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Caribbean Trademark Law Update

By George C. J. Moore, Barrister & Attorney, Caribbean Trademark Services, West Palm Beach, Florida, USA



The Caribbean is home to 18 British Commonwealth countries and territories. The countries are independent; the territories are UK dependencies. Countries: Antigua & Barbuda, Bahamas, Barbados, Belize, Dominica, Grenada, Jamaica, St. Kitts & Nevis, St. Lucia, St. Vincent & the Grenadines, and Trinidad & Tobago. Dependent Territories: Anguilla, British Virgin Islands, Cayman Islands, Montserrat, and Turks & Caicos Islands.

The other principal Caribbean countries and territories are: Aruba, Cuba, Dominican Republic, Haiti, Guadeloupe and Martinique (both part of France), the Netherlands Antilles, and Puerto Rico (part of the United States).



The Caribbean is home to some 25 trademark jurisdictions, each pursuing a unique path to trademark protection. Simply put, the laws of no two Caribbean jurisdictions are alike. This article focuses on the Caribbean's 18 Commonwealth jurisdictions.

Shedding of UK Dependence

Independence from the UK has swept through Caribbean jurisdictions, and reliance upon UK registrations has largely become a thing of the past. Today, Grenada remains the sole Caribbean holdout where a UK registration is an absolute prerequisite to registration.

Anguilla, Montserrat, St. Kitts & Nevis, St. Vincent and Turks & Caicos all have recently enacted major trademark reform. Tiny Montserrat—already reduced to one-third of its former size because of volcanic encroachment—has established its own local trademark system while still granting a special line of access to owners of UK-registered marks. St. Vincent abandoned its longtime dependence on the UK system in its new trademarks act, effective May 18, 2004, that sets up

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an altogether local trademark regime. Dominica, too, is about to enact a new system, replacing its act that dates from nearly 50 years ago.

Jurisdictional Confusion

Confusion about jurisdiction continues to afflict many trademark proprietors, made worse by the coupling of names, as with Antigua & Barbuda, St. Kitts & Nevis (St. Kitts is more formally known as St. Christopher), St. Vincent & the Grenadines, Trinidad & Tobago, and Turks & Caicos Islands. Other jurisdictional names are sometimes confused with their constituent territories, for example, Netherlands Antilles excludes Aruba but includes Bonaire, Curacao, Saba, St. Eustatius (also known as Statia) and St. Maarten.

Dutch St. Maarten is of course to be distinguished from St. Martin—the latter is the French side of the island. Similarly, the U.S. Virgin Islands are often confused with the British Virgin Islands, which are a British Dependent Territory. Guadeloupe and Martinique, among the larger islands in the Caribbean, are co-equal departments of France, ranking with those within the bounds of France itself—and, as such, these Caribbean islands are covered by trademark registration in France, as is tiny but chic St. Barths.

Most often, the incorrect jurisdictional assumption is that a single trademark registration will cover the many countries and territories of the Commonwealth Caribbean, or that a UK registration somehow extends to most or all of the English-speaking countries. To the contrary, there are 18 different jurisdictions within the Commonwealth Caribbean, all different and independent of one another.

Another divide is the wide gulf that separates the Dutch-, English-, French- and Spanish-speaking Caribbean nations. This translates into another distinction: that between the English common law jurisdictions and the others that take after Napoleon.

Service Marks

Service marks can now be registered in nearly all 18 Commonwealth Caribbean jurisdictions. The only exception is the Bahamas, whose Trade Marks Act—dating from 1906—is the antique of the region. Service marks are not even on the legislative agenda, despite the jurisdiction's exceptionally heavy reliance on service industries, both finance and tourism.

Six other Caribbean jurisdictions still allow for registration of a service mark only if the mark has already been registered in the UK: Antigua & Barbuda, British Virgin Islands, Cayman Islands, Dominica, Grenada and Guyana. The Cayman Islands also allows a European Community trade mark to ground a local service mark application.

Official Filing Fees

As one might expect, the Caribbean's many jurisdictions have a wide range of filing fees. Topping the list is St. Kitts & Nevis, which has fees of \$385 for one

mark in one class. Each additional class, however, will cost only \$30. Add another mark, and the cost of the extra mark filed simultaneously dips to \$237. Renewal, too, is costly in St. Kitts, where the \$237 per class renewal fee jumps to \$385 three months after expiration.

Also expensive is Bermuda, where the registration fee is \$360—for each and every class. Ouch, again, when it comes to renewal—that costs \$315 per class.

On the opposite end of the spectrum are Grenada and Guyana, where fees barely exceed \$10 per application. Some jurisdictions still maintain a distinction between local and UK-based trademark applications. Anguilla and Turks & Caicos charge less for UK-based applications; Dominica charges more.

Belize levies high publication costs. Registration and renewal each cost \$125 for publication. Furthermore, each separate transaction incurs a publication fee of \$50. For example, recording a change of name and address requires publication fees of \$50 times two, even when the applications are bundled. Barbados also can be expensive when it comes to publication, with design marks costing some \$225 for publication alone—more than double the \$105 application fee.

Late filing of renewals incurs an extra fee everywhere. St. Vincent's new act provides for escalation of \$25 for each month of the 12-month grace period. "Renewal fee" has an altogether different meaning in the Cayman Islands, where every trademark owner must pay an annual maintenance fee of \$61 for each registration.

Oppositions

UK norms characterize opposition practice throughout the Commonwealth Caribbean, with the only real variant being the length of the opposition period. Seven jurisdictions allow three months, but five jurisdictions allow only one month to file an opposition notice: Anguilla, the Bahamas, Guyana, Jamaica and Turks & Caicos Islands. Transmission of trademark office gazettes from distant jurisdictions can easily take weeks, and, most importantly, an extension of time for filing an opposition cannot be obtained.

Registry Practices

The relaxed Caribbean-island lifestyle is sometimes presumed to infuse Caribbean business practices, but the great majority of jurisdictions have long demonstrated efficiency in trademark processing, especially Anguilla, Belize and the Cayman Islands—and also tiny Montserrat, which continues to cope with the scourge of volcano Soufriere.

On the other hand, there are several countries where delay has become agonizing, chiefly Antigua, the Bahamas and Guyana. In the Bahamas, the December 8, 2005, Gazette published marks applied for in April 2002. That constitutes delay of three years and eight months. In the Bahamas, too, post-publication action can be painfully slow. The delay in publication also impacts trademark searching, rendering searches inherently out of date.

Other practices that could be improved upon include:

- The Bahamas require a separate signed authorization form for each and every class.
- In St. Lucia, a proprietor who enters its address after its name at the top, rather than the bottom, of the power of attorney form meets with automatic rejection. The form also requires the company's seal or stamp to be applied; otherwise, the form must be notarized.
- The Dominica Trade Marks Registry rejects certified copies of UK Certificates of Registration that have been issued by the UK Patent Office with a stamped seal (which is fully consistent with UK law) instead of a raised seal.
- St. Vincent & the Grenadines requires two separate signed authorization forms, both bearing the seal or stamp of the company and full notarization of both forms. This keeps notaries busy—too busy, some owners complain.
- St. Vincent & the Grenadines also does not issue a filing number or filing date until after examination of the application and approval on seven preliminary points—which can result in delays between the time of lodging and the time of official logging in of applications.

Trinidad & Tobago is quite critical in examining applications, and for several years objections have been almost the rule rather than the exception. Just recently a mark registered in many jurisdictions, including Australia, Canada, Jamaica, New Zealand, the United Kingdom and the United States, was refused in Trinidad as lacking distinction.

WIPO continues to conduct training for Caribbean trademark officials; this past December, there was a week-long session in St. Lucia attended by officials from Barbados, Belize, Guyana, Jamaica, St. Kitts & Nevis, Surinam and Trinidad & Tobago.

Reclassification

The 1938 British classification system still operates in five Caribbean jurisdictions: Antigua & Barbuda, the Bahamas, British Virgin Islands, Dominica and Montserrat. Even with enactment of many new trademark acts, the old British classification system remains a holdover in some jurisdictions that have abandoned it but now are being confronted with applications to reclassify registered goods into their corresponding International Classes.

Continued use of the old British classification system means two things: no service marks and antiquated categorization. Nearly 70 years old, the 1938 classification was designed more with component materials than actual goods in mind. There are, for example, 13 different classes that cover goods made of cotton, linen, wool, silk and hemp.

Applications that require the British system to be applied to goods that have already had International Classes assigned can sometimes result in messy-looking match-ups. Often the application must cover more classes or must resort

to the old system's catchalls—which sometimes catch more than is comfortable.

The 1938 classification system also speaks of “carriages,” which covers cars, trucks and planes, and “horological instruments,” which means watches and clocks. Finally, there is old British Class 50, which covers “Miscellaneous,” but also specifically covers tobacco pipes, walking sticks, plate powder, buttons, hose and other odd items—all in 10 separate sub-classes that end with the catchall “other goods.”

The eighth edition of the Nice International Classification Convention governs 13 Commonwealth Caribbean jurisdictions. Trinidad & Tobago and Turks & Caicos still rely on the seventh edition.

Counterfeit Goods

Corrective action against counterfeit LEVI'S, TOMMY HILFIGER and DOCKERS goods was taken recently in Belize. In each of these cases the U.S. Embassy became directly involved in the seizures. To invoke such action, however, it was necessary for company officials to personally confirm that the suspect goods were counterfeit.

Caribbean Single Market and Caribbean Court of Justice

The Caribbean Single Market and Economy (CSME) treaty went into effect January 1, 2006, with Barbados, Belize, Guyana, Jamaica, Surinam and Trinidad & Tobago as the first full members. Montserrat has applied for associate status. The Bahamas will not join because of a provision that allows free movement of workers among signatory nations. Other nations in the 15-member Caribbean Community are moving or at least debating whether to join.

The first sitting of the Caribbean Court of Justice (CCJ) took place at its headquarters in Trinidad & Tobago on August 8, 2005, with the former chief justice of Trinidad & Tobago sworn in as the court's first president. The court is designed to replace the UK Privy Council as the final appellate body for the Commonwealth Caribbean. Sitting in London, the Privy Council had decided Caribbean appeals since 1833. However, only two countries—Barbados and Guyana—have agreed thus far to use the CCJ as their court of last resort in all civil and criminal matters. Other countries have agreed to jurisdiction over trade disputes arising out of the Caribbean Community and Common Market (CARICOM) treaty.

*By George C. J. Moore, Barrister & Attorney, Caribbean Trademark Services,
West Palm Beach, Florida, USA*
E-mail: barrister@barrister-law.com
