

Caribbean

Pirates, plantations, rum and reggae: the complex business of protecting IP rights in the Caribbean

The effectiveness of the various IP registries in the Caribbean region is a common concern for IP rights holders wishing to obtain protection in the islands. While some registries offer excellent service, others are not yet automated and are governed by out-of-date legislation. Some Caribbean countries are working hard to ensure that their IP regimes encourage innovation and are competitive – but this can pose a major challenge as, regardless of the amount of financial investment, what can be done when the relevant legislation is outdated?

Filing requirements

Of the Caribbean states and territories, some are part of the Commonwealth; some have become independent and others were never dependent on the United Kingdom. This has led to various legal differences, including the following:

- Grenada is the only country where a UK registration is a prerequisite for filing a trademark.
- Although in the Bahamas there is no legislation allowing the extension of a UK registration to the territory, priority can be claimed on a UK application and a UK registration can be considered as evidence of registrability at the discretion of the trademark examiner.
- In Bermuda, the Trademark Law 1974 (derived from the UK Trademark Law 1938) applies. In addition, Bermuda is a member of no international trademark conventions, and thus priority cannot be claimed there. A UK registration can be extended to Bermuda at the discretion of the trademark examiner in the same circumstances and under the same limitations imposed in the United Kingdom.
- In the British Virgin Islands (BVI), both national trademark applications and those based on UK registrations can be filed. The Nice Classification

applies if an application is based on a UK registration, but for a national application the local classification is mandatory.

- In the US Virgin Islands (USVI), protection can be sought through a US registration that can be extended to USVI.
- In the Cayman Islands, a trademark application can be based on a UK, Community or international World Intellectual Property Organisation (WIPO) trademark registration. There is no need to register a trademark in all the classes of the underlying registration, but the underlying application must have matured to registration in order to be extended to Cayman.
- The Guyanan trademark legislation is in need of updating and service marks can be registered only if based on a UK registration.
- Montserrat has legislation in place permitting the extension of UK registrations to its territory.
- In the Turks & Caicos Islands (TCI), a trademark owner may file either a trademark application based on a UK registration or a national non-UK based application.

As a result of pressure from international business, the Caribbean countries have slowly adopted their own legislation and have updated their identities.

In terms of IP rights protection, while the procedures are quite expedited in some countries (eg, Jamaica, Belize and Trinidad), they are slow and tedious in most of the Caribbean (eg, in Antigua, Barbados and Guyana). The Bahamas has by far the slowest system, with one trademark application taking more than six years to mature to registration. The speed of the process is hindered by the lack of personnel at the Caribbean registries – for example, in Cayman, only one person handles all IP matters and if he or she goes on holiday,

nothing is processed. In Anguilla, although the legislation provides for the registration of Community trademarks, this is subject to the governor publishing a notice to this effect in the Official Gazette. As this has not yet happened, no Community trademarks can be registered there.

New legislation is expected to be enacted in Bermuda and Trinidad but, as yet, nothing has been confirmed. In Trinidad, the proposed trademark legislation has not yet been passed by Parliament, although this is scheduled to happen by the end of 2011.

Extending UK registrations

Although the extension of UK registrations is no longer possible in many Caribbean countries, this option is still available in Anguilla, Cayman, Bermuda, BVI, Dominica, Grenada, Guyana, Montserrat and TCI. The re-registration of UK trademarks in these islands is coterminous with the duration and validity of the mark in the United Kingdom. Hence, rights holders must remain vigilant – if a UK registration undergoes changes or is renewed, such changes must be made to the mark's underlying counterpart in each Caribbean country.

While the Bermudan Trademarks Act 1974 provides for local trademark applications with effect from the date of application, no provision extends the registration of UK trademarks to Bermuda. Instead, under the act, trademarks registered in the United Kingdom (under UK rather than Community or international provisions) will automatically be deemed to meet the Bermudan registrability criteria, subject to the same conditions and limitations imposed by the UK registrar. In essence, this provision enables UK rights holders to have their trademarks re-registered in Bermuda expeditiously. Nevertheless, the act makes clear that the acceptance of such applications is at the discretion of the registrar. Only trademarks registered in the United Kingdom can be used as the basis for Bermudan re-registration. At present, Community trademarks and international registrations which designate the United Kingdom (and the European Union) cannot be re-registered.

In contrast, Montserrat has established its own local trademark system which preserves the possibility of extending UK registrations. Hence, it has adopted a dual filing system providing for both local and UK registrations. Other countries that operate in this manner are Anguilla, Bermuda and BVI.

On May 18 2004 St Vincent changed its trademark law to leave behind its UK dependency, and St Kitts and St Lucia have done the same. Dominica's Marks, Collective Marks and Trade Names Act 1999 entered into force on February 2 2009, 10 years after it was proposed.

Nice Classification

The Ninth Edition of the Nice Classification system (the latest version) applies in the Caribbean countries of Anguilla, Antigua, Belize, Barbados, Cuba, the Dominican Republic, Guyana, Jamaica, Haiti, St Kitts, St Lucia, St Vincent and Suriname. In contrast, Trinidad applies only the Seventh Edition.

In Belize, class headings cannot be filed; in cases of doubt, the Belize IP Office will issue an office action requiring that the specification be clarified. BVI and the Bahamas have developed their own local classification systems. Rights holders should bear this in mind when considering filing trademarks there, as they will probably need to tailor their specifications to these unique classifications.

Single or multi-class application

Various Caribbean countries allow for the filing of trademark applications in more than one class. However, Barbados, Bermuda, Guyana, Haiti, Suriname and TCI still use a single-class filing system.

Although in Belize it is possible to file multi-class applications, each application is limited to five classes. Therefore, a new application is required from the sixth class onward. In Cayman, it is possible to restrict the extension of a UK registration to several classes covered by the UK registration.

Service marks

Service marks are now registrable in most Caribbean jurisdictions, with exceptions as follows:

- Service marks cannot be filed in the Bahamas, as the Trademarks Act dates back to 1906;
- In Suriname, it is not possible to obtain registration of a service mark through any alternative route – as the registry is not yet automated, this presents risks to rights holders; and
- In Guyana and BVI, service marks can be registered only as an extension of a UK registration.

Paris Convention priority

The claiming of Paris Convention priority is often essential for an international filing. While priority can usually be claimed readily in the Caribbean, there are several exceptions (ie, Antigua, the Bahamas, Bermuda, BVI and Cayman). In the Bahamas, all priority documents are required at the time of filing; a certified copy of the priority application cannot subsequently be filed.

Using trademarks

The Caribbean trademark regime comprises legislation that is generally outdated compared to the minimum

international standards imposed by WIPO and the World Trade Organisation Agreement on Trade-Related Aspects of IP Rights (TRIPs). However, the common factor is that a trademark must be used within a certain time after the registration date. Use of a trademark allows the owner to preserve its right over the registration, and is evidenced by the exploitation and commercialisation of the product or service protected by the trademark.

The mandatory use of a trademark acquires international and national relevance due to economic globalisation. However, at national level each jurisdiction requires use of the trademark – that is, international use of the mark will not suffice to satisfy the use requirement in each country. This is supported by TRIPs and the Paris Convention Treaty.

The use of a trademark is vital given that one of the primary functions of a mark is its capability to identify the origin of goods and services. A rights holder must justify the exclusivity of the rights granted by the trademark; thus, a lack of use creates a loophole for a third party to initiate a cancellation action based on non-use.

In Anguilla, Aruba, Grenada and Cayman, no legislation regulates the use of trademarks. In Grenada and Cayman, both UK dependencies, local trademark registrations are subordinated to the existence of an underlying UK registration. In such cases, cancellation actions based on non-use have no basis. In Aruba, cancellation actions based on non-use are accepted.

The use of a trademark within five years of the registration date is mandatory in Antigua, the Bahamas, Barbados, Belize, Bermuda, BVI, Curacao, the Caribbean Netherlands, St Maarten (Dutch side), Guyana, Haiti, Montserrat, St Lucia and Puerto Rico.

In Antigua, a trademark owner can argue that it had good cause not to use the mark – for example, the lack of demand for a product in Antigua. In Belize, use of a trademark outside the five-year period can overcome the lack of use if no third party has filed a cancellation action in the interim. In such case, the owner must pay a reactivation fee and justify the lack of use.

Due to a lack of legislation regulating the revocation of trademark rights, in Bermuda it is unnecessary to prove use of a trademark; rather, in order to renew a registration it is sufficient to indicate that a trademark is in use in commerce.

In Puerto Rico, a declaration of continuous use is required on renewal and evidence of use must be attached. In the case of applications filed on an ‘intent to use’ basis, use of the mark should commence within five years of filing the application. Such use cannot commence once the five-year period has passed.

In Suriname, the use of a trademark for at least two to three months at least every three years is recommended.

In Curacao, the Caribbean Netherlands and St Maarten (Dutch side), nullity cannot be invoked if, between the end of the five-year period and the filing of a cancellation action based on non-use, the trademark is used or reused in commerce. Initial or renewed use in the three months after the filing of the cancellation action will not be considered to be good use if the third party can show that the preparations to use the mark were made only after the owner became aware of the cancellation action.

Use within a three-year period is imposed by the legislation in Cuba, Dominican Republic, Jamaica, St Kitts & Nevis and St Vincent. In St Vincent, a trademark can be subject to cancellation if it is not used in commerce in a continuous manner. The three-year period does not necessarily start to run from the registration date.

In Dominica, the use period for a national registration is three years, while for UK-based registrations it is five years from the UK registration date.

Undoubtedly the obligation to use a trademark in the Caribbean is a way of controlling possible conflicts between a rights holder and an interested third party. For this reason, the penalty in cases of non-compliance with the use requirement is cancellation of the exclusive right.

Timeframes

When filing applications in the Caribbean, it is important to consider the different timeframes taken across the different jurisdictions.

In Guyana, the entire trademark recordal system is manual. There is no electronic filing and the whole registration process, from the date of filing to issuance of the certificate, can take three years. The validity of the registration certificate is retroactive to the filing date. The process commences with the filing of four copies of the mark, accompanied by an authorisation from the rights holder. The authorisation requires no notarisation, legalisation or protocolisation. After filing, the mark is advertised in the *Official Gazette*, and one month later the mark becomes eligible for registration if no opposition is filed. The registrar then issues a certificate of registration.

In contrast, in the Bahamas no filing receipt is issued. Instead, a receipt of payment is granted within six to eight months of filing the application. The registry can then take between 16 and 18 months to issue a registration certificate. In Barbados, evidence of filing is made available within eight weeks of the filing date and the corresponding registration certificate is issued within 12 to 15 months.

In Bermuda, the filing receipt is issued in between one and three months, and the certificate of registration within two to 13 months of the filing date. The registration date in Bermuda dates back to the application date, rather than the date on which the mark was advertised or the certificate was issued. In St Lucia, St Vincent and St Kitts, a registration certificate is issued within three to seven months. In general (with a few exceptions), the trademark registries in the Caribbean are understaffed and use hard-copy files, and in many cases documents go missing or files get lost for months or even years.

How to benefit from a Caribbean filing

No single trademark application is capable of securing protection across all the Caribbean countries. Rather, separate filings are required for each jurisdiction.

The benefit of filing in the Caribbean is obvious: with the exception of the Dominican Republic, where a power of attorney must be legalised, all powers of attorney and agent authorisations require only notarisation. In some cases, simply affixing the company

seal will suffice. In Cuba and Belize, no formalities are required, while no power of attorney is needed in Puerto Rico or Jamaica.

Therefore, when considering filing an application in a case with a tight deadline and where priority is being claimed, it is best to file in those islands where the power of attorney or agent authorisation and priority documents can be filed late (ie, Anguilla, Barbados, Belize, Cuba, the Dominican Republic, Haiti and Jamaica). In Antigua and Bermuda, the agent authorisation can be filed late, but priority cannot be claimed.

The Caribbean countries now understand the importance of adequate IP legislation and are slowly streamlining their legislation in order to bring it into line with international standards. Legislative changes are awaited with great interest. They are increasingly making IP matters a top priority, which in turn attracts foreign investment to the region, providing for lower filing costs and resulting in more efficient management of trademark portfolios. All these efforts combine to strengthen the position of rights holders in the Caribbean.



Gabriela Bodden

IP attorney

gbodden@eprint.com

E-Print

Caribbean

Gabriela Bodden is a recognised expert in international trademark law. She focuses primarily on trademark, copyright and patent matters, as well as advertising and legal disputes. Ms Bodden also counsels clients on the selection and registration process of IP rights and their enforcement, adding a significant competitive advantage to clients' portfolios. She has extensive experience in handling complex international IP portfolios throughout the Latin American and Caribbean region, covering matters such as clearance searches, trademark filings, the prosecution and maintenance of trademarks, licence and franchising contracts, cautionary notices and piracy issues. She initiates and completes opposition actions, lawsuits and office actions before the registries and courts of various countries. Ms Bodden has written and co-written chapters on trademark practice and procedure for various IP publications.



Aarón Montero

IP attorney

amonero@eprint.com

E-Print

Caribbean

Aarón Montero is a recognised expert on trademark law. He focuses primarily on trademark, copyright and patent matters, as well as advertising and legal disputes. Mr Montero also counsels clients on the selection and registration process for trademarks and the enforcement and registration of trademarks and copyrights in order to add value and a significant competitive advantage to clients' portfolios. Mr Montero possesses vast expertise in the drafting, preparation and filing of patent applications and the analysis of invention disclosures and making patentability and infringement options, in addition to having prosecuted national and foreign patent applications in various fields. He is a lecturer in intellectual property at the University of Costa Rica and is a member of the Costa Rica Bar Association, the Costa Rican Institute of Technology and the Computer Law Association.