

**GUIDE TO THE RENEWAL OF TRADE MARKS
IN THE BRITISH VIRGIN ISLANDS**

20 October 2015

The Trade Marks Act, 2013 and the Trade Marks Rules, 2015, as amended by the Trade Marks (Amendment) Rules, 2015, changed the duration of registration and the period for renewal for trade marks registered after 1 September 2015 in the British Overseas Territory of the Virgin Islands (the “**British Virgin Islands**”). However, all trade marks registered or renewed prior to 1 September 2015 will continue to be registered for the duration of their existing term, for example, if a trade mark was registered for 14 years prior to 1 September 2015 it would continue to be registered for 14 years and then upon its expiration date it would then conform to the new regime.

Registration of a trade mark takes effect from the date of filing the application for registration. Where the application for registration was based on a priority date from an application in a Paris Convention Country or a WTO Member State, the registration is still from the date of filing the application in the British Virgin Islands and not the priority date.

A trade mark is registered for a period of ten (10) years from the date of registration, i.e. from the date of filing the application for registration. Renewal of the registration is for a further period of ten (10) years, for example:

Date of Registration	Expiration Date	Next Expiration Date
1 September 2015	31 August 2025	31 August 2035

The expiration date in the above example assumes that it does not fall on a Saturday, a Sunday or a public holiday, in which case the expiration date would be the following day that is not a Saturday, a Sunday or a public holiday.

A renewal fee (including a fee for each class in a multi-class registration) must be paid at the time of filing the application for renewal in **Form TM11**. Failure to renew the trade mark by the expiration date results in the removal of the trade mark from the register. A request for restoration and renewal must be made in **Form TM11** and the applicable fee for restoration, renewal and a late penalty must be paid within six (6) months after the date of removal from the register. This deadline cannot be extended and once the registration has been removed the only recourse is to apply for a new registration.

Within one (1) month before the expiration of the registration the Registrar may send a notice to the trade mark owner in **Form TM10** if no application for renewal in **Form TM11** was submitted. The Registrar will publish in the Gazette the fact

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that the registration was not renewed prior to the expiration date, and the Registrar will also publish the date of removal from the register. However, if the registration is restored the Registrar must similarly publish in the Gazette the date of restoration.

There is no time limit within which a trade mark owner may apply for renewal of the trade mark but whenever the application for renewal is made the renewal would only take effect from the date of the expiration. The Registrar will issue a Notice of Renewal that reflects the next expiration date.

If there has been a change in ownership, such as an assignment or transmission, then a separate application in **Form TM13** must be filed. Additionally if there is any change in the name or address, or both, of the trade mark owner, whether by merger or otherwise, a separate application in **Form TM19** must be filed. The same **Form TM19** can be used in the event there is a change of the trade mark agent. However, it is necessary that every element of the name and address of the trade mark owner be exactly the same as it appears in the registration to avoid having to either amend the application or file a subsequent **Form TM19**.

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