



BERMUDA

TRADE MARKS ACT 2023

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WHEREAS it is expedient to repeal the Trade Marks Act 1974 and replace it with a comprehensive statutory scheme for registered trade marks in order to give effect to

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the Protocol Relating to the Madrid Agreements Concerning International Registration of Marks of 27th June 1989, and selected provisions of the Paris Convention for the Protection of Industrial Property of 20th March 1883 and for connected purposes;

Be it enacted by The King's Most Excellent Majesty, by and with the advice and consent of the Senate and the House of Assembly of Bermuda, and by the authority of the same, as follows:

PART 1 PRELIMINARY

Citation

1 This Act may be cited as the Trade Marks Act 2023.

Interpretation

2 In this Act, unless the context otherwise provides—

- “assignment” means assignment by act of the parties concerned;
- “business” includes a trade or profession;
- “certification mark” has the meaning given in section 59;
- “collective mark” has the meaning given in section 58;
- “Convention country” has the meaning given in section 96;
- “Court ” means the Supreme Court of Bermuda;
- “date of the priority” means the date on which the first application for registration of the trade mark is made in a Convention country, which date shall be a priority only if the later application is made within six months from the date of the first application;
- “earlier right” shall, subject to section 16(5), be construed as provided in section 7(5)(c) and (6);
- “earlier trade mark” has the meaning given in section 9;
- “exclusive licence” has the meaning given in section 38;
- “infringement proceedings” in relation to a registered trade mark, includes proceedings under section 22 (order for delivery up of infringing goods);
- “infringing articles” has the meaning given in section 23(4);
- “infringing goods” shall be construed as provided in section 23(2);
- “infringing material” shall be construed as provided in section 23(3);

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- “international trade mark (BM)” has the meaning given in paragraph 1 of Schedule 3;
- “Madrid Protocol” has the meaning given in paragraph 1 of Schedule 3;
- “Minister” means the Minister responsible for intellectual property;
- “Nice Classification” has the meaning given in section 43;
- “Paris Convention” has the meaning given in section 96;
- “prescribed” means prescribed by regulations;
- “the register” means the register of trade marks kept under section 60;
- “registered trade mark” has the meaning given in section 4;
- “registered trade mark agent” has the meaning given in section 69(2);
- “the Registrar” means the Registrar-General authorized to record and register documents under section 3 of the Registrar-General (Recording of Documents) Act 1955;
- “Registry General” means the office of the Registrar-General;
- “regulations” means—
- (a) with respect to the Act, regulations made by the Minister;
 - (b) with respect to—
 - (i) Schedule 1, regulations governing the use of a collective mark required to be filed by an applicant;
 - (ii) Schedule 2, regulations governing the use of a certification mark required to be filed by an applicant;
- “trade mark” has the meaning given in section 3.

PART 2

REGISTERED TRADE MARKS

Meaning of “trade mark”

- 3 (1) In this Act “trade mark” means any sign—
- (a) which is capable of being represented in the register in a manner which enables the Registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor; and

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(b) which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

(2) A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.

(3) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark or certification mark.

Registered trade marks

4 (1) A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.

(2) No proceedings lie to prevent or recover damages for the infringement of an unregistered trade mark as such, but nothing in this Act affects the law relating to passing off.

Absolute grounds for refusal of registration

5 (1) Subject to subsection (2), the following shall not be registered—

- (a) signs which do not satisfy the requirements of section 3(1);
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.

(2) Notwithstanding subsection (1), a trade mark shall not be refused registration by virtue of subsection (1)(b), (c) or (d) if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

(3) A sign shall not be registered as a trade mark if it consists exclusively of—

- (a) the shape or another characteristic which results from the nature of the goods themselves;
- (b) the shape or another characteristic of goods which is necessary to obtain a technical result; or
- (c) the shape or another characteristic which gives substantial value to the goods.

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(4) A trade mark shall not be registered if—

- (a) it is contrary to public policy or to accepted principles of morality; or
- (b) it is of such a nature as to deceive the public with respect to such matters as to the nature, quality or geographical origin of the goods or service.

(5) A trade mark shall not be registered if or to the extent that its use is prohibited in Bermuda by any enactment or rule of law (other than the law relating to trade marks).

(6) A trade mark shall not be registered if its registration is prohibited by or under—

- (a) any enactment or rule of law in Bermuda; or
- (b) any international agreement to which the United Kingdom is a party and which is extended to Bermuda, providing for the protection of—
 - (i) designations of origin or geographical indications; or
 - (ii) traditional terms for wine or traditional specialities guaranteed.

(7) A trade mark shall not be registered if it—

- (a) consists of, or reproduces in its essential elements, an earlier plant variety denomination registered as mentioned in subsection (8); and
- (b) is in respect of plant varieties of the same or closely related species.

(8) Subsection (7)(a) refers to registration in accordance with any—

- (a) enactment or rule of law in Bermuda; or
- (b) international agreement to which the United Kingdom is a party and which is extended to Bermuda,

providing for the protection of plant variety rights.

(9) A trade mark shall not be registered in the cases specified, or referred to, in section 6 (specially protected emblems).

(10) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Specially protected emblems

6 (1) A trade mark which consists of or contains a representation of the following shall not be registered—

- (a) a representation of the Arms, or of any flag or seal, of Bermuda;

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- (b) a representation of—
 - (i) the arms or emblem of a city or town in Bermuda; or
 - (ii) the emblem of a public authority or public institution in Bermuda;
- (c) a mark which is specified in the regulations as being, for the purposes of this section, a prohibited mark.

(2) The Registrar shall not, unless he is satisfied that the requisite consent has been given by or on behalf of His Majesty or the relevant member of the Royal Family, as the case may be, register a trade mark which consists of or contains the following—

- (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 them or it;
- (b) a representation of the Royal Crown or any of the Royal flags;
- (c) a representation of His Majesty or any member of the Royal Family, or any colourable imitation thereof; and
- (d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation.

(3) A trade mark shall not be registered in relation to the—

- (a) national emblems and other signs of Convention countries; or
- (b) emblems and other signs of certain international organisations,

except as provided in sections 98 and 99 of this Act.

(4) The Minister may, by regulations, prohibit the registration of a trade mark that consists of or contains—

- (a) arms to which a person is entitled by virtue of a grant of arms by the Crown; or
- (b) insignia so nearly resembling such arms as to be likely to be mistaken for them,

unless the Registrar is satisfied that consent has been given by or on behalf of that person.

Relative grounds for refusal of registration

- 7 (1) A trade mark shall not be registered if—
- (a) it is identical with an earlier trade mark; and

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(b) the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with an earlier trade mark because—

(a) it is identical with the earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected;
or

(b) it is similar to the earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected.

(3) A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Bermuda and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

(4) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.

(5) A trade mark shall not be registered if, or to the extent that, its use in Bermuda 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, where the condition in subsection (7) is met;

(b) any enactment or rule of law providing for protection of designations of origin or geographical indications, where the condition in subsection (8) is met; or

(c) an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (b) of this subsection, in particular by virtue of the law of copyright or the law relating to industrial property rights.

(6) A person entitled under this section to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(7) The condition mentioned in subsection (5)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

(8) The condition mentioned in subsection (5)(b) is that—

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- (a) an application for a designation of origin or a geographical indication has been submitted prior to the date of application for registration of the trade mark or the date of the priority claimed for that application; and
- (b) the designation of origin or (as the case may be) geographical indication is subsequently registered.

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

(10) Where an agent or representative of the proprietor of a trade mark applies for the registration of the trade mark in his own name, the application shall be refused unless such agent or representative justifies that action.

Grounds for refusal relating to only some of the goods or services

8 Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application shall be refused in relation to those goods and services only.

Meaning of “earlier trade mark”

9 (1) In this Act, an “earlier trade mark” means—

- (a) a registered trade mark or international trade mark (BM) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks; or
- (b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well-known trade mark.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a), subject to it being so registered.

Raising of relative grounds in opposition proceedings in case of non-use

10 (1) This section applies where—

- (a) an application for registration of a trade mark has been published;
- (b) there is an earlier trade mark as provided in section 9(1)(a), in relation to which the conditions set out in section 7(1), (2) or (3) apply; and
- (c) the registration procedure for the earlier trade mark was completed not less than five years prior to the date of the application for registration mentioned in paragraph (a) or (where applicable) the date of the priority

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claimed for that application, and for purposes of this section “the five year period” is referred to in subsequent provisions as the “relevant period”.

(2) In opposition proceedings, the Registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met as provided in subsection (3).

(3) The use conditions are met if—

- (a) within the relevant period, the earlier trade mark has been put to genuine use in Bermuda by the proprietor or with his consent in relation to the goods or services for which it is registered; or
- (b) the earlier trade mark has not been so used, but there are proper reasons for the non-use of the trade mark.

(4) In this section—

- (a) use of a trade mark includes use in a variant form that differs in elements which do not alter the distinctive character of the mark in the form in which it was registered, regardless of whether or not the trade mark in such variant form is also registered in the name of the proprietor; and
- (b) use in Bermuda includes affixing the trade mark to goods or to the packaging of goods in Bermuda solely for export purposes.

(5) Where an earlier trade mark satisfies the use conditions in respect of only some of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(6) Nothing in this section affects—

- (a) the refusal of registration on absolute grounds as set out in section 5 or relative grounds of refusal on the basis of an earlier right as set out in section 7(5); or
- (b) the making of an application for a declaration of invalidity as provided for in section 56.

Raising of relative grounds in case of honest concurrent use

11 (1) Subject to subsection (2), where the Registrar is satisfied that there has been “honest concurrent use” of a trade mark which is the subject of an application for registration, he shall not be required to refuse the application on the basis of an earlier trade mark or earlier right irrespective of whether any of the grounds for refusal in section 7(1) to (5) are met.

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(2) Subsection (1) applies unless objection on one of the grounds in section 7(1) to (5) is raised in opposition proceedings by the proprietor of that earlier trade mark or other earlier right.

(3) Nothing in this section shall affect the refusal of registration on absolute grounds or the making of an application for a declaration of invalidity as provided for in section 56.

(4) The Minister may in regulations provide for—

- (a) circumstances where an application for registration on the basis of an earlier trade mark or earlier right may be refused;
- (b) the relative grounds for refusal that are to apply and have effect in lieu of this section.

Power to require that relative grounds be raised in opposition proceedings

12 (1) The Minister may by regulations provide that in any case a trade mark shall not be refused registration on a ground referred to in section 7 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right.

(2) The regulations may make such consequential provision as appears to the Minister appropriate—

- (a) with respect to the carrying out by the Registrar of searches of earlier trade marks; and
- (b) as to the persons by whom an application for a declaration of invalidity may be made on the grounds specified in section 56(3) (relative grounds).

(3) It may be provided in the regulations referred to in subsection (2)(a) that provisions of section 46 (examination of application) that require the Registrar to carry out a search of earlier trade marks shall cease to have effect.

(4) Regulations made for the purposes of subsection (2)(b) may provide that provisions in section 56(12) stating that any person may make an application for a declaration of invalidity shall have effect subject to the regulations.

(6) Regulations made under this section shall be subject to the affirmative resolution procedure.

PART 3

EFFECTS OF REGISTERED TRADE MARK

Rights conferred by registered trade mark

13 (1) The proprietor of a registered trade mark has exclusive rights in the trade mark which are infringed by use of the trade mark in Bermuda without his consent, and the acts amounting to infringement under this section are those specified in section 14(1), (2), (3) and (5).

(2) Subsection (1) is without prejudice to the rights of proprietors acquired before the date of filing of the application for registration or (where applicable) the date of the priority claimed in respect of that application.

(3) References in this Act to the infringement of a registered trade mark are to any infringement of the rights of the proprietor, including such as is mentioned in subsection (1) or section 14(5).

(4) The rights of the proprietor have effect from the date of registration (which in accordance with section 49(5) is the date of filing of the application for registration), except that—

- (a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- (b) no offence under section 86 (offences for unauthorised use of trade mark, etc.) is committed by anything done before the date of publication of the registration.

Infringement of registered trade mark

14 (1) A person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark, in relation to goods or services which are identical with those for which it is registered.

(2) A person infringes a registered trade mark if he uses in the course of trade a sign where there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark because—

- (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
- (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

(3) A person infringes a registered trade mark if he uses, in the course of trade in relation to goods or services, a sign which is identical with or similar to the trade mark,

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where the trade mark has a reputation in Bermuda and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the trade mark.

(4) Subsection (3) applies irrespective of whether the goods and services in relation to which the sign is used are identical with, similar to, or not similar to, those for which the trade mark is registered.

(5) Where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trade mark is affixed could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of the trade mark, a person infringes a registered trade mark if the person carries out in the course of trade any of the following acts—

- (a) affixing a sign identical with, or similar to, the trade mark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; or
 - (b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.
- (6) For the purposes of this section a person uses a sign if, in particular, he—
- (a) affixes it to goods or the packaging thereof;
 - (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
 - (c) imports or exports goods under the sign;
 - (d) uses the sign as a trade or company name or part of a trade or company name;
 - (e) uses the sign on business papers and in advertising.

Prohibition on the use of a trade mark registered in the name of an agent or representative

15 (1) Subsection (2) applies where a trade mark is registered in the name of an agent or representative of a person who is the proprietor of the trade mark, without such person's consent.

(2) Unless the agent or representative justifies the action mentioned in subsection (1), the person may do either or both of the following—

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- (a) prevent the use of the trade mark by the agent or representative (notwithstanding the rights conferred by this Act in relation to a registered trade mark);
- (b) apply for the rectification of the register so as to substitute his name as the proprietor of the registered trade mark.

Limits on effect of registered trade mark

16 (1) A registered trade mark is not infringed by the use of a later registered trade mark where that later registered trade mark would not be declared invalid pursuant to section 56(5) or (10) or section 57(1).

(2) Where subsection (1) applies, the later registered trade mark is not infringed by the use of the earlier trade mark even though the earlier trade mark may no longer be invoked against the later registered trade mark.

(3) A registered trade mark is not infringed by—

- (a) the use by an individual of his own name or address;
- (b) the use of signs or indications which are not distinctive or which concern the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; or
- (c) the use of the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular where that use is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts),

provided the use is in accordance with honest practices in industrial or commercial matters.

(4) A registered trade mark is not infringed by the use in the course of trade in Bermuda of an earlier right which applies only in Bermuda.

(5) In this section an “earlier right” means an unregistered trade mark or other sign continuously used in relation to goods or services by a person or a predecessor in title of his, from a date prior to whichever is the earlier of—

- (a) the use of the first-mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title of his; or
- (b) the registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his.

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(6) For the purposes of subsection (5) an earlier right shall be regarded as applying in Bermuda if, or to the extent that, its use in Bermuda is protected by virtue of any rule of law (in particular, the law of passing off).

Non-use as defence in infringement proceedings

17 (1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 55(1)(a) or (b) (revocation on basis of non-use) at the date the action for infringement is brought.

(2) Subsection (3) applies in relation to an action for infringement of a registered trade mark where the registration procedure for the trade mark was completed before the start of the period of five years ending with the date the action is brought.

(3) If the defendant so requests, the proprietor of the trade mark must furnish proof—

- (a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in Bermuda by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action; or
- (b) that there are proper reasons for non-use.

(4) Nothing in subsections (2) and (3) overrides any provision of section 55, as applied by subsection (1).

Exhaustion of rights conferred by registered trade mark

18 (1) 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 in Bermuda under that trade mark by the proprietor or with his consent.

(2) Subsection (1) does not apply where there exists legitimate reasons for the proprietor to oppose further dealings in the goods (in particular, where the condition of the goods has been changed or impaired after they have been put on the market).

Registration subject to disclaimer or limitation

19 (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may—

- (a) disclaim any right to the exclusive use of any specified element of the trade mark; or
- (b) agree that the rights conferred by the registration shall be subject to a specified limitation,

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and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 13 (rights conferred by registered trade mark) are restricted accordingly.

(2) The Minister may by regulations provide for the publication and entry in the register of a disclaimer or limitation.

Action for infringement

20 (1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to the proprietor as is available in respect of the infringement of any other property right.

Order for erasure etc. of offending sign

21 (1) Where a person is found to have infringed a registered trade mark, the Court may make an order requiring him—

- (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in his possession, custody or control; or
- (b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with, or it appears to the Court likely that such an order would not be complied with, the Court may order that the infringing goods, material or articles be delivered to such person as the Court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

Order for delivery up of infringing goods, material or articles

22 (1) The proprietor 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 business.

(2) An application shall not be made after the end of the period specified in section 24 (period after which remedy of delivery up not available).

(3) No order shall be made unless the Court also makes, or it appears to the Court that there are grounds for making, an order under section 25 (order as to disposal of infringing goods, material or articles).

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(4) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 25 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(5) Nothing in this section affects any other power of the Court.

Meaning of “infringing goods, material or articles”

23 (1) In this Act, the expressions “infringing goods”, “infringing material” and “infringing articles” shall be construed in accordance with this section.

(2) Goods are “infringing goods”, in relation to a registered trade mark, if they or their packaging bear a sign identical or similar to that registered trade mark and—

- (a) the application of the sign to the goods or their packaging was an infringement of the registered trade mark;
- (b) the goods are proposed to be imported into Bermuda and the application of the sign in Bermuda to them or their packaging would be an infringement of the registered trade mark; or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.

(3) Material is “infringing material”, in relation to a registered trade mark if it bears a sign identical with or similar to that registered trade mark and either—

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trade mark; or
- (b) it is intended to be so used and such use would infringe the registered trade mark.

(4) “Infringing articles”, in relation to a registered trade mark, means articles—

- (a) which are specifically designed or adapted for making copies of a sign identical with or similar to that registered trade mark; and
- (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or material.

Period after which remedy of delivery up not available

24 (1) An application for an order under section 22 (order for delivery up of infringing goods, material or articles) may not be made after the end of the period of six years from—

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- (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,

except as mentioned in subsection (2).

(2) If during the whole or part of that period the proprietor 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,

an application may be made 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, as the case may be, could with reasonable diligence have discovered those facts.

(3) For the purposes of this section “disability” has the meaning given in section 2(2) of the Limitation Act 1984.

Order as to disposal of infringing goods, material or articles

25 (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 22, an application may be made to the Court—

- (a) for an order that they be destroyed or forfeited to such person as the Court may think fit; or
- (b) for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the Court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests.

(3) Provision may be made by rules of court as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled—

- (a) to appear in proceedings for an order under this section, whether or not he was served with notice; and
- (b) to appeal against any order made, whether or not he appeared,

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and an order shall not take effect until the end of the period within which notice of an appeal may 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.

(4) Where there is more than one person interested in the goods, material or articles, the Court shall make such order as it thinks just.

(5) If the Court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return.

(6) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order could be made under this section or under section 142, 251 or 310 of the Copyright and Designs Act 2004 (which makes similar provision in relation to infringement of copyright, and rights in performances).

Threats of infringement proceedings

26 (1) A communication contains a "threat of infringement proceedings" if a reasonable person in the position of a recipient would understand from the communication that—

- (a) a registered trade mark exists; and
- (b) a person intends to bring proceedings (whether in a court in Bermuda or elsewhere) against another person for infringement of the registered trade mark by—
 - (i) an act done in Bermuda; or
 - (ii) an act which, if done, would be done in Bermuda.

(2) For the purposes of subsection (1)(b), the reference to proceedings for infringement of a registered trade mark includes a reference to—

- (a) proceedings for an order under section 22 (order for delivery up of infringing goods, material or articles); and
- (b) proceedings for an order under section 25 (order as to disposal of infringing goods, material or articles).

(3) References in this section to a "registered trade mark" include references to a trade mark in respect of which an application for registration has been published in accordance with this Act.

(4) References in this section and in section 29 to a "recipient" include, in the case of a communication directed to the public or a section of the public, references to a person to whom the communication is directed.

Actionable threats

27 (1) Subject to subsections (2) to (6), a threat of infringement proceedings made by any person is actionable by any person aggrieved by the threat.

(2) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of—

- (a) applying, or causing another person to apply, a sign to goods or their packaging;
- (b) importing, for disposal, goods to which, or to the packaging of which, a sign has been applied; or
- (c) supplying services under a sign.

(3) A threat of infringement proceedings is not actionable if the infringement is alleged to consist of an act which, if done, would constitute an infringement of a kind mentioned in subsection (2)(a), (b) or (c).

(4) A threat of infringement proceedings is not actionable if the threat—

- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(a) or (b) in relation to goods or their packaging; and
- (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to those goods or their packaging.

(5) A threat of infringement proceedings is not actionable if the threat—

- (a) is made to a person who has done, or intends to do, an act mentioned in subsection (2)(c) in relation to services; and
- (b) is a threat of proceedings for an infringement alleged to consist of doing anything else in relation to those services.

(6) A threat of infringement proceedings which is not an express threat is not actionable if it is contained in a permitted communication as provided in section 28(1).

Permitted communications

28 (1) For the purposes of section 27(6), a communication containing a threat of infringement proceedings is a “permitted communication” if—

- (a) the communication, so far as it contains information that relates to the threat, is made for a permitted purpose as provided in subsection (2);
- (b) all of the information that relates to the threat is information that is necessary for that purpose as defined in subsection (5), and that the person making the communication reasonably believes is true.

(2) Each of the following is a “permitted purpose”—

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- (a) giving notice that a registered trade mark exists;
- (b) discovering whether, or by whom, a registered trade mark has been infringed by an act mentioned in section 27(2);
- (c) giving notice that a person has a right in or under a registered trade mark, where another person's awareness of the right is relevant to any proceedings that may be brought in respect of the registered trade mark.

(3) Subject to subsection (4), the Court may, having regard to the nature of the purposes listed in subsection (2)(a) to (c), treat any other purpose as a "permitted purpose" if it considers that it is in the interests of justice to do so.

(4) Notwithstanding the powers the Court may exercise under subsection (3), the following shall not be treated as a "permitted purpose"—

- (a) requesting a person to cease using, in the course of trade, a sign in relation to goods or services;
- (b) requesting a person to deliver or destroy goods; or
- (c) requesting a person to give an undertaking relating to the use of a sign in relation to goods or services.

(5) Where any of the following information is included in a communication made for a permitted purpose, it shall be considered as information that is "necessary for that purpose"—

- (a) a statement that a registered trade mark exists and is in force or that an application for the registration of a trade mark has been made;
- (b) details of the registered trade mark, or of a right in or under the registered trade mark, which—
 - (i) are accurate in all material respects; and
 - (ii) are not misleading in any material respect; and
- (c) information enabling the identification of the goods or their packaging, or the services, in relation to which it is alleged that the use of a sign constitutes an infringement of the registered trade mark.

(6) References in this section to a "registered trade mark" include references to a trade mark in respect of which an application for registration has been published in accordance with this Act.

Remedies and defences

29 (1) Proceedings in respect of an actionable threat may be brought against the person who made the threat for—

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- (a) a declaration that the threat is unjustified;
- (b) an injunction against the continuance of the threat;
- (c) damages in respect of any loss sustained by the aggrieved person by reason of the threat.

(2) It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the registered trade mark.

(3) It is a defence for the person who made the threat to show—

- (a) that, despite having taken reasonable steps, the person has not identified anyone who has done an act mentioned in section 27(2)(a), (b) or (c) in relation to the goods or their packaging or the services which are the subject of the threat; and
- (b) that the person notified the recipient, before or at the time of making the threat, of the steps taken.

(4) Where the threat of infringement proceedings is made after an application for registration has been published, but before such registration has occurred, the reference to “the registered trade mark” in subsection (2) shall be treated as a reference to the trade mark registered in pursuance of that application.

(5) In this section and section 30, “an actionable threat” means a threat of infringement proceedings that is actionable in accordance with section 27.

Professional advisers

30 (1) Proceedings in respect of an actionable threat may not be brought against a professional adviser (or any person vicariously liable for the actions of that professional adviser) if the following conditions are met—

- (a) in making the communication the professional adviser is acting on the instructions of another person; and
- (b) when the communication is made the professional adviser identifies the person on whose instructions the adviser is acting.

(2) In this section “professional adviser” means a person who, in relation to the making of the communication containing the threat—

- (a) is acting in a professional capacity in providing legal services or the services of a registered trade mark agent; and
- (b) is registered with the Registry General as an agent on any register of trade mark agents maintained by the Registrar under section 69.

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(3) This section does not affect any liability of the person on whose instructions the professional adviser is acting.

(4) A person asserting exemption based on communications made in the course of him acting as a professional adviser shall, if required, prove that at the time the actionable threat was communicated—

- (a) he was acting as a professional adviser; and
- (b) the conditions referred to in subsection (1) were met.

Registered trade mark as object of property

Nature of registered trade mark

31 A registered trade mark is personal property.

Co-ownership of registered trade mark

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

(2) The following provisions apply where two or more persons are co-proprietors of a registered trade mark, by virtue of subsection (1) or otherwise.

(3) Subject to any agreement to the contrary and to subsection (4), each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

- (4) One co-proprietor shall not without the consent of the other or others—
- (a) grant a licence to use the registered trade mark; or
 - (b) assign or charge his share in the registered trade mark.

(5) Subject to subsection (6), infringement proceedings may be brought by any co-proprietor, but he may not, without the leave of the Court, proceed with the action unless the other, or each of the others, is either joined as a plaintiff or added as a defendant.

- (6) Subsection (5) applies to a co-proprietor, except that—
- (a) a co-proprietor who is thus added as a defendant shall not be made liable for any costs in the action unless he takes part in the proceedings;
 - (b) nothing in subsection (5) affects the granting of interlocutory relief on the application of a any one of the co-proprietors.

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(7) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

Assignment etc. of registered trade marks

33 (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) The transmission of a registered trade mark may occur—

- (a) in connection with the goodwill of a business; or
- (b) independently of such business.

(3) A contractual obligation to transfer a business shall be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply.

(4) An assignment or other transmission of a registered trade mark may be effected in part, or with limitations, so as to apply in relation to—

- (a) some but not all of the goods or services for which the trade mark is registered; or
- (b) use of the trade mark in a particular manner.

(5) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

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

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

(8) Nothing 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.

Registration of transactions affecting registered trade mark

34 (1) On application being made to the Registrar by—

- (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 such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions—

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- (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 personal representatives of an assent in relation to a registered trade mark or any right in or under it;
 - (e) an order of a Court or other 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 it; and
 - (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of sections 39 or 40 relating to rights and remedies of licensee in relation to infringement.
- (4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction and the mark is infringed before the prescribed particulars of the transaction are registered, in proceedings for such an infringement, the Court shall not award him costs unless—
- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with the date of the registrable transaction; or
 - (b) the Court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter.
- (5) The Minister may make regulations providing 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 such particulars from the register—
 - (i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired; or
 - (ii) where no such 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.

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(6) Regulations made under subsection (5) may also provide for the amendment or removal from the register of particulars relating to a security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

Trusts and equities

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

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

(3) For the avoidance of doubt, this section does not prevent the registration of a trade mark or the registration of particulars of a registrable transaction in the name of a trustee.

Application for registration of trade mark as an object of property

36 (1) Sections 31 to 35 (which relate to a registered trade mark as an object of property) and sections 37 to 40 (which relate to licensing) apply, with the necessary modifications, in relation to an application for the registration of a trade mark as in relation to a registered trade mark.

(2) In section 32 (co-ownership of registered trade mark) as it applies in relation to an application for registration, the reference in section 32(1) to the granting of the registration shall be construed as a reference to the making of the application.

(3) In section 34 (registration of transactions affecting registered trade mark) 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

Licensing of registered trade mark

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

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

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

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

(3) A licence is not effective unless it is in writing signed by or on behalf of the grantor, except that this requirement may be satisfied in a case where the grantor is a body corporate by the affixing of its seal.

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

(5) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.

(6) The proprietor of a registered trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in the licence with regard to—

- (a) its duration;
- (b) the form covered by the registration in which the trade mark may be used;
- (c) the scope of the goods or services for which the licence is granted;
- (d) the territory in which the trade mark may be affixed; or
- (e) the quality of the goods manufactured or of the services provided by the licensee.

Exclusive licenses

38 (1) An "exclusive licence" means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence, and the expression "exclusive licensee" shall be construed accordingly.

(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.

General provisions as to rights of licensees in case of infringement

39 (1) Except as otherwise provided under this Act or by the terms of the licence, a licensee may only bring proceedings for infringement of the registered trade mark (with respect to which he is licensed) with the consent of the proprietor.

(2) An exclusive licensee may request the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(3) If the proprietor mentioned in subsection (2)—

- (a) refuses to do so; or
- (b) fails to do so within two months following such request,

the exclusive licensee may bring the proceedings in his own name as if he were the proprietor.

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(4) Where infringement proceedings are brought by a licensee by virtue of this section or with the consent of the proprietor or pursuant to the licence, the licensee may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

(5) Subsection (4) does not affect the granting of interlocutory relief on an application by a licensee alone.

(6) A proprietor who is added as a defendant pursuant to subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) In infringement proceedings brought by the proprietor of a registered trade mark—

- (a) any loss suffered or likely to be suffered by licensees shall be taken into account;
- (b) a licensee who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss; and
- (c) 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 exclusive licensees.

(8) This section shall not apply where or to the extent that, by virtue of section 40, the exclusive licensee has a right to bring proceedings in his own name.

(9) This section shall apply in relation to an exclusive licensee as if he were the proprietor of the registered trade mark, if or to the extent that he has, by virtue of section 40(1) the rights and remedies of an assignee.

Exclusive licensee having rights and remedies of assignee

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

(2) Where or to the extent that such provision is made, the licensee is entitled, subject to the licence and to the other provisions of this section, to bring infringement proceedings, against any person other than the proprietor, in his own name.

(3) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in this Act relating to infringement shall be construed accordingly.

(4) In an action brought 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 action had been brought by the proprietor of the registered trade mark.

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(5) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee 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; except that the requirement thereof with respect to the proprietor or exclusive licensee shall not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(6) A proprietor or exclusive licensee who is added as a defendant as mentioned in subsection (5) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor 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 by the Court 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 as the Court considers just, subject to any agreement between them.

(8) This section applies whether or not the proprietor and the exclusive licensee are both parties to the action; 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.

(9) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 22 (order for delivery up of infringing goods, material or articles); and the Court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(10) Subsections (5) to (9) have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

PART 4

APPLICATION FOR REGISTERED TRADE MARK

Application for registration

- 41 (1) An application for registration of a trade mark shall be made to the Registrar.
- (2) The application shall be submitted in the prescribed form together with payment of the prescribed application fee and class fees as may be appropriate.
- (3) The application shall contain—
- (a) a request for registration of a 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; and
 - (d) a representation of the trade mark which is capable of being represented in the register in a manner which enables the Registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor.
- (4) The application shall state that—
- (a) the trade mark is being used, in relation to those goods or services, by the applicant or with his consent; or
 - (b) the applicant has a bona fide intention that it should be so used.

Date of filing

- 42 (1) The date of filing of an application for registration of a trade mark is the date on which all documents, information and payment required under section 41(2) are furnished to the Registrar by the applicant.
- (2) If the documents are furnished on different days, the date of filing is the last of those days.
- (3) References in this Act to the date of application for registration are to the date of filing of the application.

Classification of trade marks in accordance with Nice Classification

- 43 (1) Goods and services shall be classified for the purposes of the registration of trade marks in accordance with the Nice Classification.
- (2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar.

(3) For the purposes of this Act, goods and services shall not be regarded as being—

- (a) similar to each other solely on the ground that they appear in the same class under the Nice Classification; or
- (b) dissimilar from each other solely on the ground that they appear in different classes under the Nice Classification.

(4) In this section “Nice Classification” means the system of classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as amended from time to time.

Priority

Claim to priority of Convention application

44 (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services.

(2) An application in respect of which a right to priority is claimed shall be made within a period of six months from the date of filing of the first Convention application.

(3) If the application for registration under this Act is made within that six-month period—

- (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application; and
- (b) the registrability of the trade mark shall not be affected by any use of the mark in Bermuda in the period between that date and the date of the application under this Act.

(4) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

(5) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application the previous application—

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

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

(6) If, in accordance with subsection (5), a subsequent application is considered to be the first Convention application, the previous application may not thereafter serve as a basis for claiming a right of priority

(7) The Minister may by regulations provide for the manner of claiming a right to priority on the basis of a Convention application.

(8) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

(9) For the purposes of—

(a) subsection (1), the reference to the applicant's "successor in title" shall be construed accordingly;

(b) subsection (4), "regular national filing" means a filing which is adequate to establish the date on which the application was filed in that country, whatever may be the subsequent date of the application.

Claim to priority from other relevant overseas application

45 (1) The Minister may by regulations provide for conferring a right to priority on a person who has duly filed an application for protection of a trade mark in any country in relation to which the United Kingdom has entered into a treaty, convention, arrangement or engagement for the reciprocal protection of trade marks, which has been extended to Bermuda.

(2) The right to priority shall be available in relation to applications made in Bermuda for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application.

Registration procedure

Examination of application

46 (1) The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act.

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

(3) If it appears to the Registrar that the requirements for registration are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, for the applicant to make representations or to amend the application.

(4) If the applicant fails to—

- (a) satisfy the Registrar that requirements for registration are met;
- (b) amend the application so as to meet the requirements for registration; or
- (c) respond before the end of the specified period under subsection (3),

then the Registrar shall refuse to accept the application.

(5) If it appears to the Registrar that the requirements for registration are met, he shall accept the application.

Publication, opposition proceedings and observations

47 (1) When an application for registration has been accepted, the Registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the Registrar of opposition to the registration.

(3) The notice referred to in subsection (2) shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) Where a notice of opposition is filed on the basis of one or more earlier trade marks or other earlier rights—

- (a) the rights (if more than one) must all belong to the same proprietor;
- (b) the notice may be filed on the basis of some or all of the goods or services in respect of which the earlier right is protected or applied for.

(5) A notice of opposition may be directed against some or all of the goods or services in respect of which the application for the trade mark has been made.

(6) Where an application has been published, any person may, at any time before the registration of the trade mark, make observations in writing to the Registrar as to whether the trade mark should be registered.

(7) The Registrar shall inform the applicant of any observations made as provided under subsection (6) that he has received.

(8) A person who makes observations as provided under subsection (6) does not thereby become a party to the proceedings on the application.

Withdrawal, restriction or amendment of application

48 (1) An applicant for registration of a trade mark may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If the application has been published, the withdrawal or restriction shall also be published.

(3) In other respects, an application may be amended, at the request of the applicant, only by correcting—

- (a) the name or address of the applicant;
- (b) errors of wording or of copying; or
- (c) obvious mistakes.

(4) An amendment under subsection (3) may only be made to the extent that the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.

(5) The Minister may by regulations provide for the publication of any amendment which affects—

- (a) 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 it.

Registration

49 (1) Subject to subsections (2), (3) and (4), the Registrar shall register a trade mark in respect of which an application has been accepted and—

- (a) no notice of opposition is given within the prescribed period; or
- (b) all opposition proceedings are withdrawn or decided in favour of the applicant.

(2) A registration under subsection (1) shall be completed by the Registrar unless, having regard to matters coming to his notice since the application was accepted as provided under section 46(5), it appears to him that the registration requirements, other than those mentioned in section 7(1), (2) or (3), were not met at the time of such acceptance.

(3) A trade mark shall not be registered unless the fee prescribed for registration is paid—

- (a) within three months from the date of notice by the Registrar to the applicant of the pending registration; or

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(b) within such extended period, not exceeding three months, as the Registrar may grant on application being made before the expiry of the period referred to in paragraph (a).

(4) If the fee is not paid within that period, the application shall be deemed to be withdrawn.

(5) A trade mark registered under this Act 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.

(6) On the registration of a trade mark the Registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

Regulations for registration: supplementary provisions

50 (1) The Minister may by regulations provide for any or all of the following matters—

- (a) the division of an application for the registration of a trade mark into several applications;
- (b) the division of a registration of a trade mark into several registrations;
- (c) the merging of separate applications or registrations; and
- (d) the registration of a series of trade marks.

(2) A “series of trade marks” means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) Regulations made under this section may include provision relating to—

- (a) the circumstances and conditions under which, division, merger or registration of a series is permitted;
- (b) the purposes for which an application or registration is to be treated as a single application or registration; and
- (c) the purposes for which an application or registration is to be treated as a number of separate applications or registrations.

Duration, renewal and alteration of registered trade mark

Duration of registration

51 (1) A trade mark shall be registered for a period of ten years from the date of registration.

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(2) Registration may be renewed in accordance with section 52 for further periods of ten years.

Renewal of registration

52 (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to payment of the prescribed renewal fee.

(2) The Minister may in the regulations provide for the Registrar to inform the proprietor of a registered trade mark, prior to the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration.

(4) If renewal is not effected prior to expiry of the registration, the request for renewal may be made and the prescribed fees paid within such further period as may be prescribed.

(5) If a request for renewal is made in respect of only some of the goods or services for which the trade mark is registered, the registration shall be renewed for those goods or services only.

(6) Renewal shall take effect from the expiry of the previous registration.

(7) If the registration is not renewed in accordance with the above provisions, the Registrar shall remove the trade mark from the register.

(8) The Minister may make regulations as to the restoration of the registration of a trade mark which has been removed from the register.

(9) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner.

Alteration of registered trade mark

53 (1) A registered trade mark shall not be altered in the register, during the period of registration or on renewal.

(2) Notwithstanding subsection (1), the Registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address.

(3) Where an alteration is made as provided in subsection (2), the alteration shall be limited to alteration of the proprietor's name or address, provided that the alteration does not substantially affect the identity of the mark.

(4) The Minister may make regulations as to the publication of any such alteration and the making of objections by any person claiming to be affected by it.

Surrender of registered trade mark

54 (1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

(2) The Minister may make regulations—

- (a) as to the manner and effect of a surrender; and
- (b) for protecting the interests of other persons having a right in the registered trade mark.

Revocation of registration

55 (1) The registration of a trade mark may be revoked on any of the following grounds—

- (a) that within the five years following the date of completion of the registration procedure it has not been put to genuine use in Bermuda by the proprietor, or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;
- (d) that in consequence of the use made of it by the proprietor, or with his consent, in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

(2) For the purposes of subsection (1)—

- (a) use of a trade mark includes use in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether the trade mark in the differing form is also registered in the name of the proprietor); and
- (b) use in Bermuda includes affixing the trade mark to goods or to the packaging of goods in Bermuda solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that subsection is commenced or resumed after the expiry of the five-year period and before the application for revocation is made.

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(4) For the purposes of subsection (3), any commencement or resumption of use after the expiry of the five year period but within the period of three months before any application for revocation is made, shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(5) An application for revocation may be made by any person, and may be made either to the Registrar or to the Court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application must 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.

(6) 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.

(7) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—

- (a) the date of the application for revocation; or
- (b) if the Registrar or Court is satisfied that the grounds for revocation existed at an earlier date, that date.

Grounds for invalidity of registration

56 (1) The Court or Registrar, as the case may be, may declare invalid the registration of a trade mark on the ground that the trade mark was registered in breach of the absolute grounds for refusal set out in section 5.

(2) Where the trade mark was registered in breach of the grounds set out in section 5(1)(b), (c) or (d), it shall not be declared invalid if, in consequence of the use which has been made of it, the trade mark has, after registration, acquired a distinctive character in relation to the goods or services for which it is registered.

(3) Subject to subsections (5) and (10), the registration of a trade mark may be declared invalid on the ground that—

- (a) there is an earlier trade mark in relation to which the conditions set out in section 7(1), (2) or (3) apply; or
- (b) there is an earlier right in relation to which the condition set out in section 7(5) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

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(4) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7(10).

(5) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

- (a) the registration procedure for the earlier trade mark was completed within the period of five years ending on the date of the application for the declaration;
- (b) the registration procedure for the earlier trade mark was not completed before that date; or
- (c) the use conditions are met as set out in subsection (6).

(6) The use conditions are met if—

- (a) the earlier trade mark has been put to genuine use in Bermuda in relation to the goods or services for which it is registered either by the proprietor or with his consent—
 - (i) during the five-year period ending on the date of application for the declaration of invalidity; and
 - (ii) during the five-year period ending on the date of filing of the application for registration of the later trade mark or the priority date for such, if applicable, provided that on such date, the five-year period within which the earlier trade mark should have been put to genuine use as provided in section 55(1)(a) has expired; or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(7) For the purposes of subsection (6)—

- (a) use of a trade mark includes use in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether the trade mark in the differing form is also registered in the name of the proprietor); and
- (b) use in Bermuda includes affixing the trade mark to goods or to the packaging of goods in Bermuda solely for export purposes.

(8) Where an earlier trade mark satisfies the use conditions in respect of only some of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(9) Subsection (5) shall not apply in cases where the earlier trade mark is a trade mark entitled to protection under the Paris Convention as a well-known trade mark pursuant to section 9(1)(b).

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(10) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (11), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or the priority date claimed in respect of that application.

(11) The reasons referred to in subsection (10) are as follows—

- (a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 5(1)(b), (c) or (d), and had not yet acquired a distinctive character as stated in section 5(2);
- (b) that the application for a declaration of invalidity is based on section 7(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 7(2);
- (c) that the application for a declaration of invalidity is based on section 7(3) and the earlier trade mark had not yet acquired a reputation within the meaning of section 7(3).

(12) An application for a declaration of invalidity may be made by any person, and shall be made to the Registrar, except that—

- (a) if proceedings concerning the trade mark in question are pending in the Court, the application must be made to the Court; and
- (b) where the application is made to the Registrar, he may at any stage of the proceedings refer the application to the Court.

(13) In the case of bad faith in the registration of a trade mark, the Registrar may apply to the Court for a declaration of the invalidity of the registration.

(14) 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 in relation to those goods or services only.

(15) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(16) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made, provided that such declaration of invalidity shall not affect any prior transactions that have been completed.

Effect of acquiescence

57 (1) Where the proprietor 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

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Bermuda, 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 relation to which it has been so used,

unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor 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 right may no longer be invoked against his later trade mark.

Collective marks and certification marks

Collective marks

- 58 (1) A collective mark is a mark which—
- (a) is described as such when it is applied for; and
 - (b) is capable of distinguishing the goods and services of members of the association which is the proprietor of the mark from those of other undertakings.
- (2) The following may be registered as the proprietor of a collective mark—
- (a) an association of manufacturers, producers, suppliers of services or traders, which has the capacity to enter into contracts and to sue or be sued in its own name; and
 - (b) a legal entity incorporated under the laws of Bermuda or the laws of any other jurisdiction.
- (3) This Act applies to collective marks subject to Schedule 1 to this Act.

Certification marks

- 59 (1) A certification mark is a mark which—
- (a) is described as such when the mark is applied for; and
 - (b) indicates that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.
- (2) This Act applies to certification marks subject to Schedule 2 to this Act.

PART 5

REGISTER AND POWERS OF THE REGISTRAR

Register

- 60 (1) The Registrar shall maintain a register of trade marks.
- (2) There shall be entered in the register in accordance with this Act—
- (a) registered trade marks;
 - (b) such particulars as may be prescribed of registrable transactions affecting a registered trade mark; and
 - (c) such other matters relating to registered trade marks as may be prescribed.
- (3) The register shall be kept in such manner as the Registrar may determine or as may be prescribed, and includes the register being kept in an electronic format.
- (4) The Minister may in the regulations provide for—
- (a) public inspection of the register; and
 - (b) the supply of certified or uncertified copies or extracts of entries in the register, on payment of the prescribed fee.

Rectification or correction of the register

- 61 (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register.
- (2) An application for rectification under subsection (1) may not be made in respect of a matter affecting the validity of the registration of a trade mark.
- (3) An application for rectification shall be made to the Registrar, except that—
- (a) if proceedings concerning the trade mark in question are pending in the Court, the application must be made to the Court; and
 - (b) where the application is made to the Registrar, he may at any stage of the proceedings refer the application to the Court.
- (4) Except where the Registrar or the Court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.
- (5) The Registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in the proprietor's name or address as recorded in the register.

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

Adaptation of entries to new classification

62 (1) The Minister may make regulations empowering 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.

(2) The regulations may, in particular, provide for the amendment of existing entries on the register so as to accord with the new classification.

(3) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Registrar that—

- (a) compliance with this requirement would involve undue complexity;
- (b) any extension would not be substantial; and
- (c) the extension would not adversely affect the rights of any person.

(4) The Minister may in the regulations provide for the Registrar to—

- (a) make any amendment or substitution to an existing classification of goods or services entered in the register so that it accords with the prescribed classification system;
- (b) require the proprietor to file a proposal for amendment of the register, by written notice sent to the proprietor of the registered trade mark; and
- (c) cancel or refuse to renew the registration of the trade mark in the event of the proprietor failing to do so.

(5) Any such proposal referred to in subsection (4)(b) shall be—

- (a) filed with the Registrar within two months from the date of the written notice from the Registrar, subject to any extension of time which may be granted by the Registrar; and
- (b) advertised, and may be opposed, in such manner as may be prescribed.

Powers and duties of the Registrar

Power to require use of forms

63 (1) The Minister may make regulations providing for—

- (a) the use of such forms or other format for submission of any notices, statements or other documents to the Registrar; and

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(b) the Registrar to require any other additional information he may deem necessary.

(2) Any form required to be completed under the regulations, may be set out on the Registry General website: <http://www.gov.bm>.

Information about applications and registered trade marks

64 (1) After publication of an application for registration of a trade mark, the Registrar shall on request provide a person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject to any prescribed restrictions.

(2) Any request under subsection (1) must be made in such manner as may be prescribed or as the Registrar may require, if not so prescribed, and must be accompanied by the prescribed fee.

(3) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the Registrar or communicated by him to any person except—

- (a) in such cases and to such extent as may be prescribed; or
- (b) with the consent of the applicant.

Costs and security for costs

65 (1) In any proceedings before the Registrar under this Act, the Registrar shall have power to—

- (a) award any party such costs as he may consider reasonable;
- (b) direct how and by what parties they are to be paid; and
- (c) require a party to give security for costs, in relation to those proceedings or to proceedings on appeal.

(2) Any such order of the Registrar under subsection (1)(a) or (b) may be enforced in the same way as an order of the Court.

(3) The Minister may make regulations in furtherance of this section as to the consequences if security for costs referred to in subsection (1)(c) is not given.

Evidence before Registrar

66 (1) The Registrar shall have the power to require the attendance of witnesses and the production of documents and to take evidence on oath, and shall for the purposes of any proceedings before him under this Act have all the powers possessed by

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a judge of the Court in relation to proceedings in the Court, and the Court shall have power to enforce the orders of the Registrar as if they were those of a judge.

- (2) The Minister may make regulations—
- (a) as to the giving of evidence in proceedings before the Registrar under this Act;
 - (b) applying in relation to the attendance of witnesses in proceedings before the Registrar the rules applicable to the attendance of witnesses before him.

Exclusion of liability in respect of official acts

67 (1) The Registrar shall not be taken to warrant the validity of the registration of a trade mark under or pursuant to this Act or under any treaty, convention, arrangement or engagement that has been extended to Bermuda.

(2) The Registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised by this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.

(3) No proceedings lie against any public officer acting for, on behalf of, or at the direction of the Registrar in respect of any matter for which, by virtue of this section, the Registrar is not liable.

Trade mark agents

Recognition of agents

68 Except as otherwise provided in the regulations, any act required or authorised by this Act to be done by or in relation to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or in relation to an agent authorised by that person.

Register of trade mark agents

69 (1) The Minister may make regulations requiring the keeping of a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks.

(2) The register shall be known as “the register of trade mark agents”, and in this Act a “registered trade mark agent” means a person whose name is entered in the register kept pursuant to regulations under this section.

(3) The regulations may contain such provision as the Minister thinks fit for regulating the registration of such persons, and may in particular—

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- (a) require the payment of prescribed fees; and
- (b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person's registration.

Unregistered persons not to be described as registered trade mark agents

70 (1) Subject to subsection (3), no person shall—

- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words "registered trade mark agent"; or
- (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent,

unless such person is registered in the register of trade mark agents.

(2) A person who contravenes this section is guilty of an offence and is liable on summary conviction to a fine of \$5,000.

(3) This section has effect only if regulations have been made under section 69 requiring the keeping of the register of trade mark agents.

Privilege for communications with attorney registered as trade mark agents

71 (1) This section applies to communications as to any matter relating to the protection of any design or trade mark, or as to any matter involving passing off.

(2) Nothing in this Act shall require the disclosure or production by a registered trade mark agent who is also an attorney of any communication in relation to a matter mentioned in subsection (1) which he would be entitled to refuse to disclose or produce on the grounds of legal professional privilege in proceedings in Bermuda if such person had at all times been acting as the person's attorney.

Power of Registrar to refuse to deal with certain agents

72 (1) The Minister may make regulations authorising the Registrar to refuse to recognise as agent in respect of any business under this Act—

- (a) a person who has been convicted of an offence under section 70(2) (unregistered persons not to be described as registered trade mark agents);
- (b) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct;

- (c) a person who is found by the Registrar to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark agents, render him liable to have his name erased from the register on the ground of misconduct;
- (d) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognise under paragraph (a), (b) or (c).

(2) The regulations may contain such incidental and supplementary provisions as appear to the Minister to be appropriate and may, in particular, prescribe circumstances and procedures in which a person is or is not to be taken to have been guilty of misconduct.

Fees and times of operation of Registry General

Fees

73 There shall be paid in respect of applications and registrations and other matters under this Act such fees as may be prescribed under the Government Fees Act 1965.

Hours of business and business days

74 The Registry General shall be open to the public and the register will be open to inspection on such days and times as may be prescribed.

PART 6

LEGAL PROCEEDINGS, REFEREE AND APPEALS

Registration to be prima facie evidence of validity

75 In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register), the fact that a person is registered as proprietor of the trade mark shall be prima facie evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions of the trade mark.

Certificate of validity of contested registration

76 (1) If, in proceedings before the Court, the validity of the registration of a trade mark is contested and it is found by the Court that the trade mark is validly registered, the Court may give a certificate to that effect.

(2) If the Court gives such a certificate and in subsequent proceedings—

- (a) the validity of the registration is again questioned; and
- (b) the proprietor obtains a final order or judgment in his favour,

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he is entitled to his costs as between attorney and client unless the Court directs otherwise.

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

Burden of proving use of trade mark

77 If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.

Registrar's appearance in proceedings involving the register

78 (1) In proceedings before the Court involving an application for—

- (a) the revocation 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 affecting the matter;
- (c) the practice of the Registry General in like cases; or
- (d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit,

and the statement shall be deemed to form part of the evidence in the proceedings.

(3) Anything which the Registrar is or may be authorised or required to do under this section may be done on his behalf by a duly authorised public officer.

Appointment of referee

79 (1) The Minister may by instrument in writing published in the Gazette appoint a person by reason of his qualifications and experience to be a referee to determine any case or matter referred to him under this Act.

(2) The person appointed under subsection (1)—

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- (a) shall hold office for a period of up to one year, as may be determined by the Minister; and
- (b) may be re-appointed from time to time for a like period.

(3) Appointments under this section shall commence on such day as the Minister may determine.

(4) The Minister may, at any time by notification in the Gazette, appoint any person to act temporarily in the place of the referee if the referee is absent from Bermuda or is for any reason unable to discharge his functions under this Act.

(5) The referee may at any time resign his appointment by notice in writing addressed to the Minister.

(6) The referee appointed under this section shall have such powers and shall perform such duties as are assigned to him under this Act and the regulations.

Case or matter may be referred to referee

80 (1) Where a notice of opposition and a counter-notice are sent to the Registrar in accordance with this Act, in any case, the Registrar may instead of hearing the parties, considering the evidence and making a decision, refer the case to the referee for the referee to deal with it on his behalf.

(2) Where an application is made to the Registrar—

- (a) by an aggrieved person in accordance with sections 55(1)(a) (non-use) or 61(1) (rectification of register); or
- (b) by a registered proprietor of a trade mark under sections 53(2) (alteration) or 61(1) (rectification of register),

then the Registrar may, instead of himself dealing with the application, refer the application to the referee to deal with it on his behalf.

(3) The Registrar shall refer a matter referenced in subsection (1) or (2) to a referee upon receipt of a joint request by the parties to such matter.

Powers and duties of referee

81 (1) The referee, in the discharge of his functions in relation to any case or matter referred to him under section 80 shall have the same powers and duties that the Registrar would have had under this Act or any regulations in relation to the case or matter, including the power to award costs under section 65.

(2) Anything done by the referee within the scope of his authority shall, for the purposes of this Act or any regulations, be deemed to have been done by the Registrar.

Appeals from the Registrar

82 (1) An appeal to the Court lies from any decision of the Registrar under this Act, except as otherwise expressly provided in this Act.

(2) For the purpose of subsection (1), "decision" includes any act of the Registrar in exercise of a discretion vested in him by or under this Act.

PART 7

IMPORTATION OF INFRINGING GOODS, MATERIAL OR ARTICLES

Infringing goods, material or articles may be treated as prohibited goods

83 (1) The proprietor of a registered trade mark, or a licensee, may give notice in writing to the Collector of Customs—

- (a) that he is the proprietor or a licensee of the registered trade mark, as the case may be;
- (b) that at a time and place specified in the notice, goods which are, in relation to that registered trade mark, infringing goods, infringing material or infringing articles are expected to arrive in Bermuda; and
- (c) that he requests that the Collector of Customs treat the goods as prohibited goods.

(2) The Registrar may—

- (a) give notice in writing to the Collector of Customs of the matters set out in subsection (1)(b) and (c);
- (b) where the Registrar determines that the goods are prohibited goods, direct the Collector of Customs to forfeit the goods.

(3) When a notice is in force under this section, the importation of the goods to which the notice relates, otherwise than by a person for private and domestic use, is prohibited, but the importer is not by reason of the prohibition liable to any penalty other than forfeiture of goods.

(4) Any person whose goods have been forfeited under subsection (3) may appeal to the Court.

Powers of the Collector of Customs and customs officers

84 (1) Where information relating to infringing goods, material or articles has been obtained by the Collector of Customs for the purposes of, or in connection with, the exercise of his functions in relation to imported goods, he may disclose or authorise the disclosure of that information to any competent authority for the purpose of facilitating

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any investigation or prosecution of an offence under section 86 (offences for unauthorised use of trade mark, etc.).

(2) For the purposes of enforcement of section 83 and any regulations made under section 92, the Collector of Customs or any customs officer shall have the same powers as they have under the Revenue Act 1898.

(3) The same powers and immunities that are afforded to members of the Customs Department, by way of section 5 of the Customs Department Act 1952, shall also be afforded to the Collector of Customs or to a customs officer under this Act.

(4) For greater certainty, goods referred to in sections 83 and 92 are included in the definition of "goods" in section 2 of the Revenue Act 1898.

Forfeiture

85 (1) Where, under sections 83, 84 or 87, a police officer or the Collector of Customs has come into the possession of the following in connection with the investigation or prosecution of an offence under section 86—

- (a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark;
- (b) material bearing a sign referred to in paragraph (a) and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or
- (c) articles specifically designed or adapted for making copies of a sign mentioned in paragraph (a),

a police officer or the Collector of Customs may apply to the Court under this section for an order for the forfeiture of the goods, material or articles.

(2) An application under this section may be made—

- (a) where proceedings have been brought in the Court for an offence relating to some or all of the goods, material or articles; or
- (b) where no application for the forfeiture of goods, material or articles has been made under paragraph (a), by way of complaint to the Court.

(3) On an application under this section the Court shall make an order for the forfeiture of any goods, material or articles only if it is satisfied that an offence under section 86 has been committed in relation to the goods, material or articles.

(4) The Court may infer for the purposes of this section that such an offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are

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representative of them (whether by reason of being of the same design or part of the same consignment or batch or otherwise).

(5) Any person aggrieved by an order made under this section by the Court, or by a decision of the Court not to make such an order, may appeal against that order or decision and an order so made may contain such provision as appears to the Court to be appropriate for delaying the coming into force of the order pending the making and determination of any appeal.

(6) Subject to subsection (7), where any goods, material or articles are forfeited under this section they shall be destroyed in accordance with such directions as the Court may give.

(7) On making an order under this section the Court may, if it considers it appropriate to do so, direct that the goods, material or articles to which the order relates shall (instead of being destroyed) be released, to such person as the Court may specify, on condition that such person—

- (a) causes the offending sign to be erased, removed or obliterated; and
- (b) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

Offences for unauthorised use of trade mark, etc.

86 (1) A person commits an offence who, with a view to gain for himself or another or with intent to cause loss to another and without the consent of the proprietor—

- (a) applies to goods or their packaging a sign identical to, or 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, such a sign; or
- (c) has in his possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or with another, which would be an offence under paragraph (b).

(2) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another and without the consent of the proprietor—

- (a) applies a sign identical to, or 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; or

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- (b) uses in the course of a business, material bearing such a sign for purposes referred to in paragraph (a)(i) to (iii); or
- (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).

(3) A person commits an offence who, with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

- (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.

(4) A person does not commit an offence under this section unless—

- (a) the goods are goods in respect of which the trade mark is registered; or
- (b) the trade mark has a reputation in Bermuda and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the reputation of the trade mark.

(5) It is a defence for a person charged with an offence under this section 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.

(6) A person guilty of an offence under this section is liable—

- (a) on summary conviction to imprisonment for a term of six months or a fine of \$10,000, or both;
- (b) on conviction on indictment to imprisonment for a term of ten years or a fine of \$50,000, or both.

Search warrants

87 (1) Where a magistrate is satisfied by information on oath given by a police officer or the Collector of Customs or the Registrar, as the case may be, that there are reasonable grounds for believing—

- (a) that an offence under section 86 (offences for unauthorised use of trade mark, etc.) has been or is about to be committed in any premises; and

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- (b) that evidence that such an offence has been or is about to be committed is in those premises,

he may issue a warrant authorising a police officer to enter and search the premises, using such reasonable force as is necessary.

(2) The power conferred by subsection (1) does not extend to authorising a search for material which may be evidence of a criminal offence under any other applicable law.

(3) A warrant under subsection (1)—

- (a) may authorise persons to accompany any police officer executing the warrant; and

- (b) shall remain in force for three months from the date of its issue.

(4) In executing a warrant issued under subsection (1) a police officer may seize an article if he reasonably believes that it is evidence that an offence under section 86 has been or is about to be committed.

(5) In this section “premises” includes land, buildings, fixed or moveable structures, vehicles, vessels and aircraft.

PART 8

GENERAL OFFENCES

Falsification of register, etc.

88 (1) It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks, knowing or having reason to believe that it is false.

(2) It is an offence for a person to—

- (a) make or cause to be made anything falsely purporting to be a copy of an entry in the register; or
- (b) produce or tender or cause to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false.

(3) A person guilty of an offence under this section is liable—

- (a) on summary conviction, to imprisonment for a term of six months or a fine of \$5,000, or both;
- (b) on conviction on indictment, to imprisonment for a term of two years or a fine of \$10,000, or both.

Falsely representing trade mark as registered

- 89 (1) It is an offence for a person—
- (a) to falsely represent that a mark is a registered trade mark; or
 - (b) to make 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 section, the use in Bermuda in relation to a trade mark—

- (a) of the word “registered”; or
- (b) of any other word or symbol importing a reference (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 Bermuda and that the trade mark is in fact so registered for the goods or services in question.

- (3) A person guilty of an offence under this section is liable on summary conviction to a fine of \$50,000.

Unauthorised use of Royal arms, etc.

- 90 (1) A person shall not without the authority of His Majesty use in connection with any business the Royal arms (or arms so closely resembling the Royal arms as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal arms.

(2) A person shall not without the authority of His Majesty or of a member of the Royal family use in connection with any business any device, emblem or title in such a manner as to be calculated to lead to the belief that he is employed by or supplies goods or services to His Majesty or that member of the Royal family.

- (3) A person who contravenes subsection (1) commits an offence and is liable on summary conviction to a fine of \$10,000.

(4) Contravention of subsection (1) or (2) may be restrained by injunction in proceedings brought by—

- (a) any person who is authorised to use the arms, device, emblem or title in question; or
- (b) any person authorized to take such proceedings.

(5) Nothing in this section affects any right of the proprietor of a trade mark containing any such arms, device, emblem or title to use that trade mark.

Offences committed by partnerships and bodies corporate

91 (1) Proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought against the partnership in the name of the partnership and not in that of the partners, but without prejudice to any liability of the partners under subsection (3).

(2) A fine imposed on a partnership on its conviction in such proceedings shall be paid out of the partnership assets.

(3) Where an offence under this Act is committed by a partnership and is proved to have been committed with the consent or connivance of a partner, or a person purporting to act in any such capacity, the partner or person purporting to act as such as well as the partnership is guilty of the offence and may be proceeded against and punished accordingly.

(4) Where an offence under this Act is committed by a body corporate and is proved to have been committed with the consent or connivance of an officer of the body corporate, or a person purporting to act in any such capacity, the officer as well as the body corporate is guilty of the offence and may be proceeded against and punished accordingly.

**PART 9
REGULATIONS**

Regulations to empower Collector of Customs

92 (1) The Minister may make regulations prescribing the form in which a notice is to be given by the proprietor or licensee of a registered trade mark under section 83(1) and requiring such proprietor or licensee giving the notice—

- (a) to furnish the Collector of Customs with such evidence as may be specified in the regulations, either on giving the notice or when the goods are imported, or at both those times; and
- (b) to comply with such other conditions as may be specified in the regulations.

(2) The regulations may, in particular, require a proprietor or licensee giving such a notice to—

- (a) pay such prescribed fees in respect of the notice ;
- (b) give such security as may be prescribed in respect of any liability or expense which the Collector of Customs may incur in consequence of the notice by reason of the detention of any goods or anything done to the goods detained;

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- (c) indemnify the Collector of Customs against any such liability or expense, whether security has been given or not; and
- (d) comply with such other procedural matters as may be prescribed.

Regulations to empower the Registrar to publish in the Official Gazette

93 (1) The Minister may make regulations for the Registrar to publish in the Gazette—

- (a) the particulars of any application for registration of a trade mark (including a representation of the mark) and such other information relating to trade marks as the Registrar may determine;
- (b) an official periodical journal for industrial property, as required under Article 12 of the Paris Convention, which shall set out the reproductions of registered trade marks.

(2) The Registrar may additionally publish such application or journal on the Registrar General website: <http://www.gov.bm>.

Regulations for purposes of the Act

94 (1) The Minister may make regulations—

- (a) for the purposes of any provision of this Act authorising the making of regulations with respect to any matter;
- (b) for prescribing anything authorised or required by any provision of this Act to be prescribed; and
- (c) generally for regulating practice and procedure under this Act.

(2) Provision may, in particular, be made—

- (a) as to the manner of filing of applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) as to the service of documents;
- (d) authorising the rectification of irregularities of procedure;
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;
- (f) providing for the extension of any time limit so prescribed, or specified by the Registrar, whether or not it has already expired; and
- (g) providing for the times and days of operation of the Registry General and for the inspection of the register.

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(3) Where a form is required for purposes related to a matter under this Act and the regulations and such a form has not been prescribed, a form set out in Trade Marks legislation of the United Kingdom that is concerned with, or provides for, a similar matter, may be adapted for use as the Registrar may determine for purposes of the matter.

(4) Where it appears to the Minister that provision in any law or instrument is inconsistent with, or requires amendment consequentially upon, or has become unnecessary in consequence of, this Act or regulations, he may by regulations provide for consequential amendments—

(a) in such law that is passed before this Act; or

(b) in such instrument made under an Act before the passing of this Act.

(5) Where, in addition to the transitional provisions under Schedule 4, it appears to the Minister that transitional provisions are necessary with respect to any matter under the Trade Mark Act 1974, he may by regulations provide for such transitional provisions.

(6) Except as provided in section 12, regulations made under this Act are subject to the negative resolution procedure.

Rules affecting court procedure

95 (1) For the purpose of giving effect to this Act the Minister may, with the concurrence of the Chief Justice, make rules that affect court procedure.

(2) Without prejudice to the generality of subsection (1), or to any provision of this Act necessitating the making of rules with respect to any matter, rules under this section may contain such incidental, supplemental and transitional provisions as may appear to the Chief Justice or, as the case may be, the Minister necessary or expedient.

(3) Rules made under this section shall be subject to the negative resolution procedure.

(4) Nothing in this section prejudices any power to make rules of court.

PART 10

INTERNATIONAL CONVENTIONS AND EMBLEMS

International Conventions

96 (1) In this Part—

“Convention country” means a country, other than Bermuda, which is a party to the Paris Convention;

“Madrid Protocol” has the meaning given in Schedule 3;

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“Paris Convention” means the Paris Convention for the Protection of Industrial Property of 20th March 1883 as amended from time to time, and references to “the Convention” shall be construed accordingly.

(2) The Minister may make regulations as he considers necessary in consequence of the Paris Convention and the Madrid Protocol, as revised or amended from time to time.

Protection of well-known trade marks: Article 6bis

97 (1) References in this Act to a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark are to a mark which is well-known in Bermuda as being the mark of a person who—

- (a) is a national of a Convention country; or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in Bermuda.

(2) References to the proprietor of a well-known trade mark as described in subsection (1) shall be construed accordingly.

(3) The proprietor of a trade mark which is entitled to protection under the Paris Convention as a well-known trade mark is entitled to restrain by injunction the use in Bermuda of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

(4) This right is subject to section 57 (effect of acquiescence by proprietor of earlier trade mark).

(5) Nothing in subsection (3) affects the continuation of any bona fide use of a trade mark begun before the commencement of this section.

National emblems etc. of Convention countries: Article 6ter

98 (1) A trade mark which consists of or contains the flag of a Convention country shall not be registered without the authorisation of the competent authorities of that country, unless it appears to the Registrar that use of the flag in the manner proposed is permitted without such authorisation.

(2) A trade mark which consists of or contains the armorial bearings or any other state emblem of a Convention country which is protected under the Paris Convention shall not be registered without the authorisation of the competent authorities of that country.

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(3) A trade mark which consists of or contains an official sign or hallmark adopted by a Convention country and indicating control and warranty shall not, where the sign or hallmark is protected under the Paris Convention, be registered in relation to goods or services of the same, or a similar kind, as those in relation to which it indicates control and warranty, without the authorisation of the competent authorities of the country concerned.

(4) The national flags and other state emblems, and official signs or hallmarks, apply equally to anything which from a heraldic point of view imitates any such flag or other emblem, or sign or hallmark.

(5) Nothing in this section prevents 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.

(6) Where by virtue of this section the authorisation of the competent authorities of a Convention country is or would be required for the registration of a trade mark, those authorities are entitled to restrain by injunction any use of the mark in Bermuda without their authorisation.

Emblems etc. of certain international organisations: Article 6ter

99 (1) This section applies to—

- (a) the armorial bearings, flags or other emblems; and
- (b) the abbreviations and names,

of international intergovernmental organisations of which one or more Convention countries are members.

(2) A trade mark which consists of or contains any such emblem, abbreviation or name which is protected under the Paris Convention shall not be registered without the authorisation of the international organisation concerned, unless it appears to the Registrar that the use of the emblem, abbreviation or name in the manner proposed—

- (a) is not such as to suggest to the public that a connection exists between the organisation and the trade mark; or
- (b) is not likely to mislead the public as to the existence of a connection between the user and the organisation.

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

(4) Where by virtue of this section the authorisation of an international organisation is or would be required for the registration of a trade mark, that

organisation is entitled to restrain by injunction any use of the mark in Bermuda without its authorisation.

(5) Nothing in this section affects the rights of a person whose bona fide use of the trade mark in question began before the relevant provisions of the Paris Convention were extended to Bermuda.

Notification under Article 6ter of the Convention

100 (1) For the purposes of section 98, state emblems of a 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 Bermuda in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, sign or hallmark;
- (b) the notification remains in force; and
- (c) Bermuda has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

(2) For the purposes of section 99, the emblems, abbreviations and names of an international organisation shall be regarded as protected under the Paris Convention only if, or to the extent that—

- (a) the organisation in question has notified Bermuda in accordance with Article 6ter(3) of the Convention that it desires to protect that emblem, abbreviation or name;
- (b) the notification remains in force; and
- (c) Bermuda has not objected to it in accordance with Article 6ter(4) or any such objection has been withdrawn.

(3) Notification under Article 6ter(3) of the Paris Convention shall have effect only in relation to applications 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 free of charge, a list of—

- (a) the state emblems and official signs or hallmarks; and
- (b) the emblems, abbreviations and names of international organisations,

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

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Madrid Protocol

101 The Madrid Protocol applies to the registration of an international trade mark as provided under Schedule 4.

PART 11 FINAL PROVISIONS

Repeal of Trade Marks Act 1974, savings and transitional provisions

102 (1) Subject to this section, the Trade Marks Act 1974 (the “1974 Act”) is hereby repealed.

(2) Notwithstanding the repeal of the 1974 Act—

- (a) all existing trade marks registered under the 1974 Act shall, to the extent permitted by virtue of this Act (and in particular, Schedule 4), continue in existence as if registered under this Act;
- (b) any application for registration of a trade mark made before the commencement of this Act that is still pending shall be handled as provided under Schedule 4; and
- (c) any proceedings pending before the Registrar before the commencement of this Act shall be handled as required under the 1974 Act, subject to Schedule 4.

(3) All liabilities and obligations relating to matters under the 1974 Act subsisting against the Registrar immediately before the commencement of this Act shall thereafter continue to subsist against the Registrar.

(4) On and after the commencement of this Act, all actions, suits or legal proceedings by or against the Registrar, that were pending on the commencement of this Act, shall be carried out on or prosecuted by or against the Registrar, and no such suit, action or legal proceedings shall abate or be affected by the coming into operation of this Act.

(5) Schedule 4, which provides for transitional provisions in relation to existing trade marks registered under the 1974 Act, has effect.

Commencement

103 This Act shall come into operation on such day as the Minister may appoint by notice published in the Gazette.

SCHEDULE 1

(section 58)

COLLECTIVE MARKS

Application

1 This Act applies to collective marks subject to this Schedule.

Signs of which a collective mark may consist

2 For the purposes of a collective mark under this Schedule, the reference in section 3(1)(b) to “distinguishing goods or services of one undertaking from those of other undertakings” shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Indication of geographical origin

3 (1) Notwithstanding section 5(1)(c) but subject to subparagraph (2), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) The proprietor of a collective mark referred to in subparagraph (1) is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Mark not to be misleading as to character or significance

4 (1) A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, including circumstances in which it is likely to be taken to be something other than a collective mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a collective mark.

(3) Notwithstanding section 48(3), an application may be amended so as to comply with the requirements of this paragraph.

Regulations governing use of collective mark

5 (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations shall set out—

- (a) the persons authorised to use the mark;
- (b) the conditions of membership of the association; and

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(c) the conditions of use of the mark, including the applicable sanctions against misuse.

(3) Where the regulations govern use of a collective mark referred to in paragraph 3(1), they must authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark, provided that the person fulfils all the other conditions of the regulations.

(4) The Registrar may, in writing, issue such directions or make such requirements as he may deem appropriate with respect to the regulations filed in accordance with subparagraph (1) of any applicant and such applicant shall comply with such directions or requirements.

Requirements with respect to regulations for registration of collective mark

6 (1) A collective mark shall not be registered unless the regulations governing the use of the mark—

- (a) comply with paragraphs 5(2) and (3) and any further directions or requirements imposed by the Registrar; and
- (b) are not contrary to public policy or to accepted principles of morality.

(2) An applicant for registration of a collective mark shall file the regulations with the Registrar and pay the prescribed fee before the end of the prescribed period after the date of the application for registration of the collective mark.

(3) If the applicant fails to file the regulations with the Registrar and pay the prescribed fee within the time period prescribed, the application shall be deemed to be withdrawn.

Regulations to be considered by Registrar

7 (1) Where, upon the Registrar's consideration of the regulations, he finds that the requirements of paragraph 6(1) have not been complied with, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(2) If the applicant fails to—

- (a) satisfy the Registrar that the requirements in paragraph 6(1) have been complied with;
- (b) file amended regulations so as to comply with the requirements; or
- (c) respond before the end of the specified period,

the Registrar shall refuse the application.

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(3) If it appears to the Registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 47 (publication, opposition proceedings and observations).

Publication of regulations

8 (1) The regulations shall be published by the Registrar in the Gazette and any person may, within a period of two months from the date of publication of the regulations, file with the Registrar a notice of opposition or observations, relating to the matters mentioned in paragraph 6(1).

(2) Any notice of opposition or observations made regarding paragraph 6(1) shall be in addition to any other grounds on which the application for registration may be opposed or observations made.

Regulations to be open to inspection

9 The regulations governing the use of a registered collective 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 collective mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations, the Registrar may in any case where it appears to him expedient to do so, cause them to be published in the Gazette.

(3) Following publication under subparagraph (2), notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 6(1).

Infringement: rights of authorised users relating to infringing goods

11 The following provisions apply in relation to an authorised user of a registered collective mark as in relation to a licensee of a trade mark—

- (a) section 25(2) (order as to disposal of infringing goods, material or articles adequacy of other remedies);
- (b) section 83 (prohibition of importation of infringing goods, material or articles request to Collector of Customs).

Infringement: rights of authorised users in infringement proceedings

12 (1) The following provisions (which correspond to section 39 setting out general provisions as to rights of licensees in case of infringement) have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.

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(2) Subject to any agreement to the contrary between the authorised user and the proprietor, an authorised user may only bring proceedings for infringement of a registered collective mark with the consent of the proprietor.

(3) Where proceedings are brought by an authorised user for infringement of a registered collective mark (with the consent of the proprietor or pursuant to any agreement referred to in subparagraph (2)), the authorised user may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

(4) The requirement set out in subparagraph (3) shall not affect the granting of interlocutory relief on an application by an authorised user alone.

(5) A proprietor who is added as a defendant as mentioned in subparagraph (3) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(6) In infringement proceedings brought by the proprietor of a registered collective mark—

- (a) any loss suffered or likely to be suffered by authorised users shall be taken into account; and
- (b) 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 such users.

(7) Where the proprietor of a registered collective mark brings infringement proceedings, an authorised user who has suffered loss is entitled to intervene in the proceedings for the purpose of obtaining compensation for that loss.

Grounds for revocation of registration

13 Apart from the grounds of revocation provided for in section 55, the registration of a collective mark may be revoked on the ground that—

- (a) the manner in which the mark has been used by the persons authorised to use it has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1);
- (b) the persons authorised to use it have not taken reasonable steps to prevent the mark being used in a manner that is incompatible with the conditions of use set out in the regulations governing the use of the mark (as amended from time to time); or
- (c) an amendment of the regulations has been made so that the regulations—

- (i) no longer comply with paragraph 5(2) and (3) and any further directions or requirements imposed by the Registrar; or
- (ii) are contrary to public policy or to accepted principles of morality.

Grounds for invalidity of registration

14 Apart from the grounds of invalidity provided for in section 56, the registration of a collective mark shall be declared invalid on the ground that the mark was registered in breach of section 58(2) (who may be registered as the proprietor of a collective mark) or paragraph 4(1) or 6(1), unless the breach was only of paragraph 6(1) and the proprietor of the mark, by amending the regulations governing use, complies with the requirements of paragraph 6(1).

SCHEDULE 2

(Section 59)

CERTIFICATION MARKS

Application

1 This Act applies to certification marks subject to this Schedule.

Signs of which a certification mark may consist

2 In relation to a certification mark, the reference in section 3(1) (signs of which a trade mark may consist) to “distinguishing goods or services of one undertaking from those of other undertakings” shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

3 (1) Notwithstanding section 5(1)(c) but subject to subparagraph (2), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services.

(2) The proprietor of such a mark is not entitled to prohibit the use of the signs or indications 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 proprietor’s business

4 A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

5 (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, including circumstances in which it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

(3) Notwithstanding section 48(3), an application may be amended so as to comply with the requirements of this paragraph.

Regulations governing use of certification marks

6 (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate—

- (a) who is authorised to use the mark;
- (b) the characteristics to be certified by the mark;
- (c) how the certifying body is to test those characteristics and supervise the use of the mark;
- (d) the fees (if any) to be paid in connection with the operation of the mark; and
- (e) the procedures for resolving disputes.

(3) The Registrar may, in writing, issue such directions or make such requirements as he may deem appropriate with respect to the regulations filed in accordance with subparagraph (1) of any applicant and such applicant shall comply with such directions or requirements.

Requirements with respect to regulations for registration of certification mark

- 7 (1) A certification mark shall not be registered unless—
- (a) the regulations governing the use of the mark—
 - (i) comply with paragraph 6(2) and any further requirements imposed by the Registrar; and
 - (ii) 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 mark is to be registered.

(2) An applicant for registration of a certification mark shall file the regulations with the Registrar and pay the prescribed fee before the end of the prescribed period after the date of the application for registration of the certification mark.

(3) If the applicant fails to file the regulations with the Registrar and pay the prescribed fee within the time period prescribed, the application shall be deemed to be withdrawn.

Regulations to be considered by Registrar

8 (1) Where, upon the Registrar's consideration of the regulations, he finds that the requirements of paragraph 7(1) have not been complied with, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

- (2) If the applicant fails to—
- (a) satisfy the Registrar that the requirements in paragraph 7(1) have been complied with;

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- (b) file amended regulations so as to comply with the requirements; or
- (c) respond before the end of the specified period,

the Registrar shall refuse the application.

(3) If it appears to the Registrar that the requirements under this paragraph and the other requirements for registration under this Schedule have been complied with, he shall accept the application and shall proceed in accordance with section 47 (publication, opposition proceedings and observations).

Publication of regulations

9 (1) The regulations shall be published by the Registrar in the Gazette and any person may, within a period of two months from the date of publication of the regulations, file with the Registrar a notice of opposition or observations, relating to the matters mentioned in paragraph 7(1).

(2) Any notice of opposition or observations made in relation to paragraph 7(1) shall be in addition to any other grounds on which the application for registration may be opposed or observations made.

Regulations to be open to inspection

10 The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations

11 (1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations, the Registrar may in any case where it appears to him expedient to do so, cause them to be published in the Gazette.

(3) Following any such publication under subparagraph (2), notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

Consent to assignment of registered certification mark

12 The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

Infringement: rights of authorised users relating to infringing goods

13 The following provisions apply in relation to an authorised user of a registered certification mark as in relation to a licensee of a trade mark—

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- (a) section 25(2) (order as to disposal of infringing goods, material or articles adequacy of other remedies);
- (b) section 83 (prohibition of importation of infringing goods, material or articles request to Collector of Customs).

Infringement: rights of authorised users in infringement proceedings

14 In infringement proceedings brought by the proprietor of a registered certification mark—

- (a) any loss suffered or likely to be suffered by authorised users shall be taken into account; and
- (b) 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 such users.

Grounds for revocation of registration

15 Apart from the grounds of revocation provided for in section 55, the registration of a certification mark may be revoked on the ground that—

- (a) the proprietor has begun to carry on such a business as is mentioned in paragraph 4;
- (b) the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1);
- (c) the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the 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 directions or requirements imposed by the Registrar; or
 - (ii) are contrary to public policy or to accepted principles of morality; or
- (e) the proprietor is no longer competent to certify the goods or services for which the mark is registered.

Grounds for invalidity of registration

16 Apart from the grounds of invalidity provided for in section 56, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of paragraph 4, 5(1) or 7(1).

SCHEDULE 3

(section 101)

MADRID PROTOCOL

PART 1

INTERNATIONAL APPLICATIONS

Interpretation

1 In this Schedule—

“applicant” means the person in whose name the international application is filed;

“basic application” means an application for registration of a trade mark and that constitutes the basis for the international application for the registration of that mark;

“basic registration” means the registration of a trade mark and that constitutes the basis for the international application for the registration of that mark;

“Contracting Party” means any state or intergovernmental organization that is a party to the Protocol;

“date of the international registration” means the date of the international registration in accordance with Article 3(4) of the Madrid Protocol;

“designated Contracting Party” means Bermuda or any other Contracting Party for which territorial extension has been requested under Article 3ter(1) or (2) of the Protocol, or in respect of which such extension has been recorded in the International Register;

“designation” means the request for extension of protection (“territorial extension”) under Article 3ter(1) or (2) of the Madrid Protocol or such territorial extension as recorded in the International Register;

“holder” means the person in whose name the international registration is recorded in the International Register;

“international application” means an application by way of the Registrar’s office as office of origin for international registration under the Madrid Protocol;

“International Bureau” means the International Bureau of the World Intellectual Property Organization;

“International Register” means the official collection of data concerning international registrations maintained by the International Bureau, which

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data the Madrid Protocol or the International Regulations require or permit to be recorded;

“international registration” means the registration of a mark effected under the Madrid Agreement Concerning the International Registration of Marks, as amended from time to time, or the Protocol or both, as the case may be;

“International Regulations” means the Regulations Under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, as amended from time to time;

“international trade mark” means a trade mark which is the subject of an international registration appearing in the International Register;

“international trade mark (BM)” means an international registration which is the subject of a request for extension and which is protected in accordance with this Schedule;

“invalidation” means a decision by the Registrar or the Court (as the case may be) pursuant to section 56 of the Act revoking or cancelling the effects, in Bermuda, of an international registration with regard to all or some of the goods and services covered by the designation of Bermuda as evidenced by a declaration of invalidity;

“Madrid Protocol” or “Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989, as amended from time to time;

“notice of provisional refusal” means a declaration by the Registrar made in accordance with Article 5(1) of the Protocol and paragraph 9 of this Schedule;

“prescribed fee” means the fee prescribed by the International Regulations or such fee as may be prescribed for the purposes of this Act, as the case may be;

“prescribed form” means an official form established by the International Bureau or any form having the same or similar contents and format;

“request for extension” means a request for an extension of protection to Bermuda under Article 3ter (1) or (2) of the Protocol for which notification has been provided by the International Bureau; and

“transformation application” has the meaning provided in paragraph 17.

Application of international registration

2 (1) An applicant for the registration of a trade mark or the proprietor of a registered trade mark may, subject to this paragraph, apply for the international registration of the trade mark.

(2) An application for international registration of a trade mark shall—

- (a) be in the prescribed form;
- (b) include the details and information required by rule 9 of the International Regulations and such additional information as the Registrar may reasonably require;
- (c) be submitted to the Registry General as the office of origin;
- (d) be accompanied by the prescribed fee(s).

(3) An applicant for international registration shall be—

- (a) Bermudian, a British citizen, a British overseas territories citizen, or a British overseas citizen;
- (b) an individual domiciled in Bermuda;
- (c) a body incorporated or registered under the law of Bermuda; or
- (d) a person who has a real and effective industrial or commercial establishment in Bermuda.

(4) Two or more persons may jointly file an application for international registration if—

- (a) such persons are also joint applicants or joint proprietors of the basic application or basic registration, as the case may be; and
- (b) each person meets the eligibility requirements under subparagraph (3).

(5) Where the Registrar has reasonable doubts about whether an applicant is eligible, the Registrar—

- (a) shall inform the applicant of the reason for those doubts; and
- (b) may require that applicant to file evidence in support of his eligibility.

Examination of application for international registration

3 The Registrar shall examine the international application to confirm that, in accordance with the Madrid Protocol and the International Regulations—

- (a) the Registry General may be considered as the office of origin in respect of that international application; and

- (b) the relevant particulars appearing in the international application correspond to those appearing in the basic registration or basic application, as the case may be.

Submission of application filed with Registrar to the International Bureau

4 (1) Where—

- (a) the Registrar has no doubts or is satisfied as to the applicant's eligibility; and
- (b) the particulars appearing in the application for an international registration correspond with the particulars at that time in the basic application or, as the case may be, the basic registration,

the Registrar shall submit the application to the International Bureau.

(2) An application submitted by the Registrar under subparagraph (1) shall be accompanied by the following—

- (a) certification by the Registrar that the particulars appearing in the international application correspond to the particulars appearing at that time in the basic application or basic registration;
- (b) in the case of a basic application, the date and number of that application;
- (c) in the case of a basic registration—
 - (i) the date and number of the registration; and
 - (ii) the date and number of the application from which the basic registration resulted; and
- (d) the date of the international application.

Irregularities in international application

5 (1) The International Bureau may provide notice to the Registrar and the applicant of any irregularity in an application submitted by the Registrar in accordance with paragraph 4.

(2) Where the International Bureau notifies the Registrar of an irregularity in an application that must be remedied by the Registrar, he shall respond to the notification in accordance with the International Regulations and, where applicable, remedy the irregularity as appropriate.

(3) Where the International Bureau notifies the applicant of any irregularity in an application that must be remedied by the applicant, the application shall be deemed abandoned if the applicant fails to remedy such irregularity within the time prescribed by

the International Regulations, or if no time is prescribed, within such time as may otherwise be set out in the notice.

Irregularities with respect to the classification of goods and services in the international application

6 (1) The classification of goods and services for an international application shall be determined by the International Bureau.

(2) If the International Bureau determines that an international application does not contain an appropriate classification of the goods and services specified in the international application, the International Bureau may provide notification to the Registrar of its own proposed classification regarding those goods and services.

(3) Within three months of the date the International Bureau notifies the Registrar of its proposed classification, the Registrar may communicate to the International Bureau an opinion on the proposed classification.

(4) The international registration shall be effected with the classification that the International Bureau considers appropriate.

PART 2

INTERNATIONAL TRADE MARKS (BM)

Effect of international registration

7 (1) An international registration which is the subject of a request for extension shall be entitled to protection subject to this Act as if the particulars of the request for extension were contained in an application for registration of a trade mark under this Act and such application would satisfy the requirements of this Act.

(2) Subject to subparagraph (3), an international trade mark (BM) shall be treated as if it were a trade mark registered under the Act and the holder shall have the same rights and remedies and be subject to the same conditions as the proprietor of a registered trade mark.

(3) This Act applies to international trade marks (BM) and requests for extension with the following modifications—

- (a) references to a registered trade mark shall include references to an international trade mark (BM);
- (b) references to a proprietor of a registered trade mark shall include references to the holder of an international trade mark (BM);
- (c) references to an application for registration of a trade mark shall include references to a request for extension;

- (d) references to an applicant for registration shall include references to the holder of an international registration in respect of which a request for extension has been made;
- (e) references to registration of a trade mark shall include the conferring of protection on an international registration which is the subject of a request for extension;
- (f) references to the goods and services for which a trade mark is registered shall include references to the goods and services in respect of which an international trade mark (BM) confers protection;
- (g) references to the publication of the application include references to the publication of the notice of details of an international registration which is the subject of a request for extension;
- (h) to the extent that a supplementary register has been established by the Registrar, references to the register include the supplementary register as appropriate;
- (i) the modifications set out in this Schedule; and
- (j) such further modifications as the context requires for the purpose of giving effect to those provisions as applied by this Schedule.

Designation of Bermuda in respect of international registration

8 (1) Where the Registrar receives notification from the International Bureau that the holder of an international registration has designated Bermuda in a request for extension, the Registrar shall examine the request and related particulars as if the request for extension were an application made under section 41 of the Act.

(2) If it appears to the Registrar that the requirements for registration are met, the Registrar shall publish the details regarding the request for extension in accordance with section 47 of the Act.

(3) The Registrar shall give notice of provisional refusal to the International Bureau if—

- (a) it appears to the Registrar that the requirements for registration are not met; or
- (b) the Registrar receives a notice of opposition following publication of the request for extension.

(4) If the International Bureau notifies the Registrar or the Registrar considers that a particular term used to indicate any of the goods and services included in the international registration is—

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- (a) too vague for the purposes of classification; or
- (b) incomprehensible or linguistically incorrect,

the Registrar may give notice of provisional refusal to the International Bureau in respect of that term.

(5) Where notification is provided to the International Bureau pursuant to subparagraph (3)(a) or (4), the Registrar shall give the holder of the international registration an opportunity, within such period as the Registrar may specify, to make representations or amend the request for extension by limiting the goods and services.

(6) Where the Registrar has issued a notice of provisional refusal pursuant to subparagraph (3)(b), the holder of the international registration shall have the same rights and remedies as if an application for registration had been filed with the Registrar.

Notice of provisional refusal

9 (1) A notice of provisional refusal shall set out the matters required by Article 5 of the Madrid Protocol and rule 17 of the International Regulations.

(2) Except as provided in subparagraph (3), a notice of provisional refusal may not be given after the expiry of the relevant period.

(3) Where before the expiry of the relevant period the Registrar has given notice to the International Bureau that the period prescribed for the purposes of section 47(2) expires—

- (a) after the end of the relevant period; or
- (b) less than one month before the end of the relevant period,

a notice of provisional refusal may be given after the expiry of the relevant period provided that it is given before the end of the period of one month beginning immediately after the period prescribed for the purposes of section 47(2).

(4) Where the Registrar sends the International Bureau a notice of provisional refusal, the Registrar shall notify the International Bureau as to the final decision (from which no appeal may be brought) on whether the refusal should be upheld.

(5) If the provisional refusal is upheld, the Registrar shall send to the International Bureau a statement confirming total refusal.

(6) The relevant period referred to in subparagraphs (2) and (3) is the period of 18 months beginning immediately after the date of notification of the request for extension from the International Bureau.

Protection of international trade mark (BM)

10 (1) Where no notice of provisional refusal is given to the International Bureau following publication under section 47(1)—

- (a) the international registration which is the subject of the request for extension shall be protected as an international trade mark (BM); and
- (b) the Registrar shall send to the International Bureau a statement confirming the grant of protection.

(2) Where notice of provisional refusal is given following publication under section 47(1) and the provisional refusal is not upheld—

- (a) the international registration which is the subject of the request for extension shall be protected as an international trade mark (BM); and
- (b) the Registrar shall send to the International Bureau a statement confirming the grant of protection following provisional refusal.

(3) The reference to the completion of the registration procedure in sections 10(1), 17(2), 55(1) and 56(5) shall be construed as a reference to the conferring of protection on an international registration in accordance with this paragraph.

(4) When an international registration becomes protected as an international trade mark (BM), the Registrar shall publish a notice specifying, in relation to that trade mark, the—

- (a) number of the international registration;
- (b) date on which protection is conferred; and
- (c) date and place of publication of the request for extension under section 47(1).

Renewal of International Registrations designating Bermuda

11 International registrations that, in accordance with Article 7 of the Protocol, have been renewed in respect of Bermuda as a designated Contracting Party shall continue to have effect in Bermuda.

Collective marks and certification marks

12 (1) Collective marks that are the subject of international registrations in which Bermuda is a designated Contracting Party shall be governed by the Act as applied by Schedule 1.

(2) Certification marks that are the subject of international registrations in which Bermuda is a designated Contracting Party shall be governed by this Act as applied by Schedule 2.

(3) Where an international registration in which Bermuda is a designated Contracting Party is for a collective mark or a certification mark, the holder of that international registration shall submit the regulations as provided by Schedule 1 or 2 governing the use of such mark to the Registrar within the prescribed time limit.

PART 3

CHANGES AFFECTING THE INTERNATIONAL REGISTRATION

Correction of international registration

13 (1) Where the International Bureau notifies the Registrar that it has corrected an international registration and the correction either—

- (a) substantially affects the identity of the trade mark; or
- (b) alters the goods and services covered by the international registration,

the Registrar may treat the notification as a new request for extension.

(2) Where subparagraph (1)(a) applies, any earlier request for extension shall be deemed to have been withdrawn and any resulting protection granted to the international trade mark (BM) shall be treated as having been declared invalid.

(3) Where subparagraph (1)(b) applies and—

- (a) the correction extends the goods and services covered by the request for extension, the new request for extension shall apply only to the additional goods and services; or
- (b) the correction restricts the goods and services covered by the international registration, to the extent that it relates to goods and services outside the restriction, an earlier request for protection shall be treated as having been withdrawn, and any resulting protection granted to the international trade mark (BM) shall be treated as having been declared invalid.

(4) Where the Registrar determines that protection cannot or can no longer be extended in respect of the international registration as corrected, the Registrar may issue a notice of provisional refusal as set out in this Schedule.

Changes to the international registration

14 (1) Where in respect of an international registration which affects Bermuda, the Registrar is notified by the International Bureau of any—

- (a) change in ownership;
- (b) recording of a licence; or

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(c) limitation of the goods and services covered,

the Registrar may declare that the change of ownership, licence or limitation, as the case may be, has no effect in Bermuda.

(2) The declaration by the Registrar shall indicate—

- (a) the reasons for which the change of ownership, licence or limitation, as the case may be, has no effect;
- (b) in the case of a declaration which does not affect all the goods and services to which the licence or limitation which is the subject of the declaration relates, those goods and services which are affected by the declaration;
- (c) the corresponding essential provisions of the Act; and
- (d) whether such declaration may be subject to review or appeal.

(3) The declaration by the Registrar shall be sent to the International Bureau before the expiry of 18 months from the date on which the notification referred to in subparagraph (1) is sent.

(4) The effect of the declaration shall be that, with respect to Bermuda—

- (a) in the case of a change of ownership, the international registration concerned shall remain in the name of the transferor; and
- (b) in relation to any licence or limitation regarding the goods or services covered by the international registration, the licence or limitation shall not apply to the goods and services affected by the declaration.

(5) The holder of the international registration may submit a request to the Registrar for a review of the declaration made by the Registrar in accordance with subparagraph (1).

(6) A request for review under subparagraph (5) shall be submitted before the expiry of two months from the date of notification by the International Bureau to the holder of the international registration.

(7) The Registrar shall notify the International Bureau of any final decision relating to a declaration made in accordance with subparagraph (1).

Division or merger of basic application or basic registration

15 (1) This paragraph applies where the Registrar submits an application to the International Bureau in accordance with paragraph 4 and—

- (a) the basic application or basic registration is divided into two or more applications or registrations; or

(b) two or more basic applications or basic registrations are merged into a single application or registration.

(2) Where, before the end of the relevant period, the basic application or basic registration is divided or two or more basic applications or basic registrations are merged, the Registrar shall notify the International Bureau accordingly and shall indicate—

(a) the number of the international registration or, where the mark has not been registered, the number of the basic application;

(b) the name of the applicant or proprietor of the relevant trade mark; and

(c) the number of each application or registration resulting from the division or the number of the application or registration resulting from the merger.

(3) The relevant period is the period of five years from the date of the international registration.

Termination of basic application or basic registration

16 (1) Where, before the end of the relevant period, a basic application or basic registration is terminated, the Registrar shall request that the International Bureau cancel the international registration.

(2) A basic application is terminated where it is—

(a) not accepted;

(b) refused; or

(c) withdrawn or deemed as withdrawn pursuant to the Act.

(3) A basic registration is terminated where the rights in the registered trade mark cease to have effect.

(4) Where a basic application or basic registration is terminated in respect of some only of the goods and services for which the trade mark is registered (or is sought to be registered), the request shall relate only to those goods and services.

(5) The relevant period is the period of five years following the date of the international registration.

(6) If, during the relevant period, the Registrar becomes aware of proceedings which may result in the termination of the basic application or basic registration, the Registrar shall notify the International Bureau accordingly, stating that no final decision has been made.

(7) On completion of the proceedings referred to in subparagraph (6), the Registrar shall promptly notify the International Bureau of the outcome.

Transformation applications

17 (1) A transformation application is an application to register a trade mark under the Act where—

- (a) the mark was the subject of an international registration;
- (b) the international registration was the subject of a request for extension;
- (c) the international registration was cancelled at the request of the office of origin under Article 6(4) of the Madrid Protocol; and
- (d) the goods and services included in the application are identical to some or all of the goods and services included in the international registration.

(2) Any application made under the Act which is a transformation application shall—

- (a) state that it is made by way of transformation;
- (b) be made by the person who was the holder of the international registration immediately before the international registration was cancelled;
- (c) be made within three months from the date on which the international registration was cancelled in accordance with Article 6(4) of the Madrid Protocol;
- (d) be in the prescribed form and shall be accompanied by the prescribed fees.

(3) Where on or before the date on which the transformation application was made, the trade mark is protected as an international trade mark (BM)—

- (a) the mark shall be registered under the Act; and
- (b) the mark shall have the date of filing of the cancelled international trade mark (BM).

(4) Where on that date the trade mark is not so protected, the transformation application shall—

- (a) be treated as an application to register under the Act; and
- (b) have the date of filing of the request for extension relating to that mark.

(5) Where in relation to the international registration a right of priority was claimed on the basis of a Convention application, the transformation application shall have the same right of priority.

Concurrent registrations; replacement

18 (1) This paragraph applies where, at the time protection is conferred on an international trade mark (BM), there is a concurrent registered trade mark.

(2) A registration is concurrent where—

- (a) the proprietor of the registered trade mark is also the holder of the international trade mark (BM);
- (b) the registered trade mark is the same as the international trade mark (BM); and
- (c) the goods and services in relation to which protection is conferred by the international trade mark (BM) include all those for which the registered trade mark is registered.

(3) When this paragraph applies, the international registration is deemed to have replaced the concurrent registration in accordance with Article 4bis of the Madrid Protocol with effect from the date of the international registration or the subsequent designation of Bermuda, as the case may be.

(4) Upon request by the holder of the international trade mark (BM) and payment of the prescribed fee, the Registrar shall note the international registration in the register against the registered trade mark and notify the International Bureau accordingly.

(5) The priorities claimed in respect of the registered trade mark may also be claimed in respect of the international trade mark (BM).

(6) This paragraph shall continue to apply after the registered trade mark lapses or is surrendered, but shall cease to apply if or to the extent that the registered trade mark is revoked or declared invalid.

Revocation or invalidation

19 (1) Where the protection of an international trade mark (BM) is revoked or declared invalid to any extent, the Registrar shall notify the International Bureau.

(2) In the case of a revocation, the rights of the proprietor shall be deemed to have ceased to exist to that extent as from—

- (a) the date of the application for revocation; or
- (b) if the Registrar or Court is satisfied that the grounds for revocation existed at an earlier date, that date.

(3) In the case of a declaration of invalidity, the trade mark shall to that extent be deemed never to have been an international trade mark (BM).

PART 4

MODIFICATIONS FOR INTERNATIONAL TRADE MARKS

Application of modifications

20 The following sections apply to international trade marks and requests for extension with the modifications specified.

Registration of transactions affecting international trade marks (BM)

21 (1) Section 34(2) applies with the addition of the following after paragraph (e)—

- “(f) a change to the ownership of a registration recorded by the International Bureau in the International Register pursuant to Article 9 of the Madrid Protocol;
- (g) the grant of a licence recorded by the International Bureau in the International Register pursuant to rule 20*bis* of the International Regulations;
- (h) any matter other than as is referred to in paragraphs (f) and (g) that is recorded in the International Register pursuant to Article 9*bis*” of the Madrid Protocol.

(2) Section 34(3) applies with the addition after the words “Until an application has been made for registration of the prescribed particulars of a registrable transaction” the words “in the register or in the International Register (in accordance with Article 9*bis* of the Madrid Protocol and rule 20*bis* of the International Regulations”.

(3) Section 34(4) applies with the deletion of paragraph (b) and substitution of the following—

- “(b) in the case of an international trade mark (BM), an application for registration of a transaction in the International Register (in accordance with Article 9*bis* of the Madrid Protocol and rule 20*bis* of the International Regulations) is made before the end of the period of six months beginning with its date; or
- (c) the Court is satisfied that it was not practicable for an application referred to in (a) or (b) to be made before the end of that period and that an application was made as soon as practicable thereafter.”.

Date of filing

22 Section 42 applies with the deletion of subsection (1) and substitution of the following—

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“(1) The date of filing of a request for extension shall be the date of the international registration as determined in accordance with Article 3(4) of the Madrid Protocol except—

- (a) where a request for extension of protection to Bermuda is made subsequently to the international registration in accordance with Article 3ter(2) of the Protocol, the date of filing shall be the date that the request for extension was recorded in the International Register; and
- (b) where at the time protection is conferred on an international trade mark (BM), there is a concurrent registered trade mark, the date of filing shall be the date of filing of the registered trade mark.”.

Claim to priority

23 Section 44 applies with the deletion of subsection (8) and substitution of the following—

“(8) The manner of claiming priority shall be determined in accordance with the Madrid Protocol and the International Regulations.”.

Restriction of request for extension

24 Section 48 applies with the deletion of subsection (1) and substitution of the following—

“(1) The goods and services covered by a request for extension may be restricted at any time by the applicant provided that if the request for extension has been published by the Registrar, the restriction must also be published by the Registrar.”.

Register

25 Section 60 applies with the addition of the following after subsection (3) —

“(4) The Registrar shall for the purpose of recording transactions under section 34 as modified by this Schedule and any disclaimers and limitations relating to international trade marks (BM) enter such transactions in—

- (a) the register required under subsection (1); or
- (b) a supplementary register which shall be maintained by the Registrar.

(5) Following notification from the International Bureau under rule 28(2) of the International Regulations, the Registrar may correct an error or omission

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in the information entered in the register required under subsection (1) or a supplementary register maintained in accordance with subsection (4), as the case may be.”

Information about international trade marks (BM)

26 Section 64(3) applies with the addition of the following after paragraph (b) —

“(c) any information recorded in the International Register.”

PART 5

MISCELLANEOUS

Assignment of international trade mark (BM)

27 (1) Except as provided in subparagraph (2), an international trade mark (BM) shall not be assigned.

(2) An assignment of an international trade mark (BM) shall have effect only where the assignment is made to—

- (a) a national of any country which is a party to the Madrid Protocol;
- (b) an individual domiciled in a country which is a party to the Madrid Protocol;
- (c) a body incorporated or registered in a country which is a party to the Madrid Protocol; or
- (d) a person who has a real and effective industrial or commercial establishment in a country which is a party to the Madrid Protocol.

Appeals

28 (1) An appeal lies from any decision of the Registrar arising from matters provided for in this Schedule in the same way as a right of appeal lies in accordance with section 82.

(2) Where an appeal is made in accordance with subparagraph (1), the Registrar shall notify the International Bureau of any final decision, order or judgment as appropriate.

Judicial notice

29 (1) Judicial notice shall be taken of the following—

- (a) the Madrid Protocol and the International Regulations;

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(b) copies issued by the International Bureau of entries in the International Register; and

(c) copies of the periodical gazette published by the International Bureau in accordance with rule 32 of the International Regulations.

(2) Any document mentioned in subparagraph (1)(b) or (c) shall be admissible as evidence of any instrument or other act of the International Bureau so communicated.

Communication of information to the International Bureau

30 (1) International applications filed with the Registrar shall be in English.

(2) Any communication concerning an international application or an international registration between the International Bureau and the Registrar shall be in English.

(3) The Registrar may communicate to the International Bureau any information which Bermuda is required to communicate by virtue of this Schedule or pursuant to the Madrid Protocol or the International Regulations.

Transmission of fees to the International Bureau

31 (1) All applications and other submissions filed with the Registrar pursuant to this Schedule shall be accompanied by the prescribed fee.

(2) The Registrar may accept for transmission to the International Bureau fees payable to the International Bureau in respect of an application for international registration originating in Bermuda or renewal of such an international registration.

(3) Acceptance of any fee by the Registrar in accordance with subparagraph (1) shall be subject to such terms and conditions as may be prescribed or as the Registrar may specify in any published notice or by written notice to the person desiring to make payment by such means.

SCHEDULE 4

(Section 102)

TRANSITIONAL PROVISIONS

Interpretation

- 1 (1) In this Schedule—
- “commencement” means the commencement of this Act;
 - “existing registered mark” means a trade mark or service mark kept on the register under the 1974 Act immediately before commencement of this Act;
 - “existing register” means a register kept under the 1974 Act;
 - “new register” means a register under this Act;
 - “the 1974 Act” means the Trade Marks Act 1974;
 - “the prior law” means the 1974 Act and any other enactment or rule of law applying to existing registered marks immediately before the commencement of this Act.
- (2) For the purposes of this Schedule—
- (a) an application shall be treated as pending on commencement if it was made but not finally determined before the commencement; and
 - (b) the date on which the application was made shall be taken to be the date of filing under the 1974 Act.

Existing registered marks

- 2 (1) Existing registered marks (whether registered in Part A or B of the existing register) shall be transferred on commencement to the new register and have effect, subject to this Schedule, as if registered under this Act.
- (2) Existing registered marks registered as a series under section 24 of the 1974 Act shall be similarly registered in the new register .
- (3) For the purposes of this paragraph, the Registrar may—
- (a) make a written request to the proprietor of an existing registered trade mark for such information regarding a registered trade mark as he determines necessary to enable each entry transferred to the new register to conform to the requirements for entries under this Act; and
 - (b) cancel or refuse to renew any registration with respect to which information has been requested by the Registrar pursuant to subparagraph (a), but such information has not been provided to the

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Registrar within a period of six months from the date of the notice, or within such additional time as the Registrar may direct.

(4) The Minister may by regulations provide for putting such entries of the existing register in such form as is required for entries under this Act.

Existing registered marks - application of conditions, disclaimers, etc.

3 (1) A condition entered on the existing register in relation to an existing registered mark immediately before commencement shall be handled under the 1974 Act and any necessary alteration made to the new register.

(2) Proceedings under section 35 of the 1974 Act (powers to expunge or vary registration for breach of condition) which are pending on commencement shall be handled under the 1974 Act and any necessary alteration made to the new register.

(3) A disclaimer or limitation entered on the existing register in relation to an existing registered mark immediately before commencement shall be transferred to the new register and have effect as if entered on the register pursuant to section 19 of this Act.

(4) A security interest entered on the existing register in relation to an existing registered mark immediately before commencement shall be transferred to the new register and have effect as if entered on the register pursuant to section 34 of this Act.

Effects of registration: infringement

4 (1) Subject to subparagraph (2), this Act shall apply to existing registered trade marks as follows—

- (a) sections 13 to 18 apply in relation to an existing registered mark as from commencement;
- (b) section 20 (action for infringement) applies in relation to infringement of an existing registered mark committed after commencement; and
- (c) the prior law shall continue to apply in relation to infringements committed before commencement.

(2) The continuation, after commencement, of any use which did not amount to infringement of an existing registered mark under the prior law shall not be considered an infringement of—

- (a) an existing registered 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 mark and which is registered for the same goods or services.

Infringing goods, material or articles

5 Section 22 (order for delivery up of infringing goods, material or articles) applies to infringing goods, material or articles whether made before or after commencement.

Rights and remedies of licensee

6 Section 39 (general provisions as to rights of licensees in case of infringement) applies to licenses granted before commencement, but only in relation to infringements committed after commencement.

Co-ownership of registered mark

7 (1) Subject to subparagraph (2), section 32 (co-ownership of registered mark) applies as from commencement to an existing registered mark of which two or more persons were, immediately before commencement, registered as joint proprietors.

(2) For so long as the relations between the joint proprietors remain such as described in section 57 of the 1974 Act, there shall be taken to be an agreement to exclude the operation of subsections (1) and (3) of section 32 (ownership in undivided shares and right of co-proprietor to make separate use of the mark).

Assignment of registered mark

8 (1) Section 33 (assignment or other transmission of registered mark) applies to transactions and events occurring after commencement in relation to an existing registered mark; and the prior law continues to apply in relation to transactions and events occurring before commencement.

(2) Existing entries in the register under section 28 of the 1974 Act (registration of assignments and transmissions) shall be transferred on commencement to the new register kept under section 28 and have effect as if made under section 34 .

(3) An application for registration under section 28 of the 1974 Act which is pending before the Registrar on commencement shall be treated as an application for registration under section 34 and shall proceed accordingly.

(4) The Registrar may require the applicant to amend an application to which subparagraph (3) applies so as to conform with the requirements of this Act.

(5) An application for registration under section 28 of the 1974 Act which has been determined by the Registrar but not finally determined before the commencement shall be handled under the prior law.

(6) Where before commencement a person has become entitled by assignment or transmission to an existing registered mark but has not registered his title, any application for registration after commencement shall be made under section 34 of this Act.

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- (7) In cases to which subparagraphs (3) or (6) apply—
- (a) section 28(3) of the 1974 Act continues to apply; and
 - (b) section 34(3) and (4) shall not apply,

as regards the consequences of failing to register.

- (8) Subparagraph (2) applies to any entry made pursuant to subparagraph (5).

Licensing of registered mark

9 (1) Sections 37 and 38(2) (licensing of registered trade mark; rights of exclusive licensee against grantor's successor in title) apply only in relation to licenses granted after commencement.

(2) Existing entries of the register under section 31 of the 1974 Act (registered users) shall—

- (a) be transferred on commencement to the new register ; and
- (b) have effect as if made under section 34 .

(3) An application for registration as a registered user which is pending before the Registrar on commencement shall be treated as an application for registration of a licence under section 34(1) and shall proceed accordingly.

(4) The Registrar may require the applicant to amend an application to which subparagraph (3) applies so as to conform with the requirements of this Act.

(5) An application for registration as a registered user which has been determined by the Registrar but not finally determined before commencement shall be handled under the prior law.

(6) Any proceedings pending on commencement under section 31(10) of the 1974 Act (variation or cancellation of registration of registered user) shall be handled under the prior law.

(7) subparagraph (2) shall apply to any resulting entry in the register which has been determined in accordance with subparagraph (5).

Pending applications for registration

10 (1) An application for registration of a mark under the 1974 Act which is pending on commencement shall be handled under the prior law, subject to subparagraphs (2) and (3).

(2) If a mark subject to an application falling within subparagraph (1) is registered, such mark shall be treated for the purposes of this Schedule as an existing registered mark.

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(3) The power of the Minister under section 93 of this Act to make regulations governing practice and procedure is exercisable in relation to an application falling within subparagraph (1), and different provision may be made for such applications from that made for other applications.

(4) Section 25 of the 1974 Act (provisions as to associated trade marks) shall be disregarded in dealing with an application for registration after commencement .

Conversion of pending application

11 (1) In the case of a pending application for registration which has not been advertised under section 18 of the 1974 Act before commencement , the applicant may give notice to the Registrar requesting that the application for registration be determined in accordance with this Act.

(2) The notice must be in the prescribed form, be accompanied by the prescribed fee and be given no later than six months after commencement.

(3) Notice duly given is irrevocable and has the effect that the application shall be treated as if made immediately after commencement.

Trade marks registered according to old classification

12 The Registrar may exercise the powers conferred by regulations made under section 62 (adaptation of entries to new classification) to secure that any existing registered marks which do not conform to the system of classification prescribed under section 43 are brought to conformity with that system.

Duration and renewal of registration

13 (1) Section 51(1) (duration of original period of registration) applies in relation to the registration of a mark in pursuance of an application made after commencement.

(2) Sections 51(2) and 52 (renewal) apply where the renewal falls due on or after the commencement.

(3) The prior law shall apply to any period of registration or renewal to which subparagraphs (1) and (2) do not apply.

Pending application for alteration of registered mark

14 An application under section 37 of the 1974 Act (alteration of registered trade mark) which is pending on commencement shall be handled under the prior law and any necessary alteration shall be made to the new register.

Revocation for non-use

15 (1) An application under section 29 of the 1974 Act (removal from register and imposition of limitations on grounds of non-use) which is pending on commencement

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shall be handled under the prior law and any necessary alteration made to the new register.

(2) Subject to subparagraph (3), an application under section 55(1)(a) or (b) (revocation for non-use) may be made in relation to an existing registered mark at any time after commencement.

(3) No application for revocation of the registration of an existing registered mark registered by virtue of section 30 of the 1974 Act (defensive registration of well-known trade marks) may be made until more than five years after commencement.

Application for rectification, etc.

16 (1) An application under section 34 or 36 of the 1974 Act (rectification or correction of the register) which is pending on commencement shall be handled under the prior law and any necessary alteration made to the new register.

(2) For the purposes of proceedings under section 56 (grounds for invalidity of registration) as applied in relation to an existing registered mark, shall, subject to subparagraph (3), be deemed to have been in force at all material times.

(3) No objection to the validity of the registration of an existing registered mark may be taken on the ground specified in subsection (3) of section 7 (relative grounds for refusal of registration: conflict with earlier mark registered for different goods or services).

[Assent Date: 17 October 2023]