



BERMUDA

TRADE MARKS ACT 1974

[The Trade Marks Act 1974 was extended by the Trade Marks (Modification and Amendment) Act 1991 so as to have effect with respect to service marks as it has effect with respect to trade marks. See Appendix at the end of this Act for modification text]

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## PART I

### PRELIMINARY

#### Interpretation

- 1 (1) In this Act, unless the context otherwise requires—
  - “assignment” means assignment by act of the parties concerned;
  - “Court” means the Supreme Court;
  - “limitations” means any limitations of the exclusive right to the use of a trade mark given by the registration of a person as proprietor thereof, including limitations of that right as to mode of use, as to use in relation to goods to be sold, or

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otherwise traded in, in Bermuda, or as to use in relation to goods to be exported to any market outside Bermuda;

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

“Minister” means the Minister responsible for intellectual property;

“permitted use” has the meaning assigned to it by section 31(1);

“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;

“the register” means the register of trade marks kept under this Act;

“the Registrar” means the Registrar-General;

“registered trade mark” means a trade mark which is registered under this Act;

“registered user” means a person who is for the time being registered as such under section 31;

“the regulations” means regulations made by the Minister under section 38 or section 39;

“statutory declaration” means a declaration in the form of an affidavit (as defined in the Commissioners for Oaths and Notaries Public Act 1972 [*title 8 item 22*]), taken in Bermuda by a Commissioner for Oaths or Notary Public or, in the case of a declaration made abroad,

- (i) which would be admissible in evidence in cases or matters depending in the Supreme Court in accordance with the rules thereof; or
- (ii) which is made and subscribed in such manner as may be prescribed;

“trade mark” means a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods, and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person;

“transmission” means transmission by operation of law, devolution on the personal representative of a deceased person, and any other mode of transfer not being assignment.

(2) References in this Act to the use of a mark shall be construed as references to the use of a printed or other visual representation of the mark, and references therein to the use of a mark in relation to goods shall be construed as references to the use thereof upon, or in physical or other relation to, goods.

(3) 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.

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(4) References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

*[Section 1 amended by 1991:39 effective 18 June 1993 and modified by First Schedule of 1991:39 effective 18 June 1991; amended by BR 11/2009 reg. 2 effective 6 February 2009; subsection (1) "Minister" deleted and substituted by BR 5 / 2011 para. 5 effective 25 February 2011]*

### PART II

#### REGISTRATION, INFRINGEMENT AND OTHER SUBSTANTIVE PROVISIONS

The register of trade marks

2 (1) For the purpose of this Act the Registrar shall keep a record called the register of trade marks, in which shall be entered—

- (a) all registered trade marks with the dates of their registration, the names and addresses of their proprietors and the proprietors' agents;
  - (b) notifications of assignments and transmissions;
  - (c) the name and addresses of all registered user and registered users' agents;
  - (d) disclaimers, conditions and limitations; and
  - (e) such other matters relating to registered trade marks as may be prescribed.
- (2) The register shall be divided into two parts, called Part A and Part B.
- (3) Part A of the Register shall comprise all trade marks which—
- (a) immediately preceding 1 July 1975 are entered in the register of trade marks under the Patents, Designs and Trade Marks Act 1930 *[title 17 item 45 (under its present title as the Patents and Designs Act 1930)]*;
  - (b) after 30 June 1975 are registered in that Part under this Act.
- (4) Part B shall comprise all trade marks registered in that Part under this Act.
- (5) The register need not be kept in documentary form.
- (6) Subject to the regulations the public shall have a right to inspect the register at all convenient times.
- (7) The register shall be kept under the control and management of the Registrar.

*[Section 2 amended by 1991:39 effective 18 June 1993]*

No action for infringement of unregistered trade mark

3 (1) No person shall be entitled to institute any proceedings to prevent, or to recover damages for, the infringement of an unregistered trade mark.

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

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### Registration to be in respect of particular goods

4 A trade mark must be registered in respect of particular goods or classes of goods, and any question arising as to the class within which any goods fall shall be determined by the Registrar.

### Right given by registration in Part A and infringement thereof

5 (1) Subject to subsections (2) and (4) and sections 3 and 9, the registration of a person in Part A of the register as a proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the exclusive right to the use of the trade mark in relation to those goods and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the trade mark or registered user thereof using by way of the permitted use, uses in the course of trade a mark identical with or nearly resembling it, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

- (a) as being use as a trade mark; or
- (b) in the case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trade mark or to goods with which such person as aforesaid is connected in the course of trade.

(2) The right to the use of a trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(3) The right to the use of a trade mark given by registration as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person—

- (a) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if as to those goods or the bulk of which they form part, the proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of trade between any person and the goods.

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(4) The use of a registered trade mark, being one of two or more registered trade marks that are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration as aforesaid, shall not be deemed to be an infringement of the right to be given to the use of any other of those trade marks.

*[Section 5 modified by First Schedule and amended by Second Schedule of 1991:39 effective 18 June 1993]*

### Right given by registration in Part B and infringement thereof

6 (1) Except as provided by subsection (2), the registration of a person in Part B of the register as proprietor of a trade mark in respect of any goods shall, if valid, give or be deemed to have given to that person the like right in relation to those goods as if the registration had been in Part A of the register, and section 5 shall have effect in like manner in relation to a trade mark registered in Part B of the register as they have effect in relation to a trade mark registered in Part A of the register.

(2) In any action for infringement of the right to the use of a trade mark given by registration as aforesaid in Part B of the register, otherwise than by an act that is deemed to be an infringement by virtue of section 7, no injunction or other relief shall be granted to the plaintiff if the defendant establishes to the satisfaction of the Court that the use of which the plaintiff complains is not likely to deceive or cause confusion or to be taken as indicating a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the trade mark.

*[Section 6 modified by First Schedule of 1991:39 effective 18 June 1993]*

### Infringement by breach of certain restrictions

7 (1) Where, by a contract in writing made with the proprietor or a registered user of a registered trade mark, a purchaser or owner of goods enters into an obligation to the effect that he will not do, in relation to the goods, an act to which this section applies, any person who, being the owner for the time being of the goods and having notice of the obligation, does that act, or authorises it to be done, in relation to the goods, in the course of trade or with a view to any dealing therewith in the course of trade, shall be deemed thereby to infringe the right to the use of the trade mark given by the registration thereof, unless that person became the owner of the goods by purchase for money or money's worth in good faith before receiving notice of the obligation or by virtue of a title derived through another who so became the owner thereof.

(2) The acts to which this section applies are—

- (a) the application of the trade mark upon the goods after they have suffered alteration in any manner specified in the contract as respects their state or condition, get up or packing;
- (b) in a case in which the trade mark is upon the goods, the alteration, part removal or part obliteration thereof;
- (c) in a case in which the trade mark is upon the goods, and there is also thereon other matter, being matter indicating a connection in the course of trade between the proprietor or registered user and the goods, the

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removal or obliteration, whether wholly or partly, of the trade mark unless that other matter is wholly removed or obliterated;

- (d) in a case in which the trade mark is upon the goods, the application of any other trade mark to the goods;
- (e) in a case in which the trade mark is upon the goods, the addition to the goods of any other matter in writing that is likely to injure the reputation of the trade mark.

(3) In this section references in relation to any goods to the proprietor, to a registered user, and to the registration, of a trade mark shall be construed, respectively, as references to the proprietor in whose name the trade mark is registered, to a registered user who is registered, and to the registration of the trade mark, in respect of those goods, and the expression “upon” includes in relation to any goods a reference to physical relation thereto.

*[Section 7 modified by First Schedule of 1991:39 effective 18 June 1993]*

### Saving for vested rights

8 Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date anterior—

- (a) to the use of the first-mentioned trade mark in respect of those goods by the proprietor or a predecessor in title of his; or
- (b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to that person being put on the register for that identical or nearly resembling trade mark in respect of these goods under section 13(2).

### Saving for use of name, address or description of goods

9 No registration of a trade mark shall interfere with—

- (a) any bona fide use by a person of his own name or of the name of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business; or
- (b) the use by any person of any bona fide description of the character or equality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in section 5(1)(b).



THE REFEREE

Appointment of referee

9A (1) The Minister may by instrument in writing published in the Gazette appoint a person who by reason of his qualifications and experience to be a referee to determine any case or matter referred to him under this Act.

(2) The person appointed under subsection (1) shall hold office for a period of one year beginning on such day as the Minister may determine and may be re-appointed from time to time for a like period.

(3) The Minister may, at any time by notification in the Gazette, appoint any person to act temporarily in the place of the referee if the referee is absent from Bermuda or is for any reason unable to discharge his functions under this Act.

(4) The referee may at any time resign his appointment by notice in writing addressed to the Minister.

(5) The referee appointed under this section shall have such powers and shall perform such duties as are assigned to him under this Act and the Regulations made thereunder.

*[Section 9A inserted by 1991:39 effective 18 June 1993]*

Case or matter may be referred to referee

9B (1) Where a notice of opposition and a counter-notice are sent to the Registrar under section 19(2) and (4) respectively, in any case, the Registrar may instead of, pursuant to section 19(5), hearing the parties, considering the evidence and making a decision, refer the case to the referee for the referee to deal with it on his behalf.

(2) Where an application is made to the Registrar—

(a) by a person aggrieved under sections 29(1), 34(1) or 35; or

(b) by a registered proprietor of a trade mark under section 36(1) or 37(1),

then the Registrar may, instead of himself dealing with the application, refer the application to the referee to deal with it on his behalf.

*[Section 9B inserted by 1991:39 effective 18 June 1993]*

Powers and duties of referee

9C The referee, in the discharge of his functions in relation to any case or matter referred to him under section 9B shall have the same powers and duties of the Registrar that the Registrar would have had under the Act or any Regulations made thereunder in relation to the case or matter, including the power to award costs under section 43, and anything done by the referee within the scope of his authority shall, for the purposes of this Act or any Regulations made thereunder, be deemed to have been done by the Registrar himself.

*[Section 9C inserted by 1991:39 effective 18 June 1993]*

REGISTRABILITY AND VALIDITY OF REGISTRATION

Distinctiveness requisite for registration in Part A

10 (1) A trade mark to be registrable in Part A of the register, must contain or consist of at least one of the following essential particulars—

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in paragraphs (a), (b), (c) and (d), shall not be registrable under this paragraph except upon evidence of its distinctiveness.

(2) For the purposes of this section “distinctive” means adapted, in relation to the goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(3) In determining whether a trade mark is adapted to distinguish as aforesaid the Registrar may have regard to the extent to which—

- (a) the trade mark is inherently adapted to distinguish as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.

*[Section 10 modified by First Schedule of 1991:39 effective 18 June 1993]*

Capability of distinguishing requisite for registration in Part B

11 (1) In order for a trade mark to be registrable in Part B of the register it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within the extent of the registration.

(2) In determining whether a trade mark is capable of distinguishing as aforesaid the Registrar may have regard to the extent to which—

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and

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(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.

(3) A trade mark may be registered in Part B notwithstanding any registration in Part A in the name of the same proprietor of the same trade mark or any part or parts thereof.

*[Section 11 modified by First Schedule of 1991:39 effective 18 June 1993]*

### Restrictions on registration

12 (1) A mark—

- (a) the use of which would be likely to deceive or cause confusion;
- (b) the use of which would be contrary to law;
- (c) which comprises or contains scandalous matter; or
- (d) which would otherwise be not entitled to protection in a court of justice,

shall not be registered as a trade mark.

(2) The Registrar may refuse to accept an application for the registration of a trade mark which contains or consists of any of the following marks or a mark so nearly resembling any of those marks as to be likely to be taken for that mark—

- (a) the word or words “Patent”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Copyright”, “To counterfeit this is a forgery”, or a word or words to the like effect;
- (b) a representation of the Sovereign or of a member of the Royal Family;
- (c) a representation of—
  - (i) the Royal Arms, crests, armorial bearings, insignia or devices;
  - (ii) any of the Royal crowns; or
  - (iii) the national flag of a country or territory in the Commonwealth;
- (d) the word “Royal” or any other word, or any letters or device, likely to lead persons to think that the applicant has or has had Royal or Government patronage or authority;
- (e) a representation of the Arms, or of any flag or seal, of Bermuda;
- (f) a representation of the Arms or emblem of a city or town in Bermuda or of a public authority or public institution in Bermuda;
- (g) a mark which is specified in the regulations as being, for the purposes of this section, a prohibited mark.

(3) The regulations may provide that a mark in relation to which subsection (2) applies (not being a registered trade mark or a mark in use in good faith as a trade mark) shall not be used as a trade mark or as part of a trade mark, either at all or after a date specified in the regulations.

(4) Where a person makes an application for registration of a trade mark which consists of or includes the name or a representation of a living person or of a person believed by the Registrar to be living, the Registrar may require the applicant to furnish him with the consent of that person to the name or representation appearing on the trade mark before he proceeds with the registration of the trade mark.

(5) No word which is the commonly used and accepted name of any single chemical element or single chemical compound, as distinguished from a mixture, shall be registered as a trade mark in respect of a chemical substance or preparation, and any such registration in force at 1 July 1975, or thereafter shall, notwithstanding anything in section 14, be deemed for the purposes of section 34 to be an entry made in the register without sufficient cause, or an entry wrongly remaining on the register, as the circumstances may require:

Provided that this subsection shall not have effect in relation to a word which is used to denote only a brand or make of the element or compound as made by the proprietor or a registered user of the trade mark, as distinguished from the element or compound as made by others, and in association with a suitable name or description open to the public use.

#### Prohibition of registration of identical and resembling trade marks

13 (1) Subject to subsection (2), no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of—

- (a) the same goods,
- (b) the same description of goods, or
- (c) services or a description of services which are associated with those goods or goods of that description.

(2) In case of honest concurrent use, or of other special circumstances which in the opinion of the Court or the Registrar make it proper so to do, the Court or the Registrar may permit the registration by more than one proprietor, in respect of—

- (a) the same goods,
- (b) the same description of goods, or
- (c) goods and services or descriptions of goods and services which are associated with each other,

of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.

(3) Where separate applications are made by different persons to be registered as proprietors respectively of marks that are identical or nearly resemble each other, in respect of—

- (a) the same goods,

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- (b) the same description of goods, or
- (c) goods and services or descriptions of goods and services which are associated with each other,

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 him or, on an appeal, by the Court.

*[Section 13 modified by First Schedule and amended by Second Schedule of 1991:39 effective 18 June 1993]*

Registration in Part A to be conclusive as to validity after seven years

14 (1) In all legal proceedings relating to a trade mark registered in Part A of the register (including applications under section 34) the original registration in Part A of the register of the trade mark shall, after the expiration of seven years from the date of that registration, be taken to be valid in all respects unless—

- (a) that registration was obtained by fraud; or
- (b) the trade mark offends against section 12(1) or section 12(5).

(2) Nothing in section 6(1) shall be construed as making applicable to a trade mark, as being a trade mark registered in Part B of the register, the foregoing provisions of this section relating to a trade mark registered in Part A of the register.

Registration subject to disclaimer

15 (1) If a trade mark—

- (a) contains any part not separately registered by the proprietor as a trade mark; or
- (b) contains matter common to the trade or otherwise of a non-distinctive character,

the Registrar or the Court, in deciding whether the trade mark shall be entered or shall remain on the register, may require, as a condition of its being on the register—

- (i) that the proprietor shall disclaim any right to the exclusive use of any part of the trade mark, or to the exclusive use of all or any portion of any such matter as aforesaid, to the exclusive use of which they hold him not to be entitled; or
- (ii) that the proprietor shall make such other disclaimer as they may consider necessary for the purpose of defining his rights under the registration.

(2) No such disclaimer 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.

*[Section 15 modified by First Schedule of 1991:39 effective 18 June 1993]*

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Words used as name or description of an article or substance

16 (1) Subject to this section the registration of a trade mark shall not be deemed to have become invalid by reason only of any use, after the date of registration, of a word or words which the trade mark contains, or of which it consists as the name or description of an article or substance.

(2) Subsection (3) shall have effect where—

- (a) there is a well-known and established use of the word or words as the name or description of the article or substance by a person or persons carrying on a trade therein, not being use in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark; or
- (b) the article or substance was formerly manufactured under a patent, that a period of two years or more after the cesser of the patent has elapsed, and that the word or words is or are the only practicable name or description of the article or substance.

(3) Where the facts mentioned in subsection (2)(a) or (b) are proved with respect to any word or words, then—

- (a) if the trade mark consists solely of that word or those words, the registration of the trade mark, so far as regards registration in respect of the article or substance in question or of any goods of the same description, shall be deemed for the purposes of section 34 to be an entry wrongly remaining on the register;
- (b) if the trade mark contains that word or those words and other matter, the Court or the Registrar, in deciding whether the trade mark shall remain on the register, so far as regards registration in respect of the article or substance in question and of any goods of the same description, may in case of a decision in favour of its remaining on the register require as a condition thereof that the proprietor shall disclaim any right to the exclusive use in relation to that article or substance and any goods of the same description of that word or those words, so however, that no disclaimer on 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.

(4) For the purposes of any other legal proceedings relating to the trade mark—

- (a) if the trade mark consists solely of that word or those words, all rights of the proprietor, whether under the common law or by registration, to the exclusive use of the trade mark in relation to the article or substance in question or to any goods of the same description; or
- (b) if the trade mark contains that word or those words and other matter, all such rights of the proprietor to the exclusive use of that word or those words in such relation as aforesaid,

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shall be deemed to have ceased on the date at which the use mentioned in subsection (2) (a) first became well known and established, or at the expiration of the period of two years mentioned in subsection (2)(b).

*[Section 16 modified by First Schedule of 1991:39 effective 18 June 1993]*

### Effect of limitation as to colour and of absence thereof

17 (1) A trade mark may be limited in whole or in part to one or more specified colours, and in any such case the fact that it is so limited shall be taken into consideration by the Registrar or the Court in deciding on the distinctive character of the trade mark.

(2) If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

## PROCEDURE FOR, AND DURATION OF, REGISTRATION

### Application for registration

18 (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or Part B of the register.

(2) Subject to this Act, the Registrar may refuse the application, or may accept it absolutely or subject to such amendments, modifications, conditions or limitations, if any, as he may think fit.

(3) In the case of an application for registration of a trade mark in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.

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

(4A) Where a person makes application for the registration of a trade mark and the country of origin of the applicant is not Bermuda, then the country of origin of the applicant shall be the country where the applicant has a bona fide and effective industrial or commercial establishment in that country, or if he has not such an establishment, the country in which he is domiciled, or if he is not domiciled in that country, the country of which he is a national.

(4B) A mark duly registered in the country indicated in subsection (4A) may be registered in Bermuda by an applicant whose country of origin is not Bermuda and the application shall be accompanied by a certification or a certified copy of the registration of the country indicated in subsection (4A).

(4C) The registration of a mark under subsection (4B) shall be independent of the registration in the country of origin of the applicant and the registrability, duration, validity or transfer in Bermuda of such registration shall be governed by the provisions of this Act.

(4D) For the removal of doubt this Act applies to any person whose country of origin is not Bermuda.

(5) In the case of a 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 thereat, and the decision shall be subject to appeal to the Court.

(6) An appeal under this section shall be made in the prescribed manner, and on the appeal, the Court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what amendments, modifications, conditions or limitations, if any, the application is to be accepted.

(7) Appeals under this section shall be heard on the materials stated as aforesaid by the Registrar, and no further grounds of objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those so stated as aforesaid by him, except by leave of the Court. Where any further grounds of objections are taken, the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(8) 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 they may think fit.

*[Section 18 amended by 1991:39 effective 18 June 1993]*

#### Opposition to registration

19 (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions or limitations, the Registrar shall, as soon as may be after acceptance, cause the application as accepted to be advertised in the prescribed manner, and the advertisement shall set forth all conditions and limitations subject to which the application has been accepted:

Provided that the Registrar may cause an application to be advertised before acceptance if it is made under section 10(1)(e), or in any other case where it appears to him that it is expedient by reason of any exceptional circumstances so to do, and where an application has been so advertised the Registrar may, if he thinks fit, advertise it again when it has been accepted but shall not be bound so to do.

(2) Any person may within the prescribed time from the date of the advertisement of an application give notice to the Registrar of opposition to the registration.

(3) The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(4) The Registrar shall send a copy of the notice to the applicant, and within the prescribed time after receipt thereof the applicant shall send to the Registrar, in the prescribed manner, 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 his application.



(5) If the applicant sends such a counter-statement as aforesaid, 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 the evidence, decide whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(6) The decision of the Registrar shall be subject to the appeal to the Court.

(7) An appeal under this section shall be made in the prescribed manner, and on the appeal the Court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions or limitations, if any, registration is to be permitted.

(8) On the hearing of an appeal under this section 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.

(9) On an appeal 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 so stated as aforesaid by the opponent, except by leave of the Court. 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 on giving notice as prescribed.

(10) On an 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 thereof, but in any such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(11) If a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such a notice, or an appellant, neither resides nor carries on business in Bermuda the Registrar or the Court may require him to give security for costs of the proceedings before them relative to the opposition or to the appeal, as the case may be, and in default of such security being duly given may treat the opposition or application, or the appeal, as the case may be, as abandoned.

(12) *[deleted by 1991:39]*

(13) *[deleted by 1991:39]*

#### Protection of marks registered in country of origin

20 The Registrar may refuse to register any trade mark if it is proved to his satisfaction by the person opposing the application for registration that such mark is identical with, or so nearly resembles as to be calculated to deceive or cause confusion, a trade mark which is already registered in respect of the same goods or description of goods in a country or place from which such goods originate:

Provided that no application to register shall be refused under this section—

- (a) if the applicant proves that he or his predecessors in business have in Bermuda, in relation to such goods, continuously used the trade mark for the registration of which he has made application from a date anterior to

the date of the registration of the other mark in such country or place of origin; or

- (b) if the opponent does not give an undertaking to the satisfaction of the Registrar that he will, within three months from the giving of the notice of opposition, apply for registration in Bermuda of the trade mark so registered in the country or place of origin, and will take all necessary steps to complete such registration.

#### Registration

21 (1) When an application for registration of a trade mark in Part A or in Part B of the register has been accepted and either—

- (a) the application has not been opposed and the time for notice of opposition has expired; or
- (b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purposes of this Act to be the date of registration.

(2) On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration thereof under the hand and seal of the Registrar.

(3) 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, treat the application as abandoned unless it is completed within the time specified in that behalf in the notice.

#### Removal of trade mark from register on proof of prior registration in country of origin

22 The Court may, on application made within seven years from the registration of a trade mark in Bermuda by any person aggrieved by such registration, remove such trade mark from the register if it is proved to the satisfaction of the Court that such trade mark is identical with, or so nearly resembles as to be calculated to deceive or cause confusion, a trade mark which was, prior to the registration in Bermuda of the first-mentioned trade mark, registered (in respect of goods of the same description as those in respect of which the first-mentioned trade mark is registered in Bermuda) in a country or place from which such goods originate:

Provided that no trade mark shall be removed from the register under this section in the following cases—

- (a) if the proprietor of the other trade mark consented to the registration in Bermuda of the first-mentioned trade mark; or

- (b) if the proprietor of the trade mark registered in Bermuda proves that he or his predecessors in business have continuously used such trade mark in Bermuda in connection with such goods as aforesaid from a date anterior to the date of the registration of the other trade mark in the country or place of origin; or
- (c) unless the applicant proves either that within the five years immediately preceding the making of the application under this section there has been bona fide user in connection with such goods as aforesaid in Bermuda of the trade mark registered in the country or place of origin, or that the special circumstances of the trade account for the non-user of such trade mark in Bermuda within the same period, or that the trade mark so registered in the country or place of origin was first registered there within the like period of five years, and in either event gives an undertaking to the satisfaction of the Registrar that he will within three months from the making of the application under this section apply for the registration in Bermuda of the trade mark so registered in the country or place of origin, and will take all necessary steps to complete the registration.

#### Duration and renewal of registration

23 (1) The registration of a trade mark shall be for a period of seven years, but may be renewed from time to time in accordance with this section:

Provided that, in relation to a registration as of a date before 1 July 1975, this subsection shall have effect with the substitution of a period of fourteen years for such period of seven years.

(2) The Registrar shall, on application made by the registered proprietor of a trade mark within the prescribed period, renew the registration of the trade mark for a period of fourteen years from the date of expiration of the original registration or of the last renewal of registration, as the case may be, which date is in this section referred to as "the expiration of the last registration".

(3) At the prescribed time before the expiration of the last registration of a trade mark, the Registrar shall send notice to the registered proprietor of the date of expiration and the conditions as to payment of fees and otherwise upon which a renewal of registration may be obtained, and, if at the expiration of the time prescribed in that behalf those conditions have not been duly complied with, the Registrar may remove the trade mark from the register, subject to such conditions, if any, as to its restoration to the register as may be prescribed.

(4) Where a trade mark has been removed from the register for non-payment of the fee for renewal, it shall, nevertheless, for the purpose of any application for the registration of a trade mark during one year next after the date of the renewal, be deemed to be a trade mark that is already on the register:

Provided that the foregoing provisions of this subsection shall not have effect where the Registrar or the Court, as the case may be, is satisfied either—

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- (a) that there has been no bona fide trade use of the trade mark that has been removed during the two years immediately preceding its removal; or
- (b) that no deception or confusion would be likely to arise from the use of the trade mark that is the subject of the application for registration by reason of any previous use of the trade mark that has been removed.

*[Section 23 modified by First Schedule of 1991:39 effective 18 June 1993]*

### Registration of parts of trade marks and of trade marks as a series

24 (1) Where the proprietor of a trade mark claims to be entitled to the exclusive use of any part thereof separately, he may apply to register the whole and any such part as separate trade marks.

(2) Each such separate trade mark must satisfy all the conditions of an independent trade mark and shall, subject to sections 26(2) and 32(2), have all the incidents of an independent trade mark.

(3) Where a person claiming to be the proprietor of several trade marks, in respect of the same goods or description of goods, which, while resembling each other in the material particulars thereof, yet differ in respect of—

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

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

### Associated trade marks

25 (1) Where a trade mark that is registered, or is the subject of an application for registration, in respect of any goods is identical with another trade mark that is registered, or is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods, or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor, the Registrar may at any time require that the trade marks shall be entered on the register as associated trade marks.

(2) Where a trade mark and any part or parts thereof are, by virtue of section 24(1) registered as separate trade marks in the name of the same proprietor, they shall be deemed to be, and shall be registered as, associated trade marks.

(3) All trade marks that are, by virtue of section 24(2) registered as a series in one registration shall be deemed to be, and shall be registered as, associated trade marks.

(4) On application made by the registered proprietor of two or more trade marks registered as associated trade marks, the Registrar may dissolve the association as respects

any of them if he is satisfied that there would be no likelihood of deception or confusion being caused if that trade mark was used by another person in relation to any of the goods in respect of which it is registered, and may amend the register accordingly.

(5) Subject to section 26(5) trade marks registered as associated marks shall be deemed to have been registered as separate trade marks.

(6) Any decision of the Registrar under this section shall be subject to appeal to the Court.

#### ASSIGNMENT AND TRANSMISSION

Powers of, and restrictions on assignment and transmission

26 (1) Notwithstanding any rule of law or equity to the contrary, a registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible either in connection with the goodwill of a business or not.

(2) A registered trade mark shall be, and shall be deemed always to have been, assignable and transmissible in respect either of all the goods in respect of which it is registered, or was registered, as the case may be, or of some (but not all) of those goods.

(3) The provisions of subsections (1) and (2) shall have effect in the case of an unregistered trade mark used in relation to any goods as they have effect in the case of a registered trade mark registered in respect of any goods, if at the time of the assignment or transmission of the unregistered trade mark it is or was used in the same business as a registered trade mark, and if it is or was assigned or transmitted at the same time and to the same person as that registered trade mark and in respect of goods all of which are goods in relation to which the unregistered trade mark is or was used in that business and in respect of which that registered trade mark is or was assigned or transmitted.

(4) Notwithstanding anything in subsections (1), (2) and (3), a trade mark shall not be, or be deemed to have been, assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, or have subsisted, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to

- (a) the same goods,
- (b) the same description of goods, or
- (c) goods and services or descriptions of goods and services which are associated with each other,

of trade marks nearly resembling each other or of identical trade marks, if, having regard to the similarity of the goods or the association of the goods and services or description of goods and services and to the similarity of the trade marks, the use of the trade marks in exercise of those rights would be, or have been, likely to deceive or cause confusion.

(5) Trade marks that are registered as, or that are deemed by virtue of this Act to be, associated trade marks shall be assignable and transmissible only as a whole and not separately.

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(6) Where an assignment in respect of any goods of a trade mark that is at the time of the assignment used in a business in those goods is made, on or after 1 July 1975, otherwise than in connection with the goodwill of that business, the assignment shall not take effect until the following requirements have been satisfied; that is to say, the assignee must, not later than the expiration of six months from the date on which the assignment is made or within such extended period, if any, as the Registrar may allow, apply to him for directions with respect to the advertisement of the assignment, and must advertise it in such form and manner and within such period as the Registrar may direct.

*[Section 26 modified by First Schedule and amended by Second Schedule of 1991:39 effective 18 June 1993]*

### Power of registered proprietor to assign and give receipts

27 Subject to this Act, the person for the time being entered in the register as proprietor of a trade mark shall, subject to any rights appearing from the register to be vested in any other person, have power to assign the trade mark, and to give effectual receipts for any consideration for an assignment thereof.

### Registration of assignments and transmissions

28 (1) Where a person becomes entitled by assignment or transmission to a registered trade mark, he shall make application to the Registrar to register his title, and the Registrar shall, on receipt of the application and on proof of title to his satisfaction, register him as the proprietor of the trade mark in respect of the goods in respect of which the assignment or transmission has effect, and shall cause particulars of the assignment or transmission to be entered on the register.

(2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

(3) Except for the purposes of an appeal under this section or of an application under section 34, a document or instrument in respect of which no entry has been made in the register in accordance with subsection (1) shall not, unless the Court otherwise directs, be admitted in evidence in any Court in proof of the title to a trade mark.

## USE AND NON-USE

### Removal from register and imposition of limitations on grounds of non-use

29 (1) Subject to section 30, the Court or the Registrar may, on application by a person aggrieved, order a trade mark to be removed from the register in respect of any goods in respect of which it is registered on the grounds—

- (a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or
- (b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade

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mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being.

(2) Except where the applicant has been permitted under section 13(2) to register an identical or nearly resembling trade mark in respect of the goods in question or where the Court or the Registrar is of opinion that he might properly be permitted so to register such a trade mark the Court or the Registrar, as the case may be, may refuse an application made under subsection (1) in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the mark by the proprietor thereof for the time being in relation to—

- (i) goods of the same description; or
- (ii) services associated with those goods or goods of that description,

being goods or, as the case may be, services in respect of which the mark is registered.

(3) An applicant shall not be entitled to rely for the purposes of subsection (1)(b), on any non-use of a trade mark that is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

*[Section 29 modified by First Schedule and amended by Second Schedule of 1991:39 effective 18 June 1993]*

### Defensive registration of well known trade marks

30 (1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods 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 would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 29, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first-mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 29.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

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(4) On application by any person aggrieved to the Court or, at the option of the applicant and subject to section 50, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1).

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

(6) 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 and of trade marks so registered as they apply in other cases.

*[Section 30 modified by First Schedule of 1991:39 effective 18 June 1993]*

### Registered users

31 (1) Subject to this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

(2) The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the "permitted use" thereof.

(3) 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 29 and for any other purpose for which such use is material under this Act or at common law.

(4) 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.

(5) A proprietor added as defendant in accordance with subsection (4) shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(6) 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—

- (a) giving 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 permitted use 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 whose registration as registered users application may be made;
- (b) stating the goods in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter; and
- (d) stating 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 the rules or by the Registrar.

(7) When the requirements of subsection (6) have been complied with, if the Registrar, after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods 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 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 for securing 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 trade.

(10) Without prejudice to section 34, the registration of a person as registered user—

- (a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing 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 of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (c) may be cancelled by the Registrar on the application in writing of any person on any of the following grounds—

- (i) 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 be likely to cause, deception or confusion;
- (ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for registration, or that the circumstances have materially changed since the date of the registration;
- (iii) 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 regulations 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 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.

*[Section 31 modified by First Schedule of 1991:39 effective 18 June 1993]*

Proposed use of trade mark by corporation to be constituted, etc.

31A (1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark—

- (a) if the Court or the Registrar is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Court or the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Court or the Registrar is also satisfied that that person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) The provisions of section 29 have effect, in relation to a trade mark registered under the power conferred by subsection (1), as if for the reference, in subsection (1)(a), to

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an intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to an intention on his part that it should be used by the corporation or registered user concerned.

(3) The Court or the Registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the Court or the Registrar relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.

*[Section 31A inserted by 1991:39 effective 18 June 1993]*

Use of one of associated or substantially identical trade marks equivalent to use of another

32 (1) Where under this Act use of a registered trade mark is required to be proved for any purpose, the Court or the Registrar, as the case may be, may, if and so far as they 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 the use required to be proved.

(2) The use of the whole of a registered trade mark shall for the purposes of this Act be deemed to be also a use of any registered trade mark, being a part thereof registered in the name of the same proprietor by virtue of section 24(1).

Use of trade mark for export trade

33 The application in Bermuda of a trade mark to goods to be exported from Bermuda, and any other act done in Bermuda in relation to goods to be so exported which, if done in relation to goods to be sold or otherwise traded in within Bermuda, would constitute use of the trade mark therein, shall be deemed to constitute use of the trade mark in relation to those goods for any purpose for which such use is material under this Act or at common law.

*[Section 33 modified by First Schedule of 1991:39 effective 18 June 1993]*

## RECTIFICATION AND CORRECTION OF THE REGISTER

General power to rectify entries in register

34 (1) 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 wrongly remaining on the register, or by any error or defect in any entry in the register, may

apply to the Court or, at the option of the applicant and subject to section 50, to the Registrar, and the Court or the Registrar, as the case may be, may make such order for making, expunging or varying the entry as they may think fit.

(2) The Court or the Registrar may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register.

(3) In case of fraud in the registration, assignment or transmission of a registered trade mark, the Registrar may himself apply to the Court under this section.

(4) Any order of the Court rectifying the register shall direct that notice of the rectification shall be served in the prescribed manner on the Registrar, and the Registrar shall, on receipt of the notice rectify the register accordingly.

(5) The power to rectify the register conferred by this section shall include power to remove a registration in Part A of the register to Part B.

#### Powers to expunge or vary registration for breach of condition

35 On application by any person aggrieved to the Court, or, at the option of the applicant and subject to section 50, to the Registrar, or on application by the Registrar to the Court, the Court or the Registrar, as the case may be, may make such order as they may think fit for expunging or varying the registration of a trade mark on the ground of any contravention of, or failure to observe a condition entered on the register in relation thereto.

#### Correction of register

36 (1) The Registrar may, on application by the registered proprietor of a trade mark, amend or alter the register by—

- (a) correcting an error in the entry of a trade mark in the register;
- (b) entering a change in the name or address of the registered proprietor;
- (c) cancelling the entry of a trade mark in the register;
- (d) amending the specification of the goods in respect of which the trade mark is registered but so that the amendment does not in any way extend the rights given by the registration of the trade mark; or
- (e) entering a disclaimer or memorandum relating to the trade mark which does not in any way extend the rights given by the registration of the trade mark,

and may make any consequential amendment or alteration in the certificate of registration, and for that purpose may require the certificate of registration to be produced to him.

(2) The Registrar may, on request made by a registered user of a trade mark, correct an error, or enter a change, in the name or address of the registered user.

(3) An appeal shall lie to the Court from a decision of the Registrar under subsection (1).

*[Section 36 amended by 1991:39 effective 18 June 1993]*

Alteration of registered trade mark

37 (1) The registered proprietor of a trade mark may apply to the Registrar for leave to add to or alter the trade mark in any manner not substantially affecting the identity thereof, and the Registrar may refuse leave or may grant it on such terms and subject to such limitations as he may think fit.

(2) The Registrar may cause an application under this section to be advertised in the Gazette in any case where it appears to him that it is expedient so to do.

(3) A person may within the prescribed time give notice to the Registrar of opposition to the application, and the Registrar shall, after hearing the parties, if they so require, decide the matter.

(4) Any decision of the Registrar under this section shall be subject to appeal to the Court.

(5) Where leave as aforesaid is granted, the trade mark as altered shall be advertised in the Gazette, unless it has already been advertised, in the form to which it has been altered, in an advertisement under subsection (2).

Adaptation of entries in register to amend or substituted classification of goods

38 (1) Subject to section 39(2) the Minister may from time to time make such regulations, prescribe such forms and generally do such things as he thinks expedient, for empowering the Registrar to amend the register, whether by making or expunging or varying entries therein, so far as may be requisite for the purpose of adapting the designation therein of the goods or classes of goods in respect of which trade marks are registered to any amended or substituted classification that may be prescribed.

(2) The Registrar shall not, in exercise of any power conferred on him for the purpose aforesaid, make any amendment of the register that would have the effect of adding any goods or classes of goods to those in respect of which a trade mark is registered (whether in one or more classes) immediately before the amendment is to be made, or of antedating the registration of a trade mark in respect of any goods:

Provided that this subsection shall not have effect in relation to goods as to which the Registrar is satisfied that compliance with this subsection in relation thereto would involve undue complexity and that the addition or antedating, as the case may be, would not affect any substantial quantity of goods and would not substantially prejudice the rights of any person.

(3) A proposal for amendment of the register for the purpose aforesaid shall be notified to the registered proprietor of the trade mark affected, shall be subject to appeal by the registered proprietor to the Court, shall be advertised with any modifications, and may be opposed before the Registrar by any person aggrieved on the ground that the proposed amendment contravenes subsection (2), and the decision of the Registrar on any such opposition shall be subject to appeal to the Court.

(4) The negative resolution procedure shall apply to regulations made under this section.

PART III  
GENERAL AND MISCELLANEOUS

Power of Minister to make regulations and prescribe forms

39 (1) The Minister may from time to time make such regulations, prescribe such forms and generally do such things as he may think expedient—

- (a) for regulating the practice under this Act including the service of documents;
- (b) for classifying goods for the purposes of registration of trade marks;
- (c) for making or requiring duplicates of trade marks and other documents;
- (d) for securing and regulating the publishing and selling or distributing in such manner as he may think fit, of copies of trade marks and other documents;
- (e) for prescribing any matter or thing required or permitted by this Act to be prescribed by regulation;
- (f) generally, for regulating the business of the Registrar in relation to trade marks and all things by this Act placed under the direction or control of the Registrar.

(2) Subject to subsection (4) the Registrar shall—

- (a) cause a copy of all regulations made under this Act to be made available in his offices and in the Registry of the Supreme Court;
- (b) cause to be published in the Gazette a notice briefly describing the nature of the regulations made under this Act, stating the date on which they are to come into operation and the places where such regulations may be inspected.

(3) Regulations made available under subsection (1)(a) may be inspected by any interested person free of charge at any time when the offices of the Registrar General or, as the case may be, the Registry of the Supreme Court are open to the public.

(4) Subsections (2) and (3) shall not apply, or shall cease to apply, as the case may be, to any regulations under this Act that are published in the Gazette or under the authority of the Revised Laws and Annual Revision Act 1971.

(5) A certificate purporting to be by the Registrar and under his hand and seal that any regulations under the Act and annexed thereto was made on a specified date shall be admitted in evidence in all courts in Bermuda and in all proceedings in proof of the fact thereof and the regulations so annexed shall likewise be so admitted without further proof or production of the original.

(6) Section 6 of the Statutory Instruments Act 1977 [*title 1 item 3*] shall not apply to regulations made under this section. The provisions of subsection (2) shall be deemed to

## TRADE MARKS ACT 1974

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be deposit for public inspection for the purpose of section 5(1) of the Statutory Instruments Act 1977 [*title 1 item 3*].

### Fees

40 There shall be paid in respect of applications and registrations and other matters under this Act such fees as may be prescribed under the Government Fees Act 1965. [*title 15 item 18*]

## POWERS AND DUTIES OF REGISTRAR

### Preliminary advice by Registrar as to distinctiveness

41 (1) The power to give to a person who proposes to apply for the registration of a trade mark in Part A or Part B of the register advice as to whether the trade mark appears to the Registrar *prima facie* to be inherently adapted to distinguish, or capable of distinguishing, as the case may be, shall be a function of the Registrar under this Act.

(2) If on an application for the registration of a trade mark as to which the Registrar has given advice as aforesaid in the affirmative, made within three months after the advice is given, the Registrar, after further investigation or consideration, gives notice to the applicant of objection on the ground that the trade mark is not adapted to distinguish or capable of distinguishing, as the case may be, the applicant shall be entitled, on giving notice of withdrawal of the application within the prescribed period, to have repaid to him any fee paid on the filing of the application.

### Hearing before exercise of Registrar's discretion

42 Where any discretionary or other power is given to the Registrar by this Act or the regulations, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without giving to the applicant or registered proprietor an opportunity of being heard.

### Power of Registrar to award costs

43 In all proceedings before the Registrar under this Act, the Registrar shall have power 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, and any such order may, by leave of the Court or a judge thereof, be enforced in the same manner as a judgment or order of the Court to the same effect.

## LEGAL PROCEEDINGS AND APPEALS

### Registration to be *prima facie* evidence of validity

44 In all legal proceedings relating to a registered trade mark (including applications under section 34), the fact that a person is registered as proprietor of the trade mark shall be *prima facie* evidence of the validity of the original registration of the trade mark and of all subsequent assignments and transmissions thereof.

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Costs of Registrar in proceedings before Court, and payment of costs by Registrar

45 In all proceedings before the Court under this Act the costs of the Registrar shall be in the discretion of the Court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Trade usage, etc. to be considered

46 In any action or proceeding relating to a trade mark or trade name, the Registrar or the Court, as the case may be, shall admit evidence of usages of the trade concerned and of any relevant trade mark or trade name or get-up legitimately used by other persons.

*[Section 46 modified by First Schedule of 1991:39 effective 18 June 1993]*

Registrar's appearance in proceedings involving rectification

47 (1) In any legal proceedings in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the Court.

(2) Unless otherwise directed by the Court, the Registrar in lieu of appearing and being heard may submit to the Court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting it or of his practice in like cases or of such other 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 proceeding.

Court's power to review Registrar's decision

48 The Court in dealing with any question of the rectification of the register (including all applications under section 34), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Discretion of Court in appeals

49 In any appeal from a decision of the Registrar to the Court under this Act, the Court shall have and exercise the same discretionary powers as under this Act are conferred upon the Registrar.

Procedure in cases of option to apply to Court or Registrar

50 Where under any of the foregoing provisions of this Act an applicant has an option to make an application either to the Court or to the Registrar—

- (a) if an action concerning the trade mark in question is pending, the application must be made to the court;
- (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 referee, or he may, after hearing the parties, determine the question between them, subject to appeal to the Court.

*[Section 50 amended by Second Schedule of 1991:39 effective 18 June 1993]*



EVIDENCE

Mode of giving evidence

51 (1) In any proceeding under this Act before the Registrar, the evidence shall be given by statutory declaration in the absence of directions to the contrary, but, in any case in which the Registrar thinks it right so to do, he may take evidence viva voce in lieu of or in addition to evidence by declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2) In case any part of the evidence is taken viva voce the Registrar shall have power to require the attendance of witnesses and the production of documents and to take evidence on oath, and shall for the purposes of any proceedings under this Act before him have all the powers possessed by a judge of the Supreme Court in relation to proceedings in the Supreme Court, and the Court shall have power to enforce the orders of the Registrar as if they were those of a judge.

Evidence of entries in register

52 (1) A copy of any entry in the register or an extract from the register which is obtained pursuant to subsection (2), purporting to be certified by the Registrar and under his hand and seal shall be admitted in evidence in all Courts in Bermuda, and in all proceedings, without further proof or production of the original.

(2) Any person requiring such a certified copy or an extract as aforesaid shall be entitled to obtain it on payment of such fee as may be prescribed under the Government Fees Act 1965 [*title 15 item 18*].

(3) In relation to any portion of the register kept otherwise than in documentary form—

- (a) the right of inspection conferred by section 2(6) is a right to inspect the material on the register; and
- (b) the right to a copy or extract conferred by this section or the Regulations is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.

*[Section 52 amended by 1991:39 effective 18 June 1993]*

Certificate of Registrar to be evidence

53 A certificate purporting to be under the hand of the Registrar as to any entry, matter, or thing which he is authorised by this Act, or the regulations, to make or do, shall be prima facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

OFFENCES

Falsification of entries in register an offence

54 If any person makes or causes to be made a false entry in the register, or a writing falsely purporting to be a copy of an entry in the register, or 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:

Punishment on summary conviction: imprisonment for 6 months or a fine of \$1,000 or both such imprisonment and fine.

55 (1) Any person who makes a representation—

- (a) with respect to a mark not being a registered trade mark, to the effect that it is a registered trade mark; or
- (b) with respect to a part of a registered trade mark not being a part separately registered as a trade mark, to the effect that it is so registered; or
- (c) to the effect that a registered trade mark is registered in respect of any goods in respect of which it is not registered; or
- (d) to the effect that the registration of a trade mark gives an exclusive right to the use thereof in any circumstances in which, having regard to limitations entered on the register, the registration does not give that right,

commits an offence:

Punishment on summary conviction: a fine of \$200.

(2) For the purposes of this section, the use in Bermuda in relation to a trade mark of the word “registered” or of any other word referring whether expressly or impliedly to registration, shall be deemed to import a reference to registration in the register, except—

- (a) where that word is used in physical association with other words delineated in characters at least as large as those in which that word is delineated and indicated that the reference is to registration as a trade mark under the law of a country outside Bermuda, being a country under the law of which the registration referred to is in fact in force;
- (b) where that word (being a word other than the word “registered”) is of itself such as to indicate that the reference is to such registration as last aforesaid; or
- (c) where that word is used in relation to a mark registered as a trade mark under the law of a country outside Bermuda and in relation to goods to be exported to that country.

*[Section 55 modified by First Schedule of 1991:39 effective 18 June 1993]*

MISCELLANEOUS

Change of form of trade connection not to be deemed to cause deception

56 The use of a registered trade mark in relation to goods between which and the person using it any form of connection in the course of trade subsists shall not be deemed to be likely to cause deception or confusion on the ground only that the trade mark has been, or is, used in relation to goods between which and that person or a predecessor in title of his a different form of connection in the course of trade subsisted or subsists.

*[Section 56 modified by First Schedule of 1991:39 effective 18 June 1993]*

Jointly owned trade marks

57 (1) Where the relations between two or more persons interested in a trade mark are such that no one of them is entitled as between himself and the other or others of them to use it except—

- (a) on behalf of both or all of them; or
- (b) in relation to an article with which both or all of them are connected in the course of trade,

those persons may be registered as joint proprietors of the trade mark, and this Act shall have effect in relation to any rights to the use of the trade mark vested in those persons as if those rights had been vested in a single person.

(2) Subject to subsection (1), nothing in this Act shall authorise the registration of two or more persons who use a trade mark independently, or propose so to use it, as joint proprietors thereof.

*[Section 57 modified by First Schedule of 1991:39 effective 18 June 1993]*

Trusts and equities

58 (1) There shall not be entered in the register any notice of any trust express, implied or constructive, nor shall any such notice be receivable by the Registrar.

(2) Subject to this Act, equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Recognition of agents

59 Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, the act may under and in accordance with the regulations, or in particular cases by special leave of the Court, be done by or to an agent of that person duly authorised in the prescribed manner.

Transitional

60 *[omitted]*

*[Section 60 modified by First Schedule of 1991:39 effective 18 June 1993]*

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Citation of No. 33 of 1930

61 *[omitted]*

Repeals and amendments

62 *[omitted]*

Commencement

63 *[omitted]*

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SCHEDULE

[omitted]

[this Act was brought into operation on 1 July 1975 by SR&O 59/1975]

[Assent Date: 29 July 1974]

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*Amended by:*

1975 : 26

1977 : 35

1985 : 44

1991 : 39

BR 11 / 2009

BR 5 / 2011]

APPENDIX

*[nb. this section is not part of the 1974 Act]*

Act No. 39 of 1991 provides:—

*Application of the 1974 Act to service marks*

2 (1) *Subject to subsection (2), the Trade Marks Act 1974 (hereafter referred to as “the 1974 Act”) shall have effect with respect to service marks as it has effect with respect to trade marks (reference to goods having effect as references to services).*

(2) *The 1974 Act shall have effect in relation to service marks as mentioned in the First Schedule to this Act.*

(3) *In consequence of subsections (1) and (2), the 1974 Act shall have effect, in cases where it applies otherwise than by virtue of subsections (1) and (2), with the amendments specified in the Second Schedule to this Act.*

(4) *In the application by virtue of subsection (1) above of section 8 of the 1974 Act (restrictions on exclusive right conferred by registration) the references in that section to the use of the mark by a person’s predecessors in title shall, as respects use before this Act comes into operation, be construed as references to use by any predecessor of his in business.*

(5) *In this Act “service mark” means a mark (including a device, name, signature, word, letter, numeral, or any combination thereof) used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person.*

(6) *The laws mentioned in the Third Schedule shall have effect subject to the amendments specified in that Schedule.*

MODIFICATIONS OF TRADE MARKS ACT 1974  
IN APPLICATION TO SERVICE MARKS

Section 1

1 Section 1 shall be modified as follows:

(a) in subsection (1) thereof—

(i) in the definition of the expression “limitations”, for all the words appearing immediately after the words “relation to” where they appear the first time there shall be substituted the words “services for use or available for acceptance within Bermuda or in relation to services for use outside Bermuda;”;

(ii) in the definition of the expression “mark” there shall be omitted the words “brand, heading, label, ticket,”;

(iii) insert immediately after the definition of the expression “prescribed” the following definition:

“provision”, in relation to services, means their provision for money or money’s worth;”;

(b) in subsection (2) thereof, for all the words appearing immediately after the words “in relation to” there shall be substituted the words “services shall be construed as references to the use of the mark as or as part of any statement about the availability or performance of services or otherwise in relation to services.”.

Section 5

2 Section 5 shall be modified as follows:

(a) for subsection (1) thereof, there shall be substituted the following:

“ (1) Subject to subsections (2) and (4) and sections 3 and 9, the registration after the coming into operation of the Trade Marks (Modification and Amendment) Act 1991 of a person in part A of the register as a proprietor of a service mark in respect of any services shall, if valid, give to that person the exclusive right to the use of the mark in relation to those services and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the mark or registered user thereof using by way of the permitted use, uses in connection with the provision of any services a mark identical with or nearly resembling it in relation to any services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either—

(a) as being use as a mark; or

(b) in a case in which the use is use at or near the place where the services are available for acceptance or performed in an advertising circular or other advertisement issued to the public,

*as importing a reference to some person having the right either as a proprietor or as registered user to use the mark or to services with the provision of which such a person as aforesaid is connected in the course of business.”;*

*(b) in subsection (2) thereof, for the words from “goods to be sold” to “any market” there shall be substituted the words “services for use or available for acceptance in any place, country or territory”;*

*(c) in subsection (3) thereof, for paragraphs (a) and (b), there shall be substituted the following paragraphs:*

*“ (a) in relation to services to which the proprietor of the mark or a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark; or*

*(b) in relation to services the provision of which is connected in the course of business with the proprietor or a registered user of the mark, where the proprietor or registered user has at any time expressly or impliedly consented to the use of the mark; or*

*(c) in relation to services available for use with other services in relation to which the mark has been used without infringement of the right given by registration or might for the time being be so used, if—*

*(i) the use of the mark is reasonably necessary in order to indicate that the services are available for such use; and*

*(ii) neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of business between any person and the provision of those services.”.*

#### Section 6

3 Section 6 shall be modified as follows:

*(a) in subsection (1) thereof—*

*(i) there shall be inserted immediately before the words “of a person” the words “after the coming into operation of the Trade Marks (Modification and Amendment) Act 1991”;*

*(ii) there shall be omitted the words “or be deemed to have given”;*

*(b) in subsection (2) thereof—*

*(i) there shall be omitted the words from “otherwise” to “section 7,”;*

*(ii) for all the words immediately after the words “as indicating” there shall be substituted the words “that a person having the right either as proprietor or as registered user to use the mark is connected in the course of business with the provision of the services”.*

#### Section 7



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4 Section 7 shall be omitted.

Section 10

5 In section 10(2), for the words from “distinguish” to “subsists” there shall be substituted the words “distinguish services with the provision of which the proprietor is or may be connected, in the course of business, from services with the provision of which he is not so connected”.

Section 11

6 In section 11(1), for the words from “distinguishing” to “subsists” there shall be substituted the words “distinguishing services with the provision of which the proprietor of the mark is or may be connected in the course of business from services with the provision of which he is not so connected”.

Section 13

7 Section 13 shall be modified as follows:

- (a) in subsection (1) thereof, for the words immediately after the words “identical with” there shall be substituted the words “or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services, the same description of services, or goods or a description of goods which are associated with those services or services of that description.”;
- (b) in subsection (2) thereof, for the words immediately after the words “the registration” there shall be substituted the following:

“by the more than one proprietor, in respect of—

- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other,

*of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.”;*

- (c) in subsection (3) thereof, for the words immediately after the words “respectively of” there shall be substituted the following:

“marks that are identical or nearly resemble each other, in respect of—

- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other,

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*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 him or, on an appeal, by the Court.*".

### Section 15

8 *In section 15(1)(b), for the words "the trade" there shall be substituted the words "the provision of services of that description".*

### Section 16

9 *Section 16 shall be modified as follows:*

(a) *in subsection (1) thereof, for the words "an article or substance" there shall be substituted the words "some activity";*

(b) *for subsection (2), there shall be substituted the following subsection:*

*" (2) If it is proved that there is a well-known and established use of the word or words as the name or description of some activity by a person or persons providing services which include that activity, not being use in relation to services with the provision of which the proprietor or a registered user of the mark is connected in the course of business, subsection (3) shall have effect. ";*

(c) *in subsection (3) thereof—*

(i) *there shall be omitted the words "paragraph (a) or (b) of";*

(ii) *in paragraph (a), for the words "article or substance in question or of any goods of the same description" there shall be substituted the words "activity in question" and for the words "that article or substance and any goods of the same description" there shall be substituted the words "that activity";*

(iii) *in paragraph (b), for the words "article or substance in question and of any goods of the same description" there shall be substituted the words "activity in question" and for the words "that article or substance and any goods of the same description" there shall be substituted the words "that activity";*

(d) *in subsection (4) thereof, for the words "article or substance in question or to any goods of the same description" there shall be substituted the words "activity in question" and there shall be omitted the words "paragraph (a) of" and the words appearing immediately after the word "established".*

### Section 23

10 *Section 23 shall be modified as follows:*

(a) *in subsection (1) thereof, there shall be omitted the proviso thereto;*

(b) *in subsection (4) thereof, in paragraph (a) of the proviso thereto, for the words "trade use" there shall be substituted the words "business use".*

*Section 26*

11 *Section 26 shall be modified as follows:*

- (a) *in subsection (1) thereof, there shall be omitted the words from “Notwithstanding” to “contrary,” and the words “, and shall be deemed always to have been,”;*
- (b) *in subsection (2) thereof, there shall be omitted the words “, and shall be deemed always to have been” and the words “, or was registered, as the case may be,”;*
- (c) *in subsection (3) thereof, there shall be omitted the words “or was” wherever they appear;*
- (d) *for subsection (4), there shall be substituted the following subsection:*

*“ (4) Notwithstanding anything in subsections (1) to (3) (inclusive) a mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to—*

- (a) the same services,*
- (b) the same description of services, or*
- (c) services and goods or descriptions of services and goods which are associated with each other,*

*of marks nearly resembling each other or of identical marks, if, having regard to the similarity of the services or the association of the goods and services or description of goods and services, and to the similarity of the marks, the use of the marks in exercise of those rights would be likely to deceive or cause confusion:*

*Provided that, where a mark is assigned or transmitted in such a case, the assignment or transmission shall not be deemed to be invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to services for use in Bermuda, in relation to services for use in the same country or territory outside Bermuda or in relation to services available for acceptance in Bermuda (wherever they are to be used).”;*

- (e) *in subsection (6) thereof, for the words from “in those goods is made, on or after the appointed day” there shall be substituted the words “of providing those services is made”.*

*Section 29*

12 *Section 29 shall be modified as follows:*

- (a) *in subsection (1) thereof, there shall be omitted the words “Subject to section 30,”;*

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(b) *in subsection (2) thereof, for the words immediately after the words “bona fide use” there shall be substituted the words “of the mark by the proprietor thereof for the time being in relation to—*

(a) *services of the same description, or*

(b) *goods associated with those services or services of that description,*

*being services or, as the case may be, goods in respect of which the mark is registered.”;*

(c) *in subsection (3) thereof, for the words “that is shown to have been due to special circumstances in the trade” there shall be substituted the words “in relation to particular services that is shown to have been due to special circumstances affecting the provisions of those services”.*

*Section 30*

13 *Section 30 shall be omitted.*

*Section 31*

14 *Section 31 shall be modified as follows:*

(a) *in subsection (1) thereof, there shall be omitted the words “(otherwise than as a defensive trade mark)”;*

(b) *in subsection (2) thereof, for the words “goods with which he is connected in the course of trade” there shall be substituted the words “services with the provision of which he is connected in the course of business”;*

(c) *in subsection (9) thereof, for the word “trade” there shall be substituted the word “business”.*

*Section 33*

15 *For section 33 there shall be substituted the following section:*

*“33 Any act done in Bermuda in relation to services for use outside Bermuda which, if done in relation to services provided within Bermuda for use there, would constitute use of a mark in Bermuda, shall be deemed to constitute use of the mark in relation to those services for any purpose for which such use is material under this Act or at common law.”.*

*Section 46*

16 *In section 46, for the words “trade name” there shall be substituted the words “business name” and for the words “usages of the trade concerned” there shall be substituted the words “business usages in the provisions of the services in question”.*

*Section 55*

17 *In section 55(2)(c), for the words “goods to be exported to that country” there shall be substituted the words “services for use in that country”.*

*Section 56*

18 *In section 56—*

- (a) for the words “goods between”, wherever they appear, there shall be substituted the words “services between the provision of”;*
- (b) for the words “trade subsists” there shall be substituted the words “business subsists” and for the words “trade subsisted” there shall be substituted the words “business subsisted”.*

*Section 57*

19 *Section 57, for paragraph (b) thereof there shall be substituted the following paragraph:*

- “ (b) in relation to services with the provision of which both or all of them are connected in the course of business.”*

*Section 60*

20 *Section 60 shall be omitted.*

*AMENDMENTS OF THE TRADE MARKS ACT 1974  
IN APPLICATION TO TRADE MARKS FOR GOODS*

*[omitted]*

*SERVICE MARKS*

1 (1) Any reference to a trade mark in a provision to which this paragraph applies shall include a reference to a service mark and accordingly any reference to a registered trade mark includes a reference to a registered service mark.

(2) The provisions to which this paragraph applies are—

(a) in *The Crown Proceedings Act, 1966*, section 4(1) and (2);

(b) in *The Companies Act 1981*—

(a) *First Schedule*, paragraph 3;

(b) *Second Schedule*, paragraph (q)