

Registration of Trade Marks and Service Marks in Bermuda

CHW provides a complete service for the registration in Bermuda of trade marks, service marks, designs and patents. In addition the Firm provides useful advice and guidance in connection with establishing copyright in original literary, dramatic, musical and artistic works or in defending a claim of copyright ownership by others in such works.

Companies offering or proposing to offer goods or services in Bermuda and in the international marketplace should consider protecting any names, logos or designs used in connection with the goods or services through the registration of a trade mark or a service mark.

Bermuda's Trade Mark Act 1974 is modelled after the comparable United Kingdom legislation. The Bermuda Act was amended on June 18, 1993 so as to permit the registration of marks associated with services.

Eligibility for Registration

To be eligible for registration in Bermuda the mark must be used in connection with either goods distributed in, or exported from, Bermuda; or services offered in, or from, Bermuda. The Act also permits registrations where there is a bona fide intention to use a mark in connection with either of the above at some point in the future.

Secondly, for registration in Part A of the Register the mark itself must be distinctive either through past use or by containing one of the following essential particulars:

- (1) the name of a company, individual, or firm, represented in a special or particular manner
- (2) the signature of the applicant for registration or some predecessor in his business;
- (3) an invented word or invented words;
- (4) a word or words having no direct reference to the character or quality of the services, and not being

according to its ordinary signification a geographical name or a surname.

If the mark does not contain one of the above essential particulars, registration in Part A may still be allowed provided evidence of the mark's distinctiveness is filed with the Registrar. Such evidence must show that the mark has been adapted to distinguish the goods/services of the owner of the mark from the goods/services being offered by others. Such evidence would normally be given by way of a statutory declaration setting out the length and extent of the actual use of the mark including, where applicable, references to annual revenues derived from the supply of goods/services associated with the mark and annual expenditures on advertising utilising the mark.

If the Registrar is not convinced that the mark has in fact been adapted to distinguish the goods/services of the owner of the mark from the goods/services being offered by others, a registration under Part B may still be available. A registration under Part B will be allowed if the Registrar is satisfied that the mark is capable of distinguishing the goods/services of the owner from the goods/services offered by others. Practically speaking, the bulk of Part B registrations are unused marks which just fail to be inherently distinctive (i.e. just fail to contain an essential particular) or used marks for which the evidence of distinctiveness is just insufficient to permit a Part A registration.

It is necessary to state the class of goods or services to be covered. Bermuda has adopted an internationally agreed classification system. While a mark may be registered with respect to as many classes as desired each application can only cover one class and it is necessary to clearly list the goods or services claimed.

Length of Registration

A registration is valid for 7 years and for a minimal cost may be renewed for additional terms of 14 years each.

Benefits of Registration

Some benefits of registration are as follows:

- Registration of a mark confers a statutory monopoly in the use of that mark in relation to the good or service for which it is registered.
- The registered owner has the right to sue in the Courts should another party infringe on their registration by using the same or a similar mark in connection with the same goods or services.
- Ownership of a registered mark is established simply from the name recorded in the Trade Marks Register and you are not required to prove ownership by showing an association of the mark with the good or service by the public.
- Suing for infringement of a trade mark is a much cheaper and easier process than bringing a passing-off action under common law.
- Registration of a mark prior to actual use in Bermuda but based upon a future intention to use the mark in Bermuda will (subject to some restrictions) enable you to prevent use of the same or a similar mark in Bermuda by another party which is protection which would otherwise be unavailable to you under common law.

Who should register a Mark?

Any company, organisation or individual, whether Bermudian or non-Bermudian can apply for a mark to be registered. The most obvious candidates to register marks are local Bermudian individuals and companies offering services to the general public in Bermuda. In addition to the non-resident individuals and companies contemplating making their goods and services available in Bermuda should register their marks to protect their ownership of them. Bermuda's "exempted entities" (companies and partnerships registered in Bermuda but exempted from local laws requiring a minimum

of 60% Bermudian ownership) carrying on a variety of international business activities from its shores should also register their marks.

True franchise arrangements are generally not permitted under current Government policy; however the offering of services through a local agent by way of an exclusive distribution arrangement is generally permitted subject to some restrictions. In such circumstances in addition to registering the service mark, the owner of the mark should define the extent of the local agent's rights to the use of the mark by way of a written license agreement.

Licensing of Permitted Users of Marks

The Act specifically permits the registration of persons as registered users of a mark. In connection with such an application the owner of the mark is required to supply a statutory declaration giving details of the relationship between the owner and the proposed registered user, particulars of the degree of control to be exercised by the owner in connection with the use of the mark, the duration of the license and any restrictions on the use of the mark to be contained in the license agreement.

The Registrar has a wide discretion to register a user of a mark if he believes that it would not be contrary to the "public interest" to do so. In assessing what is in the public interest the Registrar generally will look at the proposed license agreement to determine whether it grants the owner sufficient authority to prescribe standards of quality with respect to the services offered in connection with the mark.

A registered user does not acquire any right to use of the mark which may be assigned or transferred. The Act specifically provides that the registration of a user shall not confer any assignable or transmissible right to the use of a mark. In fact use of a mark by a registered user while he is registered as such is deemed under the Act to be use by the owner for all purposes including use required to avoid cancellation of the mark.

The registration of a registered user may be canceled upon application by the owner, or any registered user of the mark or if it is shown that the registered user used

the mark in breach of any restrictions imposed on his use by the registration or in such a way as to likely cause deception or confusion. It should be noted that a breach of a restriction contained only in the license agreement and not in the registration of the registered user may not be sufficient grounds to obtain a cancellation. Owners of marks would be wise to include specific language in the license agreement granting them the right to cancel the registration of the registered user if any restriction on use contained in the license agreement is breached.

Cost and Duration of Registration

Currently this firm generally charges a professional fees of BD \$525.00 (The Bermuda dollar is equivalent to one U.S. dollar) for the registration of a mark in one class. Additional fees may be charged on a time basis depending on any Official Action resulting from the Examination of the application. The corresponding registration fees payable to the Registry General for such a registration are BD \$378.00. Registrations of the same mark in additional classes generally cost somewhat less. A registration is valid for seven years and may be renewed for additional terms of 14 years each at a cost of BD \$315.00 for the professional fee and BD \$331.00 for the Registry fee in respect of each renewal.

Registration of Designs in Bermuda

A design consists of the visual and/or ornamental characteristics applied to an article of manufacture or the outward appearance of an article of manufacture. It can apply to the shape, configuration, appearance and/or surface ornamentation of a thing. A design is inseparable from the object to which it is applied and cannot exist alone.

All proprietors of designs should consider protection by registering the design. However it must be noted that the design must not have been publicly used or disclosed prior to filing the request for registration. A Design Registration is valid for a period of 5 years, this is extendable on expiry for a further 5 years, and again a final 5 years, making a total of 15 years in all.

There are fourteen (14) design classes covering a full range of goods. While the application may only be in respect of one design in one class, the same design may be applied for in as many classes as is required. Each application is considered an application in its own right, and each will attract the same fee.

An Application must include:

- A statement of the nature of the design. This is a brief summary of the design invention.
- Three sets of clear drawings, photographs or tracings of the design invention. These should be of the design, and viewed from different perspectives which clearly disclose all original features and details as claimed in the design invention, e.g. front, side, top, bottom and plan views.

If the mark is registered in the U.K. Design Registry then acceptance is automatic in Bermuda. However, if the U.K. entry ceases to be in force, through expiry or other reason, then the Bermuda mark will not automatically cease, but others may seek to have the registration revoked.

Registration of Patents in Bermuda

A patent is a monopoly right granted to the inventor or discoverer of any new and useful process, machine, manufacture, or composition of matter, or of any new and useful improvement for a process, machine, manufacture or composition of matter.

The Bermuda Registry offers three types of Patent registration. A full Patent, a Provisional Patent and United Kingdom and European Patent registrations.

All proprietors of patents should consider protection by registering their patents.

The application form for a full Patent must be accompanied by two copies of the specification. The specification describes the nature and object of the invention and includes:

- The title of the invention
- A detailed written description of the new invention. This description should contain enough detail to allow an expert in the field to make or use the invention easily.
- A claim. This is an important part of the application. It should clearly indicate the subject matter of the invention. It is the definition of the monopoly being claimed.
- Drawings of the new invention. These should clearly show how the invention works. If the invention is three-dimensional then perspective drawings from all angles should be supplied.

As the Bermuda Registry does not have the facility or technical expertise to fully examine the application, after a search has been made for the same or similar patents on the Bermuda Register, all applications are sent to the U.K. Patent Office. The patent will remain in force for 16 years and can be extended for further periods not exceeding 7 years at a time.

A provisional Patent is a temporary monopoly right to an inventor. The provisional application can convert to a full patent application up to a maximum of 9 months from the date of application and the resulting full patent will retain the original filing date.

The Registry will also register United Kingdom and European Patents. Any person or organisation who has been granted a United Kingdom or European patent may, within three years of the grant of that patent, apply for the patent to be registered in Bermuda.

No search is required. The patent will have the same rights as a Bermuda Patent and will only be in force as long as the UK/European patent is in force. A Bermuda patent that is based on a UK/European patent cannot be renewed.

Copyright in Bermuda

Copyright gives a measure of legal protection to the creators of original literary, dramatic, musical and artistic works. It allows them to control the ways in which their

material may be commercially exploited. The protection broadly covers the copying (or reproduction), adapting, publishing, performing and broadcasting of their material.

The copyright can cover published editions of literary, artistic and musical works, sound recordings, films (including videograms) and broadcasts (including cable and satellite broadcasts).

In Bermuda copyright protection exists the moment an original piece of work is created. There is no registration system. If it came to a matter of dispute it would be up to the Courts to decide who is the owner of copyright.

The normal time for copyright to exist on a piece of literature, music or artistic work is the lifetime of the author/creator plus fifty years beyond their death.

Conclusion

Increasing importance and value is being placed upon a business' goodwill, "logos" and other identifying marks. Businesses would be well advised to recognise the value in their intellectual property and strive to protect it. Those individuals and companies who are presently or contemplating making their goods and services available in the Bermuda marketplace should seriously consider taking advantage of Bermuda's Intellectual Property Legislation so as to protect their ownership of the marks to be used in connection with the offering of those services.