissioner of Customs in pursuance of a notice under section 122, the importer or consignee of the goods, material or articles may, by notice to the Commissioner, consent to the goods, material or articles being forfeited to the Crown, and the goods, material or articles shall be forfeited accordingly.

Powers of Court to make orders.

126. (1) The Court may, on an application made by any person appearing to the Court to have an interest ("the applicant"), determine whether any goods, material or articles detained by the Commissioner of Customs pursuant to section 124 (1) (a) are infringing goods, material or articles.

(2) An application under subsection (1) shall be served on the Commissioner of Customs within such period as may be prescribed by rules of court.

(3) Where the Court makes an order that any goods, material or articles detained pursuant to section 124 (1) (a) are infringing goods, material or articles, it shall make an order that the goods, material or articles

(a) be forfeited to the Crown;

(b) be destroyed; or

(c) be otherwise disposed of or dealt with as the Court thinks fit.

(4) In considering what order to make under subsection (3), the Court shall consider

(a) whether other remedies available in proceedings for infringement of a registered trade mark under this Act would be adequate to compensate, and to protect the interests of, the applicant; and

(b) the need to ensure that no infringing goods, material or articles are disposed of in a manner that would adversely affect the applicant.

(5) Where two or more persons are interested in any infringing goods, material or articles, the Court may

(a) direct that the goods, material or articles be sold or otherwise dealt with and the proceeds be divided among them; and

(b) make any other order it thinks fit.

(6) Where the Court determines that goods, material or articles detained by the Commissioner of Customs are not infringing goods, material or articles, it may make an order requiring the person who gave the notice to which the goods, material or articles relate to pay compensation in such amount as the Court thinks fit to the importer, consignee or owner of the goods, material or articles.

Exceptions to sections 122 to 126.

127. Nothing contained in sections 122 to 126

(a) affects the importation by a person of any goods, material or articles for private and domestic use; and

(b) done by or in relation to the Commissioner of Customs shall be construed to make him or his staff or the Crown liable to any proceedings on account of any loss or claim or otherwise.

Further provisions.

128. Regulations made under section 135 may

(a) prescribe the form of the notice to be given under section 122 and any conditions that shall be complied with;

(b) outline the particulars to be contained in the notice given under section 122;

(c) specify the period for which a notice given under section 122 may remain in force;

(d) provide for the withdrawal of a notice given under section 122 and prescribe the form for such withdrawal;

(e) provide for the consequences of a withdrawal where the Commissioner of Customs has acted or commenced the process of acting on a notice given under section 122;

(f) require the person giving a notice under section 122 to provide such security as may be specified in respect of any liability or expense which the Commissioner of Customs may incur in consequence of acting on the notice;

(g) provide for the inspection, and duration of inspection, of goods, material or articles, which are the subject of a notice under section 122, by any person who claims to have an interest in the goods, material or articles, including the taking of samples of the goods, material or articles on such terms and conditions as may be specified for the sole purpose of inspecting them;

(h) provide the form of notice of consent for forfeiture of goods, material or articles under section 125;

(i) prescribe any additional matters on which the Commissioner of Customs may provide written statements to the Court; and

(j) make different provisions with respect to different classes of case to which they apply.

Other Matters

No liability for diminution in rights.

129. No person shall be entitled to any compensation from the Registrar, Commission or the Crown for any diminution in the rights that attach to a trade mark that may arise as a consequence of the enactment of this Act.

Crown's right of disposal of forfeited goods, etc. not affected. No. 6 of 2010

130. Nothing contained in this Act shall affect the right of the Crown or any person deriving title, whether directly or indirectly, from the Crown to dispose of or use any articles forfeited under the Customs Management and Duties Act, 2010 or any other enactment.

Fees. No. 12 of 2001

131. (1) Regulations made under section 62 of the Financial Services Commission Act may provide for the fees chargeable and payable in respect of any matter contained in this Act, the regulations and rules.

(2) The Registrar may refuse to take any action required of him in respect of any matter under this Act for which a fee is payable until the fee and any other fees, penalties and charges that are payable have been paid.

(3) Any fee, charge or penalty that is due and payable may be recovered by the Registrar as a debt due to him by instituting proceedings before the Magistrate's Court.

Establishment of Intellectual Property Advisory Committee.

132. (1) There is established an Intellectual Property Advisory Committee.

(2) The Committee shall be chaired by the Managing Director of the Commission and shall comprise the Registrar and such other members of the public and the private sector, not exceeding twelve, as appear to the Commission to be knowledgeable in intellectual and industrial property law matters.

(3) The members of the Committee shall be appointed by the Commission, with the approval of the Board of the Commission.

(4) The Committee shall have responsibility for

(a) advising the Commission on any matter relating to the operation of this Act as the Commission may refer to it;

(b) advising on any matter, except the Registrar's exercise of his powers, referred to it by the Registrar; and

(c) reviewing the provisions of this Act and any rules, regulations or Orders made under it and advising on reforms and such other matters as would make the implementation of these enactments more efficient and effective.

(5) In the performance of its duties, the Committee

(a) shall devise and adopt its own rules of procedure, including determining its quorum for the conduct of its meetings and the manner of exercising the right to vote; and

(b) may co-opt such person as it considers competent to provide such advice or assistance to the Committee as the Committee considers fit, but such person shall have no right of vote in the Committee.

Offences and penalties. Schedule 3

133. (1) The offences and penalties outlined in Schedule 3 shall apply with respect to this Act.

(2) Any rules or regulations made pursuant to this Act may make provision for offences and penalties, but a penalty, upon conviction, of

(a) a fine shall not exceed fifty thousand dollars; and

(b) imprisonment shall not exceed a term of twelve months.

(3) No prosecution for an offence under this Act shall be commenced after the expiration of three years next after the commission of the offence, or one year next after the discovery of the offence by the Director of Public Prosecutions, whichever occurs first.

Rules.

134. (1) The Cabinet, acting on the advice of the Commission, may make rules

(a) in respect of the provisions of this Act which contemplate or authorise, or which by their nature require, the making of rules, other than rules of court, in relation to any matter;

(b) prescribing matters considered relevant for the proper and effective functioning of the office of the Registrar or in the performance of the Registrar's duties or exercise of his powers under this Act;

(c) prescribing anything that is authorised or required by the provisions of this Act to be prescribed, unless the context of the provisions authorise or require otherwise; and

(d) generally for regulating the practice and procedure in relation to this Act.

(2) Without prejudice to the generality of subsection (1), the rules may, unless otherwise specified,

(a) prescribe the manner of filing an application for registration of a trade mark and other documents with the Registrar;

(b) make provision for the electronic filing of documents and establish the criteria for authorising the filing of such documents in electronic form;

(c) make provision for the security and authentication of documents that are filed electronically;

(d) specify the forms that are required or considered necessary for the purposes of any matter under this Act;

(e) make provision for the making of an application for registration of a trade mark by a partnership, association or other unincorporated body and the registration of a trade mark in the name of that partnership, association or other unincorporated body;

(f) establish, subject to section 41, requirements for the division of an application or a registration, including the payment of fees, with respect to the classification of goods or services;

(g) provide for the translation of documents required to be filed and the filing of such documents;

(h) provide for the publication of any matter required to be published under this Act, in addition to publication in the *Gazette*, and the manner of such publication;

(i) provide for the manner of keeping and maintaining the register;

(j) prescribe the procedure to be followed in relation to proceedings and other matters before the Registrar, including the rectification of irregularities of procedure;

(k) empower the Registrar to tax costs awarded by him in any proceedings before him;

(l) outline the mode of giving evidence before the Registrar, whether orally or in writing and whether by means of the production of documents or articles or otherwise;

(m) provide for the security of documents filed with the Registrar, including the regulation of the inspection of such documents;

(n) provide for the extension of time in respect of any matter required to be done under this Act or in relation to the exercise of powers by the Registrar;

(o) make provision restricting the times when any documents filed, lodged, registered or otherwise in the custody of the Registrar may be inspected, including when the register may be open for public inspection;

(p) provide for arrangements to be made by the Registrar for the publication of all registered trade marks, and decisions or orders relating to trade marks made by the Registrar or the Court; and

(q) require the Registrar to perform such other duties as are consistent with the objectives of this Act.

(3) Rules made under this section may make different provisions for different types of cases.

Regulations.

135. (1) The Cabinet may make such regulations as it considers necessary for the purposes of carrying out the objectives of this Act and, in doing so, it shall have regard to any rules made under this Act.

(2) Without prejudice to subsection (1), the regulations may make provision for

(a) the protection of the symbol of the International Olympic Committee in accordance with the Treaty for the Protection of the Olympic Symbol, 1991;

(b) the protection of the symbol of the International Committee of the Red Cross;

(c) the protection of the symbol of the International Red Crescent Society;

(d) the protection of the symbol of any religious organisation that is based in the Virgin Islands;

(e) the preparation of annual reports by the Comptroller of Customs in respect of

(i) notices received by him for or in relation to the detention of goods, material or articles claimed to infringe registered trade marks;

(ii) the number of notices acted upon by him and types of goods, material or articles involved;

(iii) the period of detention of the goods, material or articles;

(iv) any consent given for the forfeiture to the Crown of goods, material or articles; and

(v) all other matters related to the detention of goods, material or articles on account of notices for infringement of registered trade marks;

(f) the criteria to be met to aid the Commission in making an objective assessment as to whether an applicant for approval as a registered trade mark agent has an appreciable knowledge of trade mark law;

(g) the application of the Commission's Guidelines on Approved Persons Regime to applicants for approval as registered trade mark agents with such modifications as may be appropriate; and

(h) any other matters contemplated by this Act for which regulations can be properly made.

Amendment of Schedules.

136. (1) The Cabinet may by Order, on the advice of the Commission, amend any Schedule to this Act in such manner as it considers necessary.

Schedules

(2) An Order made under subsection (1) shall

(a) be published in the *Gazette*; and

(b) be subject to a negative resolution of the House of Assembly.

Transitional provisions. Schedule 4

137. Schedule 4 shall have effect with respect to transitional matters contained in the Schedule with regard to the application and operation of the provisions of this Act.

Repeal and savings. Caps. 154, 157 and 158

138. (1) The Merchandise Marks Act, Registration of United Kingdom Trade Marks Act and Trade Marks Act are repealed.

(2) Notwithstanding the repeal of the Registration of United Kingdom Trade Marks Act and the Trade Marks Act, the Registration of United Kingdom Trade Marks Rules, 1947 and the Trade Marks Rules, 1937 shall, until revoked, continue to have effect with such modifications as may be necessary to ensure consistency with the provisions of this Act.

SCHEDULE 1

[Section 13 (2)]

CERTIFICATION TRADE MARKS

Scope of application.

1. This Act applies to certification trade marks subject to the provisions of this Schedule.

Signs of which a certification trade mark may consist.

2. In relation to a certification trade mark, the reference in section 2 (1) (with respect to the definition of "trade mark") to distinguishing goods or services of one person from those of another shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin of goods or services.

3. (1) Notwithstanding section 15 (1) (c), a certification trade mark which consists of a sign which may serve, in trade, to designate the geographical origin of goods or services may be registered.

(2) The owner of the certification trade mark referred to in sub-paragraph (1) is not entitled to prohibit the use of the sign in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Nature of owner's trade.

4. A certification trade mark shall not be registered if the owner of the mark carries on a trade involving the supply of goods or services of the kind certified.

Certification trade mark not to be misleading as to character or significance.

5. (1) A certification trade mark shall not be registered if the public is likely to be misled as regards its character or significance, in particular, if it is likely to be taken to be something other than a certification trade mark.

(2) The Registrar may, in relation to sub-paragraph (1), require that a sign in respect of which an application is made for registration as a certification trade mark include some indication that it is a certification trade mark.

(3) Notwithstanding section 49 (1) (b), an application may be amended so as to comply with any requirement imposed by the Registrar under subparagraph (2).

Regulations governing use of certification trade mark.

6. (1) An applicant for the registration of a certification trade mark shall file with the Registrar regulations governing the use of the certification trade mark.

(2) The regulations shall indicate

(a) the persons who are authorised to use the certification trade mark;

(b) the characteristics to be certified by the certification trade mark;

(c) how the certifying body is to test the characteristics referred to in subparagraph (b) and to supervise the use of the certification trade mark;

(d) the fees (if any) to be paid in connection with the use of the certification trade mark; and

(e) the procedures for resolving disputes.

(3) The rules may impose further requirements with which the regulations must comply.

Approval of regulations, etc.

7. (1) A certification trade mark shall not be registered unless

(a) the regulations governing its use comply with paragraph 6 (2) and any further requirements imposed by the rules, and are not contrary to public policy or to accepted principles of morality; and

(b) the applicant is competent to certify the goods or services for which the certification trade mark is to be registered.

(2) An applicant for the registration of a certification trade mark shall file the regulations and pay the prescribed fee before the end of the prescribed period after the date of the application for registration.

(3) If the applicant fails to comply with subparagraph (2), the application shall be deemed to be withdrawn.

Duty of Registrar.

8. (1) The Registrar shall consider whether the requirements mentioned in paragraph 7 (1) are met.

(2) If it appears to the Registrar that the requirements mentioned in paragraph 7 (1) are not met, he shall inform the applicant and give him an opportunity to make representations or to file amended regulations within such period as the Registrar may specify.

(3) The Registrar shall refuse the application if the applicant fails, within the period specified, to

(a) satisfy the Registrar that the requirements mentioned in paragraph 7 (1) are met; or

(b) file amended regulations so as to meet those requirements.

(4) If it appears to the Registrar that the requirements mentioned in paragraph 7 (1) and the other requirements for registration are met, he shall accept the application and proceed in accordance with section 48.

(5) In addition to any other grounds on which the registration of a certification trade mark may be opposed, notice of opposition may be given relating to any of the matters mentioned in paragraph 7 (1).

Inspection of regulations.

9. The regulations governing the use of a registered certification trade mark shall be open to public inspection in the same way as the register.

Amendment of regulations.

10. (1) An amendment of the regulations governing the use of a registered certification trade mark is not effective until the amended regulations are filed with, and accepted by, the Registrar.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to him expedient to do so, cause or require notice of the amendment to be published in the *Gazette*.

(3) Where notice of the amendment is published under subparagraph (2), notice of opposition may be given relating to any of the matters mentioned in paragraph 7 (1).

Consent to assignment, etc.

11. The assignment or other transmission of a registered certification trade mark is not effective without the consent of the Registrar.

Infringement: rights of authorised users.

12. The following provisions apply in relation to an authorised user of a registered certification trade mark as in relation to a licensee of a registered trade mark:

(a) section 29 (4); and

(b) section 114 (4).

Infringement: remedial action.

13. In infringement proceedings brought by the owner of a registered certification trade mark, any loss suffered or likely to be suffered by an authorised user shall be taken into account and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of the user.

Grounds for revocation of registration.

14. Apart from the grounds of revocation mentioned in section 67, the registration of a certification trade mark may also be revoked on the ground that

(a) the owner has begun to carry on such a trade as is mentioned in paragraph 4;

(b) the manner in which the owner uses the certification trade mark or allows it to be used has caused it to become liable to mislead the public in the manner referred to in paragraph 5 (1);

(c) the owner has failed to observe, or to secure the observance of, the regulations governing the use of the certification trade mark;

(d) an amendment of the regulations has been made so that the regulations

(i) no longer comply with paragraph 6 (2) and any further requirements imposed by the rules; or

(ii) are contrary to public policy or to accepted principles of morality; or

(e) the owner is no longer competent to certify the goods or services for which the certification trade mark is registered.

Grounds for invalidity of registration.

15. Apart from the grounds of invalidity mentioned in section 69, the registration of a certification trade mark may be declared invalid on the ground that the certification trade mark was registered in breach of paragraph 4, 5 (1) or 7 (1).

SCHEDULE 2

[Section 14 (2)]

COLLECTIVE TRADE MARKS

Scope of application.

1. This Act applies to collective trade marks subject to the provisions of this Schedule.

Signs of which a collective trade mark may consist.

2. In relation to a collective trade mark, the reference in section 2 (1) (with respect to the definition of "trade mark") to distinguishing goods or services of one person from those of another shall be construed as a reference to distinguishing goods or services of members of the association which is the owner of the collective trade mark from those which are not.

Indication of geographical origin of goods or services.

3. (1) Notwithstanding section 15 (1) (c), a collective trade mark which consists of a sign which may serve, in trade, to designate the geographical origin of goods or services may be registered.

(2) The owner of the collective trade mark referred to in subparagraph (1) is not entitled to prohibit the use of the sign in accordance with honest practices in industrial or commercial matters, in particular, by a person who is entitled to use a geographical name.

Collective trade mark not to be misleading as to character or significance.

4. (1) A collective trade mark shall not be registered if the public is likely to be misled as regards its character or significance, in particular, if it is likely to be taken to be something other than a collective trade mark.

(2) The Registrar may, in relation to subparagraph (1), require that a sign in respect of which an application is made for registration as a collective trade mark include some indication that it is a collective trade mark.

(3) Notwithstanding section 49 (1) (b), an application may be amended so as to comply with any requirement imposed by the Registrar under subparagraph (2).

Regulations governing use of collective trade mark.

5. (1) An applicant for the registration of a collective trade mark shall file with the Registrar regulations governing the use of the collective trade mark.

(2) The regulations shall specify

(a) the persons who are authorised to use the collective trade mark;

(b) the conditions of membership of the association; and

(c) where they exist, the conditions of use of the collective trade mark, including any sanctions against misuse.

(3) The rules may impose further requirements with which the regulations must comply.

Approval of regulations, etc.

6. (1) A collective trade mark shall not be registered unless

(a) the regulations governing its use comply with paragraph 5 (2) and any further requirements imposed by the rules; and

(b) are not contrary to public policy or to accepted principles of morality.

(2) An applicant for the registration of a collective trade mark shall file the regulations and pay the prescribed fee before the end of the prescribed period after the date of the application for registration.

(3) If the applicant fails to comply with subparagraph (2), the application shall be deemed to be withdrawn.

Duty of Registrar.

7. (1) The Registrar shall consider whether the requirements mentioned in paragraph 6 (1) are met.

(2) If it appears to the Registrar that the requirements mentioned in paragraph 6 (1) are not met, he shall inform the applicant and give him an opportunity to make representations or to file amended regulations within such period as the Registrar may specify.

(3) The Registrar shall refuse the application if the applicant fails, within the period specified, to

(a) satisfy the Registrar that the requirements mentioned in paragraph 6 (1) are met; or

(b) file amended regulations so as to meet those requirements.

(4) If it appears to the Registrar that the requirements mentioned in paragraph 6 (1) and the other requirements for registration are met, he shall accept the application and shall proceed in accordance with section 48.

(5) In addition to any other grounds on which the registration of a collective trade mark may be opposed, notice of opposition may be given relating to any of the matters mentioned in paragraph 6 (1).

Inspection of regulations.

8. The regulations governing the use of a registered collective trade mark shall be open to public inspection in the same way as the register.

Amendment of regulations.

9. (1) An amendment of the regulations governing the use of a registered collective trade mark is not effective until the amended regulations are filed with, and accepted by, the Registrar.

(2) Before accepting any amended regulations the Registrar may, in any case where it appears to him expedient to do so, cause or require notice of the amendment to be published in the *Gazette*.

(3) Where notice of the amendment is published under sub-paragraph (2), notice of opposition may be given relating to any of the matters mentioned in paragraph 6 (1).

Infringement: rights of authorised users.

10. The following provisions apply in relation to an authorised user of a registered collective trade mark as in relation to a licensee of a registered trade mark:

(a) section 29 (4); and

(b) section 114 (4).

Infringement: further rights of authorised users.

11. (1) The provisions of this paragraph (which correspond to the provisions of section 116) have effect as regards the rights of an authorised user in relation to infringement of a registered collective trade mark.

(2) An authorised user is entitled, subject to any agreement to the contrary between him and the owner of the registered collective trade mark, to call on the owner to take infringement proceedings in respect of any matter which affects his interests.

(3) If the owner of the registered collective trade mark

(a) refuses to commence infringement proceedings, or

(b) fails to commence infringement proceedings within one month after being called upon to do so,

the authorised user may, unless the licence or any licence through which he derives his interest provides otherwise, commence the proceedings in his own name as if he were the owner of the registered collective trade mark.

(4) Where infringement proceedings are commenced by virtue of this paragraph, the authorised user may not, without the leave of the Court, proceed with the action unless the owner is either joined as a plaintiff or added as a defendant.

(5) A person who is added as a defendant as mentioned in subparagraph (4) shall not be liable for any costs unless he takes part in the proceedings.

(6) Nothing contained in subparagraph (4) shall affect the granting of an interlocutory relief by the Court on the application of an authorised user alone.

(7) In infringement proceedings brought by the owner of a registered collective trade mark, any loss suffered or likely to be suffered by an authorised user shall be taken into account and the Court may give such directions as it thinks fit as to the

extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of the user.

Grounds for revocation of registration.

12. Apart from the grounds of revocation mentioned in section 67, the registration of a collective trade mark may also be revoked on the ground that

(a) the manner in which the owner uses the collective trade mark or allows it to be used has caused it to become likely to mislead the public in the manner referred to in paragraph 4 (1);

(b) the owner has failed to observe, or to secure the observance of, the regulations governing the use of the collective trade mark;

(c) an amendment of the regulations has been made so that the regulations

(i) no longer comply with paragraph 5 (2) and any further requirements imposed by the rules; or

(ii) are contrary to public policy or to accepted principles of morality; or

(d) the owner is no longer competent to certify the goods or services for which the collective trade mark is registered.

Grounds for invalidity of registration.

13. Apart from the grounds of invalidity mentioned in section 69, the registration of a collective trade mark may be declared invalid on the ground that the collective trade mark was registered in breach of paragraph 4 (1) or 6 (1).

SCHEDULE 3

[Section 133]

OFFENCES AND PENALTIES

Applying sign to mislead, or selling, possessing, etc. goods with misleading sign, etc.

1. (1) A person commits an offence if he, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the owner,

(a) applies to goods or their packaging a sign that is identical to, or that is likely to be mistaken for, a registered trade mark;

(b) sells or lets for hire, offers or exposes for sale or hire, or distributes goods which bear, or the packaging of which bears, a sign as referred to in sub-subparagraph (a);

(c) has in his possession, custody or control in the course of a trade any such goods with a view to the doing of anything, by himself or another, which would be an offence under sub-subparagraph (b);

(d) applies a sign that is identical to, or that is likely to be mistaken for, a registered trade mark to material intended to be used

(i) for labelling or packaging goods;

(ii) as a business paper in relation to goods; or

(iii) for advertising goods;

(e) uses in the course of a trade material bearing such a sign for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or

(f) has in his possession, custody or control in the course of a trade any such material with a view to the doing to anything, by himself or another, which would be an offence under sub-subparagraph (e).

(2) A person commits an offence if he, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the owner,

(a) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for, a registered trade mark, or

(b) has such an article in his possession, custody or control in the course of a business,

knowing or having reason to believe that it has been, or is to be, used to produce goods or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.

(3) A person who commits an offence under this paragraph is liable,

(a) on summary conviction, to imprisonment for a term not exceeding two years or a fine not exceeding five thousand dollars, or both; or

(b) on conviction on indictment, to imprisonment for a term not exceeding ten years or a fine not exceeding fifty thousand dollars, or both.

Defences to paragraph 1.

2. (1) A person does not commit an offence under paragraph 1 unless

(a) the goods relate to the trade mark that is registered; or

(b) the trade mark has a reputation in the Virgin Islands and the use of the sign takes or would take an unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark.

(2) It is a defence for a person charged with an offence under paragraph 1 to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark.

Making false entry in the register.

3. (1) A person commits an offence if he

(a) makes or causes to be made a false entry in the register, knowing or having reason to believe that it is false;

(b) makes or causes to be made anything falsely purporting to be a copy of an entry in the register; or

(c) produces or tenders or causes to be produced or tendered in evidence any such thing, knowing or having reason to believe that it is false.

(2) A person who commits an offence under subparagraph (1) is liable,

(a) on summary conviction, to imprisonment for a term not exceeding twelve months or a fine not exceeding ten thousand dollars, or both; or

(b) on conviction on indictment, to imprisonment for a term not exceeding five years or a fine not exceeding twenty-five thousand dollars, or both.

Falsely representing trade mark as registered.

4. (1) A person commits an offence if he

(a) falsely represents that a sign is a registered trade mark, or

(b) makes a false representation as to the goods or services for which a trade mark is registered,

knowing or having reason to believe that the representation is false.

(2) For the purposes of this paragraph, the use in the Virgin Islands in relation to a trade mark of

(a) the word "registered" or the symbol ®, or

(b) any other word or symbol importing a reference, whether express or implied, to registration,

shall be deemed to be a representation as to registration under this Act, unless it is shown that the reference is to registration elsewhere than in the Virgin Islands and that the trade mark is in fact so registered for the goods or services in question.

(3) A person who commits an offence under subparagraph (1) is liable on summary conviction to a fine not exceeding five thousand dollars.

Offences by bodies corporate. Cap. 136

5. (1) Where an offence under this Schedule has been committed by a body corporate, section 22 of the Interpretation Act shall apply, except that the words in that section to "the liability of whose members is limited" shall be omitted.

(2) Where the affairs of a body corporate are managed by its members, subparagraph (1) applies in relation to the acts and defaults of a member in connection with his functions of management as if he were a director of the body corporate.

(3) Where an offence under this Schedule is committed by a partnership, or by an unincorporated association other than a partnership, and is proved to have been committed with the consent or connivance of, or is attributable to the failure to exercise due diligence by, a partner in the partnership or, as the case may be, a person concerned in the management or control of the association, he, as well as the partnership or association, shall be guilty of that offence and liable to be proceeded against and punished accordingly.

(4) Subject to subparagraph (5), the reference in section 22 of the Interpretation Act to "director" shall be construed to include

(a) any person who occupies the position of director, by whatever name or title called; and

(b) any person in accordance with whose directions or instructions the directors of a body corporate are accustomed to act.

(5) A person shall not be treated as a director of a body corporate by reason only that the directors of the body corporate act on advice given by him in a professional capacity.

SCHEDULE 4

[Section 133]

TRANSITIONAL PROVISIONS

Interpretation.

1. For the purposes of this Schedule, unless the context otherwise requires,

"commencement date" means the date on which this Act comes into force pursuant to section 1;

"existing registered trade mark" means a trade mark that, immediately before the commencement date, constituted a registered trade mark under the repealed Act;

"new register" means the register of trade marks kept and maintained under section 89;

"old register" means the register of trade marks kept under the repealed Act; and

"repealed Act" means the Trade Marks Act repealed under section 138 and, where the context permits, includes the Merchandise Marks Act and Registration of United Kingdom Trade Marks Act similarly repealed under section 138.

Caps. 158, 154 and 157.

Matters before Court or Registrar at commencement date.

2. (1) Where prior to the commencement date a matter was pending before the Court or the Registrar for a decision by virtue of the repealed Act, that matter shall continue to be dealt with under the repealed Act, unless otherwise provided in this Schedule.

(2) For the purposes of subparagraph (1) and this Schedule, a matter shall be treated as pending before the commencement date if the matter was

(a) pending before the Registrar under the repealed Act but no written decision on the matter had been issued by the Registrar before the commencement date;

(b) the subject of a written decision issued by the Registrar under the repealed Act before the commencement date but the decision was subject to appeal and the period for commencing the appeal had not yet expired;

(c) the subject of proceedings under the repealed Act which were pending before a court immediately before the commencement date; or

(d) the subject of an order made by a court before the commencement date but the order was subject to appeal and the period for commencing the appeal had not yet expired.

Existing registered trade marks.

3. (1) From the commencement date, existing registered trade marks,

(a) shall be deemed to be transferred to the new register and, subject to this Schedule, shall be deemed to be similarly registered in the new register; and

(b) that were registered as a series under section 7 of the repealed Act shall be deemed to be similarly registered under the new register.

(2) The Registrar may put any entries in the old register of any series registered under section 7 of the repealed Act in the same form as is required for new entries made in the new register on or after the commencement date.

Pending proceedings.

4. (1) Where any proceedings brought pursuant to section 33 of the repealed Act are pending on the commencement date, they shall continue to be dealt with under the repealed Act, and any necessary alterations and entries arising as a result of the proceedings shall be made in the new register.

(2) If on the commencement date any entry is contained in the old register of a disclaimer, condition or restriction which relates to an existing registered trade mark, the entry shall be deemed to be transferred to the new register and shall have effect as if entered in the new register in accordance with the provisions of this Act.

Current infringements.

5. (1) The repealed Act shall apply in relation to any infringement committed before the commencement date.

(2) It is not an infringement of

(a) an existing registered trade mark, or

(b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing registered trade mark and which is registered for the same goods or services,

to continue on or after the commencement date any use which did not constitute an infringement of the existing registered trade mark under the repealed Act.

Infringing goods, material or articles.

6. Sections 112, 113 and 114 apply to infringing goods, material or articles whether made before, on or after the commencement date.

Assignment and transmission of registered trade mark.

7. (1) An existing entry in relation to an assignment or transmission of a registered trade mark made pursuant to the repealed Act shall be deemed to be transferred, on the commencement date, to the new register and shall have effect as if made under section 81.

(2) The Registrar may put any entries in the old register of any existing entries of an assignment or a transmission of a registered trade mark in the same form as is required for new entries made in the new register on or after the commencement date.

(3) An application for the registration of an assignment or a transmission which is pending on the commencement date shall be treated as an application for registration under section 81 and shall be dealt with accordingly.

(4) The Registrar may require the applicant to amend his application for registration in order to conform to the requirements of this Act.

(5) Where before the commencement date a person has become entitled by assignment or transmission to an existing registered trade mark but has not registered his title, any application for registration made on or after that date shall be made under section 81 and shall be dealt with accordingly.

Licensing of registered trade mark.

8. (1) Where before the commencement date a licence was granted pursuant to the repealed Act, any entry made in the old register in relation to the licence shall be deemed to be transferred to the new register on the commencement date and shall have effect as if made under section 81.

(2) Sections 85 and 86 (2) apply only in relation to a licence granted on or after the commencement date.

(3) The Registrar may put any entries in the old register of any existing entries of licences in the same form as is required for new entries made in the new register on or after the commencement date.

(4) An application made pursuant to the repealed Act for registration as a registered user which is pending on the commencement date shall be treated as an application for registration of a licence under section 81 (1) and shall be dealt with accordingly.

(5) The Registrar may require the applicant to amend his application in order to conform to the requirements of this Act.

(6) Where on the commencement date proceedings for any variation or cancellation of registration as a registered user is pending, the proceedings shall continue to be dealt with under the repealed Act, and any necessary alterations and entries arising as a result of the proceedings shall be made in the new register.

Pending applications for registration.

9. (1) Where an application for the registration of a trade mark under the repealed Act that was pending before the commencement date is subsequently registered, the registered trade mark shall be treated for the purposes of this Schedule as an existing registered trade mark.

(2) Section 10 of the repealed Act and any other provision of the repealed Act relating to opposition to registration continue to apply in relation to an application for the registration of a trade mark before the commencement date.

Conversion of pending application.

10. (1) Notwithstanding anything contained in this Schedule, where an application for the registration of a trade mark under the repealed Act has not been advertised under section 10 of the repealed Act before the commencement date, the applicant may give notice to the Registrar claiming to have the registrability of the trade mark determined in accordance with this Act.

(2) The notice referred to in subparagraph (1) shall

(a) be in the prescribed form;

(b) be accompanied by the prescribed fee; and

(c) be given no later than six months after the commencement date.

(3) A notice given pursuant to subparagraph (1) is irrevocable and the application for registration is to be treated as if made on the commencement date.

Trade marks registered according to old classification.

11. The Registrar may exercise the powers conferred by any rules made for the purposes of section 95 to secure that any existing registered trade mark that does not conform to the system of classification mentioned in section 39 is brought into conformity with that system.

Duration and renewal of registration.

12. (1) Section 58 applies in relation to the registration of a trade mark in pursuance of an application made on or after the commencement date, and the repealed Act continues to apply in any other case.

(2) Section 59 and the period for renewal of registration referred to in section 58 apply where the renewal falls due on or after the commencement date, and the repealed Act continues to apply in any other case.

(3) For the purposes of this paragraph, it is immaterial when the fee for renewal of registration, if any, is paid.

Pending application for alteration of registered trade mark.

13. Where an application under the repealed Act for the alteration of a registered trade mark is pending on the commencement date, the application shall continue to be dealt with under the repealed Act, and any necessary alterations and entries arising as a result of the application shall be made in the new register.

Pending application for revocation for non-use.

14. (1) Where an application under the repealed Act for the removal of a registered trade mark from the register or imposition of restrictions on non-use is pending on the commencement date, the application shall continue to be dealt with under the repealed Act, and any necessary alterations and entries arising as a result of the application shall be made in the new register.

(2) An application for the revocation of an existing registered trade mark may be made under section 67 at any time on or after the commencement date, but such an application may be made only on the ground mentioned in section 67 (2) (a).

Application for rectification, etc.

15. (1) Where an application or request under the repealed Act for rectification or correction of the register is pending on the commencement date, the application or request shall be dealt with under the repealed Act, and any necessary alterations and entries arising as a result of the application or request shall be made in the new register.

(2) For the purposes of proceedings under section 69 as it applies in relation to an existing registered trade mark, this Act shall be deemed to have been in force at all material times.

(3) No objection to the validity of the registration of an existing registered trade mark may be taken on the ground mentioned in section 24 (4).

Passed by the House of Assembly this 30th day of April, 2013.

(Sgd.) Ingrid Moses-Scatliffe,
Speaker.

(Sgd.) Phyllis Evans,
Clerk of the House of Assembly.