



[L.S.]

I Assent,

James B. Carlisle,
Governor-General.

18th December, 2003

ANTIGUA AND BARBUDA

No. 18 of 2003

AN ACT to make provision for the registration of the trade marks and other purposes related thereto.

[31st December, 2003]

ENACTED by the Parliament of Antigua and Barbuda as follows —

1. This Act may be cited as the Trade Marks Act 2003 and comes into force on a day fixed by the Minister by notice published in the Gazette.

Short title and commencement.

2. In this Act —

Interpretation.

"collective mark" means any visible sign designated as such in the application for registration and capable of distinguishing the origin of any other common characteristics, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark;

"Court" means the High Court;

"International Classification" means the classification according to the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of June 15, 1997 as last revised;

"**mark**" means any visible sign capable of distinguishing the goods ("**trademark**") or services ("service **mark**") of an enterprise;

"Minister" means the Minister responsible for intellectual property;

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

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

"Register" means the register maintained by the Registrar under section 19;

"Registrar" means the Registrar of Intellectual Property appointed under the Registrar of Intellectual Property Office Act, 2003;

"trade name" means the name or designation identifying and distinguishing an enterprise.

Acquisition of the exclusive right to a mark and registrability.

3. (1) The exclusive right to a mark, as conferred by this Act, shall be acquired by registration in accordance with the provisions thereof.

(2) A mark cannot be validly registered:

- (i) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (ii) if it is contrary to public order or morality;

- (iii) if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (iv) if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or **hallmark** adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorized by the competent authority of that State or organization;
- (v) if it is identical with, or confusingly similar to, or constitutes a translation of, a mark or trade name which is well known in Antigua and Barbuda for identical or similar goods or services of another enterprise, or if it is well-known and registered in Antigua and Barbuda for goods or services which are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use;
- (vi) if it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

4. (1) The application for registration of a mark shall be filed with the Registrar and shall contain a request, a reproduction of the mark and a list of the goods and services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification; and it shall be subject to the payment of the prescribed application fee.

Application for registration.

(2) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier

national or regional application filed by the applicant or his predecessor in title in or for any State party to the convention or any member of the World Trade Organisation in which case, the Registrar may require that the applicant furnish, within the prescribed **time** limit, a copy of the earlier application, certified as correct by the Office with which it was filed.

(3) The effect of the said declaration shall be as provided in the Paris Convention and if the Registrar **finds** that the requirements under **this** subsection and the Regulations pertaining thereto have not been fulfilled, the declaration shall be considered not to have been made.

(4) The applicant may withdraw the application at any time during its pendency.

Examination,
opposition, and
registration of
mark.

5. (1) The Registrar shall examine whether the application complies with the requirements of section 4 (1) and the Regulations pertaining thereto.

(2) The Registrar shall examine and determine whether the mark is a mark as defined in section 2 and is registrable under section 3 (2).

(3) Where the Registrar finds that the conditions referred to in subsection (1) and (2) hereof are fulfilled, he shall forthwith cause the application, as accepted, to be published in the prescribed manner.

(4) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on the grounds that one or more of the requirements of sections 2 and 3 (2) and the Regulations pertaining thereto are not fulfilled.

(5) The Registrar shall send forthwith a copy of a notice referred to in subsection (4) to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a counter-statement of the grounds on which he relies for his application and if he does not do so, he shall be deemed to have abandoned the application.

(6) If the applicant sends a counter-statement, the Registrar shall **furnish** a copy of it to the person giving notice of opposi-

tion and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the mark should be registered.

(7) After an application is published and until the registration of the mark, the applicant has the same privileges and rights as he would have if the mark had been registered; however, it shall be a valid defence to an action brought hereunder in respect of an act done after the application was published, if the defendant establishes that the mark could not validly have been registered at the time the act was done.

(8) Where the Registrar **finds** that the conditions referred to in subsections (1) and (2) are fulfilled, and either:

- (i) the registration of the mark has not been opposed **within** the prescribed time limit; or
- (ii) the registration of the mark has been opposed and the opposition has been decided in the applicant's favour,

he shall register the mark, publish a reference to the registration and issue to the applicant a certificate of registration; otherwise he shall refuse the application.

6. (1) The use of a **registered** mark, in relation to **any** goods or services for which it has been registered, by any person other than the registered owner shall require the agreement of the latter.

Rights conferred by registration, duration and renewal.

(2) The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the mark by using the mark, without his agreement, or who performs acts which make it likely that **infringement** will occur; and the right shall extend to the use of a sign similar to the registered mark and use in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in the public. In case of the use of an identical sign for identical goods or services, a **likelihood** of confusion shall be presumed.

(3) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the

market in Antigua and Barbuda by the registered owner or with his consent.

(4) The provisions of section 3 (2) (v) shall apply, *mutatis mutandis*, in any action instituted by the owner of a well-known mark against any person in respect of the unlawful use of the well-known mark.

(5) The registration of a mark shall be for a period of ten years from the filing date of the application for registration.

(6) The registration of a mark may, upon request, be renewed for consecutive periods of ten years, provided that the registered owner pays the prescribed renewal fee.

(7) A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation and removal on grounds of non-use.

7. (1) Any interested person may request the Registrar to invalidate the registration of a mark.

(2) The Registrar shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of sections 2 or 3 (2) are not fulfilled.

(3) Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and a reference thereto published as soon as possible.

(4) Any interested person may request the Registrar to remove a mark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of three years or longer; but a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.

Collective marks.

8. (1) Subject to subsections (2) and (3), sections 3 to 7 and 12 to 16 shall apply to collective marks.

(2) An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective **mark**.

(3) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in subsection (2).

(4) In addition to the grounds provided in section 7 (2), the Registrar shall invalidate the registration of a **collective** mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in subsection (2) or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

9. (1) Any licence contract concerning the registration of a mark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used. If the licence contract does not provide for such quality control or if such quality control is not effectively carried out, the licence contract shall not be valid.

Licensing of marks.

(2) The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

10. (1) A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

Trade names.

(2) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(3) In particular, any subsequent use of the trade name by a **third party**, whether as a trade name or a mark or collective mark,

or any such use of a similar trade name or mark, that is likely to mislead the public, shall be deemed unlawful.

Interpretation of terms concerning the Madrid Protocol.

11. For the purposes of this Act:

"Madrid Protocol" means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

"Common Regulations" means the Common Regulations under the Madrid Agreement and Madrid Protocol;

"international application", "international registration", "International Bureau", "holder", "designation", "subsequent designation", "date of international registration" and "date of subsequent designation" have the same meaning as in the Madrid Protocol or the Common Regulations, as the case may be.

"designation of Antigua and Barbuda" means a request made in relation to an international registration (either in the international application or subsequently) for extension of protection to Antigua and Barbuda under Article **3ter (1) or (2)** of the Madrid Protocol;

"date of the designation of Antigua and Barbuda" means the date of an international registration resulting from an international application in which Antigua and Barbuda was designated or the date of a subsequent designation of Antigua and Barbuda, as the case may be.

Effect of international registration as national application.

12. Where an international registration of a **mark** contains a designation of Antigua and Barbuda, the protection of the **mark** shall be the same, as from the date of the designation of Antigua and Barbuda, as if the **mark** had been the subject of an **application** for registration filed under section 4.

National processing of international registration.

13. (1) Where the Registrar has been notified by the **International Bureau** that an international registration contains a designation **of** Antigua and Barbuda, he shall proceed in accordance **with** section 5 (2).

(2) **Where the Registrar finds that** the conditions **referred to** in section 5 (2) are not **fulfilled, he shall notify the International**

Bureau that, to the extent that the said conditions are not fulfilled, protection of the mark in Antigua and Barbuda is refused.

(3) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the protection of the mark on the grounds that one or more of the requirements of section 2 or 3 (2) and the Regulations pertaining thereto are not fulfilled.

(4) The Registrar shall forthwith notify the International Bureau of an opposition under subsection (3) and subsequent procedure shall be in accordance with section 5 (5) and (6), references to the applicant being construed as references to the holder of the international registration.

(5) No notification in accordance with subsection (2) or (3) and (4) shall be sent to the International Bureau after the end of one year from the date on which the International Bureau notified the Registrar of the designation concerned.

14. Where no notification of refusal or opposition has been sent to the International Bureau in accordance with section 13 (2), (3), (4) and (5), or any such refusal has been withdrawn or any such opposition has been decided in favour of the holder of the international registration, the protection of the mark in Antigua and Barbuda shall, as from the date of the designation of Antigua and Barbuda, be the same as if the mark had been registered under section 5 (8) of this Act.

Effect of international registration as national registration.

15. Further details concerning international applications and international registrations, including the procedure to be followed and any fees to be paid in connection with the filing of an international application through the Intellectual Property Office, may be included in the Regulations.

Further provisions concerning international applications and international registrations.

16. In the event of any conflict between, on the one hand, this Act or the Regulations and, on the other, the Madrid Protocol or the Common Regulations, the latter shall prevail.

Conflict between the Madrid Protocol and this Act.

17. (1) Any change in the ownership of or the registration of a mark or collective mark, or in the ownership of an application therefor, shall be in writing in the prescribed form and shall, at the request of any interested party, to the Registrar, be recorded and, except in the case of an application, published by the Registrar;

Changes in ownership and licence contracts.

but such change shall have no effect against third parties until such recording is effected.

(2) Any change in the ownership of the registration of a collective **mark**, or in the ownership of an application therefor, shall require previous approval by the Minister.

(3) Any change in the ownership of a trade name must be made with the transfer of the enterprise or part thereof identified by that name and shall be in writing.

(4) A change in ownership of the registration of a mark or a collective mark shall be invalid if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services to which the mark is applied.

(5) Any licence contract concerning a registered mark, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference thereto; and the licence contract shall have no effect against third parties until such submission has been made.

Agents.

18. Where an applicant's ordinary residence or principal place of business is outside Antigua and Barbuda, he shall be represented by a registered agent resident and practising in Antigua and Barbuda before the Registrar of the Intellectual Property Office. The procedure for the registration of an agent shall be prescribed in the Regulations.

Register.

19. (1) The Registrar shall maintain a register for Marks to be called the Register of Marks; and all the recordings provided for in this Act shall be effected in the Register.

(2) Collective marks shall be registered in a special section of the Register of Marks.

(3) The Register may be consulted by any person, and any person may obtain extracts therefrom, under the conditions prescribed in the Regulations.

(4) The Registrar shall publish in the *Official Gazette* and/or in any intellectual property journal created under the authority of the Registrar of the Intellectual Property Office all the publications provided for in this Act.

20. (1) The Registrar may, subject to any provision in the Regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Registrar or in any recording effected pursuant to this Act or the Regulations.

Corrections of errors and extension of time.

(2) If the Registrar is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the Regulations, upon notice to the parties concerned and upon such terms as he may direct: and such extension may be granted though the time for doing the act or taking the proceeding has expired.

21. The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretionary power vested in him by this Act or the Regulations.

Exercise of discretionary powers.

22. (1) The High Court shall have jurisdiction in cases of dispute relating to the application of this Act and the Regulations and in matters which under this Act are to be referred to the court.

Competence of Court and appeals.

(2) Any decision taken by the Registrar under this Act, in particular the registration of a mark or collective mark, or the refusal of an application for such a grant or registration, may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within two months of the date of the decision.

23. (1) Subject to section 6 (3), an infringement shall consist of the performance of any act referred to in section 6 in Antigua and Barbuda by a person other than the owner of the title of protection and without the agreement of the latter.

Infringement, unlawful acts and offences.

(2) On the request of the owner of the title of protection, or of a licensee if he has requested the owner to institute court pro-

ceedings for a specific relief and the owner has refused or failed to do so, the court may grant an injunction to prevent infringement, an imminent infringement, or an unlawful act referred to in section 10 (2) and (3), award damages and grant any other remedy provided for in the general law.

(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection (1) or an unlawful act as defined in section 10 (2) and (3) is guilty of an offence and is liable on summary conviction to a fine of \$100,000 or to imprisonment for a term of five years, or to both.

Restrictions on
importation of
infringing
material, etc.

24. (1) The owner of the trademark may give notice in writing to the Comptroller of Customs —

- (a) that he is the owner of the registered trademark;
- (b) that the infringing trademark goods, articles or materials are expected to arrive in Antigua and Barbuda at a time and a place specified in the notice; and
- (c) that he requests the Comptroller of Customs to treat as prohibited goods under the Customs (Control and Management) Act, 1993 during a period specified in the notice, the infringing trademark goods, articles or materials.

Act No. 7 of
1993.

(2) Goods are "infringing goods", in relation to a registered trademark, if they or their packaging bear a sign identical or similar to that mark and,

- (a) the application of the sign to the goods or **their packaging** was an infringement of the registered trademark; or
- (b) the goods are proposed to be imported into Antigua and Barbuda and the application of the sign in Antigua and Barbuda to them or their packaging would be an infringement of the registered **trademark**; or
- (c) the sign has otherwise been used in relation to the goods in such a way as to infringe the registered **trademark**.

(3) Material is "infringing material", in relation to a registered trademark if it bears a sign 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 trademark; or
- (b) it is intended to be so used and such use would infringe the registered trademark.

(4) "Infringing articles" in relation to a registered trademark, means articles

- (a) which are specifically designed or adapted for making copies of a sign identical or similar to that 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 used to produce infringing goods or materials.

(5) The period specified in a notice given under subsection (1) shall not exceed five years and shall not extend beyond the end of the period for which trademark may subsist.

(6) Subject to subsection (7), where a notice has been given in accordance with this section, the importation into Antigua and Barbuda of goods, articles or materials to which the notice relates is prohibited; but notwithstanding anything contained in the Customs (Control and Management) Act, 1993, a person is not liable to any penalty under that Act other than forfeiture of the goods, articles or materials, by reason that any goods, articles or materials are treated as prohibited goods, articles or materials by virtue of this section. A 1

(7) The importation of not more than five (5) articles by a person for his private and domestic use is not prohibited under subsection (6).

(8) A person giving a notice under this section shall —

- (a) comply with such conditions as the Comptroller of Customs may by regulations prescribe; and
- (b) satisfy such requirements as may be so prescribed in connection with the giving of the notice, including requirements relating to —
 - (i) the form of the notice;
 - (ii) the furnishing of evidence, whether on giving notice, or on the importation of the goods, or at both such times;
 - (iii) the payment of fees in respect of the notice;
 - (iv) the giving of security in respect of any liability or expense which the Comptroller of Customs may incur in consequence of the notice by reason of the detention of any article or anything done to an article detained;
 - (v) the indemnification of the Comptroller of Customs against any such liability or expenses, whether security has been given or not; and
 - (vi) any incidental or supplementary matters.

(9) Regulations made under subsection (8) may make different provisions in respect of different classes of cases and are subject to negative resolution of the House of Representatives.

**Application of
International
Treaties.**

25. The provisions of any international treaties in respect of intellectual property to which Antigua and Barbuda is a party shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, shall prevail over the latter.

Regulations.

26. The Minister may make Regulations prescribing details for the implementation of this Act and the Regulations may, in particular, provide for the payment of fees in connection with applications for the registration of marks and collective marks and matters related thereto.

27. (1) The Registration of the United Kingdom Trade Marks Act and the Trade Marks Act, are repealed.

Repeal of
Cap. 377A and
Cap. 435 and
transitional
provisions.

(2) Notwithstanding the repeal of the Acts referred to in subsection (1), trademarks registered under those Acts shall remain in force but shall, subject to subsection (3), be deemed to have been granted or registered under this Act.

(3) Trademarks registered under the Acts referred to in subsection (1) shall be due for renewal within the same period as under those Acts or 10 years from the entry into force of this Act, whichever period first expires, and, upon renewal, shall be reclassified in accordance with the International Classification.

(4) Within 18 months from the entry into force of this Act, the Minister may, by notice in the *Gazette*, make any further transitional or saving provisions which appear to him to be necessary or desirable.

Passed the House of Representatives this
8th day of September, 2003.

Passed the Senate this 25th day
of September, 2003.

B. Harris,
Speaker.

M. Percival,
President.

S. Walker,
Clerk to the House of Representatives.

S. Walker,
Clerk to the Senate.