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TRADE MARKS BILL, 2015

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TRADE MARKS BILL, 2015

**A BILL FOR AN ACT TO MAKE NEW AND BETTER PROVISIONS
FOR THE PROTECTION AND REGISTRATION OF TRADE MARKS;
TO GIVE EFFECT TO CERTAIN INTERNATIONAL OBLIGATIONS
OF THE BAHAMAS WITH RESPECT TO TRADE MARKS; TO
REPEAL THE TRADE MARKS ACT, CHAPTER 322 AND TO
PROVIDE FOR CONNECTED MATTERS**

Enacted by the Parliament of The Bahamas

PART I—PRELIMINARY

1. Short title and commencement.

- (1) This Act may be cited as the Trade Marks Act, 2015.
- (2) This Act shall come into operation on such day as the Minister may, by notice published in the Gazette, appoint.

2. Interpretation.

- (1) In this Act —

“**business**” includes a trade or profession;

“**certification mark**” is a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, materials, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics;

“**collective mark**” means a mark distinguishing the goods or services of members of the association which is the proprietor from those of other undertakings;

“confusing”, when applied as an adjective to a mark, including a trade mark, means a trade-mark or other mark the use of which is likely to cause confusion if the use of both marks in the same area would be likely to lead to the inference that the goods or services associated with those marks are manufactured, sold, leased, hired or performed by the same person, and “confusingly” shall be construed accordingly;

“convention country” means any country that is a member of —

- (a) the World Trade Organization;
- (b) the Convention of the Union of Paris made on March 20, 1883 and any amendments and revisions thereof made before or after July 1, 1954; or
- (c) any other treaty which the Minister may designate by Order;

“country of origin” means —

- (a) the convention country in which the applicant for registration of a trade mark had at the date of application a real and effective industrial or commercial establishment;
- (b) if the applicant did not at the date of the application have in a convention country an establishment —
 - (i) as described in (a), the convention country where he on that date has his domicile; or
 - (ii) as described in (a), or a domicile as described in (b), the convention country of which he was on that date a citizen or national;

“Court” means the Supreme Court;

“covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper;

“geographical indication” means an indication that identifies goods as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin;

“goods” means anything which is the subject of trade, manufacture or merchandise;

“Intellectual Property Office” means the Intellectual Property Office referred to in section 3 of the Patents Act;

“international classification” means the classification according to the Nice Agreements concerning the International Classification of

Goods and Services for the Purposes of the Registration of Marks, of 15th June, 1957 as revised;

“label” includes any band or ticket;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

“Minister” means the Minister responsible for trade marks;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“prescribed” means in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the Regulations thereunder;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“published” means made available to the public and a document shall be taken to be published if a reproduction thereof can be inspected as of right by members of the public whether on payment of a fee or not;

“Register” means the Register of Trade Marks referred to in this Act;

“registered trade mark” means a trade mark which is actually upon the register;

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

“Registrar” means the Registrar of the Registrar General's Department with responsibility for the Intellectual Property Office and any reference to the Registrar shall be construed as including a reference to any officer discharging the functions of the Registrar;

“services” means the performance of any service which is the subject of trade;

“trade mark” means any mark capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings and it may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging;

“use” has the meaning defined in subsections (4), (5) and (6) of section 8;

“WTO Member” means a Member of the World Trade Organization established by Article 1 of the Marrakesh Agreement in April, 1994.

- (2) For the purposes of this Act, goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.

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

PART II—THE REGISTRAR AND THE REGISTER

3. Functions of the Registrar.

The Registrar of the Intellectual Property Office shall be responsible for matters relating to trade marks as provided herein.

4. Register of trade marks.

- (1) The Registrar shall maintain under his control and management for the purposes of this Act the Register wherein shall be entered all registered trade marks, certification marks and collective marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations and such other matters relating to such trade marks as may from time to time be prescribed.
- (2) The Registrar shall publish in the Register a notice of the registration of any trade mark.
- (3) The Register shall contain all such particulars of any application for the registration of a trade mark as may be prescribed (including a representation of the mark) and such other information relating to the trade mark as the Registrar thinks fit.
- (4) There shall not be entered in the Register any notice of any trust expressed, implied or constructive, nor shall any such notice be receivable by the Registrar.
- (5) The Register shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the office, of any entry in such register shall be given to any person requiring the same on payment of the prescribed fee.
- (6) The register may be kept manually or electronically.

5. Correction of Register.

- (1) The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled in law to act in his name
 - (a) correct any error in the name or address of the registered proprietor of a trade mark;

- (b) enter any change in the name or address of the person who is registered as proprietor of a trade mark;
 - (c) cancel the entry of a trade mark on the Register;
 - (d) strike out any goods or services from those for which a trade mark is registered; or
 - (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.
- (2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

6. Powers and duties of the Registrar in respect of forms.

- (1) The Registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any proceedings before him under this Act.
- (2) The Registrar shall make all forms available together with any directions with respect to their use.

PART III - REGISTRATION OF TRADE MARKS

7. Registrable trade marks.

- (1) A trade mark is registrable —
 - (a) only in respect of particular goods or services; and
 - (b) if it is distinctive.
- (2) For the purposes of subsection (1), a trade mark is “distinctive” if it is adapted to distinguish the goods or services of the proprietor of the trade mark from those of other persons.
- (3) In determining whether a trade mark is so adapted, the Registrar may, in the case of a trade mark in actual use, take into consideration the extent to which such use has rendered such trade mark in fact distinctive for the goods or services with respect to which it is registered or proposed to be registered.

8. Restriction on registration.

- (1) It shall not be lawful to register as a trade mark —
 - (a) any mark that is devoid of any distinctive character or is otherwise incapable of distinguishing the goods or services of one enterprise from those of other enterprises;

- (b) any matter, the use of which would —
 - (i) by reason of its being calculated to deceive in particular as regards the geographical origin of the goods or services concerned or their nature, quality or other characteristics; or
 - (ii) otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design;
 - (c) any mark that consists exclusively of matter or an indication that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time and production of goods or of rendering of service, or of other characteristics of goods or services;
 - (d) any mark that consist exclusively of matter and indication that has become customary in current language or in the bona fide established practices of the trade, or is a usual or recognised technical or scientific name of a product or service;
 - (e) any mark that is not distinct from the goods or services to which it applies, or consists of a feature or characteristic that results from the nature of the goods or services themselves;
 - (f) any mark that consist of, or contains as an element thereof, any national, territorial or civil flag, arms, crest or emblem, any official control or guarantee mark, stamp or hallmark, or any armorial bearing, flag or other emblem, abbreviation or title of any international intergovernmental organisation to which one or more convention countries belong, notice of objection to the use of which as a commercial device has been received from any person pursuant to the provisions of any international convention relating to industrial property to which The Bahamas adheres or is publicly given by the Registrar.
- (2) Except by order of the Court, a mark cannot be validly registered as a trade mark if the use of such mark would conflict with prior third party rights in force in The Bahamas, in particular where —
- (a) the mark is identical with or confusingly similar to an earlier registered trade mark or geographical indication belonging to a different proprietor, or to a trade mark which is already on the register, with respect to such goods or services or description of goods or services, or so nearly resembling such a trade mark as to be calculated to deceive;
 - (b) the mark constitutes a reproduction, imitation or translation of a trade mark or other distinctive mark that is well known in The

Bahamas in respect of identical or similar goods or services of another enterprise, or is well known in The Bahamas for goods or services that are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the trade mark or distinctive mark in relation to those goods or services would indicate a connection between the goods or services and the owner of the well known trade mark or distinctive mark, or that the reputation of the trade mark or distinctive mark or of the owner thereof would be damaged by such use, or such use without due cause would take unfair advantage of, dilute or otherwise be detrimental to, the distinctive character or the repute of the well known trade mark or distinctive mark;

- (c) the use of the mark in The Bahamas is liable to be prevented by virtue of —
 - (i) any rule of law, in particular, the law of passing off, protecting an unregistered mark, trade name, geographical indication or other mark used in the course of trade; or
 - (ii) an earlier intellectual property right, in particular the law of copyright or of industrial designs;
 - (d) the application for registration was made in bad faith or where registration of the mark would consolidate or facilitate an act of unfair competition provided that in determining whether a distinctive mark is well known it shall be sufficient that the mark be known within the relevant sector of the public in The Bahamas, including knowledge obtained as a result of the promotion of such mark, where the relevant sector of the public means —
 - (i) actual or potential consumers of the type of goods or services with which the mark is used;
 - (ii) persons involved in channels of distribution of the type of goods or services with which the mark is used; or
 - (iii) business circles dealing with the type of goods or services with which the mark is used.
- (3) The Minister may make regulations to further restrict the registration of trade marks.
- (4) For the purpose of this Act, a trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the covering of the goods in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

- (5) A trade-mark is deemed to be made well known in The Bahamas if it is used by a person in a convention country, other than The Bahamas, in association with goods or services, and
 - (a) the goods are distributed in association with it in The Bahamas; or
 - (b) the goods or services are advertised in association with it in —
 - (i) any printed publication circulated in The Bahamas in the ordinary course of business among potential traders in or users of the goods or services; or
 - (ii) radio, television or other media transmissions ordinarily received in The Bahamas by potential traders in or users of the goods or services; andit has become well known in The Bahamas by reason of the distribution or advertising.
- (6) A trade-mark that is marked in The Bahamas on goods or on the covering of the goods, when the goods are exported from The Bahamas, is deemed to be used in The Bahamas in association with those goods.
- (7) A trade mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

9. Application for registration.

- (1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner.
- (2) The filing date of an application for registration shall be the date on which the application is received by the Registrar, provided that at the time of receipt, the application contains the following —
 - (a) an express indication that the registration of a mark is applied for;
 - (b) sufficient information to identify and contact the applicant or his representative;
 - (c) the mark for which registration is applied, or a reproduction thereof if the mark features special characters, shape or colour, or is a figurative or mixed mark;
 - (d) a list specifying the goods or services for which the registration is sought; and
 - (e) for greater certainty, if the materials furnished in this subsection are furnished on different days, the date of filing is the last of these days.

- (3) If the application omits one of the elements indicated in subsection (2), the Registrar shall notify the applicant requesting that the omission be corrected and until the omission is corrected, the application shall be regarded as not filed.
- (4) The applicant may after the filing date of an application for registration pursuant to subsection (2) submit an application to the Registrar to amend or modify his application.
- (5) Subject to the provisions of this Act, the Registrar may refuse an application, or may accept it absolutely or subject to conditions, amendments or modifications.
- (6) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the Court at the option of the applicant.
- (7) An appeal under this section shall be made in the prescribed manner, and on such appeal the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments and modifications, if any, the application is to be accepted.
- (8) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the Court hearing the appeal.
- (9) Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.
- (10) The Registrar or the Court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as may be thought fit.
- (11) Any person claiming to be the proprietor of a trade mark who makes an application for registration of a trade mark in respect of goods or services bearing such trade mark that were exhibited at an exhibition certified by the Registrar for the purposes of this subsection may choose to have the date for such application deemed to be the date of the opening of such exhibition if such application is made no later than six months after such goods were so exhibited.

10. Date of registration.

When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed, the opposition has been decided in favour of the applicant, the Registrar shall register the said trade mark, and the trade mark when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the filing date of the application for registration.

11. Advertisement of application.

- (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner.
- (2) An advertisement made pursuant to subsection (1) shall set forth all conditions subject to which the application has been accepted.

12. Opposition to registration.

- (1) Any person may, within the prescribed time, from the date of the advertisement of an application for the registration of a trade mark or geographical indication, give notice to the Registrar of opposition to such registration.
- (2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.
- (3) The Registrar shall send a copy of such notice to the applicant, and, within the prescribed time after the receipt of such notice the applicant may send to the Registrar, in the prescribed manner, a counter statement of the grounds on which he relies for his application.
- (4) If the applicant sends such counter statement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering any evidence filed in the prescribed manner, decide whether, and subject to what conditions, registration is to be permitted.
- (5) The decision of the Registrar shall be subject to appeal to the Court.
- (6) An appeal under this section shall be made in the prescribed manner, and on such appeal, the Court shall —
 - (a) if required, hear the parties and the Registrar; and
 - (b) make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

- (7) On the hearing of any such appeal any party may, either in the manner prescribed, or by special leave of the Court, bring forward further material for the consideration of the court.
- (8) In proceedings under this section, no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein above provided, except by leave of the court.
- (9) Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent or giving notice as prescribed.
- (10) In any appeal under this section, the Court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.
- (11) The Registrar shall have power in proceedings under this section to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid.
- (12) If a party giving notice of opposition or of appeal neither resides nor carries on business in The Bahamas, the Court may require such party to give security for costs of the proceedings before it relative to such opposition or appeal and, in default of such security being duly given, may treat the opposition or appeal as abandoned.

13. Rival claims to identical marks.

Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or services or description of goods or services, and seek to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by the Registrar.

14. Defensive registration of well known trade marks.

- (1) Where a trade mark has become so well known in association with any goods or services in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade between those goods or services and the person entitled to use the trade mark in relation to the first-mentioned goods or services, then, notwithstanding —

(a) that the proprietor registered in respect of the first-mentioned goods or services does not use or propose to use the trade mark in relation to those other goods or services; and

(b) anything in section 51,

the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first mentioned goods or services, be registered to the same proprietor in respect of those other goods or services as a defensive trade mark and, while so registered, shall not be liable to be taken off the Register in respect of those goods or services under section 51.

(2) A trade mark registered in the name of the same proprietor —

(a) as a defensive trade mark;

(b) otherwise than as a defensive trade mark,

shall, notwithstanding that the respective registrations are in respect of different goods or services, be deemed to be, and shall be registered as, associated trade marks.

(3) On application by any person aggrieved to the Court, or at the option of the applicant and subject to the provisions of section 61, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on grounds that —

(a) the requirements of subsection (1) are no longer satisfied in respect of any goods or services in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark; or

(b) if there is no longer any likelihood that the use of the trade mark in relation to those goods or services would be taken as giving the indication mentioned in subsection (1).

(4) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark for which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(5) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks.

15. Certification of registration.

On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar and sealed with the seal of the office.

16. Non-completion of registration.

Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

17. Disclaimer of rights.

- (1) If a trade mark contains —
 - (a) parts not separately registered by a proprietor as trade marks; or
 - (b) matter common to the trade or otherwise of a non-distinctive character,the Registrar or the Court, in deciding whether such trade mark shall be entered or remain upon the Register, may require, as a condition of its being upon the Register, that the proprietor shall —
 - (i) disclaim any right to the exclusive use of any part or parts of such trade marks, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled; or
 - (ii) make such other disclaimer as they may consider necessary for the purpose of defining his rights under such registration.
- (2) No disclaimer upon the Register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

18. Duration of registration.

The registration of a trade mark shall be for a period of ten years, and may be renewed from time to time in accordance with the provisions of this Act.

19. Renewal of registration.

- (1) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and upon payment of the prescribed fee, renew the registration of such trade mark for a period of ten years from the expiration of the original registration or the last renewal of registration, as the case may be, which date is herein termed “the expiration of the last registration”.
- (2) The Registrar shall require on renewal that any registration be made to conform with prescribed regulations.

20. Procedure on expiry of period of registration.

- (1) If the registration of a trade-mark has been on the register without renewal for the period specified in section 18, the Registrar shall send a notice to the registered owner and to the registered owner's representative for service, if any, stating that if within six months after the date of the notice the prescribed renewal fee is not paid, the registration shall lapse.
- (2) If registration is not renewed in accordance with section 19, the registration shall lapse subject to such conditions (if any) as to its restoration to the Register as may be prescribed.
- (3) When the prescribed fee for a renewal of any trade-mark registration is paid pursuant to section 19 or subsection (1), the renewal shall take effect as of the day of the expiration of the period specified in section 18.

21. Paris Convention and other International conventions relating to trade marks.

- (1) The provisions of the Paris Convention and any other international treaty in respect of trade marks, collective marks and certification marks to which The Bahamas is party shall apply to matters dealt with by this Act and, in case of conflict with the provisions of this Act, the provisions of the relevant treaty shall prevail.
- (2) More particularly and without limiting the generality of subsection (1), the provisions of the Paris Convention relating to —
 - (a) Article 6bis (Well-Known Marks);
 - (b) Article 6ter (Prohibitions Concerning State Emblems, Official Hallmarks and Emblems of Intergovernmental Organisations);
 - (c) Article 6septies (Registration in the Name of the Agent or Representative of the Proprietor without the Latter's Authorisation),shall apply fully in respect of all applications for protection for trade marks in The Bahamas.
- (3) Nothing in this section, shall entitle the proprietor of the trade mark to recover damages for any infringement occurring prior to the date of registration of his trade mark in The Bahamas.
- (4) An application for registration of a trade mark shall be made in the same manner as an ordinary application under this Act and shall be accompanied by a request for convention priority together with such declaration, as may be prescribed.
- (5) Where a person has applied for protection for any trade mark by application which —

- (a) in accordance with the terms of a treaty subsisting between two or more convention countries, is equivalent to an application duly made in that convention country; or
 - (b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,
- he shall be deemed for the purposes of this section to have applied in that convention country.
- (6) For the purposes of subsection (5), “person” includes a legal representative or assignee.

PART IV-ADMINISTRATIVE AND OTHER PROVISIONS

22. Hours of business of Intellectual Property Office.

- (1) The Intellectual Property Office shall be open during normal business hours for the purpose of the transaction by the public of business under this Act.
- (2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

23. Information about applications and registered trade marks.

- (1) After publication of an application for registration of a trade mark, the Registrar shall on request, and upon payment of the prescribed fee, provide any person with such information and permit such person 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, however, to any prescribed restrictions.
- (2) Any request referred to in subsection (1) shall be made in the prescribed manner and shall be accompanied by the appropriate prescribed fee, if any.
- (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,but subject to the provisions of subsection (4).

- (4) Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will, if the application is granted bring proceedings against him in respect of acts done after publication of the application, such person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly.

24. Power of Registrar to award costs and require security.

- (1) The Minister may make Regulations empowering the Registrar, in any proceedings before him under this Act —
 - (a) to award any party such costs as he may consider reasonable; and
 - (b) to direct how and by what parties they are to be paid.
- (2) An order of the Registrar made pursuant to subsection (1) may be enforced in the same way as an order of the Court.
- (3) Provision may be made by the Regulations empowering the Registrar, in appropriate cases, to require a party to proceedings before him to give security for costs, in relation to those proceedings on appeal, and as to the consequences if such security is not given.
- (4) Regulations may make provisions as to the giving of evidence before the Registrar by affidavit or statutory declaration.

25. Exclusion of liability in respect of official acts.

- (1) The Registrar shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which The Bahamas is a party.
- (2) The Registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised under this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.
- (3) No proceedings shall lie against any member of staff of the Intellectual Property Office in respect of any matter for which, by virtue of this section, the Registrar is not liable.

26. Registrar's annual report.

- (1) The Registrar shall in the month of December in each year, make a report to the Minister concerning the operations of the Intellectual Property Office in respect of this Act, and shall include in such report the discharge of his functions under the Paris Convention and any other international arrangement concerning trade marks to which The Bahamas is a party.

- (2) The report referred to under subsection (1) shall include an account of all monies received and paid by the Intellectual Property Office pursuant to this Act.

PART V - CATEGORIES OF TRADE MARKS

27. Coloured trade marks.

- (1) A trade mark may be limited in whole or in part to one or more specified colours, and in such case, the fact that it is so limited, shall be taken into consideration by the Registrar in determining the distinctive character of such trade mark.
- (2) If a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

28. Associated trade marks.

If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the Register for the same goods or services or description of goods or services as to be calculated to deceive or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that such trade marks shall be entered on the Register as associated trade marks.

29. Combined trade marks.

- (1) If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks.
- (2) Each separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the Register as such, but the registered user of the whole trade mark shall for the purposes of this Act be deemed to be also a registered user of such associated marks.

30. Identical trade marks.

Except by order of the Court, no trade mark shall be registered in respect of any goods or services or description of goods or services which —

- (a) is identical with a trade mark belonging to a different proprietor which is already on the Register with respect to such goods or services or description of goods or services; or

- (b) is so nearly resembling such a trade mark as to be calculated to deceive.

31. Certification and collective marks.

The provisions of this Act shall apply to certification marks subject to the provisions of the *First Schedule* and to collective marks, subject to the provisions of the *Second Schedule*.

PART VI - PROVISIONS AS TO TRADE MARKS

32. Assignment and transmission of trade marks.

- (1) A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods or services for which it has been registered, and shall be determinable with that goodwill.
- (2) Nothing in this section shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any foreign country in connection with any goods or services for which it is registered together with the goodwill of the business therein in such goods or services.

33. Apportionment of marks on dissolution of partnership.

- (1) In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks) on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, as the Registrar may think necessary in the public interest.
- (2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

34. Series of trade marks.

- (1) When a person claiming to be the proprietor of several trade marks for the same description of goods or services which, while resembling each other in the material particulars thereof, differ in respect of—

- (a) statements of the goods or services for which they are respectively used or proposed to be used;
- (b) statements of number, price, quality or names of places;
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark; or
- (d) colour,

and seeks to register such trade marks, they may be registered as a series in one registration.

- (2) All trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

35. Assignment and use of associated trade marks.

- (1) Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.
- (2) Where under the provisions of this Act, use of a registered trade mark is required to be proved for any purpose, the Registrar may, if and so far as he shall think right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such use.

36. Status of un-renewed trade marks.

Where a trade mark has been removed from the Register for non-payment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year after the date of such removal, be deemed to be a trade mark which is registered, unless it is shown to the satisfaction of the Registrar that there has been no bona fide trade use of such trade mark during the two years immediately preceding such removal.

37. Registration of assignments, etc.

- (1) Subject to the provisions of this Act, where a person becomes entitled to a registered trade mark by assignment, transmission or other operation of law, the Registrar shall, on request in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the Register as proprietor of the trade mark.
- (2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

38. Alteration of registered trade mark.

- (1) The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same.
- (2) The Registrar may —
 - (a) refuse such leave; or
 - (b) grant the same on such terms as he may think fit.
- (3) A refusal or conditional permission given under subsection (2) shall be subject to appeal to the Court.
- (4) If leave be granted pursuant to subsection (2), the trade mark as altered shall be advertised in the prescribed manner.

39. Permitted use by others.

- (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of —
 - (a) all or any of the goods or services in respect of which it is registered (otherwise than as a defensive trade mark); and
 - (b) either with or without conditions or restrictions.
- (2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 51 and for any other purpose for which such use is material under this Act or at common law provided that the proprietor of the trade mark has, under the licence, direct or indirect control of the character or quality of the goods or services.
- (3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.
- (4) A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.
- (5) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner and must furnish him with a statutory declaration made by the proprietor, or by

some person authorised to act on his behalf and approved by the Registrar stating —

- (a) the particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the proposed registered user which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whom an application for registration as registered users may be made;
 - (b) the goods or services in respect of which registration is proposed;
 - (c) any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use, or to any other matter; and
 - (d) whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof, and with such further documents, information or evidence as may be required under regulations or by the Registrar.
- (6) The registered user application described in subsection (5) may be filed with the Registrar at the same time as or at any time after the application for registration of the trade-mark is filed with the Registrar.
 - (7) If the Registrar after considering the information furnished to him under subsection (5) is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods or services as to which he is so satisfied subject as aforesaid.
 - (8) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.
 - (9) The Registrar shall, if so required by an applicant, take steps to ensure that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the Register) is not disclosed to rivals in business.
 - (10) Without prejudice to the provisions of section 60, the registration of a person as a registered user —
 - (a) may be varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner

- of the registered proprietor of the trade mark to which the registration relates;
- (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of —
- (i) the registered proprietor or of the registered user or of any other registered user of the trade mark; or
 - (ii) any person on any of the following grounds, that is to say —
 - (aa) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;
 - (bb) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration; or
 - (cc) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.
- (11) Provision shall be made by regulations for the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under subsection (10) to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.
- (12) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered.
- (13) Any decision of the Registrar under the foregoing provisions of this section shall be subject to appeal to the Court.
- (14) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

40. Powers of registered proprietor.

Subject to the provisions of this Act —

- (a) the person for the time being entered in the Register as proprietor of a trade mark shall, subject to any right appearing from such Register to be vested in any other person, have the power to assign the same, and to give effectual receipts for any consideration for such assignment;
- (b) any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

41. Rights of registered proprietor of trade mark.

- (1) Subject to the provisions of section 42 and to any limitations and conditions entered upon the Register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to prevent any unauthorized person from using such trade mark upon or in connection with the goods or services in respect of which it is registered.
- (2) Where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods or services, no rights of exclusive use of such trade mark shall (except so far as their respective rights shall have been defined by the Court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.
- (3) In the case of the use of an identical mark for identical goods or services, a likelihood of confusion shall be presumed.

42. Registration to be conclusive after five years.

- (1) In all legal proceedings relating to a registered trade mark the original registration of such trade mark shall after —
 - (a) the expiration of five years from the date of such original registration; or
 - (b) five years from the commencement of this Act, whichever occurs last,be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section 8.
- (2) Nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the use by any person of a similar trade mark upon or in connection with goods or services upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date prior to the use of the first mentioned trade mark by the proprietor thereof or his predecessors in

business, or to object (on such use being proved) to such person being put upon the Register for such similar trade mark in respect of such goods or services under the provisions of section 56.

43. Unregistered trade marks.

No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark.

44. Infringement.

- (1) Each act described in sections 64 to 66, and 68 is an infringement of a trade mark.
- (2) Any such infringement of a trade mark shall be actionable before the Court at the suit of the owner or an authorized user of the trade mark in accordance with this Act.
- (3) Subject to this Act, in any action for such infringement of a trade mark, all such relief by way of damages, injunctions, accounts or otherwise, shall be available to the plaintiff as is available in respect of the infringement of other proprietary rights.
- (4) In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade mark in respect to the get-up of the goods or services for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods or services by other persons.
- (5) Any person whose trade mark rights are infringed pursuant to this Act may apply to the Court for an order that appropriate measures for the dissemination of the information concerning the finding of infringement be taken at the expense of the infringing party and such measures may include displaying the decision and publishing it in full or in part, or prominent advertising of the decision.

45. Order of erasure etc., of offending mark.

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 mark 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 reasonable practicable for the offending mark to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

46. Order for delivery up of infringing goods, material or articles.

- (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 48 and 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 49.
- (3) 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 49 is not made, retain them pending the making of such order, or the decision not to make an order under that section.
- (4) Nothing in this section affects any other power of the Court.

47. Meaning of “infringing goods, material or articles”.

- (1) In this Act, the expression “**infringing goods**”, “**infringing material**” and “**infringing articles**” shall be construed as provided for hereunder.
- (2) Goods are “infringing goods” in relation to a trade mark, if they or their packaging bear a mark identical or confusingly similar to that mark and —
 - (a) the application of the mark to the goods or their packaging was an infringement of the registered trade mark;
 - (b) the goods are proposed to be imported into The Bahamas and the application of the mark in The Bahamas to them or their packaging would be an infringement of the registered trade mark; or
 - (c) the mark has otherwise been used in relation to the goods in such a way as to infringe the registered trade mark.
- (3) Nothing in subsection (2) shall be construed as affecting the importation of goods which may lawfully be imported into The Bahamas by virtue of any law.
- (4) Material is “infringing material”, in relation to a registered trade mark if it bears a mark identical or similar to that 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.
- (5) “**Infringing articles**”, in relation to a registered trade mark, means articles —

- (a) which are specifically designed or adapted for making copies of a mark identical or similar to that 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.

48. Period after which remedy for delivery up not available.

- (1) An application for an order under section 46 may not be made after the end of the period of six years from —
 - (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;
 - (b) in the case of infringing material, the date on which the trade mark was applied to the material; or
 - (c) in the case of infringing articles, the date on which they were made, except as mentioned in the next following provisions.
- (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 such disability or, as the case may be, could with reasonable diligence have discovered those facts.

49. Order as to disposal of infringing goods, material or articles.

- (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 46, 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 shall 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, 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 would or may be made under this section.

50. Surrender of registered trade mark.

- (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) Provision may be made by 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.

51. Revocation of registration.

- (1) The registration of a trade mark may be revoked on any of the following grounds —
 - (a) that within the period of five years following the date of completion of the registration procedure, it has not been used in The Bahamas by the registered 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 the acts or inactivity of the registered 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 registered 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), “use of a trade mark” includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in The Bahamas includes affixing the trade mark to goods or to the packaging of goods in The Bahamas 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 those paragraphs is commenced or resumed after the expiry of the five year period and before the application for revocation is made, provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.
- (4) 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.
- (5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.
- (6) Where the registration of a trade mark is revoked to any extent, the rights of the 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.

52. Grounds for invalidity of registration.

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 8 or any of the provisions referred to in that section but where the trade mark was registered in breach of subsection 8(1)(a), (b), (c) or (d) of that section, it

shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

- (2) The registration of a trade mark may be declared invalid on the ground —
 - (a) that there is an earlier trade mark in relation to which the conditions set out in section 37, obtain; or
 - (b) that there is an earlier right in relation to which the condition set out in section 37 is satisfied,
 unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.
- (3) An application for a declaration of invalidity 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 shall be made to the Court; and
 - (b) if in any other case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the Court.
- (4) In the case of bad faith in the registration of a trade mark, the Registrar himself may apply to the Court for a declaration of the invalidity of the registration.
- (5) 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 as regards those goods or services only.
- (6) 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 this shall not affect transactions past and closed.

53. Effect of acquiescence of earlier trade mark.

- (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 The Bahamas, 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 as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

54. Limitations and exceptions.

- (1) The rights conferred by registration under this Act shall have no effect in respect of —
 - (a) any bona fide use or indication in the course of trade of a person's own name, address, place of business or place of production or distribution of goods or services, or those of that person's predecessors in business;
 - (b) use by any person of indications concerning the kind, quality, quantity, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of his goods or services;
 - (c) acts in respect of goods lawfully bearing the trade mark after those goods have been put on the market in The Bahamas or elsewhere in the world by the registered proprietor or by a person acting with the proprietor's consent, provided that the goods and the packaging or wrapping in direct contact with the goods have not suffered any material alteration or damage;
 - (d) use of the registered trade mark by any person for the purpose of indicating truthfully in the course of trade that the goods or services that bear the trade mark originate with the proprietor of the trade mark or with a person authorized by the proprietor;
 - (e) use of the registered trade mark by a person to provide information regarding the intended purpose, use or compatibility of a product or service, in particular with respect to accessories or spare parts;
- (2) Any acts specified in subsection (1) must be performed in accordance with honest practices and in a manner that does not cause confusion regarding the provenance of the goods or services, and must not take unfair advantage of, or be detrimental to, the distinctive character or repute of the trade mark, and must not otherwise constitute an act of unfair competition.

55. "Passing off" action.

Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.

PART VII—LEGAL PROCEEDINGS AND OFFENCES

LEGAL PROCEEDINGS

56. Concurrent user.

In the case of —

- (a) an honest concurrent user; or
- (b) other special circumstances which, in the opinion of the Court, make it proper so to do,

the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or services or description of goods or services by more than one proprietor subject to —

- (i) each proprietor being limited to using such trade mark or nearly identical trade mark in exclusive geographic areas that do not overlap; and
- (ii) such conditions and limitations, if any, as to mode of use, or otherwise, as the Court thinks right to impose.

57. Registration to be prima facie evidence of validity.

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a trade mark shall be prima facie evidence of the validity of the trade mark and of any subsequent assignment or other transmission of it that is recorded in the Register.

58. Certification of validity of contested registration.

- (1) If in the 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;he is entitled to his costs as between attorney and client unless the Court directs otherwise but this subsection does not extend to the costs of an appeal in any such proceedings.

59. Registrar's appearance in proceedings involving the Register.

- (1) In proceedings before the Court involving an application for —
 - (a) the revocation of the registration of a trade mark; or
 - (b) a declaration of the invalidity of the registration of a trade mark,

the Registrar is entitled to appear and be heard 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 it;
 - (c) the practice of the Intellectual Property Office 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) Any thing 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 officer of the staff of the Intellectual Property Office.

60. Rectification of Register.

- (1) Subject to the provisions of this Act, the Court may —
- (a) on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry, or by any entry made in the Register without sufficient cause, or by any entry wrongfully remaining on the Register, or by an error or defect in any entry in the Register, make such order for making, expunging, or varying such entry, as it may think fit; and
 - (b) in any proceeding under this section, decide any question that may be necessary or expedient to decide on in connection with the rectification of the Register.
- (2) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section.
- (3) Any order of the Court rectifying the Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the Register accordingly.

61. Appeals from decisions of the Registrar.

- (1) An appeal lies to the Court from any decision of the Registrar under this Act.

- (2) For the purposes of this section, “decision of the Registrar” includes any act of the Registrar in exercise of a discretion vested in him by or under this Act.

62. Agents.

- (1) A counsel and attorney shall be entitled to represent any party in any matter or proceedings before the Registrar under this Act.
- (2) Where an applicant's ordinary residence or principal place of business is outside The Bahamas, he shall be represented by a counsel and attorney who is resident in The Bahamas and practising in The Bahamas in accordance with the relevant law.
- (3) The Minister may make regulations requiring the keeping of a register of persons who act as agents for other persons for the purpose of applying for or obtaining the registration of trade marks, and references in this Act to “trade mark agent” or “agent” shall be construed, unless the context otherwise requires, to be references to persons whose names are entered in the register pursuant to this subsection.
- (4) Regulations shall provide for the payment of fees by persons requiring to be registered as agents.
- (5) No person who is not an agent shall carry on business under any name, description or style which contains the words “registered trade mark agent” or hold himself out or otherwise describes himself as such an agent.
- (6) A person who contravenes subsection (4) commits an offence and is liable on summary conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding three years, or to both such fine and imprisonment.
- (7) For the purposes of this Act, “counsel and attorney” has the meaning assigned to it by section 2 of the Legal Profession Act (*Ch. 64*).

63. Provision restricting importation of infringing goods.

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

- (2) 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 his private and domestic use, is prohibited, but a person is not by reason of the prohibition liable to any penalty other than forfeiture of the goods.
- (3) The proprietor of a registered trade mark, or a licensee who gives notice to the Comptroller of Customs pursuant to subsection (1) shall comply with such conditions with respect to —
 - (a) the form of the notice;
 - (b) the furnishing of evidence;
 - (c) the payment of fees in respect of the notice;
 - (d) the giving of security in respect of any liability or expense which the Comptroller may incur in consequence of the notice by reason of the detention of any article or anything done to a detained article;
 - (e) the indemnification of the Comptroller against any liability or expenses, whether security has been given or not; and
 - (f) any other incidental or supplementary matters,as may be prescribed, and different provisions may be prescribed for different classes or cases.
- (4) Notwithstanding anything in the Customs Management Act, a person shall not be liable to any penalty under that Act (other than the forfeiture of the goods) by reason only that any goods are treated as prohibited goods by virtue of this section.

OFFENCES

64. Forging or falsely applying trade marks.

Every person who —

- (a) forges any trade mark;
- (b) falsely applies to goods or services any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive,

unless he proves that he acted without intent to defraud, commits an offence under this Act.

65. Selling goods or services to which false trade mark applied.

Every person who sells, or exposes for sale, or has in his possession for sale, for any purpose of trade or manufacture, any goods or services or things to which any forged trade mark is applied, or to which any trade mark or mark so nearly

resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, commits an offence under this Act, unless he proves—

- (a) that having taken all reasonable precautions against committing an offence under this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark;
- (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or services or things; and
- (c) that otherwise he acted innocently.

66. Forging trade marks.

- (1) A person shall be deemed to forge a trade mark who either —
 - (a) without the consent of the proprietor of the trade mark makes that trade mark or mark so nearly resembling that trade mark as to be calculated to deceive;
 - (b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.
- (2) Any trade mark so made or falsified is in this Act referred to as a forged trade mark provided that in any prosecution for forging a trade mark the burden of proving the consent of the proprietor shall lie on the defendant.

67. Applying trade marks.

- (1) A person shall be deemed to apply a trade mark or mark to goods who —
 - (a) applies it to the goods themselves;
 - (b) applies it to any covering, label, reel or other thing in or with which the goods are sold or exposed or had in his possession for any purpose of sale, trade or manufacture;
 - (c) places, encloses or annexes any goods which are sold or exposed or had in his possession for any purpose of sale, trade or manufacture, in, with or to any covering, label, reel or other thing to which a trade mark has been applied; or
 - (d) uses a trade mark or mark in any manner calculated to lead to the belief that the goods in connection with which it is used are designated by that trade mark or mark.
- (2) A trade mark or mark shall be deemed to be applied whether it is woven, impressed or otherwise worked into or annexed, or affixed to the goods, or to any covering, label, reel or other thing.

68. Falsely applying trade marks.

A person shall be deemed falsely to apply to goods a trade mark or mark, who without the consent of the proprietor of a trade mark applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a trade mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant.

69. Falsification of entries in register.

If any person —

- (a) makes or causes to be made a false entry in the register kept under this Act;
- (b) creates a writing falsely purporting to be a copy of an entry in any such register;
- (c) produces or tenders or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false,

he commits an offence under this Act.

70. Penalty on falsely representing a trade mark.

- (1) Any person who represents a trade mark as registered under this Act which is not so registered shall be liable on summary conviction to a fine not exceeding two thousand dollars for each article in respect of which the false representation has been made.
- (2) A person shall be deemed for the purposes of this enactment to represent that a trade mark is registered under this Act if he uses in connection with the trade mark the word “registered” or any words expressing or implying that registration has been obtained for the trade mark.

71. Offences by body corporate or partnership.

- (1) Where an offence is committed under this Act by a body corporate, every person who at the material time was a director, manager, secretary or other similar officer of the body corporate, or any person purporting to act in such capacity shall be liable to be proceeded against in his personal capacity and punished accordingly unless he proves that the offence was committed without his knowledge or connivance, or that he tried to prevent the commission of the offence.
- (2) Subsection (1) shall, *mutatis mutandis*, apply in respect of partners in a partnership for offences committed by a partnership under this Act.

- (3) A fine imposed on a partnership on its conviction under this Act shall be paid out of the partnership assets.

72. Powers of police officers.

- (1) Any police officer may —
- (a) subject to the provisions of this Act, enter and search any premises or place, for goods which, or the packaging of which, bears a mark identical to or likely to be mistaken for a registered trade mark, or for material bearing such a mark and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or for articles specifically designed or adapted for making copies of such mark;
 - (b) stop, board and search any vessel (other than a ship of war) or any aircraft (other than a military aircraft) for goods referred to in paragraph (a);
 - (c) stop and search any vehicle, in which he reasonably suspects that there are the goods referred to in paragraph (a);
 - (d) seize, remove or detain any goods referred to in paragraph (a) found by him pursuant to this subsection.
- (2) Any police officer may —
- (a) break open any outer or inner door of any place which he is empowered or authorised by this Act to enter and search;
 - (b) forcibly board any vessel, aircraft or vehicle which he is empowered by this Act to stop, board and search;
 - (c) remove by force any person or thing obstructing him in the exercise of any power conferred on him by this Act;
 - (d) detain any person found in any place which he is empowered or authorised by this Act to search until such place has been searched;
 - (e) detain any vessel or aircraft which he is empowered by this Act to stop, board and search, and prevent any person from approaching or boarding such vessel or aircraft until it has been searched;
 - (f) detain any vehicle which he is empowered by this Act to stop and search until it has been searched.

73. Restrictions on the entry and search of domestic premises.

- (1) No domestic premises shall be entered and searched by a police officer unless a Stipendiary and Circuit Magistrate has issued a warrant under subsection (2).
- (2) A Stipendiary and Circuit Magistrate may, if he is satisfied by information on oath that there is reasonable grounds for suspecting that

there is in any domestic premises any article which may be seized, removed or detained under any provision of this Act, issue a warrant authorising a police officer to enter and search the premises.

- (3) A police officer authorised under subsection (2) to enter and search any premises may call upon any police officer to assist him in entering and searching the premises.
- (4) In this section “domestic premises” means any premises or any part thereof, used exclusively or mainly as a dwelling house.

74. Obstruction of police officers.

- (1) Without prejudice to any other written law, any person who —
 - (a) wilfully obstructs a police officer in the exercise of his powers or the performance of his duties under this Act;
 - (b) wilfully fails to comply with any requirements properly made to him by any such police officer; or
 - (c) without reasonable excuse, fails to give such police officer any other assistance which he may reasonably require to be given for the purpose of exercising his powers or performing his duties under this Act,

commits an offence and is liable on summary conviction to a fine not exceeding one thousand dollars or to imprisonment for a term not exceeding twelve months.

- (2) A person who, when required to give information to a police officer in the exercise of his powers or the performance of his duties under this Act, knowingly gives false or misleading information to any such police officer, commits an offence and is liable on summary conviction to a fine not exceeding two thousand dollars or to imprisonment for a term not exceeding two years.
- (3) Nothing in this section shall be construed as requiring any person to give any information which may incriminate him.

75. General penalty.

- (1) Any person who commits an offence under this Act for which no penalty is otherwise specifically provided, shall be liable on summary conviction —
 - (a) to a fine not exceeding two hundred and fifty thousand dollars or to a term of imprisonment for a term of five years or to both that fine and imprisonment;

- (b) to the forfeiture and destruction of all goods and materials bearing a forged trade mark in respect of which the offence was committed.
- (2) The destruction of all goods and materials bearing a forged trade mark shall be in the presence of a member of the police force and a representative of the trade mark proprietor if that proprietor so desires.

PART VIII-MISCELLANEOUS

76. Power of Minister to make Regulations.

- (1) The Minister may make Regulations —
 - (a) for the purpose of any provision of this Act authorising the making of regulations with respect to any matter; and
 - (b) for prescribing anything authorised or required by any provision of this Act to be prescribed,and 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 including such forms or other filing documents as may be required;
 - (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.
- (3) Provision may be made by regulations as to —
 - (a) the payment of a single fee in respect of two or more matters; and
 - (b) the circumstances (if any) in which a fee may be repaid or remitted.

77. Adaptation of entries to new classification.

- (1) The Minister may make Regulations empowering the Registrar to do such things as the Registrar considers necessary to implement any amended or substituted classification of goods or services for purposes of the registration of trade marks.
- (2) Regulations made pursuant to this section 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 as is referred to in this section shall not be exercised so as to extend the rights conferred by registration except where it appears to the Registrar that full compliance with this requirement would involve undue complexity and that any extension would not adversely affect the rights of any person.
- (4) The Regulations may empower the Registrar —
 - (a) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the Register; and
 - (b) to 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 shall be advertised in at least two newspapers having general circulation in The Bahamas and in one issue of the Gazette, and may be opposed, in such manner as may be prescribed.

78. International treaties.

- (1) The provisions of the Convention specified in the *Third Schedule* are hereby incorporated and made a part of this Act.
- (2) Judicial notice shall be taken of the Paris Convention or any other Treaty relating to trade marks, collective marks and certification marks to which The Bahamas may become a party, and of any bulletin, journal or gazette published under such Convention or Treaty.
- (3) Any document referred to in any such bulletin, journal or gazette shall be admissible as evidence of any instrument or other act thereby communicated, or of any institution established by or having functions under any Convention or Treaty referred to in subsection (1).

PART IX—REPEAL, SAVINGS AND TRANSITIONAL

79. Repeal.

- (1) The Trade Marks Act (*Ch. 322*) is hereby repealed.
- (2) Notwithstanding the repeal of the above mentioned Act, all subsidiary legislation made under the repealed Act shall continue in force so far as it is not inconsistent with the provisions of this Act, until revoked by subsidiary legislation made under this Act.

80. Transitional and savings.

- (1) Notwithstanding the repeal of the Act referred to in section 79, all trade marks registered in The Bahamas pursuant to the repealed Trade Marks Act and any Rules made thereunder shall, subject to subsection (2), be deemed to have been registered under this Act.
- (2) Subject to section 79, trade marks registered pursuant to the repealed Act shall remain in force for the unexpired portion of the period of protection provided under that Act.
- (3) Any application made under the repealed Act shall be continued and dealt with in all respects as if this Act had not come into force.

FIRST SCHEDULE

(Section 31)

COLLECTIVE MARKS**General**

1. The provisions of this Act apply to collective marks subject to the following provisions.

Marks of which a collective mark may consist

2. In relation to collective mark, the reference in section 2(1) (marks of which a trade mark may consist) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as 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 8(1)(c), a collective mark may be registered which consists of marks or indications which may serve, in trade to designate the geographical origin of the goods or services.
 - (2) However, the proprietor of such a mark is not entitled to prohibit the use of the marks 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, in particular, if 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, and notwithstanding any other provision of this Act, an application may be amended so as to comply with any such requirement.

Regulations governing use of the collective mark

5. (1) An applicant for registration of a collective mark shall file with the Registrar regulations governing the use of the mark.
- (2) The regulations shall specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.
- (3) Further requirements with which the regulations have to comply may be imposed by regulations.

Approval of regulations by Registrar

6. (1) A collective mark shall not be registered unless the regulations governing the use of the mark —
- (a) comply with paragraph 5(2) and any further requirements imposed by regulations; and
 - (b) are not contrary to public policy or to accepted principles of morality.
- (2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant shall file the regulations with the Registrar and pay the prescribed fee and if he does not do so, the application shall be deemed to be withdrawn.
- (3) The Registrar shall consider whether the requirements mentioned in subparagraph (1) are met.
- (4) If it appears to the Registrar that those requirements are not met, 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.

(5) If the applicant fails to satisfy the Registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.

(6) If it appears to the Registrar that those requirements, and other requirements for registration, are met, he shall accept the application and shall proceed in accordance with sections 11 and 12 as the case may be.

(7) The regulations shall be published and notice of opposition may be given relating to the matters mentioned in this paragraph.

Regulations to be open to inspection

7. 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

8. (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 amendment of the regulations the Registrar may in any case where it appears to him expedient to do so cause them to be published.
- (3) If he does so, 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

9. (1) The following provisions have effect as regards the rights of an authorised user in relation to infringement of a registered collective mark.
- (2) An authorised user is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor to take infringement proceedings in respect of any matter which affects his interests.
- (3) If the proprietor —
- (a) refuses to do so; or
- (b) fails to do so within two months after being called upon,
- the authorised user may bring the proceedings in his own name as if he were the proprietor.
- (4) Where the infringement proceedings are brought by virtue of this paragraph, 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 but this does 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 (4) 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 any loss suffered or likely to be suffered by authorised users shall be taken into account, and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

11. Apart from the grounds of revocation provided for in section 51 the registration of a collective mark may be revoked on the ground —
 - (a) that 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 4(1);
 - (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or
 - (c) that an amendment of the regulations has been made so that the regulations —
 - (i) no longer comply with paragraph 5(2) and any further conditions imposed by regulations; or
 - (ii) are contrary to public policy or to accepted principles of morality.

Grounds for invalidity of registration

12. Apart from the grounds of invalidity provided for in section 52, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4(1) or 6(1).

SECOND SCHEDULE

(Section 31)

CERTIFICATION MARKS

1. The provisions of this Act apply to certification marks subject to the following provisions.

Marks of which a certification mark may consist

2. In relation to a certification mark the reference in section 2(1) (marks 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 8(1)(c), a certification mark may be registered which consists of marks or indications which may serve, in trade, to designate the geographical origin of the goods or services.
(2) However, the proprietor of such a mark is not entitled to prohibit the use of the marks 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, in particular if 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 and notwithstanding any other provision of this Act an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6. (1) An applicant for registration of a certification mark shall file with the Registrar regulations governing the use of the mark.
- (2) The regulations shall indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.
- (3) Further requirements with which the regulations have to comply may be imposed by regulations.

Approval of regulations by Registrar

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 regulations; 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) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the Registrar and pay the prescribed fee, and if he does not do so, the application shall be deemed to be withdrawn.
- (3) The Registrar shall consider whether the requirements mentioned in subparagraph (1) are met.
- (4) If it appears to the Registrar that those requirements are not met, 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.
- (5) If the applicant fails to satisfy the Registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.
- (6) If it appears to the Registrar that those requirements, and other requirements for registration, are met, he shall accept the application and shall proceed in accordance with sections 11 and 12 as the case may be (publication and opposition proceedings).

(7) The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in this paragraph, in addition to any other grounds on which the application may be opposed or observations made.

Regulations to be open to inspection

8. 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

9. (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 amendment regulations the Registrar may in any case where it appears to him expedient to do so cause them to be published.
- (3) If he does so, notice of opposition may given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

Consent to assignment of registered certification mark

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

Infringement: rights of authorised users

11. In infringement proceedings brought by the proprietor of a registered certification mark any loss suffered or likely to be suffered by authorised users shall be taken into account, and the Court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of such users.

Grounds for revocation of registration

12. Apart from the grounds of revocation provided for in section 51, the registration of a certification mark may be revoked on the ground —
- (a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4;
- (b) that 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) that the proprietor failed to observe, or to secure the observance of, the regulations governing the use of the mark;
- (d) that an amendment of the regulations has been made so that the regulations —
 - (i) no longer comply with paragraph 6(2) and any further conditions imposed by regulations; or
 - (ii) are contrary to public policy or to accepted principles of morality; or
- (e) that the proprietor is no longer competent to certify the goods or services for which the mark is registered.

Grounds for invalidity of registration

- 14. Apart from the grounds of invalidity provided for in section 52, the registration of a certification mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4, 5(1) or 6(3).

THIRD SCHEDULE

(Section 78)

THE PARIS CONVENTION

- (1) The Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time, the Regulations made thereunder, and the Administrative Instructions made under those Regulations shall be given full effect.
- (2) Where reference is made in this Act to the Paris Convention, such reference shall include the Regulations and Administrative Instructions referred to under paragraph (1).
- (3) Where the provisions of this Act and the Regulations made thereunder conflict with those of the Paris Convention, the provisions of the Paris Convention shall prevail.

OBJECTS AND REASONS

This Bill seeks to repeal the Trade Mark Act, Chapter 322, and to modernize the law with respect to trade marks and provide more favourable provisions for the better protection and registration of trade marks in The Bahamas.

Clause 1 of this Bill provides for the short title and commencement date, which shall occur on such date as the Minister may by notice publish in the Gazette.

Clause 2 of this Bill expounds upon the interpretation provision contained in the repealed Act by providing for the definitions of additional key terms and references used throughout the Bill.

Clause 3 of this Bill provides for the functions of the Registrar who shall be responsible for matters relating to trade marks as provided under this Bill.

Clause 4 of this Bill provides for the Register of Trade Marks, which shall be maintained under the control and management of the Registrar. The Registrar shall be responsible for entering in the Register all registered trade marks, certification marks and collective marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations and any such matters relating to trade marks.

The Register shall contain all particulars of any application for the registration of a trade mark and any other information as the Registrar deems necessary. However, any notice of a trust, whether expressed, implied or constructive, shall not be entered into the Register nor be received by the Registrar, and at all convenient times the Register shall be made available for public inspection. Persons wanting certified copies of information contained on the Register shall be entitled upon payment of the prescribed fee.

Clause 5 of this Bill provides for the manner in which a registered proprietor, or his lawful agent, may make a request to the Registrar to correct, change or cancel any entry of in the Register, or enter a disclaimer or memorandum relating to a trade mark. Such persons may appeal to the Court concerning any decision of the Registrar made pursuant to this clause.

Clause 6 of this Bill provides for the Registrar to provide forms and any necessary instructions with respect to their use for the purpose of registering a trade mark.

Part III of this Bill, which includes Clauses 7 to 21, contains provisions addressing issues related to the registration of trade marks.

Clause 7 of this Bill explains that a trade mark will only be registrable in respect of certain goods or services if the trade mark is distinctive. The use of the term

“distinctive”, in this regard, means that the trade mark must be adapted to distinguish the goods and services of the proprietor from those of other persons.

Clause 8 of this Bill lists the restrictions on registering a trade mark. For example, it is unlawful to register a mark as a trade mark that is devoid of any distinctive character, or that is calculated to deceive the public.

Clause 9 of this Bill provides that a proprietor of a trade mark, who is desirous of having it registered, may make application in writing to the Registrar in the manner prescribed. Sub clause (2) of Clause 9 sets out the contents to be provided in each application.

Clauses 10 and 11 of this Bill provide, respectively, for the effective date of registration and advertisement of the application for registration of a trade mark in the prescribed manner.

Clause 12 of this Bill sets out the procedural steps to be taken by an individual seeking to oppose the registration of a trade mark and the appellate procedure should the opposing individual not accept the decision of the Registrar.

Clause 13 of this Bill provides for rival claims to identical marks. In such circumstances where several persons claim to be the proprietor of the same trade mark, the Registrar may refuse to register the mark until the individuals’ rights have been determined by the Court or settled by an agreement acceptable to the Registrar.

Clauses 14, 15 and 16 of this Bill provide, respectively, for the defensive registration of well-known trade marks, certification by the Registrar of registration of a trade mark and non-completion of registration of a trade mark within twelve months from the date of application by reason of default on the part of the applicant.

Clauses 17, 18, 19 and 20 of this Bill, respectively, provide for the disclaimer of rights in respect of the registration of a trade mark, the duration of registration of a trade mark for a period of ten years, the renewal thereof and the procedure on expiry of the period of registration.

Clause 21 of this Bill is a new provision, which explains The Bahamas’s obligations under the Paris Convention and other various international treaties and the implications of the provisions of this Bill with respect to same. The clause provides that the provisions of the Paris Convention and other international treaties concerning trade marks, of which The Bahamas is a signatory, shall apply to this Bill and in the event of conflict with this Bill the provisions of the relevant treaty shall prevail.

Part IV of this Bill, which includes clauses 22 to 26, provides mainly for the administrative functions of the Intellectual Property Office.

Clause 22 of this Bill provides for the hours of operation, which shall be normal business hours.

Clause 23 of this Bill provides for the Registrar to permit persons to inspect documents relating to the application for registration of a trade mark upon payment of a prescribed fee and subject to any prescribed restrictions.

Clause 24 of this Bill provides for the Minister to make Regulations empowering the Registrar to award costs and to require a party to give security for costs in relation to appellate matters.

Clause 25 of this Bill provides that the Registrar shall be excluded from liability in respect of official acts. Additionally, members of staff of the Intellectual Property Office shall be protected from liability in respect of matters for which the Registrar himself is not liable.

Clause 26 of this Bill mandates that the Registrar shall produce an annual report to the Minister concerning the operations of the Intellectual Property Office, his functions under the Paris Convention and any other international arrangement relating to trade marks to which The Bahamas is a signatory, as well a financial account of monies received pursuant to the provisions of this Bill.

Part V of this Bill, which includes clauses 27 to 31, lists the various categories of trade marks. These include, coloured trade marks, associated trade marks, combined trade marks, identical trade marks and certification and collective marks.

Part VI of this Bill, which includes clauses 32 to 55, contains provisions relating to the assignment and transmission of trade marks, the apportionment of marks on dissolution of partnership, series of trade marks, assignment user of associated trade marks, status of un-renewed trade marks, registration of assignments, etc.

Clause 38 of this Bill provides for the alteration of a registered trade mark by the registered proprietor if the alteration does not substantially affect the identity of the trade mark.

Clause 39 of this Bill provides for persons, other than the proprietor of a trade mark, to be registered as a registered user in respect of the goods and services of which it is registered, with the exception of a defensive trade mark. Such use may be with or without conditions or restrictions.

Clauses 40 and 41 of the Bill speak to the powers and rights of a registered proprietor, respectively and Clause 42 explains that registration of a trade mark shall be deemed to be conclusive and valid in all respects after five years from the date of the original registration or five years from the commencement of the Act, whichever occurs last, unless it is discovered that the registration was obtained by fraud or offends the provisions of section 8.

Clause 43 of this Bill explains that no person will be entitled to institute proceedings to prevent or recover damages for the infringement of an unregistered trade mark, and clause 44 goes on to outline the specifics of infringement.

Clauses 45 to 49 of this Bill provide, respectively, for in circumstances where a person is found to have infringed a registered trade mark, the Court can order that the infringing mark be erased, removed or obliterated from infringing goods, materials or articles. Additionally, the proprietor of a registered trade mark may apply to the Court for an order for the delivery up to him of any infringing goods, materials or articles.

In this Bill, “infringing goods”, in relation to trade marks, refer to goods or their packaging that bear a mark identical or similar to the registered trade mark and its application infringes the said mark.

Material is “infringing material” if it bears a mark identical or similar to a registered mark and either is it used for labelling or packaging goods, as a business paper or for advertising goods or services in a way that infringes the registered trade mark.

“Infringing articles” in relation to a registered trade mark refer to articles specially designed for making copies of a mark identical to the said trade mark.

An application for an order for delivery up may not be made after the end of a period of six years. However, this Bill provides that if, during the period, the registered proprietor was under a disability or prevented by fraud or concealment from discovering the facts of the infringement, 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 the disability or could, with reasonable diligence, have discovered the facts.

In circumstances where the infringing goods have been delivered up pursuant to an order, an application may be made for the said goods to be destroyed.

Clauses 50 and 51 of this Bill provide, respectively, for the surrender of a registered trade mark by the proprietor in accordance with Regulations made hereunder, and the revocation of the registration of a trade mark in various circumstances, for example, where after a period of five years following the completion of the registration procedure the mark has not been put to genuine use and there no proper reasons given for such non-use.

Clause 52 of this Bill sets out the grounds for invalidity of registration. Such grounds include, inter alia, where the trade mark has been registered in breach of clause 8, which deals with restriction on registration. The clause further provides that any person may make an application for a declaration of invalidity either to the Registrar or to the Court. Where the registration is declared invalid to any extent the registration shall, to that extent, be deemed to never have been made.

Clauses 53 to 56 of this Bill contain provisions concerning the effect of acquiescence of earlier trade mark, limitations and exceptions with respect to registration of a trade mark under the Act, and the fact that nothing contained in the Act shall affect rights of action against a person for “passing off” goods or services or the remedies in respect thereto.

Part VII of this Bill contains provisions relating to legal proceedings and offences. Clauses 56 to 63 relate to legal proceedings and clauses 64 to 75 relate specifically to offences.

Clause 56 of this Bill provides for circumstances concerning an honest concurrent user or other special circumstances where the Court may permit registration of the same, or similar, trade mark by more than one proprietor, for the same goods or services, subject to such conditions and limitations as the Court thinks fit to impose.

Clause 57 of this Bill explains that in legal proceedings relating to a registered trade mark, the registration of a person as proprietor will be regarded as *prima facie* evidence of the validity of the original registration and any subsequent assignment or transmission.

Clauses 58 and 59 of this Bill provide, respectively, for the certification of the validity of the contested registration by the Court, and in proceedings before the Court involving an application for the revocation or a declaration of the invalidity of the registration of a trade mark, the Registrar is entitled to appear and be heard if directed by the Court. Where the Court makes such direction, it should be noted that anything that the Registrar is authorized to do may be done on his behalf by an authorized officer of the Intellectual Property Office.

Clause 60 of this Bill provides for the rectification of the Register upon an application made in the prescribed manner by a person aggrieved. In cases of fraud, the Registrar himself may apply, and any order of the Court hereunder shall be served on the Registrar in the prescribed manner, who, upon receipt shall rectify the Register accordingly.

Clause 61 of this Bill clarifies that an appeal from any decision of the Registrar made pursuant hereto lies to the Court, and a decision of the Registrar includes any act of the Registrar vested in him pursuant hereunder.

Clause 62 of this Bill provides for trade mark agents, and states that every applicant for a the registration of a trade mark, certification mark or collective mark whose ordinarily resident outside of The Bahamas shall be represented by a counsel and attorney at law called to Bar of the Commonwealth of The Bahamas.

Clause 63 of this Bill sets out the provisions restricting the importation of infringing goods and the conditions to be complied with when providing notice to the Comptroller of Customs in respect of such goods.

Clauses 64 to 66 of this Bill provide, respectively, for several offences contained herein such as forging or falsely applying trade marks, selling goods or services to which false trade mark is applied and forging trade marks.

Clause 67 of this Bill provides for persons applying trade marks and states that a trade mark or mark is deemed to be applied whether it is woven, impressed or otherwise worked into or annexed, or affixed to the goods, covering, label, reel or other thing.

Clause 68 of this Bill provides for the offence of falsely applying trade marks where it is performed without the consent of the proprietor, or the mark is calculated to deceive. It should be noted here that instances of prosecution for falsely applying a trade mark the burden of approving the assent of the proprietor lies with the defendant. Additionally, clause 69 of this Bill provides for the offence falsifying of entries in the Register.

Clause 70 of this Bill sets out the penalty for falsely representing a trade mark, where on summary conviction such person shall be liable to a fine not exceeding two thousand dollars for each article in respect of which the false representation has been made.

Clause 71 of this Bill provides for circumstances where an offence is committed by a body corporate or partnership. In such instances every person who, at the material time, was a director, manager, secretary or other officer, or persons purporting to act as such, shall be liable to be proceeded against, unless he can prove that the offence was committed without his knowledge or connivance, or that he attempted to prevent its commission. The clause goes on further to provide that any fine imposed on a partnership shall be paid out of the partnership assets.

Clause 72 of this Bill makes provision for the powers of the police, which shall include, inter alia, powers to enter and search any premises for goods which bears a mark identical to or likely to be mistaken for a registered trade mark. Any police officer may seize, remove or detain any goods found on such premises.

However, pursuant to clause 73 of this Bill, no domestic premises shall be entered and searched by a police officer unless a Stipendiary and Circuit Magistrate issue a warrant with respect to same. Domestic premises in this regard refers to premises used exclusively as a dwelling home.

Clause 74 of this Bill sets out the offence for persons who wilfully obstruct a police officer in the exercise of his powers or performance of his duties hereunder. Persons who commit such an offence shall be liable on summary conviction to a fine not exceeding one thousand dollars or to a term of imprisonment not exceeding twelve months.

Also, a person who gives false or misleading information to any police officer commits an offence and is liable on summary conviction to a fine not exceeding two thousand dollars or to a term of imprisonment not exceeding two years.

Clause 75 of this Bill is a general penalty provision which provides for instances where persons commit an offence under the Act for which no penalty is specified. In such instances, those persons will be liable on summary conviction to a fine not exceeding fifty thousand dollars or to a term of imprisonment of five years or to both that fine and imprisonment in addition to forfeiture, and destruction of all goods bearing a forged trade mark.

Part VIII of this Bill, which include clauses 76 to 78, contains miscellaneous provisions relating to the power of the Minister to make Regulations generally for regulating practice and procedure hereunder, and for empowering the Registrar to do such things as he may be considered necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks, as well as the admissibility as evidence of international treaties relating to trade marks, notably the Paris Convention.

Part IX of this Bill, which include clauses 79 and 80, provides for the repeal of the Trade Marks Act (*Ch. 322*) and the transitional and savings clause with respect to any Rules made there under shall be deemed to have been registered under this Act. Additionally, subject to clause 69 of this Bill, trade marks registered pursuant to the repealed Act shall remain in force for the unexpired term of the periods of protection provided under that Act.

The *First* and *Second Schedule* made hereto references clause 31 of this Bill and provides for collective and certification marks, respectively and the *Third Schedule* hereto references the Paris Convention pursuant to clause 78 of this Bill.