

TRADE MARKS BILL, 2024

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TRADE MARKS BILL, 2024

A BILL FOR AN ACT TO IMPROVE THE LEGISLATIVE FRAMEWORK WITH RESPECT TO THE PROTECTION AND REGISTRATION OF TRADE MARKS; TO GIVE EFFECT TO CERTAIN INTERNATIONAL OBLIGATIONS OF THE BAHAMAS WITH RESPECT TO TRADE MARKS; TO REPEAL THE TRADE MARKS ACT, 2015 AND TO PROVIDE FOR CONNECTED MATTERS

Enacted by the Parliament of The Bahamas

PART I—PRELIMINARY

1. Short title and commencement.

- (1) This Act may be cited as the Trade Marks Act, 2024.
- (2) This Act shall come into operation on such day as the Minister may, by notice published in the Gazette, appoint.

2. Interpretation.

- (1) In this Act —
 - “**business**” includes a trade or profession;
 - “**certification mark**” means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, materials, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics;

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

“convention country” means any country that is a member of —

- (a) the World Trade Organization;
- (b) the Convention of the Union of Paris made on March 20, 1883 and any amendments and revisions thereof made before or after July 1, 1954; or
- (c) any other treaty which the Minister may designate by Order;

“Court” means the Supreme Court;

“covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper;

“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 and the expression “exclusive licensee” shall be construed accordingly;

“geographical indication” means an indication that identifies goods as originating in the territory of a country, or a region or locality in that territory, where a given quality, reputation or other characteristic of the goods is essentially attributable to its geographical origin;

“goods” means anything which is the subject of trade, manufacture or merchandise;

“Intellectual Property Office” means the Intellectual Property Office established by section 3 of the Patents Act;

“international classification” means the classification according to the Nice Agreements concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, of 15th June, 1957 as revised;

“label” includes any band or ticket;

“Minister” means the Minister responsible for trade marks;

“official mark” means a mark adopted and used by a public authority of The Bahamas for use with goods or services;

“Paris Convention” means the Paris Convention for the Protection of Industrial Property of March 20, 1883, as last revised;

“prescribed” means in relation to proceedings before the Court, prescribed by rules of court, and, in other cases, prescribed by this Act or the Regulations thereunder;

“priority date” means the date of the earlier application that serves as the basis for the right of priority provided for in the Paris Convention;

“published” means made available to the public and a document shall be taken to be published if a reproduction thereof can be inspected as of right by members of the public whether on payment of a fee or not;

“Register” means the Register of Trade Marks referred to in this Act;

“registered trade mark” means a trade mark which is actually upon the register;

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

“Registrar” means the Registrar of the Intellectual Property Office and any reference to the Registrar shall be construed as including a reference to any officer discharging the functions of the Registrar;

“services” means the performance of any service which is the subject of trade;

“sign” means a word, a personal name, a design, a letter, a numeral, a colour, a figurative element, a three-dimensional shape, a hologram, a moving image, a mode of packaging goods, a sound, a scent, a taste, a texture and the positioning of a sign;

“trade” includes any business or profession;

“trade mark” means —

- (a) a sign or combination of signs that is used or proposed to be used by a person for the purpose of distinguishing or so as to distinguish their goods or services from those of others; or
- (b) a certification mark;

“trafficking” in relation to a trade mark, means the registration of a trade mark by a person who has no intention of using the trade mark in relation to the marketing or sale of any goods or services in The Bahamas but only for the purpose of being able to licence its use to other persons;

“well known trade mark” means —

- (a) any registered trade mark that is well known in The Bahamas; or
- (b) any unregistered trade mark that is well known in The Bahamas and that belongs to a person who —
 - (i) is a national of The Bahamas or a Convention country, or

(ii) is domiciled in, or has a real and effective industrial or commercial

establishment in, The Bahamas or a Convention country, whether or not that person carries on business, or has any goodwill, in The Bahamas;

“WTO Agreement” means the Agreement on Trade Related Aspects of Intellectual Property Rights and any revisions thereto;

“WTO Member” means a Member of the World Trade Organization established by Article 1 of the Marrakesh Agreement in April, 1994.

- (2) For the purposes of this Act —
- (a) goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services;
 - (b) a likelihood of confusion between two trade marks will be presumed if, because of the identity or similarity between the respective signs and the identity or similarity between the respective goods or services, an average consumer might either mistake one trade mark for the other, or is likely to believe that one undertaking’s goods or services are from the same or economically linked undertakings.
- (2) Where the two trade marks are identical and the goods or services are also identical, a likelihood of confusion shall be presumed.
- (3) References in the Act to a trade mark include, unless the context otherwise requires, references to a collective mark or a certification mark.

PART II – THE REGISTRAR AND THE REGISTER

3. Functions of Registrar.

The Registrar of the Intellectual Property Office shall be responsible for matters relating to trade marks as provided herein.

4. Register of trade marks.

- (1) The Registrar shall maintain under his control and management for the purposes of this Act the Register wherein shall be entered all registered trade marks, certification marks and collective marks with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations and such other matters relating to such trade marks as may from time to time be prescribed.

- (2) The Registrar shall publish in the Register a notice of the registration of any trade mark.
- (3) The Register shall contain all such particulars of any application for the registration of a trade mark as may be prescribed (including a representation of the sign) and such other information relating to the trade mark as the Registrar thinks fit.
- (4) There shall not be entered in the Register any notice of any trust expressed, implied or constructive, nor shall any such notice be receivable by the Registrar.
- (5) The Register shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the office, of any entry in such register shall be given to any person requiring the same on payment of the prescribed fee.
- (6) The register may be kept manually or electronically.

5. Correction of Register.

- (1) The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled in law to act in his name —
 - (a) correct any error in the name or address of the registered proprietor of a trade mark;
 - (b) enter any change in the name or address of the person who is registered as proprietor of a trade mark;
 - (c) cancel the entry of a trade mark on the Register;
 - (d) strike out any goods or services from those for which a trade mark is registered; or
 - (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.
- (2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

6. Powers and duties of the Registrar in respect of forms.

- (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 proceedings before him under this Act.

- (2) The Registrar shall make all forms available together with any directions with respect to their use.

PART III - REGISTRATION OF TRADE MARKS

7. Registrable trade marks.

- (1) A trade mark is registrable —
- (a) only in respect of particular goods or services; and
 - (b) if it is distinctive.
- (2) For the purposes of subsection (1), a trade mark is “distinctive” if it is capable of distinguishing the goods or services of the proprietor of the trade mark from those of other persons.
- (3) In determining whether a trade mark is so capable, the Registrar may, in the case of a trade mark in actual use, take into consideration the extent to which such use has rendered such trade mark in fact distinctive for the goods or services with respect to which it is registered or proposed to be registered.

8. Restriction on registration.

It shall not be lawful to register as a trade mark —

- (a) any sign that is devoid of any distinctive character or is otherwise incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) any matter, the use of which would —
 - (i) be calculated to deceive the public in particular as regards the geographical origin of the goods or services concerned or their nature, quality or other characteristics; or
 - (ii) otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or constitute a scandalous design;
- (c) any sign that consists exclusively of matter or an indication that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time and production of goods or of rendering of service, or of other characteristics of goods or services;
- (d) any sign that consist exclusively of matter and indication that has become customary in current language or in the *bona fide* established practices of the trade, or is a usual or recognised technical or scientific name of a product or service;

- (e) any sign that is not distinct from the goods or services to which it applies, or consists of a feature or characteristic that results from the nature of the goods or services themselves;
- (f) in connection with a business, any sign consisting of, or so nearly resembling as to be likely to be mistaken for —
 - (i) the Royal Arms, Crest or Standard;
 - (ii) the arms or crest of any member of the Royal Family;
 - (iii) the standard, arms or crest of Her Excellency the Governor General;
 - (iv) any word or symbol likely to lead to the belief that the goods or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or governmental patronage, approval or authority;
 - (v) the flag or armorial bearings of The Bahamas or a convention country without the authorisation of the Government of The Bahamas or the competent authorities of the convention country, unless it appears to the Registrar that use of the flag or the armorial bearings in the manner proposed is permitted without such authorisation;
 - (vi) the words “United Nations” or the official seal or emblem of the United Nations;
 - (vii) any badge, crest, emblem or sign adopted or used by —
 - (aa) the Royal Bahamas Defence Force, the Royal Bahamas Police Force or any other governmental body;
 - (bb) any university; or
 - (cc) any public authority in The Bahamas as an official mark for goods or services in circumstances where the use of such sign would be likely to could create an improper association between the public authority and the goods and services to which the trade mark would relate.

9. Prohibition on registration.

- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- (2) A trade mark shall not be registered if —

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or
 - (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected and there exists a likelihood of confusion on the part of the public.
- (3) A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that —
 - (a) the earlier trade mark is well known in The Bahamas; and
 - (b) the use of the later mark in relation to the goods or services for which the later trade mark is sought to be registered —
 - (i) would indicate a connection between those goods or services and the proprietor of the earlier trade mark, and is likely to damage the interests of the proprietor of the earlier trade mark; or
 - (ii) would, without due cause, be detrimental to the distinctive character or the repute of the earlier trade mark, irrespective of whether the goods and services for which the trade mark is to be registered are identical with or similar to those for which the earlier trade mark is protected.
- (4) When determining whether an earlier trade mark is well known, regard shall be had to the extent to which it is known to the public in The Bahamas, based upon the nature and the extent of its use in The Bahamas, and the nature and extent to which it has been promoted in The Bahamas.
- (5) A trade mark must not be refused registration by virtue of subsection (3) if the application for registration of the trade mark was filed before the earlier trade mark became well known in The Bahamas, unless it is shown that the application was made in bad faith and in deciding whether any such application was filed in bad faith, it shall be relevant to consider whether the applicant had, at the time the application was made, knowledge of or, or reason to know of, the earlier trade mark.
- (6) A trade mark shall not be registered if, or to the extent that, at the date of application, its use in The Bahamas is liable to be prevented —
 - (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade;
 - (b) by virtue of any enactment or rule of law, providing for protection of designations of origin or geographical indications; or
 - (c) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) or (b) above, in particular by

virtue of the law of copyright, or any law relating to the protection of designs.

- (7) A person entitled to prevent the use of a trade mark in accordance with subsection (6)(c) shall be referred to as the proprietor of an “earlier right”.
- (8) The Registrar may, in his or her discretion, register a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.
- (9) The proprietor of an unregistered trade mark which is entitled to protection under Article 6bis of the Paris Convention or the WTO Agreement as a ‘well-known’ trade mark is entitled to challenge the registration of a trade mark which is identical or similar to the well known trade mark in relation to identical or similar goods or services, where the use is likely to cause confusion.
- (10) A period of five years from the date of registration shall be allowed for requesting the cancellation of such a mark pursuant to subsection (9), unless it can be shown that the mark was filed in bad faith.
- (11) A trade mark shall not be registered where the application for registration was made in bad faith or where registration of the sign would consolidate or facilitate an act of unfair competition.
- (12) Nothing in subsection (8) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.
- (13) An earlier trade mark that is a registered trade mark whose registration has expired must continue to be taken into account in determining the registrability of the trade mark in question until the date mentioned in subsection (14), unless the Registrar is satisfied that there was no *bona fide* use of the earlier mark during the two years immediately preceding that date.
- (14) The date mentioned in subsection (13) is the last date specified in this Act or regulations made under this Act on which the registration of the earlier mark may be restored or renewed.
- (15) Where grounds for refusal of an application for registration of a trade mark under this section exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.
- (16) For the purpose of this section, bad faith may be deemed to exist where a trade mark is sought to be registered in order to undermine the interests of third parties, to gain the exclusive right a registration confers for purposes other than the genuine use of a mark indicating the origin of the goods or

services or in order to avoid the loss of a trade mark which has not been used by the proprietor as required by the Act.

- (17) The Minister may make regulations to further restrict the registration of trade marks.

10. Deemed use etc. of trade marks.

- (1) For the purpose of this Act, a trade mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the covering of the goods in which they are distributed or it is in any other manner so associated with the goods that notice of the association is thereby given to the person to whom the property or possession is transferred.
- (2) A trade mark is deemed to be made well known in The Bahamas if it is used by a person in a convention country, other than The Bahamas, in association with goods or services, and —
- (a) the goods are distributed in association with it in The Bahamas; or
 - (b) the goods or services are advertised in association with it —
 - (i) in any printed publication circulated in The Bahamas in the ordinary course of business among potential traders in or users of the goods or services; or
 - (ii) on radio, television or other media transmissions ordinarily received in The Bahamas by potential traders in or users of the goods or services; andit has become well known in The Bahamas by reason of the distribution or advertising.
- (3) A trade mark that is marked in The Bahamas on goods or on the covering of the goods, when the goods are exported from The Bahamas, is deemed to be used in The Bahamas in association with those goods.
- (4) A trade mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

11. Application for registration.

- (1) An application for registration of a trade mark shall be made to the registrar on such form as may be prescribed.
- (2) The application shall contain —
- (a) a request for registration of a trade mark;
 - (b) the name and address of the applicant;
 - (c) an indication 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, which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor.
- (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 of fees as may be prescribed.

12. Date of filing.

- (1) The date of filing of an application for registration of a trade mark is the date on which documents containing all information required by section 11(2) are furnished to the registrar by the applicant.
- (2) If the documents referred to in subsection (1) 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.

13. Division of application for registration.

- (1) Subject to this section and any rules made under subsection (3), an application for registration of a trade mark may, at the request of the applicant, be divided into two or more separate applications for registration of the trade mark.
- (2) A request under subsection (1) —
 - (a) must be made to the Registrar —
 - (i) in the prescribed manner; and
 - (ii) before the trade mark is registered; and
 - (b) is subject to the payment of such fee as may be prescribed.
- (3) The Minister may make rules for the purposes of this section and may, in those rules, provide for —
 - (a) the circumstances in which an application for registration of a trade mark may be divided;
 - (b) the conditions to be satisfied before a request under subsection (1) may be granted by the Registrar; and

- (c) the effect of dividing an application for registration of a trade mark into two or more separate applications for registration of the trade mark.

14. Classification of trade marks.

- (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 questions arising as to the class within which any goods or services fall shall be determined by the Registrar.

15. Claim to priority of Convention application.

- (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a “Convention application”), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.
- (2) If the application for registration under this Act is made within the six-month period specified in subsection (1) —
 - (a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application; and
 - (b) the registrability of the trade mark shall not be affected by any use of the sign in The Bahamas in the period between that date and the date of the application under this Act.
- (3) Any filing which in a Convention country is equivalent to a regular national filing under the domestic legislation of that country or an international agreement, shall be treated as giving rise to the right of priority.
- (4) For the purposes of subsection (3), a “regular national filing” means a filing which is adequate to establish the date on which the application was filed in the convention country, irrespective of the subsequent fate of the application.
- (5) A subsequent application concerning the same subject as the first Convention application, filed in the same Convention country, shall be considered the first Convention application (of which the filing date is the starting date of the period of priority), if at the time of the subsequent application—
 - (a) the previous application has been withdrawn, abandoned or refused, without having been laid open to public inspection and without leaving any rights outstanding; and
 - (b) it has not yet served as a basis for claiming a right of priority,

and the previous application may not thereafter serve as a basis for claiming a right of priority.

- (6) The Minister may prescribe by regulations rules as to the manner of claiming a right to priority on the basis of a Convention application.
- (7) A right to priority arising as a result of a Convention application may be assigned or otherwise transmitted, either with the application or independently.

16. Claim to priority from other relevant overseas application.

- (1) The Minister may, by order, confer on a person who has duly filed an application for protection of a trade mark in a country or territory in relation to which the Government of The Bahamas has entered into a treaty, convention, arrangement or engagement 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.
- (2) An order under this section may make provision corresponding to that made by section 15 in relation to Convention countries or such other provisions as appears to the Minister to be appropriate.

17. Examination of application.

- (1) The Registrar must examine whether an application for registration of a trade mark satisfies the requirements of this Act (including any requirements imposed by rules made under this Act).
- (2) For the purpose of subsection (1), the Registrar may carry out a search, to such extent as the Registrar considers necessary, of earlier trade marks.
- (3) Subject to the provisions of this Act, the Registrar may refuse an application, or may accept it absolutely or subject to conditions, amendments or modifications.
- (4) In case of any such refusal or conditional acceptance the Registrar shall, state in writing the grounds of his decision and the materials used by him in arriving at the same, and the applicant may appeal such decision to the Court.
- (5) If it appears to the Registrar that the requirements for registration are not met or that additional information or evidence is required to meet those requirements, the Registrar shall inform the applicant and give the applicant an opportunity, within such period as may be prescribed, to either make representations, to amend the application or to provide the additional information or evidence.

- (6) If the applicant responds within the period mentioned in subsection (5) but fails to satisfy the Registrar that the requirements for registration are met, or fails to amend the application or provide the additional information or evidence so as to meet the requirements for registration, the Registrar may —
- (a) refuse to accept the application;
 - (b) accept the application but only in relation to the goods or services for which —
 - (i) registration is sought; and
 - (ii) the requirements for registration have been met; or
 - (c) give the applicant a further opportunity within such period as may be prescribed to make representations, to amend the application or to provide the additional information or evidence.
- (7) If the applicant fails to respond within the period mentioned in subsections (5) or (6) (c), the application, or the application insofar as it relates to those goods or services for which registration is sought but the requirements for registration have not been met, shall be treated as having been withdrawn, but the Registrar must accept the application in relation to those goods and services for which registration is sought and the requirements for registration have been met.
- (8) If it appears to the Registrar that the requirements for registration in relation to all of the goods or services for which registration is sought are met, the Registrar shall accept the application.
- (9) Where grounds for refusal of an application for registration of a trade mark under this section exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.

18. Withdrawal or amendment of application.

- (1) The applicant may at any time before the application has been approved by the Registrar, withdraw the application or amend the application with respect to —
- (a) the scope of the goods or services covered by the application;
 - (b) the name or other particular of the applicant;
 - (c) errors of wording or of copying; or
 - (d) obvious mistakes,
- without payment of costs and on giving notice as prescribed.
- (2) If the application has been published, the withdrawal or amendment of the application restriction must also be published.

19. Limitations in relation to plant varieties.

Where a denomination must, under any legislation which addresses legal protection for plant varieties and the rights of plant breeders, be used to designate a plant variety, no person shall adopt it as a trade mark in association with the plant variety or another plant variety of the same species or use it in a way likely to mislead, nor shall any person so adopt or so use any sign so nearly resembling that denomination as to be likely to be mistaken therefor.

20. Registration of trade mark.

- (1) When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed, the opposition has been withdrawn or decided in favour of the applicant, the Registrar shall register the said trade mark, and the trade mark when registered, shall be registered as of the date of the application for registration.
- (2) A trade mark shall not be registered unless any fee prescribed for the registration is paid within the prescribed period and if such fee is not paid within that period, the application shall be deemed to be withdrawn.

21. Advertisement of application.

- (1) When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the Registrar shall, as soon as practicable after such acceptance, cause the application as accepted to be advertised in the prescribed manner.
- (2) An advertisement made pursuant to subsection (1) shall set forth all conditions subject to which the application has been accepted.

22. Opposition to registration.

- (1) Within the prescribed time after the advertisement of an application for the registration of a trademark, any person may, on payment of the prescribed fee, file a written statement of opposition with the Registrar.
- (2) A statement of opposition may be based on any of the following grounds —
 - (a) that the application does not conform to the requirements of section 11 that the application was filed in bad faith;
 - (b) that the trademark is not registrable;
 - (c) that the applicant is not the person entitled to registration of the trademark;
 - (d) that the trademark is not distinctive;

- (e) that, at the filing date of the application in The Bahamas, the applicant was not using and did not propose to use the trademark in The Bahamas in association with the goods or services specified in the application; or
 - (f) that, at the filing date of the application in The Bahamas, the applicant was not entitled to use the trademark in The Bahamas in association with those goods or services.
- (3) A statement of opposition shall set out —
 - (a) the grounds of opposition in sufficient detail to enable the applicant to reply thereto; and
 - (b) the address of the opponent’s principal office or place of business in The Bahamas, if any, and if the opponent has no office or place of business in The Bahamas, the address of his principal office or place of business abroad and the name and address in The Bahamas of a person or firm on whom service of any document in respect of the opposition may be made with the same effect as if it had been served on the opponent himself.
- (4) If the Registrar considers that the opposition does not raise a substantial issue for decision, he shall reject it and shall give notice of his decision to the opponent.
- (5) If the Registrar considers that the opposition raises a substantial issue for decision, he shall forward a copy of the statement of opposition to the applicant.
- (6) At the applicant’s request, the Registrar may, at any time before the day on which the applicant files a counter statement, strike all or part of the statement of opposition if the statement or part of it —
 - (a) is not based on any of the grounds set out in subsection (2); or
 - (b) does not set out a ground of opposition in sufficient detail to enable the applicant to reply to it.
- (7) The applicant shall file a counter statement with the Registrar and serve a copy on the opponent in the prescribed manner and within the prescribed time after a copy of the statement of opposition has been forwarded to the applicant.
- (8) The Registrar shall provide both the opponent and the applicant with an opportunity, in the prescribed manner and within the prescribed time, to submit evidence and to make representations to the Registrar unless —
 - (a) the opposition is withdrawn or deemed under subsection (10) to have been withdrawn; or
 - (b) the application is abandoned or deemed under subsection (11) to have been abandoned.

- (9) The opponent and the applicant shall, in the prescribed manner and within the prescribed time, serve on each other any evidence and written representations that they submit to the Registrar.
- (10) The opposition is deemed to have been withdrawn if, in the prescribed circumstances, the opponent does not submit and serve either evidence under subsection (8) or a statement that the opponent does not wish to submit evidence.
- (11) The application is deemed to have been abandoned if the applicant does not file and serve a counter statement within the time referred to in subsection (7) or if, in the prescribed circumstances, the applicant does not submit and serve either evidence under subsection (8) or a statement that the applicant does not wish to submit evidence.
- (12) After considering the evidence and representations of the opponent and the applicant, the Registrar may refuse the application, reject the opposition, or refuse the application with respect to one or more of the goods or services specified in it and reject the opposition with respect to the others and the Registrar shall notify the parties of the decision and the reasons for it.
- (13) The Registrar shall have power in proceedings under this section to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid.
- (14) A decision of the Registrar imposing costs on a party pursuant to subsection (13), can be enforced by an order of the court.

23. Appeal from Registrar in opposition proceedings

- (1) A decision of the Registrar under section 22 shall be subject to appeal to the Court.
- (2) An appeal under this section shall be made in the prescribed manner, and on such appeal, the Court shall —
 - (a) hear from the parties and if required, from the Registrar; and
 - (b) make an order determining whether, and subject to what conditions, if any, registration is to be permitted.
- (3) On the hearing of any such appeal any party may, either in the manner prescribed, or by special leave of the Court, bring forward further material for the consideration of the court.
- (4) In proceedings under this section, no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as herein above provided, except by leave of the court.

- (5) Where any further grounds of objection are taken, the applicant shall be entitled to withdraw his application without payment of the costs of the opponent or giving notice as prescribed.
- (6) In any appeal under this section, the Court may, after hearing from the parties or the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.
- (7) The Court shall have power in proceedings under this section to award to any party such costs as the Court may consider reasonable.
- (8) If a party giving notice of opposition or of appeal neither resides nor carries on business in The Bahamas, the Court may require such party to give security for the costs of the proceedings and, in default of such security being duly given, the Court may order that the appeal be struck out.

24. Rival claims to identical marks.

Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or services or description of goods or services, and seek to be registered as such proprietor, the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by the Registrar.

25. Defensive registration of well known trade marks.

- (1) If, because of the extent to which a registered trade mark has been used in relation to all or any of the goods or services in respect of which it is registered, it is likely that its use in relation to other goods or services will be taken to indicate that there is a connection between those other goods or services and the registered owner of the trade mark, the trade mark may, on the application of the registered owner, be registered as a defensive trade mark in respect of any or all of those other goods or services.
- (2) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if the registered owner does not use or intend to use the trade mark in relation to those goods or services.
- (3) A trade mark may be registered as a defensive trade mark in respect of particular goods or services even if it is already registered otherwise than as a defensive trade mark in the name of the applicant in respect of those goods or services.
- (4) A trade mark registered in the name of the same proprietor —

- (a) as a defensive trade mark;
- (b) otherwise than as a defensive trade mark,

shall, notwithstanding that the respective registrations are in respect of different goods or services, be deemed to be, and shall be registered as, associated trade marks.

- (5) On application by any person aggrieved to the Court, or at the option of the applicant and subject to the provisions of section 75, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on grounds that —
 - (a) the requirements of subsection (1) are no longer satisfied in respect of any goods or services in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark; or
 - (b) if there is no longer any likelihood that the use of the trade mark in relation to those goods or services would be taken as giving the indication mentioned in subsection (1).
- (6) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark for which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.
- (7) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks.

26. Certification of registration.

On the registration of a trade mark, the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar and sealed with the seal of the office.

27. Non-completion of registration.

Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

28. Disclaimer of rights.

- (1) An applicant for the registration of a trade mark, or the registered owner of a registered trade mark, may, by notice in writing given to the Registrar,

disclaim any exclusive right to use, or authorise the use of, a specified part of the trade mark.

- (2) The Registrar or the Court may require an applicant for registration of a trademark to disclaim the right to the exclusive use apart from the trademark of such portion of the trademark as is not independently registrable.
- (3) A disclaimer given in accordance with subsection (1) or (2) does not prejudice or affect the applicant's rights then existing or thereafter arising in the disclaimed matter, nor does the disclaimer prejudice or affect the applicant's right to registration on a subsequent application if the disclaimed matter has then become distinctive of the applicant's goods or services.

29. Duration of registration.

The registration of a trade mark shall be for a period of ten years from the date of registration, and may be renewed from time to time in accordance with the provisions of this Act.

30. Renewal of registration.

- (1) The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period and upon payment of the prescribed fee, renew the registration of such trade mark for a period of ten years from the expiration of the original registration or the last renewal of registration, as the case may be, which date is herein termed "the expiration of the last registration".
- (2) The Registrar shall require on renewal that any registration be made to conform with prescribed regulations.
- (3) If a request for renewal is made or the renewal fee is paid in respect of only some of the goods or services for which the trade mark is registered, the registration is to be renewed for those goods or services only.
- (4) Renewal shall take effect from the expiry of the previous registration.

31. Procedure on expiry of period of registration.

- (1) If the registration of a trade mark has been on the register without renewal for the period specified in section 29, the Registrar shall send a notice to the registered owner and to the registered owner's representative for service, if any, stating that if within six months after the date of the notice the prescribed renewal fee is not paid, the registration shall lapse.
- (2) If registration is not renewed in accordance with section 30, the registration shall lapse subject to such conditions (if any) as to its restoration to the Register as may be prescribed.

32. Paris Convention and other International conventions relating to trade marks.

- (1) The provisions of the Paris Convention and any other international treaty in respect of trade marks, collective marks and certification marks to which The Bahamas is party shall apply to matters dealt with by this Act and, in case of conflict with the provisions of this Act, the provisions of the relevant treaty shall prevail.
- (2) More particularly and without limiting the generality of subsection (1), the provisions of the Paris Convention relating to —
 - (a) Article 6bis (Well-Known Marks);
 - (b) Article 6ter (Prohibitions Concerning State Emblems, Official Hallmarks and Emblems of Intergovernmental Organisations);
 - (c) Article 6septies (Registration in the Name of the Agent or Representative of the Proprietor without the Latter's Authorisation),shall apply fully in respect of all applications for protection for trade marks in The Bahamas.
- (3) Nothing in this section, shall entitle the proprietor of the trade mark to recover damages for any infringement occurring prior to the date of registration of his trade mark in The Bahamas.
- (4) Where a person has applied for protection for any trade mark by application which —
 - (a) in accordance with the terms of a treaty subsisting between two or more convention countries, is equivalent to an application duly made in that convention country; or
 - (b) in accordance with the law of any convention country, is equivalent to an application duly made in that convention country,he shall be deemed for the purposes of this section to have applied in that convention country.

PART IV - ADMINISTRATIVE AND OTHER PROVISIONS

33. Hours of business of Intellectual Property Office.

- (1) The Intellectual Property Office shall be open during normal business hours for the purpose of the transaction by the public of business under this Act.
- (2) Business done on any day after the specified hours of business, or on a day which is not a business day, shall be deemed to have been done on the

next business day; and where the time for doing anything under this Act expires on a day which is not a business day, that time shall be extended to the next business day.

34. Information about applications and registered trade marks.

- (1) After publication of an application for registration of a trade mark, the Registrar shall on request, and upon payment of the prescribed fee, provide any person with such information and permit such person 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) Any request referred to in subsection (1) shall be made in the prescribed manner and shall be accompanied by the appropriate prescribed fee, if any.
- (3) 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 to the provisions of subsection (4).
- (4) 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, such person may make a request under subsection (1), notwithstanding that the application has not been published, and that subsection shall apply accordingly.

35. Power of Registrar to award costs and require security.

- (1) The Minister may make Regulations 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) An order of the Registrar made pursuant to subsection (1) may be enforced in the same way as an order of the Court.
- (3) Provision may be made by the Regulations empowering the Registrar, in appropriate cases, 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 such security is not given.

- (4) Regulations may make provisions as to the giving of evidence before the Registrar by affidavit or statutory declaration.

36. Exclusion of liability in respect of official acts.

- (1) The Registrar shall not be taken to warrant the validity of the registration of a trade mark under this Act or under any treaty, convention, arrangement or engagement to which The Bahamas is a party.
- (2) The Registrar is not subject to any liability by reason of, or in connection with, any examination required or authorised under this Act, or any such treaty, convention, arrangement or engagement, or any report or other proceedings consequent on such examination.
- (3) No proceedings shall lie against any member of staff of the Intellectual Property Office in respect of any matter for which, by virtue of this section, the Registrar is not liable.

37. Registrar's annual report.

- (1) The Registrar shall in the month of December in each year, make a report to the Minister concerning the operations of the Intellectual Property Office in respect of this Act, and shall include in such report the discharge of his functions under the Paris Convention and any other international arrangement concerning trade marks to which The Bahamas is a party.
- (2) The report referred to under subsection (1) shall include an account of all monies received and paid by the Intellectual Property Office pursuant to this Act.

PART V - CATEGORIES OF TRADE MARKS

38. Trade marks incorporating colours.

- (1) A trade mark may be limited in whole or in part to one or more specified colours, and in such case, the fact that it is so limited, shall be taken into consideration by the Registrar in determining the distinctive character of such trade mark.
- (2) If a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

39. Associated trade marks.

- (1) Where a trade mark which is registered, or is the subject of an application for registration, in respect of any goods or services is —

- (a) identical with another trade mark which is registered; or
- (b) is the subject of an application for registration, in the name of the same proprietor in respect of the same goods or description of goods or same services or description of services or so nearly resembles it as to be likely to deceive or cause confusion if used by a person other than the proprietor,

the Registrar may, at any time, require that the trade marks shall be entered on the register as associated trade marks.

- (2) Where under the provisions of this Act, use of a registered trade mark is required to be proved for any purpose, the Registrar may, if and so far as he shall think right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such use.

40. Identical trade marks.

Except by order of the Court, no trade mark shall be registered in respect of any goods or services or description of goods or services which —

- (a) is identical with a trade mark belonging to a different proprietor which is already on the Register with respect to such goods or services or description of goods or services; or
- (b) is so nearly resembling such a trade mark as to be calculated to deceive.

41. Certification and collective marks.

The provisions of this Act shall apply to certification marks subject to the provisions of the *First Schedule* and to collective marks, subject to the provisions of the *Second Schedule*.

PART VI - PROVISIONS AS TO TRADE MARKS

42. Assignment and transmission of trade marks.

- (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 it is so transmissible either in connection with the goodwill of a business or independently thereof.
- (2) A contractual obligation to transfer a business is to be taken to include an obligation to transfer any registered trade mark, except where there is agreement to the contrary or it is clear in all the circumstances that this presumption should not apply.

- (3) 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.
- (4) 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.
- (5) Subsection (4) may be satisfied in a case where the assignor or personal representative is a body corporate by the affixing of its seal.
- (6) Subsections (1) to (5) apply to assignment by way of security as in relation to any other assignment.
- (7) A registered trade mark may be the subject of a charge in the same way as other personal or moveable property.
- (8) If a registered trade mark is assigned or transmitted —
 - (a) the person registered as the owner of the trade mark; or
 - (b) the person to whom the trade mark has been assigned or transmitted,must apply to the Registrar for a record of the assignment or transmission to be entered in the Register.
- (9) An application made pursuant to subsection (8) must —
 - (a) be in the prescribed form; and
 - (b) be filed, together with any prescribed document, in accordance with the regulations.
- (10) Where an application made pursuant to subsection 8 complies with this Act, the Registrar must, at, or within, the time provided for in the regulations —
 - (a) enter the particulars of the assignment or transmission in the Register; and
 - (b) register the person to whom the trade mark has been assigned or transmitted (beneficiary) as the owner of the trade mark in relation to the goods or services in respect of which the assignment or transmission has effect,and the particulars are taken to have been entered in the Register on the day on which the application was filed, and the registration of the beneficiary as the owner of the trade mark is taken to have had effect from and including that day.
- (11) The Registrar must publish in accordance with the regulations —
 - (a) the recording of an assignment or transmission; and

- (b) the registration of the beneficiary as the owner of the trade mark.
- (12) 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.
- (13) Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks.

43. Assignment of trade mark before registration.

- (1) If a trade mark, the registration of which is being sought is assigned or transmitted, either —
 - (a) the applicant for the registration of the trade mark; or
 - (b) the person to whom it has been assigned or transmitted,must apply to the Registrar for the assignment or transmission to be recorded.
- (2) An application pursuant to subsection (1) must —
 - (a) be in the prescribed form; and
 - (b) be filed, together with any prescribed document, in accordance with the regulations.
- (3) If an application made pursuant to subsection (1) complies with this Act, the Registrar must —
 - (a) at, or within, the time provided for in the regulations, record in the manner that the Registrar thinks fit (but not in the Register) the particulars of the assignment or transmission; and
 - (b) publish the particulars of the assignment or transmission in accordance with the regulations,and on and after the day on which the Registrar records the particulars of the assignment or transmission, the person to whom the trade mark has been assigned or transmitted is taken, for the purposes of this Act, to be the applicant for the registration of the trade mark.

44. Apportionment of trade marks on dissolution of partnership.

- (1) In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks) on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and

modifications, if any, as the Registrar may think necessary in the public interest.

- (2) Any decision of the Registrar under this section shall be subject to appeal to the Court.

45. Registration of series of trade marks.

- (1) A person may make a single application under section 17 for the registration of a series of trade marks.
- (2) For the purposes of this Act, “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) If the Registrar is satisfied that the trade marks in question are a series of trade marks and accepts the application, and the Registrar is required under section 17 to register the trade marks, the Registrar must register them as a series in one registration.
- (4) All trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

46. Status of un-renewed trade marks.

Where a trade mark has been removed from the Register for non-payment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year after the date of such removal, be deemed to be a trade mark which is registered, unless it is shown to the satisfaction of the Registrar that there has been no bona fide trade use of such trade mark during the two years immediately preceding such removal.

47. Alteration of registered trade mark.

- (1) The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same.
- (2) The Registrar may —
 - (a) refuse such leave; or
 - (b) grant the same on such terms as he may think fit.
- (3) A refusal or conditional permission given under subsection (2) shall be subject to appeal to the Court.
- (4) If leave be granted pursuant to subsection (2), the trade mark as altered shall be advertised in the prescribed manner.

48. Licensing of a trade mark.

- (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a licensee thereof in respect of—
 - (a) all or any of the goods or services in respect of which it is registered (otherwise than as a defensive trade mark); and
 - (b) either with or without conditions or restrictions.
- (2) A licence to use a registered trade mark may be general or limited.
- (3) 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.
- (4) A licence is not effective unless it is in writing signed by or on behalf of the grantor and that in a case where the grantor is a body corporate, this requirement may be satisfied by affixing of its seal.
- (5) Unless a licence provides otherwise, it shall be binding on a successor in title to the grantor's interest.
- (6) Where a licence so provides, a sub-licence may be granted by the licensee; and references in this Act to a licence or licensee include a sub-licence or sub-licensee.
- (7) 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.
- (8) The proprietor of a registered trade mark may invoke the rights conferred by that trade mark against a licensee who contravenes any provision in the licence with regard to —
 - (a) its duration;
 - (b) the scope of the goods or services for which the licence is granted;
 - (c) the territory in which the trade mark may be affixed; or
 - (d) the quality of the goods manufactured or of the services provided by the licensee.

49. Formalities associated with licences.

- (1) Where it is proposed that a person should be registered as a licensee of a trade mark, the proprietor and the proposed licensee must apply in writing to the Registrar in the prescribed manner and must furnish him with a statutory declaration made by the proprietor, or by some person authorised to act on his behalf and approved by the Registrar stating —
 - (a) the particulars of the relationship, existing or proposed, between the proprietor and the proposed licensee, including particulars showing

- the degree of control by the proprietor over the proposed licensee which their relationship will confer and whether it is a term of their relationship that the proposed licensee shall be the sole licensee or that there shall be any other restriction as to persons for whom an application for registration as licensees may be made;
- (b) the goods or services in respect of which registration is proposed;
 - (c) any conditions or restrictions proposed with respect to the characteristics of the goods or services, to the mode or place of permitted use, or to any other matter; and
 - (d) whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof, and with such further documents, information or evidence as may be required under regulations or by the Registrar.
- (2) The licensee application described in subsection (5) may be filed with the Registrar at the same time as or at any time after the application for registration of the trade mark is filed with the Registrar.
 - (3) If the Registrar after considering the information furnished to him under subsection (5) is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or services or any of them by the proposed licensee subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed licensee as a licensee in respect of the goods or services as to which he is so satisfied subject as aforesaid.
 - (4) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.
 - (5) The Registrar shall, if so required by an applicant, take steps to ensure that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the Register) is not disclosed to rivals in business.
 - (6) Without prejudice to the provisions of section 74, the registration of a person as a licensee —
 - (a) may be varied by the Registrar as regards the goods or services in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
 - (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of —

- (i) the registered proprietor or of the licensee or of any other licensee of the trade mark; or
 - (ii) any person on any of the following grounds, that is to say —
 - (aa) that the licensee has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;
 - (bb) that the proprietor or the licensee misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration; or
 - (cc) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.
- (7) Provision shall be made by regulations for the notification of the registration of a person as a licensee to any other licensee of the trade mark, and for the notification of an application under subsection (10) to the registered proprietor and each licensee (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.
- (8) The Registrar may at any time cancel the registration of a person as a licensee of a trade mark in respect of any goods or services in respect of which the trade mark is no longer registered.
- (9) Any decision of the Registrar under the foregoing provisions of this section shall be subject to appeal to the Court.
- (10) Nothing in this section shall confer on a licensee of a trade mark any assignable or transmissible right to the use thereof.

50. Rights conferred by a registered trade mark.

- (1) The proprietor of a registered trade mark has the exclusive rights —
 - (a) to use the trade mark; and
 - (b) to authorise others to use the trade mark,in relation to the goods or services for which the trade mark is registered.
- (2) The proprietor has the right to obtain relief under this Act for infringement of the trade mark.

- (3) The acts amounting to infringement of a registered trade mark are set out in section 54, and references in this Act to the infringement of a registered mark are to be construed accordingly.
- (4) The rights set out in subsections (1) and (2) accrue to the proprietor as from the date of registration of the trade mark, except 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, 79 and 85 is committed by anything done before the date on which the trade mark is in fact registered.
- (5) If the trade mark is registered subject to any disclaimer or limitation, the rights of the proprietor are restricted by the disclaimer or limitation.
- (6) No person shall be entitled to institute any proceedings to prevent use or to recover damages for the infringement of an unregistered mark, but nothing in this Act affects the law relating to passing off or rights under any law relating to the protection of geographical indications.

51. Co-ownership of registered trade mark.

- (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) Subject to any agreement to the contrary, each co-proprietor of a trade mark 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.
- (3) One co-proprietor may not without consent of the other or others —
 - (a) grant a licence to use the registered trade mark; or
 - (b) assign or charge his share in the registered trade mark.
- (4) Infringement proceedings may be brought by any co-proprietor, but such co-proprietor may not, without the leave of the court, proceed with the action unless the other co-proprietor, or each of the other co-proprietors, is either joined as a plaintiff or added as a defendant and a co-proprietor who is thus added as a party shall not be made liable for any proceedings.
- (5) Nothing in this subsection affects the ability of the Court to grant interlocutory relief on the application of a single co-proprietor.
- (6) Nothing in this section affects the mutual rights and obligations of trustees or personal representatives, or their rights and obligations as such.

52. Registration to be conclusive after five years.

- (1) In all legal proceedings relating to a registered trade mark the original registration of such trade mark shall after —
 - (a) the expiration of five years from the date of such original registration; or
 - (b) five years from the commencement of this Act, whichever occurs last,be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section 8.
- (2) Nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the use by any person of a similar trade mark upon or in connection with goods or services upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date prior to the use of the first mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such use being proved) to such person being put upon the Register for such similar trade mark in respect of such goods or services under the provisions of section 70.

53. Unregistered trade marks.

No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark.

54. Acts amounting to infringement.

- (1) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade 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.
- (2) A person infringes a registered trade mark if, without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign and either because —
 - (a) the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the earlier trade mark is protected; or
 - (b) the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the earlier trade mark is registered,there exists a likelihood of confusion on the part of the public.

- (3) A person infringes a registered trade mark which is well known in The Bahamas if—
 - (a) without the consent of the proprietor of the trade mark, the person uses in the course of trade a sign which is identical with or similar to the registered trade mark in relation to goods or services which are not identical or similar to those for which the trade mark is registered; or
 - (b) the use of the sign in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the registered trade mark, and would, without due cause, be detrimental to the distinctive character or the repute of the registered trade mark.
- (4) The proprietor of an unregistered trade mark which is entitled to protection under Article 6bis of the Paris Convention or the WTO Agreement as a ‘well-known’ trade mark is entitled to restrain by injunction the use in The Bahamas of a trade mark which, or the essential part of which, is identical or similar to the well known trade mark in relation to identical or similar goods or services, where a likelihood of confusion is likely to arise from the use.
- (5) Nothing in this section affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this Act.
- (6) Subject to this Act, in any action for such infringement of a trade mark, all such relief by way of damages, injunctions, accounts or otherwise, shall be available to the plaintiff as is available in respect of the infringement of other proprietary rights.
- (7) In an action for the infringement of a trade mark the Court trying the question of infringement shall admit evidence of the usages of the trade mark in respect to the get-up of the goods or services for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods or services by other persons.
- (8) Any person whose trade mark rights are infringed pursuant to this Act may apply to the Court for an order that appropriate measures for the dissemination of the information concerning the finding of infringement be taken at the expense of the infringing party and such measures may include displaying the decision and publishing it in full or in part, or prominent advertising of the decision.
- (9) For the purposes of this section, a person uses a sign if, in particular, but without limitation, the person —
 - (a) applies 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;
- (d) uses the sign as a trade or company name or part of a trade or company name; or
- (e) uses the sign on business papers, invoices, catalogues, price lists and other commercial documents.

55. General provisions as to rights of non-exclusive licensees in case of infringement.

- (1) Except so far as the licence provides otherwise and subject to the other provisions of this section, a licensee may only bring proceedings for infringement of the registered trade mark with the consent of the proprietor of the trade mark.
- (2) A licensee may request that the proprietor of the registered trade mark take infringement proceedings in respect of any matter which affects his interests.
- (3) If a request is made in accordance with subsection (2) and the proprietor of the trade mark fails to do so within two months after being called upon, the licensee may, subject to subsection (4), 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 or with the consent of the proprietor or pursuant to the terms of the licence, 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 and provided that nothing in this section affects the ability of the court to grant interlocutory relief on an application by a licensee alone.
- (5) 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.

56. Right of exclusive licensees in case of infringement.

- (1) An exclusive licence may provide that the licensee shall have, to such extent as may be provided by 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 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.

- (2) 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 trademark in the provisions of this Act relating to infringement shall be construed accordingly.
- (3) 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.
- (4) 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.
- (5) Nothing in subsection (4) shall affect the ability of the Court to grant interlocutory relief in respect of an application made by a proprietor or exclusive licensee alone.
- (6) A person 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) 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.
- (8) The provisions of subsection (7) 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.

- (9) 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 59 (order for delivery up); 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.
- (10) The provisions of subsections (2), (4), (6) and (9) shall have effect subject to any agreement to the contrary between the exclusive licensee and the proprietor.

57. Order of erasure etc., of offending signs.

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 his possession, custody or control; or
- (b) if it is not reasonable practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.

58. Non-use as defence in infringement proceedings.

- (1) The proprietor of a trade mark is entitled to prohibit the use of a sign only to the extent that the registration of the trade mark is not liable to be revoked pursuant to section 65 (revocation on basis of non-use) at the date the action for infringement is brought but a defendant to a claim for infringement shall have an affirmative duty to raise this defence failing which, unless proceedings for revocation for non-use are already pending before the court or the Registrar, the court that is seized of the claim for infringement shall not consider the issue of non-use.
- (2) In any proceedings for the revocation of a trade mark, upon a *prima facie* case of non use being shown, the onus shall lie on the proprietor of the trade mark to furnish proof—
 - (a) that during the five-year period preceding the date the action for infringement is brought, the trade mark has been put to genuine use in The Bahamas by or with the consent of the proprietor in relation to the goods and services for which it is registered and which are cited as justification for the action; or
 - (b) that there are proper reasons for non-use.

59. Order for delivery up of infringing goods, material or articles.

- (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 62 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 63.
- (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 63 is not made, retain them pending the making of such order, or the decision not to make an order under that section.

60. Power of Court to order certain information.

- (1) Where the owner of trade mark has commenced legal proceedings against a defendant for infringement of a trade mark and has alleged that the defendant has engaged in acts of infringement on a commercial scale, the Court may, on the application of the owner of the trade mark order the defendant, a financial services provider or any other person within the jurisdiction of the Court, to disclose to the owner of the trade mark or the Court, the banking or other commercial information of that defendant.
- (2) Where in any legal proceedings commenced by the owner of trade mark the Court has adjudged that one or more defendants have, in relation to specific goods, engaged in acts of infringement of that trade mark, the Court may order any of or all of the defendants to those proceedings to provide to the owner of the trade mark or the Court, information, on the origin and distribution networks of the goods in issue.

61. Meaning of “infringing goods, material or articles”.

- (1) In this Act, the expression “**infringing goods**”, “**infringing material**” and “**infringing articles**” shall be construed as provided for hereunder.
- (2) Goods are “infringing goods” in relation to a trade mark, if they or their packaging bear a sign identical or confusingly 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;

- (b) the goods are proposed to be imported into The Bahamas and the application of the sign in The Bahamas 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) Nothing in subsection (2) shall be construed as affecting the importation of goods which may lawfully be imported into The Bahamas by virtue of any law.
- (4) Material is “infringing material”, in relation to a registered trade mark if it bears a sign identical or similar to that sign 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.
- (5) “**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 trade 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.

62. Period after which remedy for delivery up not available.

- (1) An application for an order under section 59 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 provided in subsection (2).
- (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 such disability or, as

the case may be, could with reasonable diligence have discovered those facts.

63. Order as to disposal of infringing goods, material or articles.

- (1) Where infringing goods, material or articles have been delivered up in pursuance of an order under section 59, 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.
- (6) References in this section to a person having an interest in goods, material or articles include any person in whose favour an order would or may be made under this section.

64. Surrender of registered trade mark.

- (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 regulations —
 - (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.

65. Revocation of registration.

- (1) The registration of a trade mark may 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 used in The Bahamas by the registered 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 the acts or inactivity of the registered 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 registered 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 sign in the form in which it was registered, and use in The Bahamas includes affixing the trade mark to goods or to the packaging of goods in The Bahamas 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 those paragraphs 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 Court is satisfied that the grounds for revocation existed at an earlier date, that date.

66. Grounds for invalidity of registration.

- (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of sections 8 or 9 but where the trade mark was registered in breach of section 8(1)(a), (c), (d) or (e), 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 on the ground —
 - (a) that there is an earlier trade mark in relation to which the conditions set out in section 9, obtain; or
 - (b) that there is an earlier right in relation to which the condition set out in section 9 is satisfied,unless the proprietor of that earlier trade mark or other earlier right 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 shall 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.

67. Effect of acquiescence of earlier trade mark.

- (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 Bahamas, 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.

68. Limitations and exceptions.

- (1) The rights conferred by registration under this Act shall have no effect in respect of —
 - (a) any *bona fide* use or indication in the course of trade of a person's own name, address, place of business or place of production or distribution of goods or services, or those of that person's predecessors in business;
 - (b) use by any person of indications concerning the kind, quality, quantity, value, geographical origin, time of production of goods or of rendering of services, or other characteristics of his goods or services;
 - (c) acts in respect of goods lawfully bearing the trade mark after those goods have been put on the market in The Bahamas or elsewhere in the world by the registered proprietor or by a person acting with the proprietor's consent, provided that the goods and the packaging or wrapping in direct contact with the goods have not suffered any material alteration or damage;
 - (d) use of the registered trade mark by any person for the purpose of indicating truthfully in the course of trade that the goods or services that bear the trade mark originate with the proprietor of the trade mark or with a person authorized by the proprietor;
 - (e) use of the registered trade mark by a person to provide information regarding the intended purpose, use or compatibility of a product or service, in particular with respect to accessories or spare parts.
- (2) Any acts specified in subsection (1) must be performed in accordance with honest practices and in a manner that does not cause confusion

regarding the provenance of the goods or services, and must not take unfair advantage of, or be detrimental to, the distinctive character or repute of the trade mark, and must not otherwise constitute an act of unfair competition.

69. “Passing off” action.

Nothing contained in this Act shall be deemed to affect rights of action against any person for passing off goods or services as those of another person or the remedies in respect thereof.

PART VII – LEGAL PROCEEDINGS AND OFFENCES

LEGAL PROCEEDINGS

70. Concurrent user.

In the case of—

- (a) an honest concurrent user; or
- (b) other special circumstances which, in the opinion of the Court, make it proper so to do,

the Court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or services or description of goods or services by more than one proprietor subject to—

- (i) each proprietor being limited to using such trade mark or nearly identical trade mark in exclusive geographic areas that do not overlap; and
- (ii) such conditions and limitations, if any, as to mode of use, or otherwise, as the Court thinks right to impose.

71. Registration to be *prima facie* evidence of validity.

In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a trade mark shall be *prima facie* evidence of the validity of the trade mark and of any subsequent assignment or other transmission of it that is recorded in the Register.

72. Certification of validity of contested registration.

- (1) If in the proceedings before the Court the validity of the registration of a trade mark is contested and it is found by the Court that the trade mark is validly registered, the Court may give a certificate to that effect.

- (2) If the Court gives such a certificate and in subsequent proceedings —
- (a) the validity of the registration is again questioned; and
 - (b) the proprietor obtains a final order or judgment in his favour,
- he is entitled to his costs as between attorney and client unless the Court directs otherwise but this subsection does not extend to the costs of an appeal in any such proceedings.

73. Registrar's appearance in proceedings before the Court.

- (1) In proceedings before the Court involving an application for —
- (a) the revocation of the registration of a trade mark; or
 - (b) a declaration of the invalidity of the registration of a trade mark,
- the Registrar is entitled to appear and be heard if so directed by the Court.
- (2) Unless otherwise directed by the Court, the Registrar may instead of appearing submit to the Court a statement in writing signed by him giving particulars of —
- (a) any proceedings before him in relation to the matter in issue;
 - (b) the grounds of any decision given by him affecting it;
 - (c) the practice of the Intellectual Property Office in like cases; or
 - (d) such matters relevant to the issues and within his knowledge as Registrar as he thinks fit,
- and the statement shall be deemed to form part of the evidence in the proceedings.
- (3) Any thing which the Registrar is or may be authorised or required to do under this section may be done on his behalf by a duly authorised officer of the staff of the Intellectual Property Office.

74. Rectification of Register.

- (1) Subject to the provisions of this Act, the Court may —
- (a) on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the Register of any entry, or by any entry made in the Register without sufficient cause, or by any entry wrongfully remaining on the Register, or by an error or defect in any entry in the Register, make such order for making, expunging, or varying such entry, as it may think fit; and
 - (b) in any proceeding under this section, decide any question that may be necessary or expedient to decide on in connection with the rectification of the Register.

- (2) In case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the Court under the provisions of this section.
- (3) Any order of the Court rectifying the Register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the Register accordingly.

75. Appeals from decisions of the Registrar.

- (1) An appeal lies to the Court from any decision of the Registrar under this Act.
- (2) For the purposes of this section, “decision of the Registrar” includes any act of the Registrar in exercise of a discretion vested in him by or under this Act.

76. Agents.

- (1) A counsel and attorney shall be entitled to represent any party in any matter or proceedings before the Registrar under this Act.
- (2) Where an applicant's ordinary residence or principal place of business is outside The Bahamas, he shall be represented by a counsel and attorney who is resident in The Bahamas and practising in The Bahamas in accordance with the relevant law.
- (3) The Minister may make regulations requiring the keeping of a register of persons who act as agents for other persons for the purpose of applying for or obtaining the registration of trade marks, and references in this Act to “trade mark agent” or “agent” shall be construed, unless the context otherwise requires, to be references to persons whose names are entered in the register pursuant to this subsection.
- (4) Regulations shall provide for the payment of fees by persons requiring to be registered as agents.
- (5) No person who is not an agent shall carry on business under any name, description or style which contains the words “registered trade mark agent” or hold himself out or otherwise describes himself as such an agent.
- (6) A person who contravenes subsection (5) commits an offence and is liable on summary conviction to a fine not exceeding five thousand dollars or to imprisonment for a term not exceeding three years, or to both such fine and imprisonment.
- (7) For the purposes of this Act, “counsel and attorney” has the meaning assigned to it by section 2 of the Legal Profession Act (*Ch. 64*).

77. Provision restricting importation of infringing goods.

- (1) The proprietor of a registered trade mark, or a licensee, may give notice in writing to the Comptroller of Customs —
 - (a) that he is the proprietor or, as the case may be, a licensee of the registered trade mark;
 - (b) that, at a time and place specified in the notice, goods which are, in relation to that registered trade mark, infringing goods, material or articles are expected to arrive in The Bahamas; and
 - (c) that he requests the Comptroller of Customs to treat them as prohibited goods.
- (2) When a notice is in force under this section the importation of the goods to which the notice relates, otherwise than by a person for his private and domestic use, is prohibited, but a person is not by reason of the prohibition liable to any penalty other than forfeiture of the goods.
- (3) The proprietor of a registered trade mark, or a licensee who gives notice to the Comptroller of Customs pursuant to subsection (1) shall comply with such conditions with respect to —
 - (a) the form of the notice;
 - (b) the furnishing of evidence;
 - (c) the payment of fees in respect of the notice;
 - (d) the giving of security in respect of any liability or expense which the Comptroller may incur in consequence of the notice by reason of the detention of any article or anything done to a detained article;
 - (e) the indemnification of the Comptroller against any liability or expenses, whether security has been given or not; and
 - (f) any other incidental or supplementary matters,as may be prescribed, and different provisions may be prescribed for different classes or cases.
- (4) Notwithstanding anything in the Customs Management Act, a person shall not be liable to any penalty under that Act (other than the forfeiture of the goods) by reason only that any goods are treated as prohibited goods by virtue of this section.

OFFENCES**78. Forging or falsely applying trade marks.**

Every person who —

- (a) forges any trade mark;

- (b) falsely applies to goods or services any trade mark or sign which closely resembles a trade mark,

unless he proves that he acted without intent to defraud, commits an offence under this Act.

79. Selling goods or services to which false trade mark applied.

Every person who sells, or exposes for sale, or has in his possession for sale, for any purpose of trade or manufacture, any goods or services or things to which any forged trade mark is applied, or to which any trade mark or sign so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, commits an offence under this Act, unless he proves—

- (a) that having taken all reasonable precautions against committing an offence under this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark;
- (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or services or things; and
- (c) that otherwise he acted innocently.

80. Forging trade marks.

- (1) A person shall be deemed to forge a trade mark who either —
 - (a) without the consent of the proprietor of the trade mark makes that trade mark or sign so nearly resembling that trade mark as to be calculated to deceive;
 - (b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.
- (2) Any trade mark so made or falsified is in this Act referred to as a forged trade mark provided that in any prosecution for forging a trade mark the burden of proving the consent of the proprietor shall lie on the defendant.

81. Applying trade marks.

- (1) A person shall be deemed to apply a trade mark or sign to goods who —
 - (a) applies it to the goods themselves;
 - (b) applies it to any covering, label, or other thing in or with which the goods are sold or exposed or had in his possession for any purpose of sale, trade or manufacture;
 - (c) places, encloses or annexes any goods which are sold or exposed or had in his possession for any purpose of sale, trade or manufacture,

in, with or to any covering, label, reel or other thing to which a trade mark has been applied; or

- (d) uses a trade mark or sign in any manner calculated to lead to the belief that the goods in connection with which it is used are designated by that trade mark or sign.
- (2) A trade mark or sign shall be deemed to be applied whether it is woven, impressed or otherwise worked into or annexed, or affixed to the goods, or to any covering, label, reel or other thing.

82. Falsely applying trade marks.

A person shall be deemed falsely to apply to goods a trade mark or sign, who without the consent of the proprietor of a trade mark applies such trade mark, or a sign so nearly resembling it as to be calculated to deceive, and in any prosecution for falsely applying a trade mark or sign to goods the burden of proving the assent of the proprietor shall lie on the defendant.

83. Falsification of entries in register.

If any person —

- (a) makes or causes to be made a false entry in the register kept under this Act;
- (b) creates a writing falsely purporting to be a copy of an entry in any such register;
- (c) produces or tenders or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false,

he commits an offence under this Act.

84. Penalty on falsely representing a trade mark.

- (1) Any person who represents a trade mark as registered under this Act which is not so registered shall be liable on summary conviction to a fine not exceeding two thousand dollars for each article in respect of which the false representation has been made.
- (2) A person shall be deemed for the purposes of this enactment to represent that a trade mark is registered under this Act if he uses in connection with the trade mark the word “registered” or any words expressing or implying that registration has been obtained for the trade mark.

85. Offences by body corporate or partnership.

- (1) Where an offence is committed under this Act by a body corporate, every person who at the material time was a director, manager, secretary or other similar officer of the body corporate, or any person purporting to act in

such capacity shall be liable to be proceeded against in his personal capacity and punished accordingly unless he proves that the offence was committed without his knowledge or connivance, or that he tried to prevent the commission of the offence.

- (2) Subsection (1) shall, *mutatis mutandis*, apply in respect of partners in a partnership for offences committed by a partnership under this Act.
- (3) A fine imposed on a partnership on its conviction under this Act shall be paid out of the partnership assets.

86. Powers of police officers.

- (1) Any police officer may —
 - (a) subject to the provisions of this Act, enter and search any premises or place, for goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trade mark, or for material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods, or for articles specifically designed or adapted for making copies of such sign;
 - (b) stop, board and search any vessel (other than a ship of war) or any aircraft (other than a military aircraft) for goods referred to in paragraph (a);
 - (c) stop and search any vehicle, in which he reasonably suspects that there are the goods referred to in paragraph (a);
 - (d) seize, remove or detain any goods referred to in paragraph (a) found by him pursuant to this subsection.
- (2) Any police officer may —
 - (a) break open any outer or inner door of any place which he is empowered or authorised by this Act to enter and search;
 - (b) forcibly board any vessel, aircraft or vehicle which he is empowered by this Act to stop, board and search;
 - (c) remove by force any person or thing obstructing him in the exercise of any power conferred on him by this Act;
 - (d) detain any person found in any place which he is empowered or authorised by this Act to search until such place has been searched;
 - (e) detain any vessel or aircraft which he is empowered by this Act to stop, board and search, and prevent any person from approaching or boarding such vessel or aircraft until it has been searched;
 - (f) detain any vehicle which he is empowered by this Act to stop and search until it has been searched.

87. Restrictions on the entry and search of domestic premises.

- (1) No domestic premises shall be entered and searched by a police officer unless a Magistrate has issued a warrant under subsection (2).
- (2) A Magistrate may, if he is satisfied by information on oath that there is reasonable grounds for suspecting that there is in any domestic premises any article which may be seized, removed or detained under any provision of this Act, issue a warrant authorising a police officer to enter and search the premises.
- (3) A police officer authorised under subsection (2) to enter and search any premises may call upon any police officer to assist him in entering and searching the premises.
- (4) In this section “domestic premises” means any premises or any part thereof, used exclusively or mainly as a dwelling house.

88. Obstruction of police officers.

- (1) Without prejudice to any other written law, any person who —
 - (a) wilfully obstructs a police officer in the exercise of his powers or the performance of his duties under this Act;
 - (b) wilfully fails to comply with any requirements properly made to him by any such police officer; or
 - (c) without reasonable excuse, fails to give such police officer any other assistance which he may reasonably require to be given for the purpose of exercising his powers or performing his duties under this Act,

commits an offence and is liable on summary conviction to a fine not exceeding one thousand dollars or to imprisonment for a term not exceeding twelve months.

- (2) A person who, when required to give information to a police officer in the exercise of his powers or the performance of his duties under this Act, knowingly gives false or misleading information to any such police officer, commits an offence and is liable on summary conviction to a fine not exceeding two thousand dollars or to imprisonment for a term not exceeding two years.
- (3) Nothing in this section shall be construed as requiring any person to give any information which may incriminate him.

89. General penalty.

- (1) Any person who commits an offence under this Act for which no penalty is otherwise specifically provided, shall be liable on summary conviction —

- (a) to a fine not exceeding two hundred and fifty thousand dollars or to a term of imprisonment for a term of five years or to both that fine and imprisonment;
 - (b) to the forfeiture and destruction of all goods and materials bearing a forged trade mark in respect of which the offence was committed.
- (2) The destruction of all goods and materials bearing a forged trade mark shall be in the presence of a member of the police force and a representative of the trade mark proprietor if that proprietor so desires.

PART VIII - MISCELLANEOUS

90. Power of Court to order certain information.

- (1) Where legal proceedings have been instituted by an interested party against an opposing party that is alleged to have engaged in acts which infringe an intellectual property right granted under this Act on a commercial scale, the Court may, on the application of the interested party, order the opposing party a financial services provider or any other person within the jurisdiction of the court, to disclose to the interested party or the Court, the banking or other commercial information the opposing party.
- (2) Where in any case the court has adjudged that one or more persons have engaged in conduct which infringes an intellectual property right granted under this Act, the Court may order any of or all such persons to provide to an interested party or the Court, information, on the origin and distribution of networks of the goods in issue.

91. Power of Minister to make Regulations.

- (1) The Minister may make Regulations —
 - (a) for the purpose of any provision of this Act authorising the making of regulations 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 including such forms or other filing documents as may be required;
 - (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) Provision may be made by regulations 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.

92. Adaptation of entries to new classification.

- (1) The Minister may make Regulations empowering the Registrar to do such things as the Registrar considers necessary to implement any amended or substituted classification of goods or services for purposes of the registration of trade marks.
- (2) Regulations made pursuant to this section may in particular provide for the amendment of existing entries on the Register so as to accord with the new classification.
- (3) Any such power of amendment as is referred to in this section shall not be exercised so as to extend the rights conferred by registration except where it appears to the Registrar that full compliance with this requirement would involve undue complexity and that any extension would not adversely affect the rights of any person.
- (4) The Regulations 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 the proprietor failing to do so.
- (5) Any such proposal shall be advertised in at least two newspapers having general circulation in The Bahamas and in one issue of the Gazette, and may be opposed, in such manner as may be prescribed.

93. International treaties.

- (1) The provisions of the Convention specified in the *Third Schedule* are hereby incorporated and made a part of this Act.
- (2) Judicial notice shall be taken of the Paris Convention or any other Treaty relating to trade marks, collective marks and certification marks to which The Bahamas may become a party, and of any bulletin, journal or gazette published under such Convention or Treaty.

- (3) Any document referred to in any such bulletin, journal or gazette shall be admissible as evidence of any instrument or other act thereby communicated, or of any institution established by or having functions under any Convention or Treaty referred to in subsection (1).

PART IX – REPEAL, SAVINGS AND TRANSITIONAL

94. Repeals.

- (1) The —
 - (a) Trade Marks Act (*Ch. 322*); and
 - (b) Trade Marks Act, 2015 (*No. 39 of 2015*),are hereby repealed.
- (2) Notwithstanding the repeal of the Act referred to in subsection (1)(a), all subsidiary legislation made under the repealed Act shall continue in force so far as it is not inconsistent with the provisions of this Act, until revoked by subsidiary legislation made under this Act.

95. Transitional and savings.

- (1) Notwithstanding the repeal of the Act referred to in section 94(1)(a), all trade marks registered in The Bahamas under repealed Act and any Rules made thereunder shall, subject to subsection (2), be deemed to have been registered under this Act.
- (2) Subject to section 94, trade marks registered pursuant to the repealed Act shall remain in force for the unexpired portion of the period of protection provided under that Act.
- (3) Any application made under the repealed Act shall be continued and dealt with in all respects as if this Act had not come into force.

FIRST SCHEDULE

(section 41)

COLLECTIVE MARKS

General

1. The provisions of this Act apply to collective marks subject to the following provisions.

Signs of which a collective mark may consist

2. In relation to collective mark, the reference in section 2(1) (definition of collective mark) to distinguishing goods or services of one undertaking from those of other undertakings shall be construed as reference to distinguishing goods or services of members of the association which is the proprietor of the collective mark from those of other undertakings.

Indication of geographical origin

3. (1) Notwithstanding section 8(1)(c), 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.
- (2) The proprietor of a collective mark referred to in paragraph (1) is not entitled to prohibit the use of the marks 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

4. (1) A collective mark shall not be registered if the public is liable to be misled as regards its character or significance, and in particular, if it is likely to be taken to be something other than a collective mark.
- (2) The Registrar may require that a sign in respect of which application is made for registration include some indication that it is a collective mark, and notwithstanding any other provision of this Act, an application may be amended so as to comply with any such requirement.

Regulations governing use of the collective mark

5. (1) An applicant for registration of a collective mark shall file with the Registrar regulations governing the use of the mark.
- (2) The regulations shall specify the persons authorised to use the sign, the conditions of membership of the association and, where they exist, the conditions of use of the sign, including any sanctions against misuse.
- (3) Further requirements with which the regulations have to comply may be imposed by regulations.

Approval of regulations by Registrar

6. (1) A collective mark shall not be registered unless the regulations governing the use of the sign —
- (a) comply with paragraph 5(2) and any further requirements imposed by regulations; 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 shall file the

regulations with the Registrar and pay the prescribed fee and if he does not do so, the application shall be deemed to be withdrawn.

(3) The Registrar shall consider whether the requirements mentioned in paragraph (1) are met.

(4) 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.

(5) 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.

(6) If it appears to the Registrar that those requirements, and other requirements for registration, are met, he shall accept the application and shall proceed in accordance with the provisions of this Act.

(7) The regulations shall be published and notice of opposition may be given relating to the matters mentioned in this paragraph.

Regulations to be open to inspection

7. 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

8. (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 amendment of the 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 6(1).

Infringement: rights of licensees

9. (1) The following provisions have effect as regards the rights of a licensee in relation to infringement of a registered collective mark.
- (2) An licensee is entitled, subject to any agreement to the contrary between him and the proprietor, to call on the proprietor 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 licensee may bring the proceedings in his own name as if he were the proprietor.
- (4) Where the infringement proceedings are brought by virtue of this paragraph, 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 but this does not affect the granting of interlocutory relief on an application by a licensee alone.
- (5) A proprietor who is added as a defendant as mentioned in subparagraph (4) shall not be made liable for any costs in the action unless he takes part in the proceedings.
- (6) In infringement proceedings brought by the proprietor of a registered collective 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 such users.

Grounds for revocation of registration

11. Apart from the grounds of revocation provided for in section 65 the registration of a collective mark may be revoked on the ground —
- (a) that the manner in which the mark has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 4(1);
 - (b) that the proprietor has failed to observe, or to secure the observance of, the regulations governing the use of the mark; or
 - (c) that an amendment of the regulations has been made so that the regulations —
 - (i) no longer comply with paragraph 5(2) and any further conditions imposed by regulations; or
 - (ii) are contrary to public policy or to accepted principles of morality.

Grounds for invalidity of registration

12. Apart from the grounds of invalidity provided for in section 66, the registration of a collective mark may be declared invalid on the ground that the mark was registered in breach of the provisions of paragraph 4(1) or 6(1).

SECOND SCHEDULE

(section 41)

CERTIFICATION MARKS

1. The provisions of this Act apply to certification marks subject to the following provisions.

Signs of which a certification mark may consist

2. In relation to a certification mark the reference in section 2(1) (definition of certification mark) 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

3. (1) Notwithstanding section 8(1)(c), a certification mark may be registered which consists of marks or indications which may serve, in trade, to designate the geographical origin of the goods or services.
(2) The proprietor of such a certification mark is not entitled to prohibit the use of the sign 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

4. 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.

Certification Mark not to be misleading as to character or significance

5. (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 and notwithstanding any other provision of this Act an application may be amended so as to comply with any such requirement.

Regulations governing use of certification mark

6. (1) An applicant for registration of a certification mark shall file with the Registrar regulations governing the use of the mark.
(2) The regulations shall 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.

(3) Further requirements with which the regulations have to comply may be imposed by regulations.

Approval of regulations by Registrar

7. (1) A certification mark shall not be registered unless —
- (a) the regulations governing the use of the mark —
 - (i) comply with paragraph 6(2) and any further requirements imposed by regulations; 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 sign 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, and if he does not do so, the application shall be deemed to be withdrawn.
- (3) The Registrar shall consider whether the requirements mentioned in paragraph (1) are met.
- (4) 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.
- (5) 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.
- (6) If it appears to the Registrar that those requirements, and other requirements for registration, are met, he shall accept the application and shall proceed in accordance with the provisions of this Act, as the case may be (publication and opposition proceedings).
- (7) The regulations shall be published and notice of opposition may be given, and observations may be made, relating to the matters mentioned in this paragraph, in addition to any other grounds on which the application may be opposed or observations made.

Regulations to be open to inspection

8. 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

9. (1) An amendment of the regulations governing the use of a registered certification mark is not effective unless and until the amended regulations are filed with the Registrar and accepted by him.
- (2) Before accepting any amendment 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 given, and observations may be made, relating to the matters mentioned in paragraph 7(1).

Consent to assignment of registered certification mark

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

Infringement: rights of licensees

11. In infringement proceedings brought by the proprietor of a registered certification 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 such users.

Grounds for revocation of registration

12. Apart from the grounds of revocation provided for in section 65, the registration of a certification mark may be revoked on the ground —
 - (a) that the proprietor has begun to carry on such a business as is mentioned in paragraph 4;
 - (b) that the manner in which it has been used by the proprietor has caused it to become liable to mislead the public in the manner referred to in paragraph 5(1);
 - (c) that the proprietor failed to observe, or to secure the observance of, the regulations governing its use;
 - (d) that an amendment of the regulations has been made so that the regulations —
 - (i) no longer comply with paragraph 6(2) and any further conditions imposed by regulations; or
 - (ii) are contrary to public policy or to accepted principles of morality; or
 - (e) that the proprietor is no longer competent to certify the goods or services for which the sign is registered.

Grounds for invalidity of registration

14. Apart from the grounds of invalidity provided for in section 66, the registration of a certification mark may be declared invalid on the ground that it was registered in breach of the provisions of paragraph 4, 5(1) or 6(3).

THIRD SCHEDULE

(section 93)

THE PARIS CONVENTION

- (1) The Paris Convention for the Protection of Industrial Property of March 20th 1883, as revised or amended from time to time, the Regulations made thereunder, and the Administrative Instructions made under those Regulations shall be given full effect.
- (2) Where reference is made in this Act to the Paris Convention, such reference shall include the Regulations and Administrative Instructions referred to under paragraph (1).
- (3) Where the provisions of this Act and the Regulations made thereunder conflict with those of the Paris Convention, the provisions of the Paris Convention shall prevail.

OBJECTS AND REASONS

This Bill seeks to repeal and replace the Trade Marks Act (*Ch. 322*) and the Trade Marks Act, 2015 (No. 39 of 2015) to modernise the current legislation framework with respect to trade marks. While much of the provisions of the 2015 remain substantially unchanged, new provisions have been made to provide for, *inter alia* —

- (a) the word “mark” has been removed and replaced with the word “sign” throughout the document as the concept of a trade mark revolves around a trade mark being a distinctive sign that denotes origin.
- (b) for marks that consists of or contain any element thereof, adopted and used by a public authority in The Bahamas as an official mark for goods and service.
- (c) that any infringement of a trade mark shall be actionable before the Court at the suit of the owner or an authorized user of the trade mark or by a licensee.
- (d) to empower the Court to order certain information.