



MONTSERRAT

CHAPTER 15.23

TRADE MARKS ACT and Subsidiary Legislation

Revised Edition

showing the law as at 1 January 2013

This is a revised edition of the law, prepared by the Law Revision Commissioner under the authority of the Revised Edition of the Laws Act.

This edition contains a consolidation of the following laws—

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TRADE MARKS ACT

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CHAPTER 15.23

TRADE MARKS ACT

(Acts 19 of 1999, 7 of 2000 and 9 of 2011)

AN ACT TO CONSOLIDATE AND UPDATE THE LAW RELATING TO TRADE MARKS; AND FOR CONNECTED PURPOSES.

Commencement

[28 February 2000]

PART 1

PRELIMINARY

Short title

1. This Act may be cited as the Trade Marks Act.

Interpretation

2. (1) In this Act—

“**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 mark;

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

“**court**” means the High Court;

“**Registrar**” means the person appointed by the Governor to be the Registrar of Trade Marks;

“**trade mark**” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

(2) References to a trade mark include, unless the context otherwise requires, references to a collective mark and a certification mark.

(3) References to “**this Act**” or to the provisions of this Act include references to any rules, orders or regulations made thereunder.

PART 2

REGISTRATION OF TRADE MARKS

Application for registration

3. (1) An application for registration of a trade mark shall be made to the Registrar.

(2) The application shall contain—

- (a) a request for registration of the trade mark;
- (b) the name and address of the applicant;
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark; and
- (d) a representation of the trade mark.

(3) The application shall state that the trade mark is being used by the applicant, or, with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.

(4) The application shall be subject to the payment of the application fee and such class fees as may be appropriate.

Date of filing

4. (1) The date of filing of an application for registration of a trade mark is the date on which documents containing everything required by section 3(2), and, in the case of collective marks or certification marks everything additionally required by sections 39 and 48 is furnished to the Registrar by the applicant.

(2) If the documents are furnished on different days, the date of filing is the last of those days.

(3) References in this Act to the date of application for registration are to the date of filing of the application.

Classifications of trade marks

5. (1) Goods and services shall be classified for the purposes of the registration of trade marks according to a prescribed system of classification.

(2) Any question arising as to the class within which any goods or services fall shall be determined by the Registrar, whose decision shall be final.

Examination of application

6. (1) The Registrar shall examine whether an application for registration of a trade mark satisfies the requirements of this Act, and, if it appears to the Registrar that the requirements are not met, he shall inform

the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to amend the application.

(2) If the applicant fails to satisfy the Registrar that those requirements are met, or to amend the application so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse to accept the application.

(3) If it appears to the Registrar that the requirements for registration are met, he shall accept the application.

Unregistrable marks: similarity

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

- (a) subject to subsection (2), a trade mark that—
 - (i) resembles, in such a way as to be likely to mislead the public, a trade 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 an Order made under section 34 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 trade mark that resembles, in such a way as to be likely to mislead the public, an unregistered mark in use in Montserrat 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 trade mark that resembles, in such a way as to be likely to mislead the public, a business name registered under the Registration of Business Name Act and in use in Montserrat by another person, if the applicant is aware or could not reasonably have been unaware of the earlier use;
- (d) subject to subsection (2), a trade mark that, with regard to another trade mark or trade-name, constitutes a reproduction, in whole or in part, or an imitation, translation or description of that other trade mark or trade-name, if the other mark or the trade-name—
 - (i) is well known in Montserrat;
 - (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 trade mark that infringes the interest of another person or the use of which is an offence under this Act;
- (f) a trade 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) A trade mark referred to in subsection (1)(b), (c), (d) or (e) may be registered under this Act if the persons whose rights will be or are likely to be infringed by the registration give their consent to the registration.

Unregistrable marks: inherent defects

8. (1) The following trade marks may not be registered under this Act—

- (a) any trade mark which consists exclusively of signs or indications which may serve in trade to designate the kind, quality, intended purpose, value, geographical origin, the time of production of the goods or of rendering of services or other characteristics of goods or services;
- (b) subject to subsection (2), any trade 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 or origin of, or time of supply of, the goods or service to which the mark relates;
- (c) subject to subsection (2), any trade 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 Montserrat, a customary designation of the goods or service to which the trade mark relates;
- (d) subject to subsection (2), any trade mark by the use of which it is for other reasons impossible to distinguish the goods or service of one business enterprise from those of another business enterprise, unless those business enterprises are using the trade mark as a collective mark to which they are entitled;
- (e) any trade mark that offends public morals or the use of which is likely to provoke a breach of the peace;
- (f) any trade 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 trade mark relates;

- (g) any trade 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, a service mark or collective mark, as the case requires;
- (h) any trade mark that is a reproduction or imitation of an official sign or hallmark adopted by a county, 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 trade mark that resembles, in such a way as to be likely to mislead the public, a collective mark—
 - (i) the registration or 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 three year period immediately before the application to register the trade mark is made under this Act.

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

Registration Procedure

Publication, opposition proceedings and observations

9. (1) When an application for registration has been accepted, the Registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice in writing to the Registrar of opposition to the registration, stating the grounds of opposition.

(3) Where an application has been published, any person may, at any time before the registration of the trade mark, make observations in writing to the Registrar as to whether the trade mark should be registered; and the Registrar shall inform the applicant of any such observations.

Withdrawal, restriction or amendment of application

10. (1) The applicant may at any time withdraw his application or restrict the goods or services covered by the application.

(2) If the application for registration was published, the withdrawal or restriction shall also be published.

(3) In other respects, an application may be amended, at the request of the applicant, only by correcting—

- (a)* the name or address of the applicant;
- (b)* errors of wording or of copying; or
- (c)* obvious mistakes, and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or service covered by the application.

(4) Provision shall be made by Rules for the publication of any amendment which affects the representation of the trade mark, or the goods or services covered by the application, and the making of objections by any person claiming to be affected by it.

Registration

11. (1) Where an application has been accepted and—

- (a)* no notice of opposition is given within the period referred to in section 9(2); or
- (b)* all opposition proceedings are withdrawn or decided in favour of the applicant,

the Registrar shall register the trade mark, unless it appears to him having regard to matters coming to his notice since he accepted the application that it was accepted in error.

(2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period.

(3) If the fee is not paid within that period, the application shall be deemed to be withdrawn.

(4) A trade mark when registered shall be registered as of the date of filing of the application for registration; and that date shall be deemed for the purposes of this Act to be the date of registration.

(5) On the registration of a trade mark the Registrar shall publish the registration in the prescribed manner and issue to the applicant a certificate of registration.

Registration: supplementary provisions

12. (1) Provision may be made by Rules as to—

- (a) the division of an application for the registration of a trade mark into several applications;
- (b) the merging of separate applications or registrations;
- (c) the registration of a series of trade marks.

(2) A series of trade marks means a number of trade marks which resemble each other as to their material particulars and which differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark.

(3) Rules under this section may include provision as to—

- (a) the circumstances in which, and conditions subject to which, division, merger or registration of a series is permitted; and
- (b) the purposes for which an application to which the Rules apply is to be treated as a single application and those for which it is to be treated as a number of separate applications.

Effects of Registered Trade Marks

Rights conferred by registered trade mark

13. (1) A registered trade mark is a property right obtained on registration under this Act.

(2) The proprietor of a registered trade mark has exclusive rights in the trade mark, which rights are infringed by use of the trade mark in Montserrat without his consent.

(3) The rights of the proprietor have effect from the date of registration (which in accordance with section 11(4) is the date of filing of the application for registration):

Provided that—

- (a) no infringement proceedings may be begun before the date on which the trade mark is in fact registered; and
- (b) no offence under section 78 is committed by anything done before the date of publication of the registration.

Local exception

14. (1) Notwithstanding section 13, the registration under this Act of a trade mark does not vest in the owner of the trade mark the right to prevent the use by other persons of the mark in relation to goods lawfully sold in Montserrat if those goods have not undergone any change, including change attributable to aging or weather.

(2) For the purpose of this section “**lawfully sold in Montserrat**” means in relation to any goods or services, that those goods have been imported into Montserrat for sale, or have been purchased in Montserrat for

sale, in either case with the consent of the registered owner of the trade mark or his agent, or the goods have been so imported or purchased before the trade mark was registered in Montserrat.

Infringement of registered trade mark

15. (1) A person infringes a registered trade mark if he uses in the course of trade—

- (a) a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered;
- (b) a sign which—
 - (i) is identical with the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered; or
 - (ii) is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered,

and where as a result of such use there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark;

- (c) a sign which—
 - (i) is identical with or similar to the trade mark, and
 - (ii) is used in relation to goods or services which are not similar to those for which the trade mark is registered,

where the trade mark has a reputation in Montserrat and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

(2) For the purposes of this section a person uses a sign if, in particular, he—

- (a) affixes it to goods or the packaging thereof;
- (b) offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
- (c) imports or exports goods under the sign; or
- (d) uses the sign on business papers or in advertising.

(3) A person who applies a registered trade mark to material intended to be used for labelling or packaging goods, as a business paper, or for advertising goods or services, shall be treated as a party to any use of the material which infringes the registered trade mark if when he applied the mark he knew or had reason to believe that the application of the mark was not duly authorised by the proprietor or a licensee.

(4) Nothing in the preceding provisions of this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee but any such use otherwise than in accordance with honest practices in industrial or commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.

Limits on effect of registered trade mark

16. (1) A registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered.

(2) A registered trade mark is not infringed by—

- (a) the use by a person of his own name or address;
- (b) the use of indications concerning the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services; or
- (c) the use of the trade mark where it is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts),

provided that, the use is in accordance with honest practices in industrial or commercial matters.

Registered Trade Mark as Object of Property

Nature of registered trade mark

17. A registered trade mark is personal property.

Co-ownership of registered trade mark

18. (1) Where a registered trade mark is granted to two or more persons jointly, each of them is entitled, subject to any agreement to the contrary, to an equal undivided share in the registered trade mark.

(2) The following provisions apply where two or more persons are co-proprietors of a registered trade mark.

(3) Subject to any agreement to the contrary, each co-proprietor is entitled, by himself or his agents, to do for his own benefit and without the consent of or the need to account to the other or others, any act which would otherwise amount to an infringement of the registered trade mark.

(4) One co-proprietor may not without the consent of the other—

- (a) grant a licence to use the registered trade mark; or

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(b) assign or charge his share in the registered trade mark.

(5) Infringement proceedings may be brought by any co-proprietor, but he may not, without the leave of the court, proceed with the action unless the other, or others, is either joined as a plaintiff or added as a defendant.

(6) A co-proprietor who is thus added as a defendant shall not be made liable for any costs in the action unless he takes part in the proceedings.

(7) Nothing in this subsection affects the granting of interlocutory relief on the application of a single co-proprietor.

(8) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

Assignment of registered trade mark

19. (1) A registered trade mark is transmissible by assignment, testamentary disposition or operation of law in the same way as other personal or moveable property; and is so transmissible either in connection with the goodwill of a business or independently.

(2) An assignment or other transmission of a registered trade mark may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered.

(3) An assignment of a registered trade mark, or an assent relating to a registered trade mark, is not effective unless it is in writing signed by or on behalf of the assignor or, as the case may be, a personal representative.

(4) The above provisions apply to assignment by way of security as in relation to any other assignment.

(5) A registered trade mark may be the subject of a charge in the same way as other personal or moveable property.

(6) Nothing in this Act shall be construed as affecting the assignment or other transmission of an unregistered trade mark as part of the goodwill of a business.

Registration of transactions affecting registered trade mark

20. (1) On application being made to the Registrar by—

- (a) a person claiming to be entitled to an interest in or under a registered trade mark by virtue of a registrable transaction; or
- (b) any other person claiming to be affected by such a transaction,

the prescribed particulars of the transaction shall be entered in the register.

(2) The following are registrable transactions—

- (a) an assignment of a registered trade mark or any right in it;
 - (b) the grant of a licence under a registered trade mark;
 - (c) the granting of any security interest (whether fixed or floating) over a registered trade mark or any right in or under it;
 - (d) the making by personal representatives of an assent in relation to a registered trade or any right in or under it;
 - (e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it.
- (3) Until an application has been made for registration of the prescribed particulars of a registrable transaction—
- (a) the transaction is ineffective as against a person acquiring a conflicting interest in or under the registered trade mark in ignorance of it; and
 - (b) a person claiming to be a licensee by virtue of the transaction does not have the protection of section 32 or 33 (rights and remedies of licensee in relation to infringement).
- (4) Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction, then unless—
- (a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of six months beginning with its date; or
 - (b) the court is satisfied that it was not practicable for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter,
- he is not entitled to damages or an account of profits in respect of any infringement of the registered trade mark occurring after the date of the transaction and before the prescribed particulars of the transaction are registered.
- (5) Provision may be made by Rules as to—
- (a) the amendment of registered particulars relating to a licence so as to reflect any alteration of the terms of the licence; and
 - (b) the removal of such particulars from the register—
 - (i) where it appears from the registered particulars that the licence was granted for a fixed period and that period has expired, or
 - (ii) where no such period is indicated and, after such period as may be prescribed, the Registrar has notified the parties of his intention to remove the particulars from the register.

(6) Provision may also be made by Rules as to the amendment or removal from the register of particulars relating to security interest on the application of, or with the consent of, the person entitled to the benefit of that interest.

Duration, Renewal and Alteration of Registered Trade Mark

Duration of registration

21. (1) A trade mark shall be registered for a period of ten years from the date of registration.

(2) Registration may be renewed in accordance with section 22 for further periods of ten years.

Renewal of registration

22. (1) The registration of a trade mark may be renewed at the request of the proprietor, subject to the payment of such renewal fee as may be prescribed.

(2) Provision shall be made by Rules for the Registrar to inform the proprietor of a registered trade mark, before the expiry of the registration, of the date of expiry and the manner in which the registration may be renewed.

(3) A request for renewal must be made, and the renewal fee paid, before the expiry of the registration.

(4) Renewal shall take effect from the expiry of the previous registration.

(5) If the registration is not renewed in accordance with the above provisions, the Registrar shall remove the trade mark from the register.

(6) Provision may be made by Rules for the restoration of the registration of a trade mark which has been removed from the register, subject to such conditions as may be prescribed.

(7) The renewal or restoration of the registration of a trade mark shall be published in the prescribed manner.

Alteration of registered trade mark

23. (1) Subject to subsection (2) a registered trade mark shall not be altered in the register, during the period of registration or on renewal.

(2) The Registrar may, at the request of the proprietor, allow the alteration of a registered trade mark where the mark includes the proprietor's name or address and the alteration is limited to alteration of that name or address and does not substantially affect the identity of the mark.

(3) Provision shall be made by Rules for the publication of any such alteration and the making of objections by any person claiming to be affected by it.

Infringement Proceedings

Action for infringement

24. (1) An infringement of a registered trade mark is actionable by the proprietor of the trade mark.

(2) In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to him as is available in respect of the infringement of any other property right.

Order for erasure of offending sign

25. (1) Where a person is found to have infringed a registered trade mark, the court may make an order requiring him—

- (a) to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in question;
- (b) if it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

(2) If an order under subsection (1) is not complied with, or it appears to the court likely that such an order would not be complied with, the court may order that the infringing goods, material or articles be delivered to such person as the court may direct for erasure, removal or obliteration of the sign, or for destruction, as the case may be.

Order for delivery up of infringing goods, material or articles

26. (1) The proprietor of a registered trade mark may apply to the court for an order for the delivery up to him, or such other person as the court may direct, of any infringing goods, material or articles which a person has in his possession, custody or control in the course of a business.

(2) An application shall not be made after the end of the period specified in section 28 and no order shall be made unless the court also makes, or it appears to the court that there are grounds for making an order under section 29.

(3) A person to whom any infringing goods, material or articles are delivered up in pursuance of an order under this section shall, if an order under section 29 is not made, retain them pending the making of an order, or the decision not to make an order, under that section.

(4) Nothing in this section affects any other power of the court.

Meaning of “infringing goods, material or articles”

27. (1) In this Act the expressions “**infringing goods**”, “**infringing material**” and “**infringing articles**” shall be construed in accordance with this section.

(2) Goods are “**infringing goods**”, in relation to a registered trade mark if they or their packaging bear a sign identical or similar to that mark and—

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

(3) Material is “**infringing material**”, in relation to a registered trade mark if it bears a sign identical or similar to that mark and either—

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

(4) “**Infringing articles**”, in relation to a registered trade mark, means articles—

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

Period after which remedy of delivery up not available

28. (1) An application for an order under section 26 may not be made after the end of the period of six years from—

- (a) in the case of infringing goods, the date on which the trade mark was applied to the goods or their packaging;
- (b) in the case of infringing material, the date on which the trade mark was applied to the material; or
- (c) in the case of infringing articles, the date on which they were made,

except as mentioned in the following provisions.

(2) If during the whole or part of that period the proprietor of the registered trade mark—

(a) is under a disability; or

(b) is prevented by fraud or concealment from discovering the facts entitling him to apply for an order,

an application may be made at any time before the end of the period of six years from the date on which he ceased to be under a disability or, as the case may be, could with reasonable diligence have discovered those facts.

Order as to disposal of infringing goods, material or articles

29. (1) Where infringing goods, materials or articles have been delivered up in pursuance of an order under section 26, an application may be made to the court—

(a) for an order that they be destroyed or forfeited to such person as the court may think fit; or

(b) for a decision that no such order should be made.

(2) In considering what order (if any) should be made, the court shall consider whether other remedies available in an action for infringement of the registered trade mark would be adequate to compensate the proprietor and any licensee and protect their interests.

(3) Provision shall be made by Rules of court as to the service of notice on persons having an interest in the goods, material or articles, and any such person is entitled—

(a) to appear in proceedings for an order under this section, whether or not he was served with notice; and

(b) to appeal against any order made,

whether or not he appeared;

and an order shall not take effect until the end of the period within which notice of an appeal may be given or, if before the end of that period notice of appeal is duly given, until the final determination or abandonment of the proceedings on the appeal.

(4) Where there is more than one person interested in the goods, material or articles, the court shall make such order as it thinks just.

(5) If the court decides that no order should be made under this section, the person in whose possession, custody or control the goods, material or articles were before being delivered up is entitled to their return.

Licensing

Licensing of registered trade mark

30. (1) A licence to use a registered trade mark may be general or limited.

(2) A limited licence may, in particular, apply—

(a) in relation to some but not all of the goods or services for which the trade mark is registered; or

(b) in relation to use of the trade mark in a particular manner or a particular locality.

(3) A licence is not effective unless it is in writing signed by or on behalf of the grantor.

(4) Unless the licence provides otherwise, it is binding on a successor in title to the grantor's interest.

(5) Where the licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee shall be construed accordingly.

Exclusive licences

31. (1) In this Act an “**exclusive licence**” means a licence (whether general or limited) authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a registered trade mark in the manner authorised by the licence.

(2) An exclusive licensee has the same rights against a successor in title who is bound by the licence as he has against the person granting the licence.

General provisions as to rights of licensees in case of infringement

32. (1) This section has effect with respect to the rights of a licensee in relation to infringement of a registered trade mark.

(2) The provisions of this section do not apply where or to the extent that, by virtue of section 33, the licensee has a right to bring proceedings in his own name.

(3) A licensee is entitled, unless his licence, or any licence through which his interest is derived, provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests.

(4) If the proprietor—

(a) refuses to do so; or

(b) fails to do so within two months after being called upon,

the licence may bring the proceedings in his own name as if he were the proprietor.

(5) Where infringement proceedings are brought by a licensee by virtue of this section, the licensee may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

(6) This section does not affect the granting of interlocutory relief on an application by a licensee alone.

(7) A proprietor who is added as a defendant as mentioned in subsection (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(8) In infringement proceedings brought by the proprietor of a registered trade mark any loss suffered or likely to be suffered by licensees shall be taken into account; and the court may give such directions as it thinks fit as to the extent to which the plaintiff is to hold the proceeds of any pecuniary remedy on behalf of licensees.

(9) The provisions of this section apply in relation to an exclusive licensee if or to the extent that he has, by virtue of section 31(1), the rights and remedies of an assignee as if he were the proprietor of the registered trade mark.

Exclusive licensee having rights and remedies of assignee

33. (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by the licence, the same rights and remedies in respect of matters occurring after the grant of the licence as if the licence had been an assignment.

(2) Where or to the extent that such provision is made, the licensee is entitled, subject to the provisions of the licence and to the following provisions of this section, to bring infringement proceedings, against any person other than the proprietor, in his own name.

(3) Any such rights and remedies of an exclusive licensee are concurrent with those of the proprietor of the registered trade mark; and references to the proprietor of a registered trade mark in the provisions of this Act relating to infringement shall be construed accordingly.

(4) In an action brought by an exclusive licensee by virtue of this section a defendant may avail himself of any defence which would have been available to him if the action had been brought by the proprietor of the registered trade mark.

(5) Where proceedings for infringement of a registered trade mark brought by the proprietor or an exclusive licensee relate wholly or partly to an infringement in respect of which they have concurrent rights of action, the proprietor or, as the case may be, the exclusive licensee may not, without the leave of the court, proceed with the action unless the other is either joined as a plaintiff or added as a defendant.

(6) The provisions of subsection (5) do not affect the granting of interlocutory relief on an application by a proprietor or exclusive licensee alone.

(7) A person who is added as a defendant as mentioned in subsection (6) shall not be made liable for any costs in the action unless he takes part in the proceedings.

(8) Where an action for infringement of a registered trade mark is brought which relates wholly or partly to an infringement in respect of which the proprietor and an exclusive licensee have or had concurrent rights of action—

- (a) the court shall in assessing damages take into account—
 - (i) the terms of the licence; and
 - (ii) any pecuniary remedy already awarded or available to either of them in respect of the infringement;
- (b) no account of profits shall be directed if an award of damages has been made, or an account of profits has been directed, in favour of the other of them in respect of the infringement; and
- (c) the court shall if an account of profits is directed, apportion the profits between them as the court considers just, subject to any agreement between them.

(9) The provisions of subsection (8) apply whether or not the proprietor and the exclusive licensee are both parties to the action; and if they are not both parties the court may give such directions as it thinks fit as to the extent to which the party to the proceedings is to hold the proceeds of any pecuniary remedy on behalf of the other.

(10) The proprietor of a registered trade mark shall notify any exclusive licensee who has a concurrent right of action before applying for an order under section 26; and the court may on the application of the licensee make such order under that section as it thinks fit having regard to the terms of the licence.

(11) The provisions of subsections (4) to (9) above have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

Priority

Claim to priority from other relevant overseas application

34. The Governor acting on the advice of Cabinet may by Order make provision for conferring on a person who has duly filed an application for protection of a trade mark in a country in relation to which Her Majesty's Government in the United Kingdom have entered into a treaty, convention, arrangement or engagement on behalf of Montserrat for the reciprocal

protection of trade marks, a right to priority, for the purpose of registering the same trade mark under this Act for some or all of the same goods or services, for a specified period from the date of filing of that application. (*Amended by Act 9 of 2011*)

Collective Marks

Collective marks

35. The application of the provisions of this Act to collective marks shall be subject to the provisions of sections 36 to 42.

Signs of which a collective mark may consist

36. In relation to a collective mark references in this Act to distinguishing goods or services of one undertaking shall be construed as a reference to distinguishing goods or services of members of the association which is the proprietor of the mark from those of other undertakings.

Indication of geographical origin

37. Notwithstanding section 8(1)(a), a collective mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters, in particular by a person who is entitled to use a geographical name.

Mark not to be misleading as to character or significance

38. A collective mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a collective mark.

Regulations governing use of collective mark

39. (1) An applicant for registration of a collective mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must specify the persons authorised to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark, including any sanctions against misuse.

Approval of regulations by Registrar

40. (1) A collective mark shall not be registered unless the regulations governing the use of the mark—

- (a) comply with section 39 and any further requirements imposed by Rules; and
- (b) are not contrary to public policy or to accepted principles of morality.

(2) Before the end of the prescribed period after the date of the application for registration of a collective mark, the applicant must file the regulations with the Registrar and pay the prescribed fee.

(3) If the provisions of subsection (2) are not complied with the application shall be deemed to be withdrawn.

(4) If it appears to the Registrar that the requirements for the registration of a collective mark are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(5) If the applicant fails to satisfy the Registrar that those requirements, and the other requirements for registration, are met, he shall accept the application.

Regulations to be open to inspection

41. The regulations governing the use of a registered collective mark shall be open to public inspection in the same way as the register.

Amendment of regulations

42. (1) An amendment of the regulations governing the use of a registered collective mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations the Registrar may, where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in section 39.

Certification Marks

Certification marks

43. The application of the provisions of this Act applying to certification marks shall be subject to the provisions of sections 44 to 52.

Signs of which a certification mark may consist

44. In relation to a certification mark references in this Act to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as a reference to distinguishing goods or services which are certified from those which are not.

Indication of geographical origin

45. Notwithstanding section 8(1)(a), a certification mark may be registered which consists of signs or indications which may serve, in trade, to designate the geographical origin of the goods or services, but the proprietor of such a mark is not entitled to prohibit the use of the signs or indications in accordance with honest practices in industrial or commercial matters (in particular, by a person who is entitled to use a geographical name).

Nature of proprietor's business

46. A certification mark shall not be registered if the proprietor carries on a business involving the supply of goods or services of the kind certified.

Mark not to be misleading as to character or significance

47. (1) A certification mark shall not be registered if the public is liable to be misled as regards the character or significance of the mark, in particular if it is likely to be taken to be something other than a certification mark.

(2) The Registrar may accordingly require that a mark in respect of which application is made for registration include some indication that it is a certification mark.

Regulations governing use of certification mark

48. (1) An applicant for registration of a certification mark must file with the Registrar regulations governing the use of the mark.

(2) The regulations must indicate who is authorised to use the mark, the characteristics to be certified by the mark, how the certifying body is to test those characteristics and to supervise the use of the mark, the fees (if any) to be paid in connection with the operation of the mark and the procedures for resolving disputes.

Approval of regulations

49. (1) A certification mark shall not be registered unless—

- (a)** the regulations governing the use of the mark—
 - (i)** comply with section 48(2) and any further requirements implied by Rules; and
 - (ii)** are not contrary to public policy or to accepted principles of morality; and
- (b)** the applicant is competent to certify the goods or services for which the mark is to be registered.

(2) Before the end of the prescribed period after the date of the application for registration of a certification mark, the applicant must file the regulations with the Registrar and pay the prescribed fee.

(3) If he does not do so, the application shall be deemed to be withdrawn.

(4) The Registrar shall consider whether the requirements mentioned in subsection (1) are met.

(5) If it appears to the Registrar that those requirements are not met, he shall inform the applicant and give him an opportunity, within such period as the Registrar may specify, to make representations or to file amended regulations.

(6) If the applicant fails to satisfy the Registrar that those requirements are met, or to file regulations amended so as to meet them, or fails to respond before the end of the specified period, the Registrar shall refuse the application.

(7) If it appears to the Registrar that those requirements, and the other requirements for registration, are met, he shall accept the application and shall proceed in accordance with section 9 (publication, opposition proceedings and observations).

(8) The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in subsection (1).

This is in addition to any other grounds on which the application may be opposed or observations made.

Regulations to be open to inspection

50. The regulations governing the use of a registered certification mark shall be open to public inspection in the same way as the register.

Amendment of regulations

51. (1) An amendment of the regulations governing the use of a registered certificate mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.

(2) Before accepting any amended regulations the Registrar may in any case where it appears to him expedient to do so cause them to be published.

(3) If he does so, notice of opposition may be given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

Consent to assignment of registered certification mark

52. The assignment or other transmission of a registered certification mark is not effective without the consent of the Registrar.

PART 3

REGISTRATION OF UNITED KINGDOM TRADE MARKS

Application for registration

53. (1) Any person, being the proprietor of a United Kingdom trade mark or of a registrable interest may apply to the Registrar in accordance with the provisions of this Part to register the trade mark or registrable interest as the case may be.

(2) For the purpose of this Part—

- (a)* United Kingdom Trade Marks Act means the Trade Marks Act 1994 of the United Kingdom and any law amending or substituted for the same;
- (b)* registrable interest means any interest arising from a transaction involving a trade mark registered under the United Kingdom Trade Marks Act, which interest is also registered under that Act;
- (c)* United Kingdom trade mark means any trade mark registered under the United Kingdom Trade Marks Act and any trade mark which, by virtue of any law in force in the United Kingdom is deemed to be a trade mark registered in the United Kingdom or which could, though not in fact registered in the United Kingdom, be given effect to in the United Kingdom.

Provisions of Act to apply

54. The provisions of this Act apply to United Kingdom trade marks subject to the provisions of this Part.

Procedure on application

55. An application for registration under this Part shall be made to the Registrar and accompanied by a certified representation of the trade mark or registrable interest giving full particulars of the registration of the trade mark in the United Kingdom.

Issue of certificate

56. Upon such application being lodged, together with the documents mentioned in section 55 the Registrar shall enter the prescribed particulars in the register and shall issue a certificate of registration to the applicant who shall then be the registered proprietor in Montserrat of the trade mark or registrable interest in respect of the goods entered in the register.

Privileges of proprietor

57. Subject to the provisions of this Act, a proprietor registered under this Part shall have in Montserrat such privileges and rights in the use of the trade mark in respect of the goods entered in the register as *mutatis mutandis* would be conferred on him by the law in force in the United Kingdom.

Duration of privileges

58. The privileges and rights conferred by section 57 shall date from the date of registration in the United Kingdom and shall continue in force, subject to the provisions of this Act, for so long as the registration in the United Kingdom remains in force in respect of the goods for which the trade mark is registered in Montserrat:

Provided that, no action for infringement of the trade mark shall be entertained in respect of any use of the trade mark prior to the date of the issue of the certificate of registration in Montserrat.

Powers of Court

59. The Court shall have power, upon the application of any person who alleges that his interests have been prejudicially affected by the issue of a certificate of registration, to declare on any of the grounds on which the United Kingdom registration might be cancelled under the law of the United Kingdom that the exclusive privileges and rights have not been acquired by the applicant.

Assignment of privileges

60. Subject to the provisions of this Act, where a person becomes entitled by assignment or other mode of transfer to the privileges and rights conferred by a certificate of registration issued under this Act, the Registrar shall, on application being made in the prescribed manner, and on proof of title to his satisfaction, cause such person to be entered on the register as subsequent registered proprietor of the trade mark.

Application by United Kingdom registered user to be registered in Montserrat

61. (1) Any person entered in the United Kingdom Register of Trade Marks as a registered user in respect of which a certificate of registration under this Act is in force, may apply to be registered in Montserrat as a registered user of the mark in respect of some or all of such goods, subject to any conditions or restrictions entered in the United Kingdom Register.

(2) Upon such application being lodged together with a certificate of the United Kingdom Registrar of Trade Marks giving full particulars of the entry in the United Kingdom Register, the Registrar shall cause the applicant to be entered in the register as a registered user of the trade mark, and on such entry the registered user shall be entitled in Montserrat, subject

to the aforesaid conditions and restrictions, to such privileges and rights in respect of the goods for which he is entered as *mutatis mutandis* would be conferred on him by the law for the time being in force in the United Kingdom.

Renewal of registration

62. (1) If the registration in the United Kingdom of a trade mark registered under this Act is renewed, the registered proprietor may, within three months after the date of renewal in the United Kingdom or such further period as may be prescribed, notify the Registrar who shall then, on sufficient evidence thereof and on payment of the prescribed fee, renew the registration in the register in the prescribed manner.

(2) If the registration in the register is not so renewed it shall be cancelled by the Registrar.

PART 4

ADMINISTRATION AND SUPPLEMENTARY PROVISIONS

The Register

The register

63. (1) The Registrar shall maintain a register of trade marks.

(2) There shall be entered in the register in accordance with this Act—

- (a) registered trade marks;
- (b) such particulars as may be prescribed of registrable transactions affecting a registered trade mark; and
- (c) such other matters relating to registered trade marks as may be prescribed.

(3) The register shall be kept in such manner as may be prescribed, and provision shall in particular be made for—

- (a) public inspection of the register; and
- (b) the supply of certified or uncertified copies, or extracts, of entries in the register.

Rectification or correction of the register

64. (1) Any person having a sufficient interest may apply for the rectification of an error or omission in the register:

Provided that, an application for rectification may not be made in respect of a matter affecting the validity of the registration of a trade mark.

(2) An application for rectification may be made either to the Registrar or to the court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the Registrar, he may at any stage of the proceedings refer the application to the court.

(3) Except where the Registrar or the court directs otherwise, the effect of rectification of the register is that the error or omission in question shall be deemed never to have been made.

(4) The Registrar may, on request made in the prescribed manner by the proprietor of a registered trade mark, or a licensee, enter any change in his name or address as recorded in the register.

(5) The Registrar may remove from the register matter appearing to him to have ceased to have effect.

Surrender, Revocation and Invalidity

Surrender of registered trade mark

65. (1) A registered trade mark may be surrendered by the proprietor in respect of some or all of the goods or services for which it is registered.

(2) Provision may be made by Rules—

- (a) as to the manner and effect of a surrender; and
- (b) for protecting the interests of other persons having a right in the registered trade mark.

(Inserted by Act 7 of 2000)

Revocation of registration

66. (1) The registration of a trade mark be revoked on any of the following grounds—

- (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the Montserrat, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
- (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (c) that, in consequence of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service for which it is registered;

- (d) that in consequence of the use made of it by the proprietor or with his consent in relation to the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.
- (2) For the purposes of subsection (1) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and use in the Montserrat includes affixing the trade mark to goods or to the packaging of goods in the Montserrat solely for export purposes.
- (3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:
- Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.
- (4) An application for revocation may be made by any person, and may be made either to the registrar or to the court, except that—
- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.
- (5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.
- (6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from—
- (a) the date of the application for revocation; or
- (b) if the registrar or the court is satisfied that the grounds for revocation existed at an earlier date, that date.

(Inserted by Act 7 of 2000)

Grounds for invalidity of registration

67. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 7 or 8 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(a), (b) or (c) of section 8, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid if—

- (a) it is identical to an earlier registered trade mark and relates to goods or services identical to those protected thereunder; or
- (b) is identical to an earlier registered trade mark and relates to goods or services similar to those protected thereunder; or
- (c) is similar to an earlier registered trade mark and relates to goods or services similar to those protected thereunder,

unless the proprietor of the earlier registered trade mark has consented to the registration.

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and
- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that, this shall not affect transactions past and closed.

(Inserted by Act 7 of 2000)

Effect of acquiescence

68. (1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the Montserrat, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right—

- (a) to apply for a declaration that the registration of the later trade mark is invalid; or
 - (b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used,
- unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.

(Inserted by Act 7 of 2000)

Adoption of entries to new classification

69. (1) Provision may be made by Rules empowering the Registrar to do such things as he considers necessary to implement any amended or substituted classification of goods or services for the purposes of the registration of trade marks.

(2) Provision may in particular be made for the amendment of existing entries on the register so as to accord with the new classification.

(3) Any such power of amendment shall not be exercised so as to extend the rights conferred by the registration, except where it appears to the Registrar that compliance with this requirement would involve undue complexity and that any extension would be substantial and would not adversely affect the rights of any person.

(4) The Rules may empower the Registrar—

- (a) to require the proprietor of a registered trade mark, within such time as may be prescribed, to file a proposal for amendment of the register; and
- (b) to cancel or refuse to renew the registration of the trade mark in the event of his failing to do so.

(5) Any such proposal shall be advertised, and may be opposed, in such manner as may be prescribed.

Powers and Duties of the Registrar

Power to require use of forms

70. (1) The Registrar may require the use of such forms as he may direct for any purpose relating to the registration of a trade mark or any other proceeding before him under this Act.

(2) The forms, and any directions of the Registrar with respect to their use, shall be published in the prescribed manner.

Information about applications and registered trade marks

71. (1) After publication of an application for registration of a trade mark, the Registrar shall on a request in the prescribed manner and subject to such fees as may be prescribed, provide any person with such information and permit him to inspect such documents relating to the application, or to any registered trade mark resulting from it, as may be specified in the request, subject, however, to any prescribed restrictions.

(2) Before publication of an application for registration of a trade mark, documents or information constituting or relating to the application shall not be published by the Registrar or communicated by him to any person except—

- (a) in such cases and to such extent as may be prescribed; or
- (b) with the consent of the applicant,

but subject as follows.

(3) Where a person has been notified that an application for registration of a trade mark has been made, and that the applicant will if the application is granted bring proceedings against him in respect of acts done after publication of the application, he may make a request under subsection (1) notwithstanding that the application has been published and that subsection shall apply accordingly.

Costs and security for costs

72. (1) Provision may be made by Rules empowering the Registrar, in any proceedings before him under this Act—

- (a) to award any party such costs as he may consider reasonable; and
- (b) to direct how and by what parties they are to be paid.

(2) Any such order of the Registrar may be enforced by the High Court.

(3) Provision may be made by Rules empowering the Registrar, in such cases as may be prescribed, to require a party to proceedings before him to give security for costs, in relation to those proceedings on appeal, and as to the consequences if security is not given.

Evidence before Registrar

73. Provision may be made by Rules—

- (a) as to the giving of evidence in proceedings before the Registrar under this Act by affidavit or statutory declaration;
- (b) conferring on the Registrar powers in relation to the examination of witnesses on oath and the discovery and production of documents; and

- (c) applying in relation to the attendance of witnesses in proceedings before the Registrar the Rules applicable to the attendance of witnesses before such a referee.

Exclusion of liability in respect of official acts

74. (1) The Registrar shall not be taken to warrant the validity of the registration of a trade mark under this Act.

(2) The Registrar is not subject to any liability by reason of, or in connection with, any examination or proceeding required or authorised by this Act.

(3) No proceedings lie against an officer of the Registrar in respect of any matter for which, by virtue of this section, the Registrar is not liable.

Appeals from the Registrar

75. An appeal lies from any decision of the Registrar under this Act to the court.

Rules, Fees, Hours of Business, etc.

Power of to make Rules

76. (1) The Governor acting on the advice of Cabinet may make Rules—

- (a) for the purposes of any provision of this Act authorising the making of Rules with respect to any matter; and
- (b) for prescribing anything authorised or required by any provision of this Act to be prescribed,

and generally for regulating practice and procedure under this Act.

(Amended by Act 9 of 2011)

(2) Provision may, in particular, be made—

- (a) as to the manner of filing of applications and other documents;
- (b) requiring and regulating the translation of documents and the filing and authentication of any translation;
- (c) as to the service of documents;
- (d) authorising the rectification of irregularities of procedure;
- (e) prescribing time limits for anything required to be done in connection with any proceeding under this Act;
- (f) providing for the extension of any time limit so prescribed, or specified by the Registrar, whether or not it has already expired.

(3) Rules under this Act shall be made by Order which shall be subject to annulment in pursuance of a resolution of the Legislative Assembly. (*Amended by Act 9 of 2011*)

Fees

77. (1) There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed.

(2) Provision may be made by Rules as to—

- (a) the payment of a single fee in respect of two or more matters; and
- (b) the circumstances (if any) in which a fee may be repaid or remitted.

Trade Mark Agents

Recognition of agents

78. Except as otherwise provided by Rules, any act required or authorised by this Act to be done by or to a person in connection with the registration of a trade mark, or any procedure relating to a registered trade mark, may be done by or to an agent authorised by that person orally or in writing.

The register of trade mark agents

79. (1) The Governor acting on the advice of Cabinet may make Rules requiring the keeping of a register of persons who act as agent for others for the purpose of applying for or obtaining the registration of trade marks; and in this Act a “**registered trade mark agent**” means a person whose name is entered in the register kept under this section. (*Amended by Act 9 of 2011*)

(2) The Rules may contain such provision as the Governor acting on the advice of Cabinet thinks fit, and may in particular—

- (a) require the payment of such fees as may be prescribed; and
- (b) authorise in prescribed cases the erasure from the register of the name of any person registered in it, or the suspension of a person’s registration.

(*Amended by Act 9 of 2011*)

Unregistered persons not to be described as registered trade mark agents

80. An individual, company, or association of persons who is not a registered trade mark agent shall not—

- (a) carry on a business (otherwise than in partnership) under any name or other description which contains the words “registered trade mark agent”; or
- (b) in the course of a business otherwise describe or hold himself out, or permit himself to be described or held out, as a registered trade mark agent.

Power of Registrar to refuse to deal with certain agents

81. (1) The Governor acting on the advice of Cabinet may make Rules authorising the Registrar to refuse to recognise as agent in respect of any business under this Act—

- (a) an individual whose name has been erased from and not restored to, or who is suspended from, the register of trade mark agents on the ground of misconduct;
- (b) a person who is found by the Governor acting on the advice of Cabinet to have been guilty of such conduct as would, in the case of an individual registered in the register of trade mark agents, render him liable to have his name erased from the register on the ground of misconduct;
- (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognise under paragraph (a) or (b) above.

(2) The Rules may contain such incidental and supplementary provisions as appear to the Governor acting on the advice of Cabinet to be appropriate and may, in particular, prescribe circumstances in which a person is or is not to be taken to have been guilty of misconduct.

(Amended by Act 9 of 2011)

Offences

Unauthorised use of trade marks etc., in relation to goods

82. (1) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

- (a) applies to goods or their packaging a sign identical to, likely to be mistaken for, a registered trade mark; or
- (b) sells or lets for hire, offers or exposes for sale or hire or distributes goods which bear, or the packaging of which bears, such a sign; or
- (c) has in possession, custody or control in the course of a business any such goods with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).

(2) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

- (a) applies a sign identical to, or likely to be mistaken for, a registered trade mark to material intended to be used—
 - (i) for labelling or packaging goods;
 - (ii) as a business paper in relation to goods; or
 - (iii) for advertising goods; or
- (b) uses in the course of a business material bearing such a sign for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or
- (c) has in his possession, custody or control in the course of a business any such material with a view to the doing of anything, by himself or another, which would be an offence under paragraph (b).

(3) A person commits an offence who with a view to gain for himself or another, or with intent to cause loss to another, and without the consent of the proprietor—

- (a) makes an article specifically designed or adapted for making copies of a sign identical to, or likely to be mistaken for, a registered trade mark; or
- (b) has such an article in his possession, custody or control in course of a business,

knowing or having reason to believe that it has been, or is to be, used to produce goods, or material for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods.

(4) A person does not commit an offence under this section unless—

- (a) the goods are goods in respect of which the trade mark is registered; or
- (b) the trade mark has a reputation in the United Kingdom and the use of the sign takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the trade mark.

(5) It is defence for a person charged with an offence under this section to show that he believed on reasonable grounds that the use of the sign in the manner in which it was used, or was to be used, was not an infringement of the registered trade mark.

(6) A person who commits an offence under this section is liable—

- (a) on summary conviction to imprisonment for a term of six months or to a fine of \$5,000;

- (b) on conviction on indictment to a fine or imprisonment for a term not exceeding ten years, or both.

Falsification of register

83. (1) It is an offence for a person to make, or cause to be made, a false entry in the register of trade marks, knowing or having reason to believe that it is false.

(2) It is an offence for a person—

- (a) to make or cause to be made anything falsely purporting to be a copy of an entry in the register; or
(b) to produce or tender or cause to be produced or tendered in evidence any such thing,

knowing or having reason to believe that it is false.

(3) A person guilty of an offence under this section is liable—

- (a) falsely to represent that a mark is a registered trade mark; or
(b) on summary conviction, to imprisonment for a term of six months or a fine not exceeding the statutory maximum, or both.

Falsely representing trade mark as registered

84. (1) It is an offence for a person—

- (a) falsely to represent that a mark is a registered trade mark; or
(b) to make a false representation as to the goods or services for which a trade mark is registered,

knowing or having reason to believe that the representation is false.

(2) For the purposes of this section, the use in Montserrat in relation to a trade mark—

- (a) of the word “**registered**”; or
(b) of any other word or symbol importing a reference (express or implied) to registration,

shall be deemed to be a representation as to registration under this Act unless it is shown that the reference is to registration elsewhere than in Montserrat and that the trade mark is in fact so registered for the goods or services in question.

(3) A person guilty of an offence under this section is liable on summary conviction to a fine of \$5,000.

*Miscellaneous***Act not to affect law of passing off**

85. Nothing in this Act affects the law relating to passing off.

TRADE MARKS RULES

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TRADE MARKS RULES – SECTIONS 76, 77, 79 and 81

(S.R.O. 51/2012)

Commencement

[15 October 2012]

Preliminary

Short title

1. These Rules may be cited as the Trade Marks Rules.

Interpretation

2. (1) In these Rules, unless the context otherwise requires—

“**Nice Classification**” means the current version of the international classification drawn up under the Nice Agreement concerning the International Classification of Goods and Services for the purposes of the Registration of marks of 15 June 1957;

“**proprietor**” means the person registered as the proprietor of a trade mark;

“**publish**” means to publish in the *Gazette*;

“**Registry**” means the registry of trade marks located at the offices of the Financial Services Commission or such other place as may by law be designated from time to time;

“**specification**” means the statement of goods or services in respect of which a trade mark is registered or proposed to be registered.

(2) In these Rules a reference to the filing or the making of an application, the giving of notice or the delivery of any document, unless the contrary intention appears, is to be construed as a reference to it being delivered to the Registrar at the office of the Registrar wherever located.

Fees

3. (1) The fees to be paid in relation to trade marks are specified in the Schedule.

(2) Payments shall be made in East Caribbean Currency but the equivalent amount in a foreign convertible currency may be accepted.

(3) A payment of a fee by cheque or other negotiable instrument may be accepted by the Registrar as payment of the fee when received, but if the cheque or negotiable instrument is not paid when presented to the bank on which it is drawn, and not made good within such time as the Registrar may direct, the acceptance of the fee shall be revoked and anything done pursuant to the payment shall be void and of no effect.

(4) Where a fee is paid to the Registrar by any person in respect of an application that is withdrawn before it is given an application number, or for a service

that cannot be provided, the person who paid the fee is entitled to a refund of the fee less an administrative fee of \$100.

Forms

4. A reference in these Rules to a request or application being made or notice given in a particular form referred to by number shall be a reference to a form bearing that number prescribed by the Registrar in the Trade Marks (Forms) Rules made pursuant to section 70 of the Act.

Address for service

5. (1) For the purposes of any proceedings before the Registrar under these Rules or any appeal from a decision of the Registrar under the Act or these Rules, an address for service in Montserrat shall be filed by every applicant for or in respect of—

- (a) the registration of a trade mark or series of marks, collective mark or certification mark;
- (b) an application for the division or merger of trade marks;
- (c) the revocation, invalidation and rectification of trade marks;
- (d) the alteration, renewal or restoration of trade marks;
- (e) leave to intervene in any proceeding; and
- (f) any other matter or proceeding before Registrar under these Rules.

(2) An address for service shall be provided using Form 1.

(3) The address for service of an applicant for registration of a trade mark shall, upon registration of the mark, be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under these Rules.

Agents

Applications may be made by authorised agent

6. Except as otherwise provided by these Rules—

- (a) an application, request or notice that is required or permitted by the Act or these Rules to be made or given to the Registrar; and
- (b) all other communications—
 - (i) between an applicant or a person making such request or giving such notice and the Registrar; or
 - (ii) between a registered owner or a licensee of a trade mark and the Registrar,

may be made, signed or given through an agent.

Appointment of agent

7. (1) A person referred to in rule 6 may, by signing and sending to the Registrar an authorisation using Form 2, appoint an agent to act for that person in any proceeding or matter under the Act or these Rules.

(2) Where an agent has been appointed under this Rule—

- (a) service upon the agent of any documentation relating to the proceeding or matter for which the agent has been appointed, is service upon the person who appointed him;
- (b) all communications that relate to any proceedings or matter referred to in paragraph (a) that are directed to be made to an applicant, person making a request or giving a notice, or to any registered owner or licensee, may be addressed to the agent; and
- (c) the attendances upon the Registrar relating to any proceeding or matter referred to in paragraph (a) may be made by or through the agent.

(3) Notwithstanding subrules (1) and (2) the Registrar may in a particular case require the personal signature or presence of an applicant under these Rules.

(4) Where after a person has become a party to proceedings before the Registrar, he appoints an agent for the first time or appoints one agent in substitution for another, a new form of authorisation using Form 2 shall be submitted to the Registrar and any act required or authorised by the Act or these Rules in connection with the registration of a trade mark or any procedure relating to a trade mark may not be done by the newly appointed agent until on or after the date on which the form is submitted to the Registrar.

Registrar may refuse to deal with certain agents

8. Notwithstanding rule 7, the Registrar may refuse to recognise as agent in respect of any business under the Act or these Rules—

- (a) a person who has been convicted of an offence under section 82, 83 or 84 of the Act;
- (b) an individual whose name has been erased from and not restored to the register of trade mark agents on the ground of misconduct; and
- (c) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognise under paragraph (a) or (b).

Registration of Trade Marks

Application for registration

9. (1) An application under section 3 of the Act for the registration of a trade mark, including a collective mark, certification mark, series of marks and all other forms of marks under the Act or these Rules, shall be made on Form 3.

- (2) An application under subrule (1) shall—
- (a) be made in respect of one or more of the classes of goods and services set out in the Nice Classification;
 - (b) specify the class or classes to which it relates and list the goods or services appropriate to that class;
 - (c) if it relates to more than one class, set out the classes in consecutive numerical order;
 - (d) if made in relation to a three-dimensional mark, contain a statement to that effect; and
 - (e) if made in relation to a trade mark in respect of which a colour is claimed, include a statement to that effect and specify the colour.

(3) An application for the registration of a three-dimensional mark shall not be treated as such unless subrule (2)(d) has been complied with.

(4) Where colour is claimed as an element of the trade mark, it shall not be treated as such unless subrule (2)(e) has been complied with.

(5) An application to register a trade mark which is or includes a word shall be treated as an application to register that word in the graphical form shown in the application, unless the applicant includes a statement that the application is for registration of the word without regard to its graphical form.

(6) An application which has been accepted for registration shall, for the purposes of section 9(1) of the Act, be published as soon after such acceptance as may be practicable.

(7) The Registrar shall send to the applicant a copy of any documents containing observations made under section 9(3) of the Act.

(8) On the registration of a trade mark the Registrar shall publish the registration, specifying the date upon which the trade mark was entered in the register.

Classification of goods and services

10. (1) For the purpose of section 5 of the Act, goods and services shall, except as provided in subrule (2), be classified in accordance with the Nice Classification.

(2) If the specification contained in an application under this Rule lists items by reference to a class in which they do not fall, the applicant may request an amendment to the application by filing an application using Form 7.

Non-compliant applications

11. (1) Where an application for registration of a trade mark does not satisfy the requirements of section 3(2), (3) or (4) of the Act or subrule (1), (2)(a), 2(b) or 2(c) of Rule 9, the Registrar shall send notice to the applicant to remedy the non-compliance or, in the case of section 3(4) of the Act, to remedy the default in payment.

(2) If within three months of the date of the notice or such longer period as the Registrar may permit, the applicant fails to remedy the non-compliance or default in payment, the application shall be deemed to have been abandoned.

Oppositions Proceedings

Procedure in cases of opposition to the registration of trade marks

12. (1) A notice to the Registrar of opposition to the registration of a trade mark under section 9(2) of the Act shall be given on Form 4 within three months of the date on which the application was published and shall include a statement of the grounds of opposition.

(2) The Registrar shall as soon as may be practicable after a notice of opposition under subrule (1), send a copy of the notice to the applicant who may, within three months of the date on which a copy of the notice was sent by the Registrar under subrule (1), file a notice of defence and counter-statement in the form set out as Form 5.

(3) Where a notice of defence and counter-statement is filed within the period specified in subrule (2), the Registrar shall send a copy to the person opposing the application.

(4) Subject to subrule (5), at any time before the expiry of the period specified in subrule (2) for the filing of a notice of defence and counter-statement by the applicant, the Registrar may, on a request in writing made by the applicant and on the concurrence of the other party, grant an extension of up to three months.

(5) The Registrar may on a further request by one of the parties on Form 6, extend the period under subrule (4) by a further period of up to three months.

(6) Within one month after the expiry of the extended period under subrule (4) or (5), the applicant may file a defence and counter-statement using Form 5. Where filed within the period of one month the Registrar shall send a copy of the defence and counter-statement to the person opposing the application.

(7) Where a defence and counter-statement are not filed by the applicant within the period prescribed by subrule (2) or (6), the applicant shall be deemed to have withdrawn the application for registration.

(8) Within three months of the date upon which a copy of the defence and counter-statement is sent by the Registrar to the person opposing the registration, that person may file evidence in support of his grounds of opposition and shall send a copy to the applicant.

(9) If the person opposing the registration files no evidence under subrule (8), he shall, unless the Registrar otherwise directs, be deemed to have withdrawn his opposition.

(10) If the person opposing the registration files evidence under subrule (8) or the Registrar otherwise directs under subrule (9), the applicant who has filed a defence and counter-statement under subrule (2) or (6) may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file evidence in support of his application for registration and shall send a copy to the person opposing the application.

(11) Within three months of the date upon which a copy of the applicant's evidence is sent to him under subrule (10), the person opposing the application may

file evidence in reply which shall be confined to matters strictly in reply to the applicant's evidence, and shall send a copy to the applicant.

(12) No further evidence may be filed, except that, in relation to any proceedings before the Registrar, the Registrar may at any time give leave to either party to file such evidence upon such terms as the Registrar thinks fit.

(13) Upon completion of the evidence the Registrar shall request the parties to state by notice to the Registrar whether they wish to be heard.

(14) If any of the parties make a request to be heard the Registrar shall send to the parties, notice of a date for the hearing.

Decision of Registrar

13. (1) When the Registrar has made a decision on the acceptability of an application for registration following the procedure under rule 12, the Registrar shall send the applicant and the person opposing the application written notice of it, stating the reasons for the decision.

(2) For the purpose of any appeal against the Registrar's decision the date of the decision shall be the date when notice of the decision is sent under subrule (1).

Amendment of application

14. (1) A request to amend an application under section 10 of the Act to correct an error or to change the name or address of the applicant or in respect of any amendment requested after publication of the application shall be made on Form 7.

(2) Where, pursuant to section 10 of the Act, a request is made for amendment of an application which has been published and the amendment affects the representation of the trade mark or the goods or services covered by the application, the amendment or a statement of the effect of the amendment shall be published.

(3) Notice of opposition to the amendment shall be filed on Form 4 within one month of the date on which the amended application was published under subrule (1), and shall include a statement of the grounds of objection and, in particular, how the amendment would be contrary to section 10(2) of the Act.

(4) The provisions of rule 12 shall apply to proceedings relating to the opposition to the amendment of the application as they apply to proceedings relating to opposition to the registration of a trade mark.

Division, merger and series of marks

Provisions for division of applications made pursuant to section 12(1)(a) of the Act

15. (1) An applicant may, at any time before registration of a trade mark, apply to the Registrar on Form 8 for a division of the original application for registration into two or more separate divisional applications indicating for each division the specification of goods or services.

(2) Each divisional application shall be treated as a separate application for registration with the same filing date as the original application.

(3) Where an application to divide an application is made after publication of the application, any objections in respect of, or opposition to, the original application shall be taken to apply to each divisional application and shall be proceeded with accordingly.

(4) Upon the division of an original application in respect of which notice has been given to the Registrar of particulars relating to the grant of a license, or a security interest or any right in or under it, the notice and the particulars shall be deemed to apply in relation to each of the applications into which the original application has been divided.

Provisions for merger of applications made pursuant to section 12(1)(b) of the Act

16. (1) An applicant may, at any time before the publication of two or more applications for the registration of trade marks, apply to the Registrar to merge the separate applications into a single application.

(2) An application under subrule (1) shall be made on Form 9.

(3) The Registrar shall merge the applications into a single application if satisfied that all the applications which are the subject of the request for merger are all in respect of the same trade mark, bear the same date of application, and are, at the time of the request, in the name of the same person.

(4) The proprietor of two or more registrations of a trade mark may apply to the Registrar using Form 10 to merge them into a single registration.

(5) The Registrar shall, if satisfied that the registrations are in respect of the same trade mark, merge them into a single registration.

(6) Where any registration of a trade mark to be merged under subrule (5):

(a) is subject to a disclaimer or limitation; or

(b) has registered in relation to it, particulars relating to the grant of a licence or a security interest or any right in or under it, or of any memorandum or statement of the effect of a memorandum,

the Registrar shall enter in the register the same particulars in relation to the merged registration.

(7) If the separate registrations bear different dates of registration, the date of registration of the merged registration shall be the latest of those dates.

Provisions for the registration of a series of trade marks pursuant to section 12(1)(c) of the Act

17. (1) The proprietor of a series of trade marks may apply to the Registrar for their registration as a series in a single registration.

(2) An application under subrule (1) shall—

(a) be in the form set out as Form 3; and

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(b) include a representation of each mark of the series.

(3) The Registrar shall, if satisfied that the marks constitute a series, accept the application.

(4) At any time before publication of the application an applicant under subrule (1) may apply to the Registrar under rule 15 for the division of the application into separate applications in respect of one or more marks in that series and the Registrar shall, if satisfied that the marks resemble each other as to their material particulars and differ only as to matters of a non-distinctive character not substantially affecting the identity of the trade mark within the meaning of section 12(2) of the Act, divide the application accordingly.

(5) The applicant for the registration of a series of trade mark or the proprietor of a registered series of trade mark may at any time request the deletion of a mark in that series, and the Registrar shall delete the mark accordingly.

(6) The division of an application into one or more applications shall be subject to the payment of a divisional fee and such application and class fees as are appropriate.

Collective marks and certification marks

Filing of Regulations

18. An applicant for the registration of a collective mark or certification mark shall, within nine months of the date of such application file a copy of Form 11 accompanied by a copy of the regulations governing the use of the mark.

Amendment of Regulations

19. (1) Form 12 shall be filed in respect of any application for the amendment of the regulations governing the use of a registered collective mark or certification mark.

(2) Where it appears expedient to the Registrar that amended regulations should be made available to the public, the Registrar shall publish a notice indicating that copies of the amended regulations may be inspected at the Trade Marks Registry.

(3) Any person may, within three months of the date of publication of a notice under subrule (2), make observations to the Registrar with respect to the amendments to a collective mark or a certification mark.

(4) The Registrar shall send a copy of a notice under subrule (3) to the applicant.

(5) Any person may, within three months of the date of publication of the notice, give notice to the Registrar using Form 4, of opposition to the amendment, accompanied by a statement of the grounds of opposition, indicating why the amended regulations do not comply with the requirements of the Act or these Rules.

(6) The Registrar shall send a copy of the notice and the statement to the applicant, and thereafter the procedure in subrule of rule 12(3) and (6) to (12) shall apply to the proceedings as they apply to proceedings relating to opposition to an application for registration of a trade mark.

*Disclaimers, limitations, alteration and
surrender of registered trade mark*

Registration subject to disclaimer or limitation

20. Where the applicant for registration of a trade mark or the proprietor by notice in writing sent to the Registrar—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

the Registrar shall make the appropriate entry in the register and publish such disclaimer or limitation.

Alteration of registered trade mark

21. (1) An application to alter a registered trade mark pursuant to section 23 of the Act shall be made on Form 13.

(2) The Registrar may require an applicant under subrule (1) to support the application by submitting such evidence by statutory declaration or otherwise as to the circumstances in which the application is made.

(3) Any application for an alteration permitted by the Registrar shall be published.

(4) Any person claiming to be affected by the alteration may within three months of the date of publication of the alteration under subrule (3) send a notice on Form 4 to the Registrar of opposition to the alteration and shall include a statement of the grounds of opposition.

(5) The Registrar shall send a copy of the notice and the statement to the proprietor and thereafter the procedure in subrule of rule 12(3) and (6) to (12) shall apply to the proceedings as they apply to proceedings relating to opposition to an application for registration.

Surrender of registered trade mark

22. (1) The proprietor of a registered trade mark may by notice to the Registrar surrender a trade mark in respect of all the goods or services for which it is registered or in respect only of those goods or services specified by him in the notice.

(2) Either Form 14 or 15 shall be used in respect of an application to surrender under subrule (1).

(3) A notice under subrule (1) shall be of no effect unless the proprietor in that notice gives the name and address of any person having a registered interest in the mark, and certifies that any such person has been sent not less than three months' notice of the proprietor's intention to surrender the mark, or is not affected, or if affected consents thereto.

(4) The Registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish notice of the surrender.

*Renewal and restoration of registered trade mark***Reminder of renewal of registration**

23. At any time not earlier than six months nor later than one month before the expiration of the last registration of a trade mark, the Registrar shall, except where renewal has already been effected under rule 24, send to the registered proprietor notice of the approaching date of expiration and inform him at the same time that the registration may be renewed as set out in rule 24.

Renewal of registration

24. The registration of a trade mark may be renewed by the filing of a request for renewal on Form 16 within the period of six months ending on the date of the expiration of the registration.

Delayed renewal and removal of registration

25. (1) If on the expiration of the last registration of a trade mark, the renewal fee has not been paid, the Registrar shall so notify the applicant and if within six months from the date of the expiration of the last registration, an application is filed using Form 16 accompanied by the renewal fee, the Registrar shall renew the registration without removing the mark from the register.

(2) Where no request for renewal is filed, the Registrar shall, subject to rule 26, remove the mark from the register.

(3) The removal of the registration of a trade mark shall be published.

Restoration of registration

26. (1) Where the Registrar has removed a mark from the register for failure to renew its registration in accordance with rule 25, the Registrar may, upon an application filed within six months of the date of the removal of the mark accompanied by the renewal and restoration fees, restore the mark to the register and renew its registration if, having regard to the circumstances of the failure to renew, the Registrar is satisfied that it is just to do so.

(2) A request under subrule (1) shall be filed using Form 17.

(3) The restoration of the registration shall be published showing the date of restoration.

*Revocation, invalidation and rectification***Procedure on application for revocation on the grounds of non-use**

27. (1) An application to the Registrar under sections 66(1)(a) and (b) of the Act for the revocation of a registered trade mark shall be made on Form 18 which shall be filed together with a statement of the grounds on which the application is made. The Registrar shall send a copy of the application and the statement to the proprietor.

(2) Within three months of the date on which a copy of the notice and statement is sent by the Registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with a notice on Form 5 and either—

- (a) two copies of evidence of use made of the mark; or
- (b) reasons for non-use of the mark.

(3) Where such a notice and counter-statement, and evidence of use of the mark or reasons for non-use of the mark, are filed within the prescribed period, the Registrar shall send a copy of Form 5 and the counter-statement, and the evidence of use of the mark or the reasons for non-use of the mark, to the applicant.

(4) Where the documentation and information referred to in subrule (3) are not filed by the proprietor within the period specified therein, the Registrar may treat the opposition to the application as having been withdrawn.

(5) Within three months of the date upon which a copy of Form 5 and counter-statement is sent by the Registrar to the applicant, the applicant may file such evidence as the applicant may consider necessary to adduce in support of the grounds stated in the application and shall send a copy to the proprietor.

(6) If the applicant files no evidence under subrule (5) in support of the application, the applicant shall, unless the Registrar otherwise directs, be deemed to have withdrawn his application.

(7) If the applicant files evidence under subrule (5), or the Registrar otherwise directs under subrule (6), the proprietor who has filed a notice and counter-statement under subrule (2) may, within three months of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such further evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy to the applicant.

(8) Within three months of the date upon which a copy of the proprietor's evidence is sent to him under subrule (7), the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy to the proprietor.

(9) No further evidence may be filed, except that, in relation to any proceedings before the Registrar, the Registrar may at any time give leave to either party to file such evidence upon such terms as may be specified.

(10) Upon completion of the evidence the Registrar shall request the parties to state by notice to the Registrar in writing whether they wish to be heard, and if any party so requests, the Registrar shall send to the parties, notice of a date for the hearing.

(11) When the Registrar has made a decision on the application the Registrar shall send the parties to the proceedings written notice of it, stating the reasons for the Registrar's decision.

(12) For the purposes of any appeal against the Registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure on application for revocation (on grounds other than non-use)

28. (1) An application to the Registrar for revocation of the registration of a trade mark under sections 66(1)(c) and (d) of the Act shall be made on Form 18 which shall be filed together with a statement of the grounds on which the application is made. The Registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the Registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same in the form set out as Form 5 and where such a notice and counter-statement are filed within the prescribed period, the Registrar shall send a copy of Form 5 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by subrule (2), the Registrar may treat the opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the Registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy to the proprietor.

(5) If the applicant files no evidence under subrule (4) in support of his application, he shall, unless the Registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files evidence under subrule (4) or the Registrar directs under subrule (5), the proprietor who has filed a notice and counter-statement under subrule (2) may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary in support of the reasons stated in the counter-statement and shall send a copy to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under subrule (6), the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy to the proprietor.

(8) No further evidence may be filed, except that, in relation to any proceedings before the Registrar, the Registrar may at any time give leave to either party to file such evidence upon such terms as the Registrar may think fit.

(9) Upon completion of the evidence the Registrar shall request the parties to state by notice to the Registrar in writing whether they wish to be heard; if any party requests to be heard the Registrar shall send to the parties, notice of a date for the hearing.

(10) When the Registrar has made a decision on the application the Registrar shall send the parties to the proceedings written notice of it, stating the reasons for the Registrar's decision.

(11) For the purposes of any appeal against the Registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure on application for invalidation

29. (1) An application to the Registrar for a declaration of invalidity of the registration of a trade mark under section 67(1) or (2) of the Act shall be made on Form 19 accompanied by a statement of the grounds on which the application is made.

(2) The Registrar shall send a copy of the application and the statement under subrule (1) to the proprietor.

(3) Within six weeks of the date on which a copy of the application and statement is sent by the Registrar in accordance with subrule (2), the proprietor may file a counter-statement, in conjunction with notice on Form 5.

(4) If the notice and counter-statement are filed within the period specified in subrule (3), the Registrar shall send a copy of Form 5 and the counter-statement to the applicant.

(5) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by subrule (3), the Registrar may treat the opposition to the application as having been withdrawn.

(6) The applicant may, within six weeks of the date upon which a copy of the counter-statement is sent by the Registrar to the applicant, file such evidence as the applicant may consider necessary to adduce in support of the grounds stated in the application and shall send a copy to the proprietor.

(7) If the applicant files no evidence under subrule (6) in support of the application, he shall, unless the Registrar otherwise directs, be deemed to have withdrawn the application.

(8) If the applicant files evidence under subrule (6) or the Registrar directs under subrule (7), the proprietor who has filed a notice and counter-statement under subrule (3) may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of the reasons stated in the counter-statement and shall send a copy to the applicant.

(9) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under subrule (6), the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy to the proprietor.

(10) No further evidence may be filed, except that, in relation to any proceedings before the Registrar, the Registrar may at any time give leave to either party to file such evidence upon such terms as the Registrar may think fit.

(11) Upon completion of the evidence the Registrar shall request the parties to state by notice to the Registrar in writing whether they wish to be heard, and if any party requests to be heard the Registrar shall send to the parties, notice of a date for the hearing.

(12) When the Registrar has made a decision on the application the Registrar shall send the parties to the proceedings written notice of it, stating the reasons for the decision.

(13) For the purposes of any appeal against the Registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure on application for rectification

30. (1) An application for rectification of an error or omission in the register under section 64(1) of the Act shall be made on Form 20 and shall be accompanied by a statement of the grounds on which the application is made and any evidence to support those grounds.

(2) Where an application is made under subrule (1) by a person other than the proprietor of the registered trade mark the Registrar shall send a copy of the application and the statement, together with any evidence filed, to the proprietor; and may give such direction with regard to the filing of subsequent evidence upon such terms as the Registrar may think fit.

(3) Upon completion of the evidence the Registrar shall request the parties to state by notice to the Registrar in writing whether they wish to be heard, and if any party requests to be heard the Registrar shall send to the parties, notice of a date for the hearing.

(4) When the Registrar has made a decision on the application the Registrar shall send the parties to the proceedings written notice of it, stating the reasons for the decision.

(5) For the purposes of any appeal against the Registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision.

Procedure for intervention

31. (1) Any person, other than the registered proprietor, claiming to have an interest in proceedings on an application under these Rules may file an application to the Registrar on Form 21 for leave to intervene, stating the nature of his interest and the Registrar may, after hearing the parties concerned if so required, refuse leave or grant leave upon such terms and conditions, including any undertaking as to costs.

(2) Any person granted leave to intervene shall, subject to any terms and conditions imposed in respect of the intervention, be treated as a party to the proceedings in respect of which application to intervene was made.

Case Management Conference and Pre-Hearing Review

Case Management Conference

32. At any stage of any proceedings before the Registrar, the Registrar may direct that the parties to the proceedings attend a case management conference where they shall have an opportunity to be heard with regard to the future conduct of the proceedings, and in particular with regard to the proposed exercise of any of the Registrar's powers. The Registrar shall give the parties at least fourteen days notice of the date of the case management conference.

Pre-trial review

33. (1) Before hearing any party that desires to be heard in any proceedings before the Registrar, the Registrar may direct that the parties to the proceedings attend a pre-trial review at which the Registrar may give such directions as to the conduct of the hearing.

(2) The Registrar shall give the parties at least fourteen days notice of the date of the pre-hearing review.

The Register

Form of register

34. The register required to be maintained by the Registrar under section 63(1) of the Act may be kept in documentary, electronic or other form.

Entry of particulars of registered trade marks

35. In addition to the entries in the register of registered trade mark required to be made by section 63(2) of the Act, there shall be entered in the register in respect of each trade mark the following particulars—

- (a) the date of registration of each trade mark;
- (b) the actual date of entry in the register;
- (c) the priority date, if any, to be accorded pursuant to a claim to a right to priority under provisions made pursuant to section 34 of the Act;
- (d) the name and address of the proprietor;
- (e) the address for service, if any, as furnished pursuant to rule 5;
- (f) any disclaimer or limitation of rights under the Act or under provisions made pursuant to the Act;
- (g) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the Registrar has been notified;
- (h) the goods or services in respect of which the mark is registered;
- (i) where the mark is a collective or certification mark, that fact; and
- (j) any other particulars which the Registrar determines should be entered in the Register.

Entry in register of particulars of registrable transactions

36. Upon application made to the Registrar under section 20(1)(a) or (b) of the Act, there shall be entered in the register the following particulars of registrable transactions—

- (a) in the case of an assignment of a registered trade mark or any right in it—
 - (i) the name and address of the assignee;

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- (ii) the date of the assignment; and
 - (iii) where the assignment is in respect of any right in the mark, a description of the right assigned;
- (b) in the case of the grant of a licence under a registered trade mark—
- (i) the name and address of the licensee;
 - (ii) where the licence is an exclusive licence, that fact;
 - (iii) where the licence is limited, a description of the limitation; and
 - (iv) the duration of the licence if the same is or is ascertainable as a definite period,
- (c) in the case of the grant of any security interest over a registered trade mark or any right in or under it—
- (i) the name and address of the grantee;
 - (ii) the nature of the interest, whether fixed or floating; and
 - (iii) the extent of the security and the right in or under the mark secured;
- (d) in the case of the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it—
- (i) the name and address of the person in whom the mark or any right in or under it, vests by virtue of the assent, and
 - (ii) the date of the assent; and
- (e) in the case of a court or other competent authority transferring a registered trade mark or any right in or under it—
- (i) the name and address of the transferee;
 - (ii) the date of the order; and
 - (iii) where the transfer is in respect of a right in the mark, a description of the right transferred,

and, in each case, there shall be entered the date on which the entry is made.

Application to register or give notice of transaction

37. (1) An application to register particulars under section 20 of the Act or to give notice to the Registrar of particulars of a transaction under section 20 shall be made, subject to subrule (2)—

- (a) relating to an assignment or transaction other than a transaction referred to in paragraphs (b) to (d), on Form 22;
 - (b) relating to a grant of a licence, on Form 23;
 - (c) relating to an amendment to, or termination of a licence, on Form 24;
- and

- (d) relating to the grant, amendment or termination of any security interest, on Form 25.
- (2) An application under subrule (1) shall—
- (a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment;
- (b) where the transaction falls within subrule (1)(b), (c) or (d), be signed by or on behalf of the grantor of the licence or security interest,
- and be accompanied by such documentary evidence as suffices to establish the transaction.
- (3) Where the transaction is effected by an instrument chargeable with duty, the application shall be subject to the Registrar being satisfied that the instrument has been duly stamped.
- (4) Where an application to give notice to the Registrar has been made of particulars relating to an application for registration of a trade mark, upon registration of the trade mark, the Registrar shall enter those particulars in the register.

Public inspection of register

38. (1) The register shall be open for public inspection at the trade marks office during the normal hours of business of the office.
- (2) Where any portion of the register is kept otherwise than in documentary form, the right of inspection is a right to inspect the material on the register.

Supply of certified copies etc.

39. The Registrar shall supply a certified copy or extract or uncertified copy or extract, as requested on Form 26, of any entry in the register.

Request for change of name or address in register

40. (1) The Registrar shall, on the application made by the proprietor or a licensee or any person having an interest in or charge on a registered trade mark which has been registered under rule 9 enter any change in his name or address as recorded in the register.
- (2) An application under subrule (1) shall be made on Form 27.

Removal of matter from register

41. (1) The Registrar may, subject to subrule (2), remove from the register any matter which ceased to have effect.
- (2) Before removing a matter from the register under subrule (1) the Registrar shall—
- (a) where the Registrar considers it appropriate, publish the Registrar's intention to remove that matter; and
- (b) notify any person who appears to the Registrar to be affected by the removal.

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(3) Within three months of the date on which notice under subrule (2)(a) or (b) is given—

- (a) any person may file notice of opposition to the removal on Form 4; and
- (b) the person to whom a notice is sent under subrule (1)(b) may file, in writing—
 - (i) his objections, if any, to the removal; or
 - (ii) a request to have his objections heard orally,

and where such opposition or objections are made, the procedure in rule 12 shall apply.

(4) If the Registrar is satisfied after considering any objections or opposition that the matter referred to in subrule (1) has not ceased to have effect, the Registrar shall not remove it.

(5) Where no response to the Registrar's notice under subrule (2) is received, the Registrar may remove the matter.

(6) Where representations objecting to the removal of the entry have been made, whether in writing or orally, the Registrar may, if the Registrar is of the view after considering the objections that the entry or any part thereof has ceased to have effect, remove the matter or part thereof.

Change of classification

Change of classification

42. (1) Subject to section 69 of the Act, the Registrar may—

- (a) in order to reclassify the specification of a registered trade mark; or
- (b) consequent upon an amendment of the Nice Classification,

make such amendments to entries on the register for the purposes of reclassifying the specification of the registered trade mark.

(2) Before making any amendment to the register under subrule (1) the Registrar shall give the proprietor of the mark written notice of the proposal to amend and shall at the same time advise the proprietor

- (a) that written objections to the proposals may be made within three months of the date of the notice, stating the grounds of the objections; and
- (b) that if no written objections are received within the period specified the Registrar will publish the proposals and the proprietor will not be entitled to make any objections.

(3) If the proprietor makes no written objections within the period specified in subrule (2)(a) or at any time before the expiration of that period gives the Registrar

written notice of his intention not to make any objections, the Registrar shall as soon as practicable after the expiration of that period or upon receipt of the notice, publish the proposals.

(4) Where the proprietor makes written objections within the period specified in subrule (2)(a), the Registrar shall, as soon as practicable after the Registrar has considered the objections, publish the proposals or, where the Registrar has amended the proposals, publish the proposals as amended.

Opposition to proposals

43. (1) Notice of any opposition shall be filed on Form 4 within three months of the date of publication of the proposals under rule 42 stating the grounds of opposition and, in particular, how the proposed amendments would be contrary to section 69(3) of the Act.

(2) The Registrar may require or admit evidence regarding the opposition under subrule (1) and if so requested by any person opposing the proposal give that person the opportunity to be heard before deciding the matter.

(3) If no notice of opposition under subrule (1) is filed within the time specified, or where any opposition has been determined, the Registrar shall make the amendments as proposed and shall enter in the register the date when they were made.

Request for information, inspection of documents and confidentiality

Request for information

44. A request for information relating to an application for registration or to a registered trade mark shall be made using Form 28.

Information available before publication

45. (1) Before publication of an application for registration the Registrar shall make available for inspection by the public the application and any amendments made to it and any particulars contained in a notice given to the Registrar under rule 44.

(2) Nothing in section 71(2) of the Act relating to publication of information shall be construed as preventing the publication of decisions on cases relating to trade mark decided by the Registrar.

Inspection of documents

46. (1) Subject to subrules (2) and (3), the Registrar shall permit the inspection at the trade marks registry, of all documents filed or kept at the trade marks registry in relation to a registered mark or, where an application for the registration of a trade mark has been published, in relation to that application.

(2) The Registrar shall not be obliged to permit the inspection of any such document under subrule (1) until the Registrar has completed any procedure, or the stage in the procedure which is relevant to the document in question, which the Registrar is required or permitted to carry out under the Act or these Rules.

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- (3) The right of inspection under subrule (1) does not apply to—
- (a) any document until fourteen days after it has been filed at the trade marks registry;
 - (b) any document prepared in the registry solely for use in the registry;
 - (c) any document sent to the registry, whether at its request or otherwise, for inspection and subsequent return to the sender;
 - (d) any request for information under rule 44;
 - (e) any document issued by the registry which the Registrar considers should be treated as confidential;
 - (f) any document in respect of which the Registrar issues directions under rule 47 that it be treated as confidential.

(4) Nothing in subrule (1) shall be construed as imposing on the Registrar any duty of making available for public inspection—

- (a) any document or part of a document which in the Registrar's opinion disparages any person in a way likely to damage him;
- (b) any document or information filed at or sent to or by the registry before the date of commencement of the Act; or
- (c) any document or information filed at or sent to or by the registry after the date of commencement of the Act relating to an application for registration of a trade mark under the previous Act.

(5) No appeal shall lie from a decision of the Registrar under subrule (4) not to make any document or part of a document available for public inspection.

Confidential documents

47. (1) Where a document other than a prescribed form is filed at the registry and the person filing it requests, at the time of filing or within fourteen days of the filing, that it or a specified part of it be treated as confidential, giving his reasons, the Registrar may direct that it or part of it, as the case may be, be treated as confidential, and the document shall not be open to public inspection while the matter is being determined by the Registrar.

(2) Where the Registrar directs that a document is to be treated as confidential, nothing in this rule shall be taken to authorise or require any person to be allowed to inspect the document or part of it to which the direction relates except by leave of the Registrar.

(3) The Registrar shall not withdraw any direction given under this rule without prior consultation with the person at whose request the direction was given; unless the Registrar is satisfied that such prior consultation is not reasonably practical.

(4) The Registrar may where the Registrar considers that any document issued by the registry should be treated as confidential so direct, and upon such direction that document shall not be open to public inspection except by leave of the Registrar.

(5) Where a direction is given under this rule for a document to be treated as confidential a record of the fact shall be filed with the document.

Decision of Registrar, evidence and costs

Decisions of Registrar to be taken after hearing

48. (1) Without prejudice to the provisions of the Act or these Rules requiring the Registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the Registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before the Registrar, give that party an opportunity to be heard.

(2) The Registrar shall give a party at least fourteen days' notice of the time when he may be heard unless that party consents to shorter notice.

Evidence in proceedings before the Registrar

49. (1) Where under these Rules evidence may be admitted by the Registrar in any proceedings before the Registrar, it shall be by the filing of a statutory declaration or affidavit.

(2) The Registrar may in any particular case take oral evidence in *lieu of* or in addition a statutory declaration or affidavit shall, unless the Registrar otherwise directs, allow any witness to be cross-examined on his statutory declaration, affidavit or oral evidence.

(3) Where these Rules provide for the use of an affidavit or statutory declaration, a witness statement verified by a statement of truth may be used as an alternative.

(4) The Registrar may give a direction in any particular case that evidence must be given by affidavit or statutory declaration instead of or in addition to a witness statement verified by a statement of truth.

(5) The practice and procedure of the High Court with regard to witness statements and their form and contents and the procedure governing their use are to apply as appropriate to all proceedings under these Rules.

(6) Where in proceedings before the Registrar, a party adduces evidence of a statement made by a person otherwise than while giving oral evidence in the proceedings and does not call that person as a witness, the Registrar may permit any other party to the proceedings to call that person as a witness and cross-examine him on the statement as if he had been called by the first-mentioned party and as if the statement were his evidence in chief.

Making and subscription of statutory declaration or affidavit

50. (1) Any statutory declaration or affidavit filed under the Act or these Rules shall be made and subscribed as follows—

- (a) in Montserrat by an attorney at law, notary public or commissioner of oaths;

- (b) in the United Kingdom, before any justice of the peace or any commissioner or other officer authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceedings; and
- (c) where, before a commissioner for oaths, notary public, judge or magistrate.

(2) Any document purporting to have affixed, impressed or subscribed thereto or thereon the seal or signature of any person authorised by subrule (1) to take a declaration may be admitted by the Registrar without proof of the genuineness of the seal or signature, or of the official character of the person or his authority to take the declaration.

Registrar's power to require documents, information or evidence

51. At any stage of any proceedings before the Registrar, the Registrar may direct that such documents, information or evidence as the Registrar may reasonably require shall be filed within such period as the Registrar may specify.

Registrar to have power of an official referee

52. (1) The Registrar shall in relation to the examination of witnesses on oath and the disclosure and production of documents have all the powers of an official referee of the Supreme Court.

(2) The rules applicable to the attendance of witnesses before such a referee shall apply in relation to the attendance of witnesses in proceedings before the Registrar.

Hearings before Registrar to be in public

53. The hearing before the Registrar of any dispute between two or more parties relating to any matter in connection with an application for the registration of a mark or a registered mark shall be in public unless the Registrar, after consultation with those parties who appear in person or are represented at the hearing, otherwise directs.

Costs of proceedings

54. In any proceedings before the Registrar under the Act or these Rules, the Registrar may by order award costs to any party and direct how and by what time they are to be paid.

Security for costs

55. (1) The Registrar may require any person who is a party in any proceedings before the Registrar under the Act or these Rules to give security for costs in relation to those proceedings and may require security for the costs of any appeal from the Registrar's decision.

(2) In default of such security being given, the Registrar, in the case of the proceedings before the Registrar, or, in the case of an appeal, the court may treat the party in default as having withdrawn his application, opposition, objection or intervention, as the case may be.

Decision of Registrar

56. (1) When, in any proceedings before the Registrar, the Registrar has made a decision, the Registrar shall send to each party to the proceedings written notice of it, and for the purposes of any appeal against that decision, subject to subrule (2), the date on which the notice is sent shall be taken to be the date of the decision.

(2) Where a statement of the reasons for the decision is not included in the notice sent under subrule (1), any party may, within one month of the date on which the notice was sent to him, apply to the Registrar on Form 29 to send to him a statement of the reasons for the decision and upon such request the Registrar shall send the statement; and the date on which that statement is sent shall be deemed to be the date of the Registrar's decision for the purpose of any appeal against it.

Appeals

Appeals from decision of Registrar

57 The procedures for the hearing of an appeal by the court of appeal with respect to a decision of the Magistrate shall be applied *mutatis mutandis* for the purpose of the hearing of an appeal by the High Court with respect to a decision of the Registrar under section 75 of the Act.

Transitional provisions

Revocation of previous Rules

58. The Trade Mark Rules 1937 and the Registration of United Kingdom Trade Mark Rules 1947 are hereby revoked.

SCHEDULE

FEES FOR REGISTRATION OF TRADE MARKS

Application to register a local trade mark in one series/class			\$400
Registration of a series of trade marks			
	(a)	For the first mark	\$400
	(b)	For each additional mark	\$100
Registration of trade mark in different classes			
	(a)	For the first class	\$400
	(b)	For each additional class	\$ 75
Renewal of a general/local trade mark on or before the date of expiration of ten years			\$175
	(a)	Within three months after expiration	\$200
	(b)	More than three months after expiration	\$300
	(c)	For each additional mark/class	\$ 50
	(d)	Restoration of mark to the register	\$300
Registration of trade mark in one series/class on production of U.K. certificate			\$250
Registration of a series of U.K. trade marks			
	(a)	For the first mark	\$250
	(b)	For each additional mark	\$100
Registration of U.K. trade mark in different classes			
	(a)	For the first class	\$250
	(b)	For each additional class	\$ 75
Renewal of a U.K. trade mark at expiration of ten years			\$200
	(a)	For each additional mark/class	\$ 50
	(b)	For late payment	\$ 50
	(c)	For restoration to the register	\$100
Fees applicable to both general/local and U.K. trade marks:			
Request for change or amendment to an application			\$ 50
Settling a special case by the Registrar			\$175

Inspecting the register	\$ 25
Office copies, per page	\$ 15
Certificates and certified copies	\$ 50
Recording change of name or address	\$ 40
Request for filing counterstatement or any opposition proceedings document	\$100
Request for filing of licence contract	\$ 50
Application to remove or amend the records of a licence	\$ 75
Filing of regulations governing the use of certification or collective marks	\$200
Application to amend the regulations governing the use of a certification or collective mark	\$100
Application to invalidate registered trade mark	\$200
Request for an extension of time to resolve filing deficiencies	\$100
Filing of any other document	\$ 25
Application to record assignment of trade mark	\$ 75

TRADE MARKS (FORMS) RULES

ARRANGEMENT OF RULES

RULE

1. Short title
2. Interpretation
3. Forms
4. Paper

SCHEDULE

TRADE MARKS (FORMS) RULES – SECTION 70

(S.R.O.s. 52/2012 and 62/2012)

Commencement

[15 October 2012]

Short title

1. These Rules may be cited as the Trade Marks (Forms) Rules.

Interpretation

2. In these Rules—

“Act” means the Trade Marks Act

“Registrar” means the Registrar of Trade Marks appointed in accordance with the Act;

“Rules” means the Trade Mark Rules.

Forms

3. The forms set out in the Schedule are for use in relation to, and for the purposes of, the Rules.

Paper

4. (1) All applications, notices, statements, papers having representations affixed, or other documents authorised or required by the Act or the Rules to be filed, left with or sent to the Registrar, except in the case of statutory documents and affidavits, must be on durable white paper written on one side of each sheet.

- (2) Each sheet of paper, other than representations, must have short sides at the top and bottom.

- (3) Each sheet of paper must be the same size.

SCHEDULE
TRADE MARKS RULES

FORM NO. 1

(Rule 5)

APPLICATION FOR AN ADDRESS FOR SERVICE

I/We¹
.....
the registered owner(s)/licensee(s) of the²
Mark(s) registered under No.(s).....hereby apply for an entry of
the following as my/our address for service in Montserrat³.
.....
.....
.....
.....

Dated this day of, 20.....

Signature.....⁴

-
- 1. Name of registered owner(s) or registered licensee(s)
 - 2. Insert Trade, Service or Collective as appropriate
 - 3. State address.
 - 4. Signature.
-

TRADE MARKS RULES

FORM NO. 2

(Rule 7)

AUTHORISATION OF AGENT

I/We¹
 have appointed² of to
 act as my/our agent for³ No.
 and request that all notices, requisitions and communications relating thereto be sent
 to the agent at the above address.

I/We hereby revoke all previous authorisations, if any, in respect of the same
 matter of proceeding.

I/We hereby declare that I am/We are⁴

Dated this day of, 20.....
 5

Address⁶

I/we also authorise the said²
 to request the entry of an address for service as part of any registration obtained
 under the above authorisation.

Address⁶

Dated this day of, 20.....

5

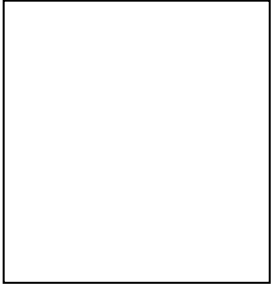
Signature.....⁷

1. The full name of all the partners in a firm must be inserted, and the kind and country of incorporation of bodies corporate stated.
2. Here insert name and address of agent.
3. Here state the particular matter or proceeding for which the agent is appointed giving the reference number, if known.
4. Here state nationality.
5. To be signed by the person appointing the agent
6. Here insert the full trade or business address of the person appointing the agent.
(To be struck out if the person appointing the Agent desires his own address to be treated as the address for service after registration)
7. To be signed in the presence of a commissioner of Oaths or Notary Public if not signed in Montserrat.

TRADE MARK RULES

FORM NO. 3

*(Rules 9 and 17)***APPLICATION TO REGISTER A TRADE MARK**

1. Full name and address (including postcode) of the person applying. If applicant is a company, state country of incorporation	
2. Illustration of mark or marks	
3. State here whether trade mark is a three dimensional	
4. State whether mark is to be registered in colour and indicate colour.	
5. If your application is for a series of marks under Rule 17 how many marks are in the series?	
6. If your application claims priority, give the Priority Date Country Number Details.	
7. If you are applying to register a UK UK Registration Number UK Registration No. Date of Registration (certified copy of UK Registration to be attached) Form No. 32.	
8. State whether you are applying for a Certification mark or Collective mark.	

9. List any limitations or disclaimers to be recorded	
10. Name and address of agent (if any)	
11. Declaration. The trade mark is being used by the applicant, or with his or her consent, in relation to the goods or services shown, or there is a <i>bona fide</i> intention that it will be used in this way. Signature.	
Name in BLOCK CAPITALS	
Date.	
12. Name and daytime phone number of the person we should contact in case of query.	
13. Number of sheets attached to this Form No.	
14. List the goods or services which you are using, or intend to use your mark in relation to.	
15. Class number, list of goods or services	

TRADE MARK RULES

FORM NO. 4

*(Rules 12, 14, 19, 41 and 43)***NOTICE OF OPPOSITION AND STATEMENT OF GROUNDS**

1. Trade mark number	
2. Full name of the applicant or registered Proprietor.	
3. Full name and address (including postcode) of person opposing	
4. Name and address (including postcode) of the agent (if any).	
5. If there are any related proceedings currently before the Registrar or the courts state application, registration or opposition number	
6. Statement of grounds for opposition and Relevant sections of Act (Use additional paper if required)	
7. Number and representation of earlier mark	
8. Goods or services (including their class) covered by the earlier mark	
9. Goods or services in the application alleged to be similar or identical to those covered by the earlier mark (if applicable)	
10. Declaration I believe that the facts stated in this notice and in the statement of grounds are true. Your signature	
11. Your name in BLOCK CAPITALS Date.	
12. Name and daytime phone number of the person to be contacted in case of query.	
Number of sheets attached to this Form No.	This is sheet 2 of

TRADE MARK RULES

FORM NO. 5

(Rules 12, 27, 28 and 29)

DEFENCE AND COUNTERSTATEMENT

1. Trade mark number	
2. Full name of the applicant or registered proprietor.	
3. Opposition, invalidation, revocation, or rectification number.	
4. Name and address (including postcode) of the agent (if any).	
5. If a statement of use of any earlier trade marks has been given in support of the opposition or invalidation action, do you accept this statement?	
6. If the answer to item 5 is "no" do you want the other side to provide proof of use of the earlier marks? If you want the other side to provide proof of use state in your counterstatement for which earlier marks and for which goods and services you require that proof.	
7. Counter statement	
8. Declaration I believe that the facts stated in this notice and in the attached statement of grounds are true. Your signature	
 Your name in BLOCK CAPITALS	
 Date	
9. Name and daytime phone number of the person we should contact in case of query.	

Your reference.

Number of sheets attached to this Form No.

Note: If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

TRADE MARK RULES

FORM NO. 6

(Rule 12)

REQUEST FOR AN EXTENSION OF TIME (see note 1)

Please read the notes below before filling in this form.

1. Trade mark number.	(Lowest) Class
2. When does (or did) the time period expire?	
3. If the request is in respect of a published mark which is in dispute, what is the opposition, invalidation, revocation, or rectification number? (See note 2.)	
4. How much more time do you want from the date stated at 2 above?	
5. Why do you want more time? (Use a separate blank sheet if there is not enough space for your answer.)	
6. Full name of the person or company making this request.	
7. Your name and address (including postcode) or your agent's name and address, if you have one.	
8. Your signature.	
Your name in BLOCK CAPITALS.	
Date.	
9. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this form.	This is sheet 1 of

Notes:

1. This form is for use where the request is being made for any of the following reasons:
Extension to the period for resolving filing deficiencies;
Extension of time after publication;

Any request for a retrospective extension;

All other requests (including those following an *ex-parte* hearing) should be made by letter without payment of a fee.

2. If the request is for a trade mark which is in dispute, you must send a copy of this request to everyone else involved in the case.

TRADE MARK RULES

FORM NO. 7

(Rule 14)

CHANGE OR AMENDMENT TO AN APPLICATION

1. Trade mark numbers in relation to which change or amendment requested. (List on a separate sheet if there is not enough space on this Form No.)	
2. Full name of the applicant or proprietor as now shown on our records.	
3. New name or address (including postcode) to be recorded.	
Other change to an application	
4. Details of change.	
5. Name and address (including postcode) of agent (if any), or your contact address (including postcode) if not the same as in Section 3.	
6. Declaration. I declare there has been no change in the ownership of the Marks, and that I have the authority to request this change Signature.	
Name in BLOCK CAPITALS	
Date.	
7. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	

TRADE MARKS RULES

FORM NO. 8

*(Rule 15)***REQUEST TO DIVIDE AN APPLICATION**

Please read the notes below before filling in this form.

1. Trade mark application number.	(Lowest) Class
2. Full name of the applicant.	
3. Do you want to divide: (a) the list of goods or services; or (b) a series of marks? List the class number or numbers, or the goods or services, or the marks in the series, to be transferred. Use a separate sheet if there is not enough space on this form and say in section 7 how many sheets are attached.	
4. How many parts do you want to divide the application into?	
5. Name of agent (if any).	
6. Signature.	
Name in BLOCK CAPITALS.	
Date.	
7. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this form.	This is sheet 1 of

Notes:

If we have objected to some of the classes in a multi-class application, you can divide the application to allow those classes which are acceptable to go forward for publication, and for objections to the remaining classes to be dealt with later in more detail. List in section 3 the class number or numbers, or the goods or services to be transferred to a divisional application.

TRADE MARK RULES

FORM NO. 9

(Rule 16)

REQUEST TO MERGE APPLICATIONS

1. Trade mark numbers to be merged. (List on a separate sheet if there is not enough space on this Form No.)	
2. Full name of the proprietor as now shown on our records.	
3. Full name and address (including postcode) to which confirmation that the merger is completed should be sent	
4. The address given in section 3 above will be used for future correspondence about these marks unless a different address is provided here.	
5. Your Signature.	
Your name in BLOCK CAPITALS.	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	

Notes:

1. You cannot merge applications and registrations together or merge expired marks.
You cannot reverse the merger process.
2. It is important that you notify us of any change to your e-mail address.

Applications:

You can merge applications at any time before they are accepted for advertisement, as long as they have the same application date **and** are for the same marks **and** are in the same ownership.

TRADE MARK RULES

FORM NO. 10

*(Rule 16)***REQUEST TO MERGE REGISTRATIONS**

Please read the notes below before filling in this form.

1. Trade mark numbers to be merged. (List on a separate sheet if there is not enough space on this form.)	(Lowest) Class
2. Full name of the applicant or proprietor as now shown on our records.	
3. Full name and address (including postcode) where we should send confirmation that we have completed the merger. Trade Marks ADP number (if you know it).	
4. We will record the address given in section 3 above as the contact address for future correspondence about these marks unless you give a different address here.	
5. Your Signature.	
Your name in BLOCK CAPITALS.	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this form.	This is sheet 1 of
7. E-mail Contact Details If your e-mail contact details have changed, please notify us of the new e-mail address (see note 2).	

Notes:

1. You cannot merge applications and registrations together or merge expired marks. You cannot reverse the merger process.
2. It is important that you notify us of any change to your e-mail address.

Registration:

You can merge registrations at any time, as long as they are for the same marks **and** are in the same ownership.

Registered marks do not have to have the same registration dates but, on merging, the new merged registration will take the latest filing date.

TRADE MARK RULES

FORM NO. 11

*(Rule 18)***REGISTRATION OF CERTIFICATION MARK OR COLLECTIVE MARKS**

1. Trade mark or numbers.	
2. Full name of the applicant	
3. This is an application in respect of a: a) certification mark, or b) collective mark? and the Regulations governing the use of the mark are annexed to this Form No.	
4. Name and address (including postcode) of agent (if any).	
5. Signature	
Name in BLOCK CAPITALS.	
Date.	
6. Name and daytime phone number of the person we should contact in case of query	
Number of sheets attached to this Form No.	

TRADE MARK RULES

FORM NO. 12

(Rule 19)

APPLICATION TO AMEND REGISTRATION OF
CERTIFICATION MARK OR COLLECTIVE MARKS

1. Trade mark or numbers.	
2. Full name of the applicant	
3. Is this application for a: a) certification mark, or b) collective mark?	
4. Name and address (including postcode) of agent (if any).	
5. Signature	
Name in BLOCK CAPITALS.	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
7. Amendment to Regulations (Use additional sheets if required)	
Number of sheets attached to this Form No.	

TRADE MARK RULES

FORM NO. 13

*(Rule 21)***REQUEST TO ALTER REGISTERED TRADE MARK**

1. Trade mark number:	
2. Full name and address (including postcode) of the registered proprietor.	
3. Details of the alteration requested.	
4. Name and address (including postcode) of the agent (if any).	
5. Signature.	
Name in BLOCK CAPITALS	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	

TRADE MARK RULES

FORM NO. 14

(Rule 22)

NOTICE TO SURRENDER A REGISTRATION

1. Trade mark number to be surrendered	
2. Full name of the registered proprietor.	
3. List names and addresses of any other person having a registered interest in the mark.	
4. Full name and address (including postcode) Where we should send confirmation that we have taken the action requested.	
5. Declaration. I declare that I have authority to surrender this Delete any statement which does not apply registration. I confirm that no-one else has an interest in this mark, or confirm that I have notified everyone listed as having a registered interest in this mark three months before sending this Form No., or I confirm that everyone listed as having a registered interest in this mark consents to its surrender	
Signature.	
Name in BLOCK CAPITALS	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	

TRADE MARK RULES

FORM NO. 15

*(Rule 22)***NOTICE TO PARTIALLY SURRENDER A REGISTRATION**

1. Trade mark number.	
2. Full name of the registered proprietor.	
3. List goods or services to be surrendered	
4. List the names and addresses of any other person having an interest in the mark	
5. Declaration I declare that I have authority to partially this Surrender registration. I confirm that no-one else has an interest in this mark, or confirm that I have notified everyone listed as having a registered interest in this mark three months before sending this Form No., or I confirm that everyone listed as having a registered interest in this mark consents to its partial surrender. Delete the statements that do not apply	
Signature.	
Name in BLOCK CAPITALS	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	

TRADE MARK RULES

FORM NO. 16

(Rules 24 and 25)

RENEWAL OF TRADE MARK REGISTRATION

1. Trade mark number	
2. Which classes are now registered?	
3. Which classes do you want to renew, if not all?	
4. Full name of the registered proprietor.	
5. Renewal date.	
6. Name and address (including postcode) where we should send confirmation of renewal.	
7. Signature.	
Your name in BLOCK CAPITALS.	
Date.	
8. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	

TRADE MARK RULES

FORM NO. 17

*(Rules 26)***REQUEST TO RESTORE OR RENEW REGISTRATION**

1. Trade mark number	
2. Class or classes you want to renew, if not all	
3. Full name of the proprietor as now shown on our records.	
4. When should the mark have been renewed?	
5. Your name and address (including postcode), if you are not the proprietor, or your agent's name and address, if you have one.	
6. Your signature	
Your name in BLOCK CAPITALS.	
Date	
7. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this Form No.	This is sheet 1 of

Trade Mark Rules

Form No. 18

(Rules 27 and 28)

APPLICATION FOR REVOCATION OF REGISTRATION

1. Trade mark number in relation to which application is made	
2. Full name of the registered proprietor.	
3. Full name and address (including postcode) of the applicant for revocation	
4. Name and address (including postcode) of the agent (if any).	
5. Your signature	
Your name in BLOCK CAPITALS	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	This is sheet 1 of

Note: Attach a statement of grounds on which application for revocation of trade mark.

TRADE MARK RULES

FORM NO. 19

*(Rule 29)***APPLICATION TO INVALIDATE REGISTERED TRADE MARK**

1. Trade mark number in respect of which the application is made	
2. Full name of the registered proprietor.	
3. Full name and address (including postcode) of the applicant for invalidation of trade mark	
4. Name and address (including postcode) of the agent (if any).	
5. Your signature	
Your name in BLOCK CAPITALS	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	This is sheet 1 of

Note: Attach a statement of grounds in support of application.

TRADE MARK RULES

FORM NO. 20

(Rule 30)

APPLICATION TO RECTIFY THE REGISTER

1. Trade mark number.	
2. Full name of the registered proprietor.	
3. Name and address of the applicant for rectification (if not the registered proprietor)	
4. Details of the error or omission to be corrected. (Attach a separate sheet if necessary.)	
5. Name and address (including postcode) of the agent (if any).	
6. Declaration I declare that to the best of my knowledge there is no action concerning this registration pending in the courts. I believe that the facts stated in the attached statement of case are true. Your signature	
Your name in BLOCK CAPITALS	
Date.	
7. Name and daytime phone number of the person to be contacted in case of query.	
Number of sheets attached to this Form No.	This is sheet 1 of

Note: You must attach a statement of your reasons for making this request.

TRADE MARK RULES

FORM NO. 21

*(Rule 31)***APPLICATION TO INTERVENE IN PROCEEDINGS**

1. Trade mark number.	
2. Full name of the registered proprietor.	
3. Full name and address of the applicant for intervention.	
4. Name and address of the agent (if any).	
5. Your signature	
Your name in BLOCK CAPITALS	
Date.	
6. Name and phone number of the person we should contact in case of query.	
Your reference.	
Number of sheets attached to this Form No. This is sheet 1 of	

Note: You must attach a statement of your reasons for making this application.

TRADE MARK RULES

FORM NO. 22

(Rule 37)

(Amended by S.R.O. 62/2012)

APPLICATION TO RECORD A CHANGE OF OWNERSHIP

1. Trade mark number affected. (List on a separate sheet if there is not enough space on this form)	
2. Full name of the registered proprietor as shown on our records	
3. Full name and address of the new applicant or proprietor (including postcode)	
4. (a) If the new proprietor is a corporate body, in what country is it incorporated (b) If incorporated in the USA, also give the state in which it is incorporated	
5. Date new proprietor took ownership	
6. If only part of the ownership has been transferred, for example, by partial assignment, what rights or goods or services have been transferred	
7. Authorisation to change the register You must complete (a) and (b). (See note 3) (a) Signature of the current applicant or proprietor or representative Name in BLOCK LETTERS Status of signatory Date	

<p>(b) Signature of the new applicant or proprietor or representative</p> <p>Name in BLOCK LETTERS</p> <p>Status of signatory</p> <p>Date</p>	
<p>Number of sheets attached to this form</p>	<p>This is sheet 1 of</p>

Notes:

1. If the applicant or proprietor has merely changed his/her/its name, use Form 27.
2. Before completing this form, check the proprietor's name and the marks owned by the proprietor by doing a proprietor search.
3. Both the old and new proprietors or their representatives must sign the form. If this cannot be done, you must send a copy of the deed of assignment or other written proof of the transaction.

TRADE MARK RULES

FORM NO. 23

(Rule 37)

APPLICATION TO REGISTER A LICENCE

1. Trade mark number or numbers. (List on a separate sheet if there is not enough space on this Form No.)	
2. Full name of the proprietor as now shown on our records.	
3. Full name and address of the licensee.	
4. (a) Date licence starts. (b) Date licence ends (if any).	
5. Is the licence exclusive?	
6. List the goods or services which each class Class Goods or services for which licence is to be registered (or state 'ALL').	
7. Geographical area to which licence is limited (or state 'NONE').	
8. Full name and address where confirmation of Registration of the licence should be sent	
9. Signature of the registered proprietor (or their representative).	
Name in BLOCK CAPITALS	
Date.	
10. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached to this Form No.	

TRADE MARK RULES

FORM NO. 24

*(Rule 37)***APPLICATION TO REMOVE OR AMEND
THE REGISTRATION OF A LICENCE**

1. Trade mark number or numbers (List on a separate sheet if there is not enough space on this Form No.)	
2. Full name of the proprietor as now shown on our records.	
3. Full name of the licensee.	
4. Is this request to: (a) remove the licensee, or (b) amend the licensee details? If so, please give full details of amendment.	
5. Full name and address where confirmation of recording of transaction should be sent	
6. Signature of the registered proprietor (or their representative).	
Name in BLOCK CAPITALS	
Date.	
7. Name and daytime phone number of the person we should contact in case of query.	
Number of sheets attached this Form No.	

TRADE MARK RULES

FORM NO. 25

(Rule 37)

APPLICATION TO GRANT, AMEND OR TERMINATE SECURITY INTEREST

1. Trade mark number or numbers. (List on a separate sheet if there is not enough space on this Form No.)	
2. Full name of the proprietor as now shown on our records.	
3. Full name and address of the interested person	
4. (a) Date security interest commences in case of grant of security interest. (b) Date security interest terminates (if applicable). (c) In the case of amendment to existing security Interest, state nature of amendment requested and date of commencement or termination as applicable. (d) In case of termination state effective date of termination of security interest In relation to items (a) (b) (c) and (d) of this item state nature of security interest in each case.	
5. Full name and address where confirmation of registration of the licence should be sent	
6. Signature of the registered proprietor (or their representative). Name in BLOCK CAPITALS Date.	
7. Name and daytime phone number of the person we should contact in case of query. Number of sheets attached to this Form No.	

TRADE MARK RULES

FORM NO. 26

*(Rule 39)***REQUEST FOR A CERTIFIED COPY**

1. Trade mark number.	
2. No of copies required	
3. Confirm whether you wish for a certified copy of: (a) the application as it was applied for, (b) the application or registration as it is. (c) other documentation (give details.)	
4. Full name and address where certified copy to be sent.	
5. Your signature	
Your name in BLOCK CAPITALS	
Date.	
6. Name and daytime phone number of the person we should contact in case of query.	

TRADE MARK RULES

FORM NO. 27

(Rule 40)

(Amended by S.R.O. 62/2012)

CHANGE OF PROPRIETOR'S NAME OR ADDRESS

1. Trade mark numbers to be changed	
2. Change of name or address Full name of applicant or proprietor as now shown on our records	
3. New name or address to be recorded (including postcode)	
4. Name and address of agent	
5. Declaration Signature Name in BLOCK LETTERS Date	I declare there has been no change in ownership of the trade mark and that I have the authority to request this change.
6. Name and daytime phone number of the person we should contact in case of query	
7. Number of sheets attached to this form	This is sheet 1 of

TRADE MARK RULES

FORM NO. 28

*(Rule 44)***REQUEST FOR INFORMATION ABOUT
EVENTS IN THE PROGRESS OF A TRADE MARK***Please read the notes below before filling in this form.*

1. Trade mark number.	<i>(Lowest)</i> Class
2. Event you want to be notified about A Application published or withdrawn, refused or abandoned before publication. B Opposition filed. C Application registered or withdrawn, refused or abandoned after publication. D Registration renewed or removed. E Registration surrendered or revoked F Assignment application received. G Full or partial assignment received Other – please say what you want to know.	List here the letter shown against the event.
3. Full name and address (including postcode) where we should send the information.	
Your signature.	
Your name in BLOCK CAPITALS.	
Date.	
4. Name and daytime phone number of the person we should contact in case of query.	
Your reference.	

Notes: We charge a fee for each event that you want to be told about.

TRADE MARK RULES

FORM NO. 29

(Rule 56)

REQUEST FOR A STATEMENT OF REASONS FOR REGISTRAR'S DECISION

1. Trade mark application number and number of proceedings or matter in relation to which reasons for decision requested	
2. Full name of the applicant.	
3. Name and address of agent (if any).	
4. Signature.	
Name in BLOCK CAPITALS	
Date.	
5. Name and daytime phone number of the person we should contact in case of query.	

