

Caribbean

Filing trademarks in the Caribbean: what to expect

Caribbean countries are working to ensure that their IP regimes encourage innovation and are internationally competitive. However, this is a challenge, as the legislation in some countries is very outdated.

Although the legislative regimes differ between the various Caribbean jurisdictions, these regimes all originated from the same country – the United Kingdom – and thus bear some resemblance to one another. The Caribbean comprises approximately 25 islands, some of which are gradually becoming independent of the United Kingdom and the Netherlands.

During this process of independence, the laws of some jurisdictions have undergone changes, while in others antiquated legislation remains in force. For instance, in 2002 Anguilla updated its trademark legislation, although it still allows the extension of UK-registered trademarks.

In the Bahamas, there is no provision for extending the registration of UK trademarks, as is provided for in many other Commonwealth Caribbean jurisdictions. However, international priority (Paris Convention) is available and a UK registration certificate may serve as evidence of registrability, at the discretion of the Trademark Registry.

Antigua and Barbuda is no longer a UK-dependent territory, having established its own trademark registration system and repealed its previous laws (the Trademarks Act 2003 and the Trademarks Regulations 2006). It is no longer possible to extend UK registrations to this jurisdiction.

This leads to the question of which jurisdictions allow for the extension of UK registrations.

Extending UK registrations

Although the extension of UK registrations is no longer possible in many Caribbean countries, there are various islands where this option is still available (ie, Anguilla, the Cayman Islands, Bermuda, the British Virgin Islands, Dominica, Grenada, Guyana, Montserrat and Turks and Caicos).

The re-registration of UK trademarks in these islands will be coterminous with the duration of the UK mark and its validity in the United Kingdom. Hence, rights holders must remain vigilant, as if a UK registration undergoes changes or is renewed these 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, there is no provision for extending the registrations of UK trademarks, as is the case in many other Commonwealth jurisdictions. Under the act, trademarks registered in the United Kingdom (under UK as opposed to Community or international trademark provisions) will automatically be deemed to meet the registrability criteria in Bermuda, subject to the same conditions and limitations as are imposed by the UK registrar. It is not possible in the strict sense of the word to extend a UK registration to Bermuda:

Where a person makes application for the registration of a trade mark and satisfies the Registrar that he, or his predecessors in title, has registered the mark under the Trade Marks Act 1938, of the United Kingdom, as amended from time to time or under any legislation of the United Kingdom that replaces that Act, the Registrar may accept the application if it is for registration on the same basis and subject to the same conditions and limitations as in the United Kingdom; but upon advertisement of the application in accordance with Section 19 any person may, in accordance with that section oppose the registration as if the trade mark were one to which this subsection does not apply.

In essence, this provision enables rights holders in the United Kingdom 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. Community trademarks and international registrations

which designate the United Kingdom (and the European Union) cannot be re-registered at this time.

On the other hand, Montserrat has established its own local trademark system and preserved the possibility of extending UK registrations. Hence, it has adopted a dual filing system, which provides for both local and UK registrations. Other countries that operate in this manner are Anguilla, Bermuda and the British Virgin Islands.

St Vincent changed its trademark law on May 18 2004, leaving behind its UK dependency. The same happened in St Kitts and St Lucia.

On the other hand, 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 latest edition of the Nice Classification system is readily applicable in the Caribbean islands of Anguilla, Antigua, Belize, Barbados, Cuba, the Dominican Republic, Guyana, Jamaica, Haiti, St Kitts, St Lucia, St Vincent and Suriname. These jurisdictions are the most up to date when it comes to classification, as they apply the ninth edition of the Nice Classification, while Trinidad applies only the seventh edition.

In Belize, it is not permissible to file class headings. In case of doubt, the Belize IP Office will issue an office action requiring that the specification be clarified.

The British Virgin Islands and the Bahamas have developed their own local classification systems. Rights holders should bear this in mind when considering filing a trademark in these islands, as it is more than likely that they will need to tailor the specification of goods to these unique classifications.

Single class or multi-class applications?

Various Caribbean countries allow for the filing of trademark applications in more than one class. However, the following countries still utilise a single class filing system: Barbados, Bermuda, Guyana, Haiti, Suriname, and Turks and Caicos.

While 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 the Cayman Islands, it is possible to restrict the extension of a UK registration to several classes covered by the UK registration.

Service marks

Although service marks are now registrable in nearly all Caribbean jurisdictions, they are not registrable in the

Bahamas, as the Trademarks Act there dates back to 1906. It appears that the passing of a new Trademarks Act is not a priority at this time.

In Suriname, it is not possible to obtain registration of a service mark via any alternative route.

In Guyana and the British Virgin Islands, service marks can be registered only as an extension of a UK registration.

Paris Convention priority

For many clients, the claiming of Paris Convention priority is essential for any international filing project. While priority can usually be claimed readily in the Caribbean, there are several countries where it cannot be claimed (ie, Antigua, the Bahamas, Bermuda, the British Virgin Islands and the Cayman Islands).

In the Bahamas, all priority documents are required at the time of filing the application; hence, a certified copy of the priority application cannot be subsequently filed.

Timeframes

When filing applications in the Caribbean, it is important to consider the timeframes for granting evidence of filing respective receipts.

In Guyana, the entire trademark recordal system is manual. There is no electronic filing and typically 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 does not require notarisation, legalisation or protocolisation. After filing, the mark is advertised in the *Official Gazette*. One month must elapse between the date of publication and the date on which the mark becomes eligible for registration. If no opposition is filed, the mark is then ready for registration. The registrar thereafter issues a certificate of registration.

On the other hand, 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 anywhere from 16 to 18 months to issue a registration certificate.

In Barbados, evidence of filing is made available within eight weeks of the filing date; 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

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application date, and not when the mark was advertised or the actual certificate was issued.

In St Lucia, St Vincent and St Kitts, a registration certificate is issued within three to seven months.

Common confusions

When filing in the Caribbean, clients face an important decision: where to file and how to understand the differences between different jurisdictions.

Many clients assume that a single application can cover all Commonwealth countries. However, filing in the Caribbean can be tricky.

Potential applicants are also advised to pay close attention to changing political landscapes. For instance, the Netherlands Antilles was dissolved as of October 10 2010. On this date Bonaire, Saba and St Eustatius became special municipalities of the Netherlands (now the BES Islands), and will have to apply most Dutch law. The country-code top-level domain (ccTLD) of these islands remains ‘.nl’.

On the other hand, Curacao and St Maarten are now independent countries, becoming constituent states within the Kingdom of the Netherlands along the lines of Aruba, which broke away from the Netherlands Antilles in 1986. The ccTLD for Curacao is now ‘.cw’. The ccTLD for St Maarten is yet to be decided.

In the same manner, there is much confusion regarding the US Virgin Islands and the British Virgin Islands. The British Virgin Islands (made up of four larger islands and 32 smaller islands) is an overseas territory of the United Kingdom comprising Tortola, Virgin Gorda, Jost Van Dyke and over 50 smaller islands. The US Virgin Islands (consisting of four larger islands and some 50 smaller islets and cays) is an unincorporated territory of the United States comprising St Croix to the

south, with St John, St Thomas, and smaller islands.

There are several French dependencies in the Caribbean: Guadeloupe and Martinique, St Bartholomew and the French side of St Martin (the other half was a Dutch dependency).

Spanish is spoken in Cuba and the Dominican Republic, meaning that all documents must be translated into Spanish. Dutch and Papiamentu are spoken in Curacao and the Dutch side of St Maarten, while French is spoken in Haiti and the French side of St Martin.

When filing in the Caribbean, most clients anticipate that island life will affect the manner in which their applications are handled and sadly this is still sometimes true. The process can often be slow and tedious, as is the case in Antigua, the Bahamas and Guyana. This can impact negatively on clients used to European standards. However, not all is negative: Anguilla, Barbados, Cuba, Dominica, the Dominican Republic, Jamaica and Trinidad all offer top levels of service and clients can expect to receive swift responses from the registries, depending on the backlog of cases.

How to benefit when filing in the Caribbean

The benefit of filing in the Caribbean is a simple one: with the exception of the Dominican Republic, where 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 and Jamaica.

Based on the above, when considering filing an application where there is 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 islands are slowly streamlining their legislation, bringing it into line with international standards. Legislative changes in islands such as Guyana

are awaited with interest. The Caribbean islands are increasingly making IP matters a top priority.

Adequate and up-to-date legislation promotes foreign investment in the region, allowing clients to save on filing costs and manage their portfolios in an efficient manner – all of which ultimately strengthens their position against competitors.



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Gabriela Bodden is a recognised expert in international trademark law. She helps clients to select, register and enforce their IP rights and has extensive experience in handling complex international IP portfolios throughout Latin America and the Caribbean. Ms Bodden manages the IP portfolios of a broad range of clients in a wide variety of industries, including automobiles, hotels, finance, entertainment, pharmaceuticals, beauty, music, furniture, clothing, liquor and food.



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