



MONTSERRAT

CHAPTER 15.23

TRADE MARKS ACT

Revised Edition
showing the law as at 1 January 2002

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—

TRADE MARKS ACT

Act 19 of 1999 .. in force 28 February 2000

Amended by Act 7 of 2000 .. in force 14 November 2000

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CHAPTER 15.23

TRADE MARKS ACT

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CHAPTER 15.23

TRADE MARKS ACT

(Acts 19 of 1999 and 7 of 2000)

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

Commencement

[28 February 2000]

PART I

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 II

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 paragraph (b), (c), (d) or (e) of subsection (1) 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 3 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 paragraphs (b) to (d) of subsection (1), 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 labeling 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

(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.

(3) 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.

(4) 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.

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

(6) 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.

(7) 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.

(8) 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 in Council 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.

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 III

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 IV

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 in Council 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.

(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 Council.

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 in Council 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.

(2) The rules may contain such provision as the Governor in Council 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.

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 in Council 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 in Council 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 in Council 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.

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 not exceeding 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.

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