

**ALERT**  
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**NEW TRADE MARKS ACT PASSED IN THE BRITISH VIRGIN ISLANDS**

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by Jamal S. Smith  
[jamal.smith@thorntonsmith.com](mailto:jamal.smith@thorntonsmith.com)

The Trade Marks Act, 2013 was passed by the House of Assembly of the British Overseas Territory of the Virgin Islands (the “**British Virgin Islands**”) on 30 April 2013 which must now be brought into force by Proclamation. Since the release by the Financial Services Commission of the exposure draft of the Trade Marks Bill on 23 January 2012, the Premier and Minister of Finance introduced the Trade Marks Bill, 2013 into the House of Assembly on 12 February 2013 which will replace the existing trade mark regime.

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**What Can Be Registered as a Trade Mark?**

Any sign that is capable of being represented graphically and distinguishing the goods or services of one person from those of another will be capable of being registered as a trade mark. A sign will now include a brand, color, device, figurative element, heading, label, letter, name, numeral, shape, signature, smell, sound, taste, ticket or word and “numeral” and “word” in this regard include a foreign numeral and foreign script or word.

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**Can Service Marks Be Registered?**

It will be possible to register trade marks in relation to goods or services, including registering a trade mark in relation to both goods and services. In the absence of any Order to the contrary published by the Financial Services Commission, the classification system will be in accordance with the 1957 Nice Agreement as subsequently amended or revised. The current version of the 10<sup>th</sup> Edition came into force on 1 January 2013 and would be applicable to the classification of goods and services in the British Virgin Islands unless changed by an Order of the Financial Services Commission.

For trade marks registered before the Trade Marks Act, 2013 comes into force, new rules will have to allow the Registrar to bring existing registered trade marks into conformity with the new classification system. Until those new rules are made, all existing registered trade marks will have to continue to be registered in respect of the goods for which they had been previously registered.

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**What if the Trade Mark Contains Foreign Characters?**

It will be possible to register trade marks using non-Latin characters such as Arabic, Chinese, Devanagari or Cyrillic characters. When foreign numerals and foreign script are

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used in a trade mark, the application for registration must be accompanied by a certified translation into, or equivalent meaning or transliteration in, the English language of those foreign numerals or foreign script.

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### **What if the Trade Mark is a Person's Name?**

With respect to a person's name or representation (including a signature or image or other likeness), unless the person died ten (10) years before the date of the application for registration, the application to register a person's name or representation as a trade mark must be accompanied by the written consent of that person, or their legal representative, whose name or representation is being sought to be registered. This will effectively protect celebrities from the abuse of their names and images.

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### **Why Register a Trade Mark?**

While it is possible to acquire some common law rights solely through use of the trade mark, the law now favors the first person to register a trade mark rather than the first person to use the trade mark. It is, therefore, advisable to register a trade mark to avoid a third party applying to register the trade mark which will require commencing opposition proceedings, or failing that, the third party will have to commence cancellation, revocation or invalidity proceedings.

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### **What if the Trade Mark is Registered Elsewhere?**

If a trade mark is used in the British Virgin Islands with the word "registered" or the symbol ® or any other word or symbol that expresses or implies registration in the British Virgin Islands it is an offence and makes the person, including a body corporate, who uses the trade mark liable to a maximum fine of Five Thousand United States Dollars (US\$5,000.00). Therefore, it is necessary for goods and services that suggest the trade mark is registered to ensure that the packaging indicates that the trade mark is registered in some other country and not the British Virgin Islands otherwise the sale of those goods or services may be an offence in the British Virgin Islands.

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### **What if the Trade Mark is not Used in the British Virgin Islands?**

It would be use of a trade mark in the British Virgin Islands if goods or services are offered for sale to consumers in the British Virgin Islands, and this may include services over the internet or other electronic media where the goods are offered in United States Dollars and provides international shipping that would include the British Virgin Islands.

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### **How Can a Trade Mark Stop Counterfeit Goods or Parallel Import?**

The owner or licensee of a registered trade mark may give notice to the Commissioner of Customs to detain infringing goods that are not being imported into the British Virgin Islands for private and domestic use. This allows the trade mark owner to grant rights on a

territorial basis in the British Virgin Islands and to set prices specifically for the British Virgin Islands market or sell particular types or models of a product that isn't sold in other markets.

This will not prohibit the traditional means of using search and seizure orders under the Eastern Caribbean Supreme Court Civil Procedure Rules 2000, previously known as Anton Piller Orders, to seize and search infringing goods pending a hearing. In fact, this method may be used in conjunction with the new right to detain goods upon entry in cases where infringing goods have already entered the market and escape the detaining powers of the Commissioner of Customs.

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### **How Can I Register a Trade Mark?**

Every application for registration of a trade mark must be filed by a registered trade mark agent along with the payment of application fees. The registered trade mark agent must be approved by the Financial Services Commission and the approval renewed annually. Before filing an application to register a trade mark it is advisable to conduct a trade mark search for any identical or similar trade marks which would be an absolute ground to refuse the registration of the trade mark. If there is no identical or similar trade mark already registered, then the registered trade mark agent must file an application in the prescribed form. Until new rules are made, the Trade Marks Rules, 1937 (the "**1937 Rules**") will continue to have effect with such modifications as may be necessary to file the application for registration. Therefore, it will be necessary for the registered trade mark agent to file a Statement of Application in Form A under the 1937 Rules along with the Declaration in Form B under the 1937 Rules.

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If you would like more information about intellectual property issues in the British Virgin Islands, including our newly developed Guides for the new legislation, contact Jamal S. Smith.

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