



ANGUILLA

REVISED STATUTES OF ANGUILLA

CHAPTER T30

TRADEMARKS ACT

Showing the Law as at 15 December 2002

This Edition was prepared under the authority of the Revised Statutes and Regulations Act, R.S.A. c. R55 by the Attorney General as Law Revision Commissioner.

This Edition revises Act 8/2002, in force 12 August 2002 (except s. 34)

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TRADEMARKS ACT

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TRADEMARKS ACT

PART 1

PRELIMINARY

Definitions

1. (1) In this Act—

“Agent” means an agent approved and authorised by the Registrar to represent trademark proprietors before him or an Attorney-at-Law;

“Attorney-at-Law” means legal practitioner admitted to practice before the Eastern Caribbean Supreme Court in Anguilla;

“business” includes a trade or profession;

“certification mark” means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the trademark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics;

“collective mark” means a mark distinguishing the goods or services of members of the association which is the proprietor of the trademark from those of other undertakings;

“Community trademark” has the same meaning as in the Community Trademark Regulation;

“Community Trademark Regulation” means Council Regulation (EC) No. 40/94 of 20th December 1993 on the Community trademark (O.J. No. L11 14.1.94, p.1);

“Comptroller-General” means the Comptroller-General of Patents, Designs and Trademarks in the United Kingdom;

“Court” means the High Court;

“domain name” means any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet;

“infringing articles”, in relation to a registered trademark, means articles—

- (a) which are specifically designed or adapted for making copies of a sign identical or similar to that trademark; and
- (b) which a person has in his possession, custody or control, knowing or having reason to believe that they have been or are to be used to produce infringing goods or infringing material;

“infringing goods”, in relation to a registered trademark, means goods which bear, or the packaging of which bears, a sign identical or similar to that trademark and—

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

“infringing material”, in relation to a registered trademark, means material which bears a sign identical or similar to that trademark and either—

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way as to infringe the registered trademark; or
- (b) it is intended to be so used and such use would infringe the registered trademark;

“International Classification” means the classification established by the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Trademarks;

“Internet” means the worldwide system of computer networks;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property signed in Paris on the 20th day of March, 1883 as amended from time to time;

“prescribe” means prescribe under section 48(1)(a);

“register” means enter in the Register;

“Register” means the Register of Trademarks maintained pursuant to section 24;

“registered licensee” means any person who is for the time being registered as such under section 27;

“registered proprietor” means any person for the time being entered in the Register as a proprietor of the trademark;

“registered trademark” means a trademark that is currently entered in the Register;

“Registrar” means the Registrar of Trademarks appointed pursuant to section 2 and “his seal”, in relation to the Registrar, means a seal prepared under that section;

“Regulations” means regulations made under section 48, but for greater certainty, does not include regulations referred to in section 5(2)(b), relevant filed regulations, the Community Trademark Regulation or regulations made under section 34(5);

“relevant filed regulations” means—

- (a) in relation to a collective mark, the regulations governing the use of that trademark which have been filed with the Comptroller-General in accordance with paragraph 5 of Schedule 1 to the Trade Marks Act 1994 (UK); and
- (b) in relation to a certification mark, the regulations governing the use of that trademark which have been filed with the Comptroller-General in accordance with paragraph 6 of Schedule 2 to the Trade Marks Act 1994 (UK);

“trademark” means—

- (a) any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings;
- (b) a collective mark; or
- (c) a certification mark;

and may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging;

“trade name” means the name or designation identifying and distinguishing an enterprise;

“United Kingdom register of trademarks” means the register of trademarks maintained pursuant to section 63 of the Trade Marks Act 1994 (UK).

(2) References in this Act to use (or to any particular description of use) of a trademark, or of a sign identical with, similar to, or likely to be mistaken for a trademark, include use (or that description of use) otherwise than by means of a graphic representation.

(3) A reference in this Act to an enactment (including any enactment of the United Kingdom) is a reference to that enactment as amended, and includes a reference to that enactment as extended or applied by or under any other enactment, including any other provision of this Act.

PART 2

REGISTERED TRADEMARKS

Registrar and other officers

2. (1) The Registrar of Companies shall be the Registrar of Trademarks.

(2) The Registrar may direct a seal or seals to be prepared for the authentication of documents required for or in connection with the registration of trademarks.

(3) Any functions of the Registrar under this Act may, to the extent authorised by him, be exercised by any officer on his staff.

Acquisition of the exclusive right to a trademark

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

Registrability

4. A trademark cannot be validly registered—

- (a) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) if it is contrary to public order or morality;
- (c) if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (d) if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation;
- (e) if it is identical with, or confusingly similar to, or constitutes a translation of, a trademark or trade name which is well known in Anguilla for identical or similar goods or services of another enterprise;
- (f) if it is well known and registered in Anguilla for goods or services which are not identical or similar to those in respect of which registration is applied for, if, in the latter case, use of the trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known trademark and that the interests of the owner of the well-known trademark are likely to be damaged by such use; or
- (g) if it is identical with a trademark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a trademark as to be likely to deceive or cause confusion.

Application for registration

5. (1) Every application for registration of a trademark shall be filed with the Registrar and shall be subject to the payment of the prescribed fee.

(2) Every application—

- (a) shall contain—
 - (i) a request,
 - (ii) reproduction of the trademark, and

- (iii) a list of the goods or services for which registration of the trademark is requested, listed under the applicable class or classes of the International Classification; and
- (b) in the case of an application for registration of a collective mark or certification mark, shall designate the mark as a collective mark or certification mark and shall be accompanied by a copy of the regulations governing the use of the collective mark or certification mark.

Priority

6. (1) An application for registration of a trademark may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or his predecessor in title.

(2) Where an application contains a declaration under this section, the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application certified as correct by the registry with which it was filed.

(3) The effect of the declaration shall be as provided in the Paris Convention.

(4) Where the Registrar finds that the requirements under this section and the Regulations have not been fulfilled, the declaration shall be considered not to have been made.

Withdrawal

7. An applicant for the registration of a trademark may withdraw the application at any time during its pendency.

Examination

8. (1) The Registrar shall—

- (a) examine whether the application complies with the requirements of section 4 and the Regulations; and
- (b) examine and determine whether the mark is a trademark and is registrable under section 4.

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

Opposition

9. (1) Any person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the trademark on the grounds that one or more of the requirements of the definitions of trademark and section 4 and the Regulations are not fulfilled.

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

(3) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, shall decide whether the trademark should be registered.

Rights before registration

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

Registration of trademark

- 11.** Where the Registrar finds that the conditions referred to in section 8 are fulfilled, and either—
- (a) the registration of the trademark has not been opposed within the prescribed time limit; or
 - (b) the registration of the trademark has been opposed and the opposition has been decided in the applicant's favour;

he shall register the trademark, publish as prescribed a reference to the registration and issue to the applicant a certificate of registration. Otherwise, he shall refuse the application.

Rights conferred by registration

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

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

(3) The rights conferred by registration of a trademark shall not extend to acts in respect of articles which have been put on the market in Anguilla by the registered owner or with his consent.

Duration and renewal

13. (1) The registration of a trademark shall be for a period of 10 years from the filing date of the application for registration.

(2) The registration of a trademark may, upon request, be renewed for consecutive periods of 10 years, if the registered owner pays the prescribed renewal fee.

(3) A grace period of 6 months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation

14. (1) Any person may request the Registrar to invalidate the registration of a trademark.

(2) The Registrar shall invalidate the registration if the person requesting the invalidation proves that the mark is not a validly registered trademark.

(3) In addition to the grounds provided in subsection (2), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in section 5(2)(b) or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

(4) Any invalidation of a registration of a trademark shall be deemed to have been effective as of the date of registration, and the Registrar shall record and publish a reference thereto as soon as possible.

Removal on grounds of non-use

15. Any interested person may request the Registrar to remove a trademark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to 1 month prior to filing the request the trademark had, after its registration, not been used by the registered owner or a licensee during a continuous period of 3 years or longer, but a trademark shall not be removed if it is shown that special circumstances prevented the use of the trademark and that there was no intention not to use or to abandon the same in respect of those goods or services.

Collective marks

16. (1) Subject to subsection (2), sections 3 to 15 shall apply to collective marks except that references therein to trademarks shall be read as references to collective marks.

(2) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to section 5(2)(b).

Licensing of trademarks

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

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

Trade names

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

(2) Notwithstanding any Act or regulation providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act

committed by third parties. In particular, any subsequent use of the trade name by a third party whether as a trade name or a trademark or collective mark, or any such use of a similar trade name or trademark, likely to mislead the public, shall be deemed unlawful.

Changes in ownership

19. (1) Any change in the ownership of the registration of a trademark, or in the ownership of an application therefor, shall be in writing and shall, at the request of any interested party made to the Registrar, be recorded and, except in the case of an application, published by the Registrar. Such change shall have no effect against third parties until such recording is effected.

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

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

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

(5) Any licence contract concerning a registered trademark, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish as prescribed a reference thereto. The licence contract shall have no effect against third parties until such recording is effected.

Agents

20. Where an applicant's ordinary residence or principal place of business is outside Anguilla, he shall be represented by an Agent resident in Anguilla.

Correction of errors; extension of time

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

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

Exercise of discretionary power

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

Competence of Court; appeals

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

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

Register of Trademarks

24. (1) There shall be maintained at the Register of Companies a Register of Trademarks in which there shall be entered—

- (a) all trademarks together with the names and addresses of their proprietors;
- (b) particulars of assignments and transmissions of registered trademarks;
- (c) the names and addresses of all registered licensees; and
- (d) such other matters relating to trademarks as may be prescribed or as the Registrar may think fit.

(2) Save as may otherwise be prescribed, the Register shall, at all convenient times, be open to inspection by the public and certified copies of any entry in the Register shall be given to any person requiring them on payment of the prescribed fee.

(3) The Register shall be *prima facie* evidence of any matters required or authorised by or under this Act to be entered therein.

(4) No notice of any trust, whether express, implied or constructive, shall be entered in the Register and the Registrar shall not be affected by any such notice.

PART 3

REGISTRATION OF TITLE TO UK TRADEMARKS

Registration of title to UK trademarks

25. (1) Any person for the time being entered in the United Kingdom register of trademarks as the proprietor of a trademark may apply to the Registrar for the registration of that trademark in respect of the goods or services comprised in the United Kingdom registration.

(2) A person who—

- (a) has become entitled by assignment, transmission or other operation of law to the privileges and rights conferred on a registered proprietor under this Act; and

- (b) has obtained registration in the United Kingdom of such title in accordance with the law for the time being in force in the United Kingdom;

may apply to the Registrar for the registration of such title.

(3) Every application under this section shall—

- (a) be made in such manner as may be prescribed;
- (b) be supported by a certificate of the Comptroller-General setting forth the title of the applicant to the trademark; and
- (c) in the case of an application under subsection (1), be accompanied by a certified representation of the trademark.

(4) Where an application under this section is for the registration of a certification mark or a collective mark, the application shall be accompanied by a copy of the relevant filed regulations amended where necessary to enable an authorised user of the trademark to use the trademark in Anguilla.

(5) A trademark cannot be validly registered and may be refused by the Registrar on the ground that it—

- (a) contains or consists of a geographical name, or a surname, connected with Anguilla;
- (b) contains or consists of the Anguilla flag or the official Anguilla crest unless it appears to the Registrar that consent has been given by or on behalf of the Governor and in such a case the registration of the trademark shall not give rise to exclusive rights as established in section 12 in the use of the Anguilla flag or the official Anguilla crest;
- (c) is identical with, or is an imitation of, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, the Government of Anguilla or any intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of the Government or organisation; or
- (d) is identical with, or confusingly similar to, or constitutes a translation of, a trademark or trade name which is well known in Anguilla for identical or similar goods or services of another enterprise.

(6) Subject to subsections (7) to (9), on the receipt of an application under this section together with the documents required to accompany that application, the Registrar shall register the title and issue a certificate of registration.

(7) Except under subsection (5), where it appears doubtful to the Registrar whether the application should be granted, or where any question arises in relation to the application, he may seek evidence and make such enquiries as he considers necessary.

(8) Where after such enquiries the Registrar is doubtful whether the application should be granted, or where any question arises in relation to the application, he shall present a statement of the matter in question to the Governor in Council for the directions of the Court, and the Court may order

such persons to be convened, such evidence to be taken and such enquiries to be made as it considers necessary.

(9) Subject to rules of Court, the Court shall determine whether any application referred to it should be granted, and if granted, the Registrar shall register the title and issue a certificate of registration accordingly.

(10) Where the application relates to a trademark which is associated with another trademark registered in the name of a proprietor other than the applicant, the Registrar shall not register the title unless the applicant applies at the same time to register the other trademark.

Renewal of registration

26. (1) Where a trademark has been registered under this Part and its registration in the United Kingdom has been renewed, the registered proprietor may apply to the Registrar for registration of the renewal in such manner as may be prescribed, and the Registrar shall, on production of sufficient evidence of the renewal in the United Kingdom, register the renewal.

(2) Where the registration of a trademark has not been renewed and not less than 12 months have elapsed since the expiry of the period for which it was registered under section 42 of the Trade Marks Act 1994 (UK), the Registrar shall, having notified the registered proprietor, remove that trademark from the register of trademarks.

Registered licensees

27. (1) Where a trademark has been registered under this Part, any person for the time being granted a licence to use that trademark in the United Kingdom may apply to the Registrar for registration as a registered licensee of that trademark in respect of the goods or services comprised in the United Kingdom registration, being goods or services in respect of which the trademark is registered under this Act.

(2) Every application shall be made in such manner as may be prescribed and shall be supported by a certificate of the Comptroller-General relating to the United Kingdom registration.

(3) Subject to subsections (4) and (5), on the receipt of an application under this section, the Registrar shall register the applicant as a registered licensee of the trademark in respect of the goods or services for which the application is made and issue a certificate of registration.

(4) Where it appears doubtful to the Registrar whether the application should be granted, or where any question arises in relation to the application, he may seek evidence and make such enquiries as he considers necessary.

(5) Where after such enquiries the Registrar is doubtful whether the application should be granted, or where any question arises in relation to the application, he shall present a statement of the matter in question to the Governor in Council for the directions of the Court, and the Court may order such persons to be convened, such evidence to be taken and such enquiries to be made as it considers necessary.

(6) Subject to rules of Court, the Court shall determine whether any application referred to it should be granted, and if granted, the Registrar shall register the applicant and issue a certificate of registration accordingly.

Cancellation of registration and registration of change of name or address

- 28.** (1) The Registrar may, on request in writing made by the registered proprietor—
- (a) cancel the registration of a trademark, either wholly or as regards any particular goods or services in respect of which the trademark is registered; or
 - (b) enter in the Register any change of the name or address of the registered proprietor.
- (2) The Registrar may, on request in writing made by a registered licensee of a trademark, enter in the Register any change in his name or address.
- (3) Any notice or summons sent to the address notified to the Registrar in accordance with subsection (1) shall be deemed to be sufficiently served.

Effect of registration

29. (1) Subject to subsection (2), the rights and remedies conferred upon the registered proprietor or registered licensee of a registered trademark under this Act regarding the use of that trademark, in relation to the goods and services in respect of which it is registered, shall in respect of a trademark registered under this Part date from the date of issuance of registration in the United Kingdom and shall continue in force for so long only as the registration in the United Kingdom remains in force in respect of the goods or services for which the trademark is registered under this Act.

- (2) No action for infringement of a trademark shall be entertained and no offence under section 36 shall be committed—
- (a) in respect of any use of the trademark prior to its registration under this Act; or
 - (b) where the registration of the trademark in the United Kingdom has been renewed, unless such renewal has been registered in Anguilla.

Power of Court to revoke registration

- 30.** (1) A petition for the revocation of the registration of a trademark registered under this Part may be presented to the Court by—
- (a) the Attorney General or by any person who alleges that his interests have been prejudicially affected by such registration on the ground—
 - (i) that the trademark was registered on the application of a person not entitled under the provisions of this Act to make the application, or
 - (ii) which is set out in section 25(5); or
 - (b) the Attorney General or any person having a sufficient interest on the ground of any contravention of, or failure to observe, a condition registered in relation to that trademark.

(2) On the presentation of any petition under this section, the Court may, after considering the representations of any party to the proceedings, revoke the registration or dismiss the petition and the Registrar shall forthwith take such action as the order of the Court may require.

(3) In proceedings under this section, the Court may determine any question which it may consider necessary or expedient to determine in connection with the revocation of the registration.

Rectification of Register

31. (1) The Court may, on the application of the Attorney General or of any person having a sufficient interest, order the Register to be rectified in respect of a registration under this Part by the making of any entry therein or the variation or deletion of any such entry and the Registrar shall forthwith take such action as the order may require.

(2) In proceedings under this section, the Court may determine any question which it may be necessary or expedient to determine in connection with the rectification of the Register.

Adaptation of entries to UK registration

32. The Registrar may, either at the written request of a person having sufficient interest or of his own motion, make such amendment to or substitution of any entry in the Register as is necessary to bring it into conformity with the entry for the time being in respect of that trademark in the United Kingdom register of trademarks.

Amendment of filed regulations to be furnished to Registrar

33. Where the Comptroller-General has accepted the amendment of the regulations filed under section 5(2)(b) to which any registered collective mark or certification mark relates, the registered proprietor shall, within 6 weeks of such acceptance, furnish to the Registrar a copy of the amended regulations duly certified by the Comptroller-General, and, if he fails to do so, he is liable to a fine for each day during which the default continues.

PART 4

COMMUNITY TRADEMARKS

¹Community trademarks

34. (1) The provisions of the Community Trademark Regulation specified in the Schedule to this Act shall have full force and effect in Anguilla subject to the exceptions, adaptations and modifications specified in subsections (2) to (4).

(2) Unless the context otherwise requires, references to the Community Trademark Regulation or to any provision thereof shall be construed as references to the Regulation or provision as it has effect in Anguilla.

(3) In relation to Anguilla, references to a Community trademark court shall be construed as references to the Court and references to the Community trademark court of second instance shall be construed as references to the Court of Appeal.

(4) The Community Trademark Regulation shall be construed as if Anguilla were a Member State.

¹ This section was not in force as at 15/12/2002.

(5) The Governor in Council may by regulation make any provision he considers appropriate (including amending this Act) to give further effect to the Community Trademark Regulation and any amendments made thereto.

PART 5

ADMINISTRATION AND OTHER SUPPLEMENTARY PROVISIONS

Restrictions on recovery of damages for infringement of a registered trademark

35. (1) Damages shall not be awarded in proceedings for the infringement of a registered trademark against a defendant who proves that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the trademark was registered.

(2) A person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the trademark was registered by reason only of the application of the word “Registered” or any other word or words referring expressly or impliedly to registration unless the words “in Anguilla” followed the word “Registered” or the words “Registered in Anguilla” accompanied that other word or those other words.

(3) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of a registered trademark.

Infringement and offences

36. (1) Subject to the provisions of section 12(3), the performance of any of the acts referred to in section 12 in Anguilla by a person, other than the owner of the title of the trademark and without the agreement of the latter, shall constitute an infringement.

(2) On the request of the owner of the title of the trademark, or of a licensee if he has requested the owner to institute court proceedings for specific relief and the owner has refused or failed to do so, the Court may grant an injunction to prevent infringement, an imminent infringement or an unlawful act referred to in section 18(2) and may award damages and grant any other remedy provided for in the general law.

(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection (1) or an unlawful act as defined in section 18 is guilty of an offence and is liable to a fine of \$25,000 or to imprisonment for a term of 5 years or to both.

Remedy for groundless threats of infringement proceedings

37. (1) Where a person threatens another with proceedings for infringement of a registered trademark or a Community trademark other than—

- (a) the application of that trademark to goods or their packaging;
- (b) the importation of goods to which, or to the packaging of which, the trademark has been applied; or
- (c) the supply of services under the trademark;

any person aggrieved may bring proceedings in the Court for relief under this section.

(2) The relief available under this section is—

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) damages in respect of any loss sustained by the threats.

(3) The plaintiff is entitled to relief unless—

- (a) the defendant shows that the acts in respect of which proceedings were threatened constitute, or, if done, would constitute an infringement of the trademark concerned; and
- (b) the plaintiff is unable to show that the registration of the trademark is invalid or liable to be revoked in a relevant respect.

(4) The mere notification that a trademark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

Privilege for communications with trademark agents or professional representatives

38. (1) Any communication under this Act between a person and a person he has instructed—

- (a) as an Agent or Attorney-at-Law;
- (b) whose name is entered in the register of trademark agents kept under section 83 of the Trade Marks Act 1994 (UK); or
- (c) who is on the list of professional representatives maintained in pursuance of section 89 of the Community Trademark Regulation, in relation to the protection of any trademark or any matter involving passing off;

is privileged from disclosure in the same way as a communication between a person and his Attorney-at-Law.

(2) Any communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing a person described in subsection (1) in relation to the protection of any trademark or any matter involving passing off, is privileged from disclosure in the same way as a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his Attorney-at-Law.

Use of trademark for export trade

39. The application in Anguilla of a trademark to goods or services to be exported from Anguilla, and any other act done in Anguilla in relation to goods or services to be so exported which, if done in relation to goods or services to be sold or otherwise traded in within Anguilla, would constitute use of a trademark therein, shall be deemed to constitute use of the trademark in relation to those goods or services for any purpose for which such use is material under this Act or under the customary law.

Infringing goods may be treated as prohibited goods

40. (1) The proprietor or licensee of a registered trademark or Community trademark may give notice in writing to the Comptroller of Customs—

- (a) that he is the proprietor or a licensee of that trademark, as the case may be;
- (b) that, at a time and place specified in the notice, goods which are, in relation to the trademark, infringing goods being counterfeit and pirated goods are expected to arrive in Anguilla; and
- (c) that he requests the Comptroller of Customs to treat them as prohibited goods.

(2) Where a notice is in force under this section, any goods to which the notice relates which are imported otherwise than by a person for his private and domestic use shall be treated as prohibited.

Orders concerning the importation of infringing goods

41. The notice referred to in section 40 must—

- (a) be—
 - (i) in the form and subject to any conditions,
 - (ii) accompanied by security in the form and amount, and
 - (iii) an indemnity in the form,
required by the Registrar; and
- (b) be accompanied by the prescribed fee.

Power of Comptroller of Customs to disclose information

42. Where information relating to infringing goods has been obtained by the Comptroller of Customs for the purposes of, or in connection with, the exercise of his functions in relation to imported goods, he may authorise the disclosure of that information for the purpose of facilitating the exercise by any person of any function in connection with the investigation or prosecution of an offence under section 44 or any enactment relating to trade descriptions.

Falsification of Register

43. A person who—

- (a) makes or causes to be made—
 - (i) a false entry in the Register, or
 - (ii) anything falsely purporting to be a copy of an entry in that Register; or
- (b) produces or tenders or causes to be produced or tendered in evidence any such thing;

knowing or having reason to believe the entry or thing to be false, is liable to imprisonment for a term of 2 years or to a fine or to both.

False representations in respect of trademarks

44. (1) A person who—

- (a) falsely represents that a trademark is a registered trademark or a Community trademark; or
- (b) makes a false representation as to the goods or services for which such a trademark is registered;

knowing or having reason to believe the representation to be false, is liable to a fine of \$25,000.

(2) For the purposes of this section, the use in Anguilla in relation to a trademark of the words “Registered in Anguilla”, or of any other word or symbol referring, whether expressly or impliedly, to registration shall be deemed to import a reference to registration in the Register.

Forfeiture

45. (1) Where, in connection with the investigation or prosecution of a relevant offence—

- (a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trademark or Community trademark;
- (b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or
- (c) articles specifically designed or adapted for making copies of such a sign;

have come into the possession of any person, such person may apply to the Court for an order for the forfeiture of the goods, material or articles and where the Court is satisfied that such an offence has been committed, it shall make such an order.

(2) For the purposes of this section, the Court may infer that a relevant offence has been committed in relation to any goods, material or articles if it is satisfied that such an offence has been committed in relation to goods, material or articles which are representative of them, whether by reason of being of the same design or part of the same consignment or batch, or otherwise.

(3) Where any goods, material or articles are forfeited under this section, the Court shall—

- (a) direct that they be destroyed in accordance with such directions as it may give; or
- (b) if it considers it appropriate to do so, direct that they shall be released to such person it may specify, on condition that that person—
 - (i) causes the offending sign to be erased, removed or obliterated, and
 - (ii) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

- (4) In this section, “relevant offence” means—
- (a) an offence under section 36;
 - (b) an offence under any enactment relating to trades descriptions; or
 - (c) any offence involving dishonesty or deception.

PART 6

MISCELLANEOUS

Offences by partnerships and bodies corporate

46. (1) Proceedings for an offence under this Act alleged to have been committed by a partnership shall be brought against the partnership in the name of the firm and not that of the partners, but without prejudice to any liability of the partners under subsection (3).

(2) A fine imposed on a partnership on its conviction in proceedings for an offence under this Act shall be paid out of the partnership assets.

(3) Where a partnership is guilty of an offence under this Act, every partner, other than a partner who is proved to have been ignorant of or to have attempted to prevent the commission of the offence, is guilty of the offence and liable to be proceeded against and punished accordingly.

(4) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body corporate, or any person purporting to act in any such capacity, he (as well as the body corporate) is guilty of that offence and is liable to be proceeded against and punished accordingly.

Accessories and abettors

47. A person who aids, abets, counsels or procures the commission of an offence under this Act is liable to be dealt with, tried and punished as a principal offender.

Regulations

48. (1) The Governor in Council may make regulations for the purpose of carrying this Act into effect including regulations—

- (a) prescribing any matter which may be prescribed under this Act;
- (b) requiring the payment of fees in respect of any action that the Registrar is required or authorised to take under this Act, other than any action for which a fee is to be prescribed under paragraph (a), and prescribing their amount;
- (c) respecting the manner of filing of applications and other documents;
- (d) requiring and regulating the translation of documents and the filing and authentication of any translation;

- (e) respecting the service of documents.
- (2) Regulations made under subsection (1) may—
- (a) make different provision in relation to different cases or circumstances; and
 - (b) contain such incidental, supplementary or transitional provisions as the Governor in Council may consider necessary or expedient.

Saving of vested rights

49. Nothing in this Act shall entitle the registered proprietor or a registered licensee of a registered trademark to interfere with or restrain the use by any person of a trademark identical with or similar to it in relation to goods or services for which that person or a predecessor in title of his has continuously used that trademark from a date prior to the registration in the United Kingdom of the first-mentioned trademark in respect of those goods in the name of the registered proprietor or a predecessor in title of his.

Saving of rights of action for passing off

50. Nothing in this Act shall affect rights of action against any person for passing off or the remedies in respect thereof.

Application of treaties and international conventions

51. The provisions of any treaty or international convention in respect of trademarks which are extended to Anguilla shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, the treaty or international convention shall prevail over this Act.

Administrative instructions

52. The Registrar may issue administrative instructions relating to the procedures under this Act and the Regulations as well as to the other functions of the Financial Services Department or the Registrar.

Citation

53. This Act may be cited as the Trademarks Act, Revised Statutes of Anguilla, Chapter T30.

Transitional provisions

54. (1) Trademarks registered in accordance with the Trademarks Act (Cap. 192) (now repealed) shall be due for renewal within the same period as under this Act and, upon renewal, shall be reclassified in accordance with the International Classification.

(2) On 12th August 2002—

- (a) any registered trademark registered in accordance with the Trademarks Act (Cap. 192) (now repealed) or the Registration of United Kingdom Trademarks Act (Cap. 191) (now repealed), before 12th August 2002, shall have effect as if registered under this Act;
- (b) an application for the registration of a trademark made under the Trademarks Act (Cap. 192) (now repealed) or the Registration of United Kingdom Trademarks Act

(Cap. 191) (now repealed) and not yet determined shall be treated as an application under section 5 or section 25 of this Act, as the case may be; and

- (c) a disclaimer or limitation or an assignment or transmission entered in the register of trademarks kept under Trademarks Act (Cap. 192) (now repealed) or the Registration of United Kingdom Trademarks Act (Cap. 191) (now repealed) shall have effect as if entered in the Register maintained under section 24 of this Act.

Commencement

55. (1) Subject to subsection (2), this Act came into force on 12th August 2002.

(2) Section 34 shall come into force on the date of publication of a notice providing for the reciprocal treatment for Community trademarks in the Official Journal pursuant to Rule 101 of Commission Regulation (EC) 2868/95.

SCHEDULE

(Section 34)

**PROVISIONS OF COMMUNITY TRADEMARK REGULATION
APPLIED TO ANGUILLA****TITLE I: GENERAL PROVISIONS**

Article 1 (Community trademark)

Article 3 (Capacity to act)

TITLE II: THE LAW RELATING TO TRADEMARKS

Article 9 (Rights conferred by a Community trademark)

Article 10 (Reproduction of Community trademarks in dictionaries)

Article 11 (Prohibition on the use of a Community trademark registered in the name of an agent or representative)

Article 12 (Limitation of the effects of a Community trademark)

Article 13 (Exhaustion of the rights conferred by a Community trademark)

Article 14 (Complementary application of national law relating to infringement)

Article 15 (Use of Community trademarks)

Article 16 (Dealing with Community trademarks as national trademarks)

Article 19 (Rights in rem), except paragraph 2

Article 22 (Licensing), except—

in paragraph 1, the words “and for the whole or part of the Community”;

paragraph 5

Article 23 (Effects vis-à-vis third parties), except—

in paragraph 1 the words “17” and “in all the Member States”;

paragraphs 3 and 4

TITLE VI: SURRENDER, REVOCATION AND INVALIDITY

Article 53 (Limitation in consequence of acquiescence)

Article 54 (Consequences of revocation and invalidity)

TITLE VIII: COMMUNITY COLLECTIVE MARKS

Article 64 (Community collective marks), except paragraphs 2 and 3

Article 70 (Persons who are entitled to bring an action for infringement)

TITLE IX: PROCEDURE

Article 86 (Administrative cooperation), except—

in the first sentence the words “the Office and”

the second sentence

TITLE X: JURISDICTION AND PROCEDURE IN LEGAL ACTIONS
RELATING TO COMMUNITY TRADEMARKS

Article 92 (Jurisdiction over infringement and validity), except paragraph (d)

Article 95 (Presumption of validity - Defence as to the merits), except—

in paragraph 1, the words from “unless” to the end of the paragraph;

paragraph 3

Article 97 (Applicable law)

Article 98 (Sanctions)

Article 99 (Provisional and protective measures), except—

in paragraph 1 the words “or Community trademark application”

paragraph 2

Article 100 (Specific rules on related actions), except paragraph 2

Article 101 (Jurisdiction of Community trademark courts of second instance - Further appeal)

Article 103 (Obligation of the national Court)

TITLE XI: EFFECTS ON THE LAWS OF MEMBER STATES

Article 105 (Simultaneous and successive civil actions on the basis of Community trademarks and national trademarks)

Article 106 (Prohibition of use of Community trademarks), except paragraph 1

Article 107 (Prior rights applicable to particular localities)

TITLE XIII: FINAL PROVISIONS

Article 142 (Compatibility with other Community legal provisions)
