



Conyers Dill & Pearman

Intellectual Property and Trade Mark Protection in Bermuda

Foreword

This memorandum has been prepared for the assistance of those who are seeking information on the protection and enforcement of intellectual property rights in Bermuda, and deals in broad terms with the statutory regime and procedure for the registration of trade marks. It is not intended to be exhaustive, but provides brief details and information which we hope will be of use to our clients.

This memorandum has been prepared on the basis of the law and practice as at the date referred to below.

Conyers Dill & Pearman

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1. INTELLECTUAL PROPERTY PROTECTION IN BERMUDA

Bermuda has comprehensive legislation protecting all aspects of intellectual property. The majority of Bermudian intellectual property ("IP") laws derive from their UK equivalents. The legal system is common law, and continues to evolve to meet the needs of current technological developments and trends. Bermuda is not a signatory to the Paris Convention or the Patent Cooperation Treaty, nor was it party to the GATT Trips agreement.

Relief available for IP infringement includes emergency and permanent injunctions, Anton Piller orders, delivery up and/or destruction of infringing articles, discovery upon oath, damages, an enquiry as to damages or an account of profits. Costs will usually be awarded to the winning party.

2. THE REGISTRATION OF TRADE MARKS IN BERMUDA

2.1 Statutory Regime

Trade Marks and Service Marks are registered in Bermuda pursuant to the Trade Marks Act 1974 (as amended) ("the Act"). The statutory provisions were largely derived from similar provisions in the old 1938 U.K. legislation. Bermuda is not a party to any international convention on the protection of trade marks.

Under the Act, trade marks registered in the UK (under UK as opposed to Community or International Trade Mark provisions) will automatically be deemed to meet the registrability criteria in Bermuda, subject to the same conditions and limitations imposed by the UK Registrar. It is not possible to "extend" a UK registration to Bermuda (as is possible in Cayman and the British Virgin Islands), and a separate local application must be filed.

It is not possible to widen the scope of a specification post filing, and it is therefore of the utmost importance that all goods/services of interest are included on the initial application. Full class headings are acceptable in all goods classes, except class 7 and class 9, and in most service classes. It is not necessary to prove use prior to securing registration. Under the Act, multi-class applications are not possible, and it is therefore necessary to file separate applications in each particular class of interest. Series applications are available.

2.2 The Register

Bermuda operates an independent trade marks register, which is divided into Parts A and B. To be registrable in Part A, a mark must inherently distinguish the applicant's goods or services from those of other traders. Part B is for less distinctive marks.

The principal difference between registration in Parts A and B is that after seven years, a Part A registration is deemed to be conclusively valid unless it can be shown that the registration was obtained by fraud or offends certain specific provisions of the 1974 Act. Furthermore, the infringer of a Part A registration cannot rely on the statutory defence that there is no likelihood of confusion - a defence available to the infringer of a Part B registration.

Registration is valid for an initial period of 7 years, and may be renewed for subsequent fourteen year periods on payment of a fee.

2.3 Procedure

Applications for registration are prepared and filed with the Intellectual Property Office, which operates under the auspices of the Ministry of Labour, Home Affairs and Public Safety, Bermuda Government. An application will only be accepted if it is accompanied by an authorization of agent form (specimen attached). A questionnaire setting out pertinent information required to complete the application process is also attached. Bermuda follows the WIPO international classification system for goods and services (Nice Classification 9thth edition).

The examination process usually takes about two months. The time limit imposed by the Registrar for responding to office actions is six months from the date of issue, although time extensions are available in two month blocks.

Once a mark is accepted for registration, it is advertised for opposition purposes. If no third party opposition is filed within the statutory two month period, application is made for issue of the registration certificate. In a straight-forward case, the registration certificate would normally issue within eighteen months from the time of filing the application.

Registrations in Bermuda may become vulnerable to attack by aggrieved third parties following five years continuous non-use.

3. DOCUMENTATION

3.1 Trade Mark/Service Mark Registration Questionnaire

To ensure all information required to complete the application process is available (and so avoid any delay in filing), we have prepared a questionnaire which must be completed and returned with all filing instructions. It is particularly important to provide a comprehensive list of all goods/services intended to be covered by the application, as it is not possible to widen the scope of a specification post filing. Where application is to be made for a colour mark, or for a mark which contains a particularly detailed device element, it is necessary to provide 6 clear prints of the mark.¹

¹ A form of Trade Mark/Service Mark Registration Questionnaire is available upon request.

3.2 General Authorization of Agent Form

In Bermuda, an application will not be accepted by the Intellectual Property Office (or a filing date allocated to such an application) if it is not accompanied by an authorization of agent form simply signed by an authorized representative of the applicant. A copy of the signed authorization of agent submitted via e-mail or fax is acceptable for filing purposes.²

² The Authorization of Agent form is available upon request.

This publication is not a substitute for legal advice nor is it a legal opinion. It deals in broad terms only and is intended merely to provide a brief overview and give general information.

About Conyers Dill & Pearman

Conyers Dill & Pearman advises on the laws of the Cayman Islands, British Virgin Islands, Bermuda, Mauritius and Cyprus. Conyers' lawyers specialise in company and commercial law, commercial litigation and private client matters.

The combination of Conyers' structure, culture and expertise enables the highest quality, responsive, timely and thorough legal advice. Conyers' strategic global presence in major international business centres allows a seamless 24 hour service.

Conyers' sophisticated client base includes FTSE 100 and Fortune 500 companies. Working with leading local and international firms, Conyers advises on highly complex multi-jurisdictional projects.

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Founded in 1928, Conyers has 600 staff, including more than 150 lawyers.

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