

**CHAPTER 319****TRADE MARKS****ARRANGEMENT OF SECTIONS**

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## CHAPTER 319

## TRADE MARKS

*An Act to revise and reform the law governing signs used as trade marks, service marks or collective marks in connection with the marketing of goods or services.* 1981-56.  
1984-20.  
1988-6.

[1st January, 1985] Commence-  
ment.  
1984/179.

*Citation*

1. This Act may be cited as the *Trade Marks Act*. Short title.

*Interpretation*

2. In this Act, Definitions.

"Director" means the Registrar of Corporate Affairs and Intellectual Property Office; 1988-6.

"Gazette" means the *Official Gazette* or such other publication as is prescribed for the purpose;

"Industrial Property Office" means the Corporate Affairs and Industrial Property Office established under section 3 of the *Corporate Affairs and Industrial Property Office Act*; 1988-6.  
Cap. 21A.

"licensee" means the holder of a licence under a licence-contract;

"licence-contract" means a licence-contract referred to in section 30;

"mark" refers to a trade mark, service mark and, except in sections 28, 30, 31, 32, 33, 34, 35, 39 and 40, a sign used as a collective mark;

"register" means the Register of Trade and Service Marks referred to in section 20;

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"transfer" extends to every mode (whether direct or indirect, voluntary or involuntary, absolute or conditional) of disposing of or parting with any right vested under this Act, or of any interest in any such right, including retention of title to the right or interest as security for any obligation.

Purpose.

3. The purpose of this Act is to protect trade marks, service marks and collective marks registered under this Act so that the law of Barbados will accord with its obligations

- (a) under the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of Marks, dated June 15, 1957, as revised from time to time, in this Act called the "Nice Agreement"; and
- (b) under the Paris Convention for the Protection of Industrial Property dated March 20, 1883, as revised from time to time, in the Act called the "Paris Convention".

Trade, service and collective marks.

4. (1) A trade mark is a visible sign used or to be used, upon, with or in relation to any goods for the purpose of distinguishing, in the course of trade or business, the goods of one person from those of another person.

(2) A service mark is a visible sign used or to be used in connection with or in relation to, any services for the purpose of distinguishing, in the course of business, the services provided by one person from those provided by another person.

(3) A collective mark is a visible sign used or to be used, in the course of trade or business, by a group of business enterprises for the common benefit under an agreement in writing that provides for the specific conditions governing the use of the sign.

(4) Without limiting the generality of subsections (1) to (3), but subject to sections 8 and 9, marks can consist of arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.

*Protection of Marks*

**5. (1)** The registration of a mark vests in the registered owner <sup>Rights.</sup> of the mark the exclusive right to prevent any other person

- (a) from using the mark or any sign so nearly resembling the mark as to be likely to mislead the public
  - (i) in respect of goods or services for which the mark is registered, or
  - (ii) in respect of other goods or services in connection with which the use of the mark or a mark resembling it is likely to mislead the public; or
- (b) from using, without just cause or in circumstances likely to affect adversely the interests of the registered owner of the mark.
  - (i) the mark or any sign resembling it, or
  - (ii) any business name resembling the mark, that is to say, any name or style under which any business or profession will be carried on in Barbados, whether in partnership or otherwise, that resembles the mark.

(2) In relation to a collective mark, the rights vested in the registered owner of the mark under this section are subject to the conditions governing the use of the collective mark.

(3) The registered owner of a collective mark may use that mark himself so long as the mark is being used by persons permitted to use it under the conditions governing its use; and use by any of those other persons is presumed, for the purposes of this Act, to be use by the registered owner.

**6.** The registration of a mark under this Act does not vest in the registered owner of the mark any right <sup>Excepted uses.</sup>

- (a) to prevent the use by a person in good faith of his own name, address or pseudonym or a geographical name; or
- (b) to prevent the use by a person in good faith of an exact indication concerning the kind, quality, quantity, destination, value, place of origin, time of production, or time of supply of his goods or services,

if that use is confined exclusively to purposes of identification or information and is not likely to mislead the public regarding the source of any goods or services to which the registered mark relates.

Local  
exception.

7. (1) The registration under this Act of a mark does not vest in the owner of the mark the right to prevent the use by other persons of the mark in relation to goods lawfully sold in Barbados if those goods have not undergone any change, including change attributable to ageing or weather.

(2) For the purpose of this section "lawfully sold in Barbados" means in relation to any goods or services, that those goods have been imported into Barbados for sale, or have been purchased in Barbados for sale, in either case with the consent of the registered owner of the mark or his agent, or the goods have been so imported or purchased before the mark was registered in Barbados.

Unregis-  
trable  
marks:  
similarity.  
1984-20.

8. (1) An application may not be made under this Act for the registration of any of the following marks:

- (a) subject to subsection (2), a mark that
  - (i) resembles, in such a way as to be likely to mislead the public, a mark registered under this Act by another person or for which an application for registration by another person is pending under this Act, or
  - (ii) is subsequently sought to be registered under this Act by a person claiming priority under section 12 in respect of the same goods or services in connection with which the use of the mark for which application is being made might be likely to mislead the public;
- (b) subject to subsection (2), a mark that resembles, in such a way as to be likely to mislead the public, an unregistered mark in use in Barbados at an earlier period by some other person in connection with identical or similar goods or services, if the applicant is aware or could not reasonably have been unaware of the earlier use;

- (c) subject to subsection (2), a mark that resembles, in such a way as to be likely to mislead the public, a business name registered under the *Registration of Business Names Act* and in use in Barbados by another person, if the applicant is aware or could not reasonably have been unaware of the earlier use; Cap. 317.
- (d) subject to subsection (2), a mark that, with regard to another mark or trade-name, constitutes a reproduction, in whole or in part, or an imitation, translation or description of that other mark or trade-name
- (i) is well known in Barbados,
  - (ii) belongs to a person other than the applicant, and
  - (iii) its reproduction, imitation, translation or description is likely to mislead the public;
- (e) a mark that infringes the interest of another person or the use of which could lead to a contravention of section 48; or
- (f) a mark that has been registered in another country, or an application for the registration of which has been made by an agent of a person who is the owner of the mark in another country, unless the authorisation of that owner is given or the agent justifies his action.

(2) In determining whether a mark can be registered under this Act, the consent to registration by a person described in paragraph (b), (c), (d) or (e) of subsection (1) whose rights will be or are likely to be infringed if a particular mark is registered under this Act may be taken into account to permit registration of the particular mark.

9. (1) The following marks may not be registered under this Act:

- (a) any mark that consists of a shape or form imposed by the inherent nature of the goods or services to which the mark relates or imposed by the industrial function of the mark;

Unregis-  
trable  
marks:  
inherent  
defects.

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- (b) subject to subsection (2), any mark that consists exclusively of a sign or indication that might serve, in the course of trade or business, to designate the kind, quality, quantity, purpose, value, place of origin of, or time of supply of, the goods or services to which the mark relates;
- (c) subject to subsection (2), any mark that exclusively consists of a sign or indication that has become in current language or in the *bona fide* and established practices of the trade or business in Barbados, a customary designation of the goods or services to which the mark relates;
- (d) subject to subsection (2), any mark by the use of which it is for other reasons impossible to distinguish the goods or services of one business enterprise from those of another business enterprise, unless those business enterprises are using the mark as a collective mark to which they are entitled;
- (e) any mark that offends public morals or the use of which is likely to provoke a breach of the peace;
- (f) any mark the use of which is likely to deceive persons in trade or business, or the public in general, regarding the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods or services to which the mark relates;
- (g) any mark that is an imitation of an armorial bearing, flag or other emblem, or is an initial, name or abbreviation of a name of any country or of any intergovernmental or international organisation created by an international convention, unless its use is authorised by an authority in the country or organisation concerned that is competent to authorise the use of the mark as a trade mark, service mark or collective mark, as the case requires;
- (h) any mark that is a reproduction or imitation of an official sign or hallmark adopted by a country, unless its use is authorised by an authority in the country concerned that is competent to authorise the use of the mark as a trade mark, service mark or collective mark, as the case requires; and

- (i) any mark that resembles, in such a way as to be likely to mislead the public, a collective mark
- (i) the registration of which had expired and had not been renewed, or
- (ii) the renunciation, removal or invalidity of which had been recorded in the register,

in the course of the 3-year period immediately before the application to register the mark is made under this Act.

(2) In determining whether or not a mark can be registered under this Act, account must be taken, for the purposes of paragraphs (b) to (d) of subsection (1), of all the facts, particularly the length of time the mark has been in use in Barbados or in any other country, and whether the mark has been held to be distinctive in any other country.

#### *Application for Registration*

10. (1) An application for registration of a mark may be made to the Director upon payment of the prescribed fee. Application.

- (2) The application must contain
  - (a) a request for registration of the mark;
  - (b) the full name and address of the applicant, and if he resides outside Barbados, an address for service within Barbados;
  - (c) 4 copies of a representation of the mark for which registration is requested; and
  - (d) a clear and complete list of the particular goods or services for which the registration of the mark is requested, accompanied by an indication, under the classification referred to in the Nice Agreement, of the classification of the goods or services that correspond to the goods or services to which the mark is to be applied.

(3) When an application for registration of a mark is made by an agent, the application must be accompanied by a power of attorney authorising the agent to make the application.

- (4) When the application is for the registration of a collective mark, the application
- (a) must designate the mark a collective mark; and
  - (b) must be accompanied by a copy of the agreement which
    - (i) must be signed by the applicant,
    - (ii) must contain the conditions governing the use of the mark as a collective mark, and
    - (iii) must be in compliance with the requirements of subsection (5).
- (5) An agreement providing for the use of a collective mark must specify
- (a) the common characteristics or quality of the goods or services to which the collective mark is to be applied;
  - (b) the conditions under which, and the persons by whom, the collective mark can be used;
  - (c) how effective control of the use of the collective mark in compliance with the conditions governing its use will be exercised; and
  - (d) the penalties or sanctions that are to be applied if the collective mark is used in contravention of any of the conditions governing its use.

Priority.

**11.** Registration of a mark may only be granted under this Act to the person who first complies with section 10 or claims the earliest priority for his application for registration under this Act.

Priority claim.

**12. (1)** An applicant for registration under this Act of a mark who is availing himself of the priority of an earlier application in another country that is a member of the Paris Convention must submit with his application a written statement

- (a) indicating the date and number of the earlier application;
- (b) identifying the country in which the earlier application was made; and

(c) giving the name of the applicant who made the earlier application in that other country.

(2) In a declaration made under subsection (1) the applicant must give an undertaking to the Director to furnish him, within a period of 90 days from the date of the application, with a copy of the earlier application, certified as correct by an authority in the other country competent to so certify.

(3) This section does not come into operation until the day Barbados accedes to the Paris Convention.

13. (1) Where a person who, having, at an exhibition recognised by the Minister as an official national or international exhibition, exhibited goods bearing a mark or rendered services under a mark, makes, within 6 months from the date on which those goods or services were first exhibited bearing or under that mark at the exhibition, an application for the registration of that mark under this Act, he may, if he so desires, be deemed to have made application under this Act for registration of that mark on the date on which the goods or services were so exhibited. Temporary protection.

(2) An exhibition is recognised by the Minister as an official national exhibition or an official international exhibition when the Minister publishes a notice of that fact in the *Gazette*.

14. (1) The Director shall examine each application for registration of a mark to determine if sections 10, 12 and, if relevant, section 13 have been complied with. Form examination.

(2) If the Director determines that section 10 has not been complied with in respect of an application for the registration of a mark, the Director shall refuse to accept the application.

(3) If the Director determines that section 12 or 13, as the case requires, has not been complied with on an application for the registration of a mark, the Director may, subject to section 15, register the mark, but mention may not be made in the register of any priority claimed under section 12 or of any use of the mark at an exhibition described in section 13.

Substance  
examina-  
tion.

15. (1) When the Director has determined that an application complies with the requirements of section 10, he shall examine the mark for which the application is made to determine if the mark can be registered under this Act having regard to sections 8 and 9.

(2) When the Director determines that the application or the mark being registered would contravene section 8 or 9, the Director shall

- (a) refuse registration and inform the applicant by notice in writing why the application cannot be accepted or the mark cannot be registered in Barbados; and
- (b) invite the applicant either to withdraw the application or to present, within a period of 60 days from the date of the receipt of the notice, the applicant's comments on the reasons for the refusal to accept the application or to register the mark.

(3) The Director may refuse to register a mark for which the application described in subsection (2) was made,

- (a) if the applicant does not withdraw his application or present his comments within the time limited therefor by that subsection; or
- (b) if the applicant presents his comments and the Director is of the view that he ought not to accept the application or register the mark.

(4) When, after considering any comments presented to him by an applicant described in subsection (2), the Director is of the opinion that the mark for which the application has been made cannot be registered under this Act in respect of a part of the goods, or, as the case requires, some of the services mentioned in the application, the Director may proceed under section 16 with the application in respect of those goods or services for which the mark can be registered.

*Publication of Application*

16. (1) Where it appears to the Director that the requirements of this Act governing registration of a mark have been complied with in respect of an application, he may so notify the applicant and require that the applicant, within a period of 60 days from the receipt of the notification, pay the prescribed fee for publication of the notice of the application. Publishing application.

(2) Upon payment of the fee required under subsection (1), the Director shall publish a notice of the application in the *Gazette*; but if the fee is not paid within the time limited for payment thereof by that subsection, the mark for which the application was made may not be registered.

(3) The publication of a notice of an application for registration of a mark must

- (a) specify the date of the application;
- (b) indicate the goods or services for which registration of the mark is being applied for;
- (c) indicate the corresponding class or classes of goods or services to which the mark relates;
- (d) give the name and address of the applicant, and, if relevant, the address for service of the applicant;
- (e) indicate any priority claimed, or the date of certified use of the mark at an exhibition within the meaning of section 13; and
- (f) if the mark is a collective mark, contain the statement of conditions governing the use of the collective mark that accompanied the application for its registration.

17. (1) A person who opposes an application for the registration of a mark under this Act may, within 90 days from the date of the publication of the notice of the application, inform the Director, by a notice in the prescribed manner, of that person's opposition and the reasons therefor. Opposition.

(2) If no notice of opposition to the registration of the mark is received by the Director within the period limited therefor under subsection (1), section 19 applies.

(3) A copy of the notice of opposition to registration received by the Director shall be sent by him to the applicant for registration of the mark, who shall, within 30 days from the receipt by him of the notice, send to the Director in the prescribed manner an answer to the opposition in which he must set out the grounds on which he relies to support his application for registration; and, if the applicant fails within the 30 days to send the Director the answer to the opposition to registration, the applicant thereupon abandons his application for registration.

Hearing.

18. (1) When, pursuant to section 17, the Director receives from the applicant for registration of a mark an answer to an opposition to the registration of the mark, the Director, after furnishing a copy of the answer to the person opposing the application, shall require the opposing person and the applicant to attend before the Director, at a time and place fixed by him, to hear the matter of the opposition.

(2) At the conclusion of the hearing, the Director may either register the mark that was opposed or refuse its registration; but, in either case, the Director shall state in writing his reasons for his decision.

*Registration*

Regis-  
tration.

19. After all the requirements of this Act governing the registration of a mark have been complied with in the case of an application, the applicant is entitled, on payment of the prescribed fee, to have the mark registered under this Act.

Register.

20. (1) The Director shall maintain a Register of Trade and Service Marks and record therein

(a) all marks registered under this Act; and

(b) all transactions required by this Act to be recorded in connection with each mark registered under this Act.

(2) The marks recorded in the register must be numbered in the order of their registration.

(3) A collective mark must be recorded in a separate section of the register reserved for registration of collective marks.

21. (1) A mark is registered when there is recorded in the register Particulars  
for regis-  
tration.

- (a) a reproduction of the mark;
- (b) the number of the mark;
- (c) the name and address of the registered owner of the mark and if he resides outside Barbados his address for service in Barbados; 1984-20.
- (d) the dates of application and registration of the mark;
- (e) if priority is claimed, an indication of that fact and the number, date and country of the application with which the priority claim is connected;
- (f) if the mark was exhibited within the meaning of section 13, the contents of the certificate relating to its exhibition that has been filed with the Director; and
- (g) if the mark is a collective mark, the conditions governing the use of the mark that accompanied the application for its registration as a collective mark.

(2) The registered owner of a mark recorded in the register shall notify the Director of any change in the owner's address, or in his address for service in Barbados; and, upon payment of the prescribed fee, the Director shall record the change in the register.

(3) The registered owner of a collective mark recorded in the register shall notify the Director of any change affecting the conditions governing the use of the mark; and, upon payment of the prescribed fee, the Director shall record the change in the register, after publishing a notice of the change in the *Gazette*.

(4) Sections 16(3), 17 and 18 apply, with such modifications as the circumstances require, to any change to be



made in the register under subsection (3) with regard to any conditions governing the use of a collective mark.

**Certificate.** 22. Upon the registration of a mark, the Director shall send, by registered post to the registered owner of the mark at his address as recorded in the register, a certificate of the registration.

**Publication of marks.** 23. (1) From time to time as prescribed by the regulations, the Director shall publish in the *Gazette* in the order of their registration such marks as have been registered in the register to that time or since the last publication.

(2) The publication of marks must include all the particulars recorded in the register pursuant to section 21 in respect of the marks.

**Inspection of register.** 24. (1) The register is a public record and may be inspected during business hours by any member of the public free of charge.

(2) An inspection of the register includes making copies or extracts therefrom; but, on payment of the prescribed fee therefor, extracts or copies of any records in the register may be obtained from the Director.

**Duration.** 25. Subject to sections 41 to 45, the registration of a mark is valid for a period of 10 years from the date of its registration; but a registration may be renewed for further consecutive periods of 10 years each upon payment of the prescribed fee on each renewal.

**Application for renewal.** 26. (1) An application for renewal of a registration of a mark must be in the prescribed form and signed by the applicant and must contain a statement in the prescribed wording to the effect that the mark has been used by the registered owner or by a licensee under a licence-contract during the year preceding the date of application, or that the mark has not been so used because of good reasons beyond the control of the registered owner, but insufficient finances may not be one of these reasons.

(2) To show use during the year preceding the application for renewal of the registration of a mark, it is sufficient if

- (a) the use of the mark was in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered; or
- (b) the use of the mark was in connection with one or more of the goods or services belonging to any given class in respect of which the mark was registered.

27. (1) Upon the renewal of the registration of a mark, no change may be made in the list of goods or services in respect of which the mark is registered, except to remove any goods or services from that list.

(2) An application for the renewal of the registration of a mark must be in the prescribed form, and is not subject to a fresh examination of the mark by the Director, nor may its renewal be opposed unless the renewal would contravene subsection (1).

(3) An application for renewal of a registration must be made, and the prescribed fee therefor paid, within the 12 months immediately preceding the expiration of the earlier period of registration.

(4) Notwithstanding subsection (3), the registered owner of a mark, upon payment of the prescribed fee therefor, is entitled to renew a previous registration within 6 months from the expiration of the earlier registration.

(5) A renewal of a registration of a mark noting any elimination of goods or services in respect of the mark shall be recorded in the register and a notice thereof published by the Director in the *Gazette*.

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*Proprietary Activities*

Transfer of  
application  
or mark.

**28. (1)** An application for the registration of a trade mark or service mark, and the registration of a trade or service mark, are both transferable; and a trade mark or service mark may be transferred

- (a) independently of any business enterprise in connection with which the trade mark or service mark is used; and
- (b) independently of the goods or services in respect of which the application was made or the trade mark or service mark was registered.

(2) A transfer of an application for the registration of a trade mark or service mark, or the transfer of the registration of a trade mark or service mark, must be recorded in the register upon payment of the prescribed fee.

(3) A transfer of an application for the registration of a trade mark or service mark, or the transfer of the registration of a trade mark or service mark, is void as against any person other than the parties to the transfer until the transfer is recorded in the register.

(4) A transfer of an application for registration of a trade mark or service mark, or the registration of a trade mark or service mark, is void if the transfer is likely to mislead the public in any way, particularly with respect to the nature, source, manufacturing process, characteristic or suitability for their purpose of the goods or services to which the trade or service mark relates.

(5) In order to be recorded in the register, a transfer, otherwise than by operation of law, of an application for registration of a trade mark or service mark or of a registration of a trade mark or service mark must be in writing and signed by the parties to the transfer.

29. (1) The Director may in writing approve the transfer of the registration of a collective mark if the transferee undertakes in writing to exercise effective control of the use of the collective mark in accordance with the conditions governing its use.

Transfer of  
collective  
marks.

(2) A transfer of the registration of a collective mark is void until it is recorded in the register; and it may not be recorded unless the application to record the transfer is accompanied by the prescribed fee and a copy of the Director's approval of the transfer.

### *Licence-contracts*

30. (1) A registered owner of a trade mark or service mark may, by a licence-contract, grant to another person or an enterprise a licence to use the mark for any of the goods or services for which the mark is registered.

Licence-  
contracts.

(2) A licence-contract must be in writing and signed by the parties to the contract; and it is void against persons other than the parties thereto until it is recorded in the register.

(3) A licence-contract may be recorded in the register upon payment of the prescribed fee.

(4) The record in the register of a licence-contract relating to a trade mark or service mark shall be cancelled by the Director

(a) at the request of the registered owner of the trade mark or service mark, or at the request of the licensee under the licence-contract; and

(b) on production to the Director of satisfactory evidence by the person making the request that the licence-contract has terminated.

31. In the absence of an agreement to the contrary, joint owners of a trade mark or service mark registered under this Act

Joint  
owners.

(a) may separately transfer their share of the mark as well as separately exercise any exclusive right acquired under this Act; but

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- (b) may by joint action only grant a licence-contract to another person to use the mark for any of the goods or services in respect of which it is registered.

Quality control. 1984-20.

32. (1) A licence-contract relating to a trade mark or service mark is void and may not be recorded in the register if the licence-contract does not contain a stipulation that ensures that the quality of the goods or services to which the mark relates can be effectively controlled by the registered owner of the mark.

(2) A provision in a licence-contract or a provision in an agreement relating to a licence-contract is void if, in respect of a trade mark or service mark, it purports

- (a) to impose on the industrial or commercial use of the trade mark or service mark a restriction on the licensee that does not derive from the rights vested by registration of the mark under this Act; or
- (b) to impose a restriction that is unnecessary for the purpose of safeguarding the rights vested by registration of the mark under this Act.

(3) Whether a restriction is unnecessary for the purpose of safeguarding the rights vested by registration under this Act is a question of fact to be determined in each case after having due regard to all the circumstances.

Further licences.

33. (1) In the absence of a provision to the contrary in a licence-contract, but subject to subsection (2), the grant of a licence to a person to use a trade mark or service mark in industry or commerce does not prevent the grantor of the licence

- (a) from granting further licences to other persons to use the same mark, or
- (b) from using the mark himself.

(2) If the licence-contract provides that the licence granted under it is an exclusive licence, the grantor of the licence may not

- (a) grant further licences to other persons to use the trade mark or service mark to which the licence-contract relates; or

(b) in the absence of a provision in the licence-contract to the contrary, use the trade mark or service mark himself.

34. In the absence of a provision to the contrary in the licence-contract, a licensee thereunder may, while he is a registered licensee under that contract, exercise in Barbados, in relation to the trade mark or service mark to which the licence-contract relates, all the rights vested by registration under this Act in respect of that mark, including the right to apply for renewal of the registration of the mark. Licensee right.

35. (1) Unless the licence-contract otherwise provides, a licence under a licence-contract is not transferable nor may a licensee thereunder grant a sub-licence. No transfer of licence.

(2) When a licensee under a licence-contract has authority thereunder to transfer his licence or to grant a sub-licence, sections 30 to 34 and section 36 apply to the transfer or sub-licence.

36. When in the economic interests of Barbados, the Minister of Finance so provides by order, Royalties abroad.

(a) licence-contracts requiring payment of royalties abroad, or such classes thereof as are described in the order; and

(b) changes or renewals of the licence-contracts referred to in paragraph (a),

have no effect in Barbados without the approval in writing of the Minister of Finance.

### *Renunciation*

37. (1) Subject to this section, the registered owner of a mark may renounce registration of the mark by means of a written renunciation addressed to the Director. Renunciation.

(2) A renunciation may be limited to a part only of the goods or services for which the mark is registered.

(3) Upon receiving a renunciation, the Director shall record it in the register and publish a notice of the renunciation in the *Gazette* as soon as possible.

(4) A renunciation of a mark has no effect until it is recorded in the register pursuant to subsection (3).

(5) Subject to subsection (6), when a licence-contract is recorded in the register for a trade mark or service mark, a renunciation made in respect of the mark may not be recorded in the register unless the renunciation contains a statement that it was made with the consent of the licensee under the licence-contract.

(6) Subsection (5) does not apply if the licence-contract relating to the mark referred to in that subsection expressly waives the right of the licensee thereunder to prevent the recording of a renunciation without his consent.

#### *Protective Measures*

Owner's  
remedies.

**38.** (1) The registered owner of a mark whose rights under this Act are in imminent danger of being infringed, or are being infringed, may institute proceedings in the High Court

(a) for an injunction to prevent the infringement or to prohibit the continuation of the infringement; or

(b) for damages for the infringement.

(2) An injunction issued pursuant to subsection (1) does not deprive the registered owner of the mark of any damages that he is entitled to be awarded for any loss sustained by him as a result of an infringement or imminent infringement of his rights under this Act.

Licensee's  
remedies.

**39.** (1) A licensee under a licence-contract may in writing request the registered owner of the trade mark or service mark to which the licence-contract relates to institute, within a period of 90 days from receipt by him of the request, any necessary legal proceedings in respect of any infringement or imminent infringement of that mark.

(2) A request under subsection (1) must contain a statement of the relief desired.

(3) Subject to subsection (5), if the registered owner of a trade mark or service mark who receives a request under subsection (1)

fails to institute legal proceedings within the time limited therefor by that subsection, the licensee who made the request may, unless the licence-contract otherwise provides, institute those proceedings in his own name after notifying the registered owner of the mark of his intention to do so.

(4) The registered owner of the trade mark or service mark may join in any legal proceedings instituted under subsection (4) by a licensee; but the licensee is liable to the registered owner of the mark for any damages that the owner incurs as a result of any unwarranted legal proceedings instituted by the licensee.

(5) When a licensee institutes legal proceedings in his own name under this section, he must prove to the court that the registered owner of the mark to which the proceedings relate failed within the time limited therefor by subsection (1) to institute legal proceedings.

**40.** (1) Subject to subsection (2), the High Court may, before the expiration of the period of 90 days referred to in section 39(1), grant an injunction to a licensee of a trade mark or service mark to prevent infringement or to prohibit further infringement of the mark. Judicial aid.

(2) In making an application to the High Court to exercise its jurisdiction under subsection (1), the licensee must prove that

- (a) immediate action is necessary to prevent substantial damage from the infringement of the trade mark or service mark for which the application is made; and
- (b) the registered owner of the mark had been requested to institute legal proceedings but had failed to do so.

**41.** (1) Proceedings requesting that the registration of a mark be ordered removed from the register may be made by application to the High Court by any interested person, if Registration removal.

- (a) the mark has become a generic name; or
- (b) the mark has fallen into disuse.

(2) A mark becomes a generic name when the registered owner by his action causes or acquiesces in the transformation of the mark into a generic name in respect of one or more of the goods or



services for which the mark was registered, so that, in trade and business circles and in the estimation of the public, the mark's significance as a distinctive trade, service or collective mark has been lost.

(3) A mark falls into disuse when its registered owner, without good reason, has, within the 5 years immediately preceding the date of the application to the High Court, failed, after registration of the mark, to use it within Barbados or failed to cause its use within Barbados.

1984-20

(4) The use of a mark in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was registered does not of itself cause the mark to lose its significance nor does it diminish the rights of the registered owner under this Act.

(5) In determining whether a mark has fallen into disuse within the meaning of subsection (3), the court may have regard to the following:

- (a) only circumstances beyond the control of the registered owner ought to be taken to be a good reason for failing to use a mark under licence or otherwise;
- (b) insufficient financial resources ought not to be taken to be a good reason for failing to use a mark under a licence or otherwise; and
- (c) the use of a mark in connection with one or more of the goods or services belonging to any given class in respect of which the mark is registered constitutes use of the mark.

Court order.

**42.** After hearing the parties to the proceedings for the removal of a mark from the register under section 41, the court may

- (a) dismiss the application; or
- (b) order a total or partial removal of the mark from the register, as the court thinks appropriate.

Invalidity.

**43.** (1) Proceedings requesting that the registration of a mark be declared invalid may be made by application to the High Court

by any interested person claiming that the registration was not permitted under section 8 or 9.

(2) After hearing the parties to the application, the court may declare the registration of the mark invalid if it is shown to the court that the mark ought not to have been registered, having regard to the requirements of section 8 or 9.

(3) Notwithstanding subsection (2), the court shall disregard any ground not existing at the hearing of the application but that ought to have resulted in the refusal of registration when the application was examined under section 15.

(4) When the grounds for invalidating the registration of a mark exist in respect of a part only of the goods or services for which the mark was registered, the declaration of invalidity may be limited by the court to that part only of the goods or services to which the mark applies.

(5) An application under this section for a declaration invalidating a mark

(a) may be brought within 5 years from the date of registration of the mark, if the mark ought not to have been registered, having regard to section 8(1); or

(b) may be brought within 12 years from the date of registration of the mark, if the mark ought not to have been registered, having regard to any other provision of section 8 or 9.

44. (1) In addition to any proceedings under section 43 to have a mark declared invalid, proceedings may also be brought, in the circumstances to which this section applies, in the High Court, by application, to have a collective mark declared invalid.

Invalid  
collective  
mark.

(2) The circumstances to which this section applies are:

(a) when the registered owner of the collective mark uses the mark to the exclusion of its use by other persons, or uses, or permits the use of the collective mark in contravention of the conditions governing its use as recorded in the register; or

(b) uses or permits use of the collective mark in a manner likely

- (i) to deceive in trade or business circles, or
- (ii) to deceive members of the public, as to the origin of any common characteristics of the goods or services in connection with which the mark is used.

(3) For the purposes of paragraph (b) of subsection (2), it is immaterial whether

- (a) the registered owner of the collective mark tolerated its use in the manner described in that paragraph while being aware of its being so used; or
- (b) the registered owner of the collective mark is ignorant through lack of adequate control of the manner of use of the collective mark.

(4) To prevent doubt, section 43 applies to proceedings brought under this section in like manner as proceedings brought under that section.

Effect of invalidation.

45. (1) When the registration of a mark is declared invalid in whole or in part by the High Court in any proceedings brought under sections 41 to 44, the registration is, to the extent declared by the Court invalid from the date of the impugned registration.

(2) When the registration of a trade mark or service mark to which a licence-contract applies is declared invalid by the High Court, no royalties need be repaid by the grantor of the licence under the licence-contract to the licensee thereunder unless it is shown to the court that the licensee had not substantially benefitted from the licence.

Copy of court decision.

46. On the determination of any proceedings under section 41, 42, 43 or 44 in the High Court, the Registrar of the Supreme Court shall transmit a certified copy of the court's decision to the Director, who shall record the decision in the register and publish a notice of it in the *Gazette*.

### *Appeals*

Appeals.

47. (1) A person aggrieved by any determination of the Director regarding the registration of, or refusal to register, a

mark under this Act may appeal to the High Court from that determination, within 14 days after the determination is made known to him.

(2) After hearing the appeal, the court may rescind or confirm the determination of the Director.

(3) The Registrar of the Supreme Court shall transmit a certified copy of the court's decision to the Director who shall record the decision in the register and publish a notice of it in the *Gazette*.

(4) The Director may be heard in person or by his attorney on an appeal under this section.

### *Trading Practices Offences*

**48.** (1) No person shall knowingly

Competitive  
offences.

- (a) make use either directly or indirectly of a false or deceptive indication of the source of goods or services, or of the identity of the producer, manufacturer or supplier of goods, or the originator or supplier of services;
- (b) make use either directly or indirectly of a false or deceptive appellation of origin of goods or services, or imitate an appellation or origin of goods or services, even if
  - (i) the true origin of the goods or services is indicated, or
  - (ii) the appellation is used in translated form or is accompanied by words indicative of a relationship or similarity between the goods or services;
- (c) commit any act of a nature likely to cause confusion by any means in relation to the business establishment, the goods or services, or the industrial or commercial activities, of a business competitor;
- (d) make any false allegation in the course of trade or business of such a nature as to discredit the business establishment, the goods or services, or the industrial or commercial activities, of a competitor; or
- (e) give any indication or make any allegations the use of which, in the course of trade or business, is likely to mislead the

public regarding the nature of goods or services, the manufacturing or originating process, the characteristics, suitability for their purpose, or the quantity or quality of those goods or services.

(2) In this section,

- (a) "appellation of origin" means the geographical name of a country, region or locality serving to designate a produce originating therein, the quality or characteristics of which are due exclusively or essentially to the geographical environment, including natural or human factors; and
- (b) "indication of source" means any expression or sign that is used to indicate that a product or service originates in a given country or group of countries.

Infringe-  
ment.

**49.** No person shall knowingly infringe any right vested in any other person under this Act.

Penalties.

**50.** A person who contravenes section 48 or 49 is guilty of an offence and liable on summary conviction

- (a) to a fine of \$10 000 or to imprisonment for a term of 2 years or to both; and
- (b) in the case of a continuing offence, to a further fine of \$1 000 for each day or part thereof on which the offence continues.

Limitation.

**51.** A prosecution for an offence under section 48 or 49 may be brought at any time within 5 years from the date the offence, or the last date on which the last of any continuing offence, was committed.

### *Civil Remedies*

Civil  
remedies.

**52.** (1) A person who sustains any damage by reason of any acts described in section 48 or 49 may institute proceedings in the High Court to recover his damages, whether or not the person who committed those acts had been successfully prosecuted under that section.

(2) The court may, in addition to awarding damages under subsection (1), grant an injunction prohibiting a person from continuing any contravention of section 48 or 49.

### *Administration*

53. Except as otherwise provided in this Act, any communication with the registered owner of a mark may be validly made by sending the communication to his address, or to his address for service as recorded in the register. Communications.

54. The Minister may, by order, provide that reciprocal treatment of marks be given in relation to any country that provides similar protection to marks registered in Barbados, and to applications for registration of marks in Barbados, as are given by this Act. Reciprocity.

55. The Director may issue directions relating to practice and procedure in the registration of marks under this Act, and regarding the operations of the register generally, but subject to any regulations made under section 56. Directions.

56. The Minister may make regulations prescribing for any matters or things required to be prescribed or provided for under this Act, and generally, for the effective operation of this Act. Regulations.

57. (1) After 1st January, 1985, no marks may be registered or renewed under the *Trade Marks Act*.<sup>1</sup> Effect of former Act.

(2) A renewal of a mark registered under the *Trade Marks Act*<sup>1</sup> may be made under section 26.

(2.1) A reference in this Act to a mark registered under this Act or to an application pending under this Act for registration of a mark in any of the following provisions, namely, sections 3, 8(1)(a)(i), 20(1)(a) and (b), and 31, includes, as the circumstances require, 1984-20.

(a) the registration before 1st January, 1985, of a mark under the *Trade Marks Act*;<sup>1</sup>

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<sup>1</sup> means the former Trade Marks Act (1949-52) (Cap. 319) repealed by this Act.

(b) an application for registration of a mark pending under the *Trade Marks Act*<sup>1</sup>, on 1st January, 1985;

and this Act applies, *mutatis mutandis*, to a mark registered under Chapter 319 of the Laws of Barbados but without diminishing the rights acquired by virtue of registration under Chapter 319.

(3) Orders-in-Council made after 1st January, 1985, under the *Patents and Designs Act* of the United Kingdom 1907 and under the *Patents Act, 1949* of the United Kingdom do not extend to Barbados; and trade marks registered in the United Kingdom under the *Trade Marks Act* of the United Kingdom cease to be entitled to registration by virtue only of their having been so registered.

Binding  
Crown.

**58.** This Act is binding on the Crown.

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<sup>1</sup> means the former Trade Marks Act (1949–52) (Cap. 319) repealed by this Act.