



What You Need Know About Registering Trade Marks In The BVI

On 1 September 2015, a new Trade Marks Act, 2013 (the “**New Act**”) and the Trade Mark Rules, 2015 came into force in the British Virgin Islands (the “**BVI**”).

The Act repeals and replaces the existing Trade Mark Act (Cap. 158) (the “**repealed Act**”) the corresponding Trade Mark Rules, the Merchandise Marks Act (Cap. 154) and the Registration of United Kingdom Trade Marks Act (Cap. 157).

Under the New Act, registrations and renewals of trademarks submitted upon the New Act coming into force will no longer require the submission of the UK registration or renewal certificate. A welcomed new feature.

Under the new Act, a “**trade mark**” means any sign that is capable of (a) being represented graphically, and (b) distinguishing the goods or services of one person from those of another person, and includes a certification trade mark and collective trade mark (see below), unless otherwise specifically excepted. A “**sign**” includes (a) a brand, colour, device, figurative element, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word and “numeral” and “word” in this regard includes a foreign numeral and foreign script or word; and (b) any combination of signs.

BENEFITS THAT THE NEW ACT INTRODUCES

- The New Act allows marks relating to **services** to be registered. Under the former Act, only marks in respect of goods were allowed to be registered.
- Under the New Act, registrations and renewals of trademarks submitted upon the New Act coming into force will **no longer** require the submission of the UK registration or renewal certificate.
- **Smells, sounds and tastes** may obtain protection under the New Act.
- A **collective trade mark** (meaning a sign that is capable of (a) being represented graphically; and (b) distinguishing the goods or services of members of the collective association that is the owner of the sign from those persons who are not members of the collective association) may be registered under the New Act.
- A **certification trade mark** (meaning a sign that is capable of: (a) being represented graphically; and (b) distinguishing, in the course of trade, (i) goods that are certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic from goods that are not so certified; or (ii) services that are certified by any



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person in respect of quality, accuracy, performance or other characteristic from services that are not so certified) may be registered under the New Act.

APPLICATION FOR REGISTRATION OF TRADE MARK

An application to register a trade mark must be filed with the Registrar through an approved **Trade Mark Agent**. The application must include the following:

- (a) a request for registration of the trade mark;
- (b) the name and address of the applicant;
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark;
- (d) a representation of the trade mark and such other information, document or matter as may be prescribed.

The application must state whether the trade mark is being used by the applicant or with his consent in relation to the goods or services for which it is to be registered or whether the applicant honestly intends to use the trade mark or to allow it to be used in relation to the goods or services concerned.

An application for the registration of a trade mark may be made in more than one class of the Nice Classification and shall specify the class or classes of goods or services to which the application relates.

The specification must include for each class of goods or services a clear description (appropriate to that class) of the goods or services in respect of which the trade mark is proposed to be registered.

Where the application relates to more than one class of goods or services in the Nice Classification, the specification must set out the classes in consecutive numerical order and the specification of the goods or services shall be grouped accordingly.

EXAMINATION, SEARCH AND APPROVAL

Upon receiving an application for the registration of a trade mark, the Registrar will examine the application and conduct a search of earlier trade marks.

Provided that (a) no disabilities apply (for example, where another application that relates to the trade mark concerned has priority under the New Act), (b) no notice of opposition has been filed with the Registrar within 3 months from the date of publication of the application for registration, (c) all oppositions are withdrawn or decided in favour of the applicant and (d) the required fees



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have been paid, **the Registrar will approve the application and register the trade mark** in the Trade Mark Register and **issue a Certificate of Registration**.

Registration lasts for a period of ten (10) years from the date of registration.

RENEWAL AND/OR RESTORATION

The owner of a registered trade mark may file a request to renew the registration **prior to or on** the expiration of the registration period by filing Form TM 11 along with the renewal fee of US\$250 for 1 class (and \$150 for each additional class and \$75 for each additional mark of the series).

Where 6 months have elapsed from the expiration of the registration and the removal of the trade mark name from the register, the owner must request to have the name **restored** to the register, and pay the requisition fee (\$250), the renewal fee (\$250) and the applicable penalty for late renewal of registration (\$150). The restoration will be treated as if it were a renewal of the trade mark registration and the effective will be from the date of expiry of the previous registration.

PRIORITY

First in time will have priority in respect of identical or similar trade marks. Also, a person who has duly filed an application for the registration of a trade mark in a Paris Convention country (the “Convention application”) or WTO member (the “WTO application”), or his successor in title, has a right of priority, for the purposes of registering the same trade mark under the New Act for some or all of the same goods or services, for a period of 6 months from the date of filing of the first such application.

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