

CHAPTER 435

THE TRADE MARKS ACT

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TRADE MARKS

(31st December, 1887.)

11/1887.
S.R.O. 22/1956.
18/1989.
S.I. 39/1989.

- 1.** This Act may be cited as the Trade Marks Act. **Short title.**
- 2.** In this Act— **Interpretation.**
- "Court" means the High Court.
- "person" includes a body corporate.
- "Registrar" means the Registrar of the High Court.

PART I

Registration of Trade Marks

3. (1) The Registrar may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark. **Application for registration.**

(2) The application must be made in the form set forth in the Schedule, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Trade Marks Office in the prescribed manner. **Schedule.**

(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered.

(4) The Registrar may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Court, and the Court shall have jurisdiction to hear and determine the appeal, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5) When an applicant for the registration of a trade mark, otherwise than under an international convention, is out of Antigua and Barbuda at the time of making the application, he shall give the Registrar an address for service in Antigua and Barbuda, and, if he fails to do so, the application shall not be proceeded with until the address has been given.

Limit of time for proceeding with application.

4. Where registration of a trade mark has not been or shall not be completed within twelve months from the date of the application, by reason of default on the part of the applicant, the Registrar shall give notice of the non-completion to the agent (if any) employed on behalf of the applicant, and, if at the expiration of fourteen days from that notice the registration is not completed, shall give the like notice to the applicant (to be left at his address within Antigua and Barbuda, if he be out of Antigua and Barbuda), and if at the expiration of the latter fourteen days, or such further time as the Registrar may in special cases permit, the registration is not completed, the application shall be deemed to be abandoned.

Particulars of trade mark.

5. For the purposes of this Act a trade mark must consist of or contain, at least, one of the following essential particulars—

(a) a name of an individual or firm printed, impressed or woven in some particular and distinctive manner; or

(b) a written signature, or copy of a written signature, of the individual or firm applying for registration thereof as a trade mark; or

(c) a distinctive device, mark, brand, heading, label or ticket; or

(d) an invented word or invented words; or

(e) a word or words having no reference to the character or quality of the goods, and not being a geographical name.

(2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words or figures, or combination of letters, words or figures, or any of them; but the applicant for registration of any

such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register:

Provided that a person need not, under this section, disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

6. A trade mark must be registered for particular goods or classes of goods. **Connection of trade mark with goods.**

7. When a person claiming to be the proprietor of several trade marks, which, while resembling each other in the material particulars thereof, yet differ in respect of— **Registration of a series of marks.**

(a) the statement of the goods for which they are respectively used or proposed to be used, or

(b) statements of numbers; or

(c) statements of price; or

(d) statements of quality; or

(e) statements of names of places,

seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks comprising a series shall be deemed and treated as registered separately.

8. A trade mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours. **Trade marks may be registered in any colour or colours.**

9. Every application for registration of a trade mark under this Act shall, as soon as may be after its receipt, be advertised by the Registrar, unless the Registrar refuses to entertain the application. **Advertisement of**

Opposition to registration.

10. (1) Any person may within one month, or such further time, not exceeding three months, as the Registrar may allow, of the advertisement of the application give notice in duplicate at the Trade Marks Office of opposition to registration of the trade mark, and the Registrar shall send one copy of such notice to the applicant.

(2) Within one month after receipt of such notice, or such further time as the Registrar may allow, the applicant may send to the Registrar a counter statement in duplicate of the grounds on which he relies for his application, and, if he does not do so, shall be deemed to have abandoned his application.

(3) If the applicant sends such counter statement, the Registrar shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Court, and the said Court shall have jurisdiction to hear and determine the appeal, and shall hear the applicant and the opponent and the Registrar, and shall make an order determining whether, and subject to what conditions (if any) registration is to be permitted.

(4) If the applicant abandon his application after notice of opposition in pursuance of this section, he shall be liable to pay to the opponent such costs in respect of the opposition as the Registrar may determine to be reasonable.

(5) When the opponent is out of Antigua and Barbuda, he shall give the Registrar an address for service in Antigua and Barbuda.

Assignment and transmission of trade mark.

11. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

Conflicting claims to registration.

12. Where each of several persons claims to be registered as proprietor of the same trade mark, the Registrar may refuse to register any of them until their

rights have been determined according to law, and the Registrar may himself submit, or require the claimants to submit, their rights to the Court.

13. (1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the Registrar shall not register in respect of the same goods, or description of goods, a trade mark identical with one already on the register with respect to such goods or description of goods. **Restrictions on registration.**

(2) Except as aforesaid the Registrar shall not register, with respect to the same goods or description of goods, a trade mark having such resemblance to a trade mark already on the register with respect to such goods, or description of goods, as to be calculated to deceive.

14. It shall not be lawful to register as part of, or in combination with, a trade mark any scandalous design or any words, the use of which would, by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a Court of Justice. **Further restriction on registration.**

15. (1) Nothing in this Act shall be construed to prevent the Registrar entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark, any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made. **Saving for power to provide for entry on register of common marks as additions to trade marks.**

(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register:

Provided that a person need not, under this section, disclaim his own name or the foreign equivalent thereof, or his place of business; but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.

PART II

Effect of Registration

Effect of application.

16. Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.

Right of first proprietor to exclusive use of trade mark.

17. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark, subject to the provisions of this Act.

Restrictions on actions for infringement.

18. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark, unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act.

Costs of action for infringement of trade marks.

19. In an action for infringement of a registered trade mark, the Court or a Judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a Judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or Judge trying the subsequent action certifies that he ought not to have the same.

PART III

Register of Trade Marks

Register of trade marks.

20. There shall be kept at the Trade Marks Office a book called the register of trade marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and transmissions of trade marks, and such other matter as may be from time to time prescribed.

Removal of trade mark after fourteen years unless fee paid.

21. (1) At a time not being less than two months, nor more than three months, before the expiration of fourteen years from the date of the registration of a trade

mark, the Registrar shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the Registrar before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee; and if such fee be not previously paid, he shall, at the expiration of one month from the date of the giving of the first notice, send a second notice to the same effect.

(2) If such fee be not paid before the expiration of such fourteen years, the Registrar may, after the end of three months from the expiration of such fourteen years, remove the mark from the register, and so, from time to time, at the expiration of every period of fourteen years.

(3) If, before the expiration of the said three months, the registered proprietor pays the said fee together with the additional prescribed fee, the Registrar may, without removing such trade mark from the register, accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where, after the said three months, a trade mark has been removed from the register for non-payment of the prescribed fee, the Registrar may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

(5) Where a trade mark has been removed from the register for non-payment of the fee or otherwise, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that the non-payment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.

PART IV

Fees

Fees for
registration.

22. There shall be paid in respect of applications for registration and other matters under this Act such fees as may be from time to time prescribed.

PART V

General

Trade Marks
Office.

23. (1) The Cabinet may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Trade Marks Office.

(2) Until a new Trade Marks Office is provided, the office of the Registrar shall be the Trade Marks Office within the meaning of this Act.

(3) The Trade Marks Office shall be under the immediate control of the Registrar, who shall act under the superintendence and direction of the Minister.

(4) Any act or thing directed to be done by or to the Registrar may, in his absence, be done by or to any officer for the time being in that behalf authorized by the Minister.

Officers and
clerks.

24. (1) The Public Service Commission may, at any time after the passing of this Act, and from time to time, appoint such officers and clerks with such designations and duties as they shall think fit, and may from time to time remove any of these officers and clerks.

(2) The salaries of these officers and clerks shall be appointed by the Public Service Commission, with the concurrence of Parliament, and the same, and the other expenses of the execution of this Act, shall be paid out of the money provided by Parliament.

Trusts not to be
entered in
registers.

25. There shall not be entered in any register kept under this Act, or be receivable by the Registrar, any notice of any trust expressed, implied, or constructive.

26. The Registrar may refuse to register a trade mark of which the use, in his opinion, would be contrary to law or morality.

Refusal to register trade mark in certain cases.

27. Where a person becomes entitled by assignment, transmission, or other operation of law to a registered trade mark, the Registrar shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the trade mark in the Register of Trade Marks. The person for the time being entered in the register of trade marks as proprietor of a trade mark shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with, the same, and to give effectual receipts for any consideration for such assignments, licence or dealing:

Entry of assignments and transmissions in register.

Provided that any equities in respect of such trade mark may be enforced in like manner as in respect to any other personal property.

28. There shall be a seal for the Trade Marks Office, and impressions thereof shall be judicially noticed and admitted in evidence.

Seal of Trade Marks Office.

29. Every register kept under this Act shall, at all convenient times, be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Trade Marks Office, of any entry in any such register shall be given to any person requiring the same, on payment of the prescribed fee.

Inspection of, and extracts from, registers.

30. Printed or written copies or extracts, purporting to be certified by the Registrar and sealed with the seal of the Trade Marks Office, of or from the registers and other books kept there shall be admitted in evidence in all Courts of Antigua and Barbuda, and in all proceedings, without further proof or production of the originals.

Sealed copies to be received in evidence.

31. (1) The Court may, on the application of any person aggrieved by the omission, without sufficient cause, of the name of any person, or of any other particulars, from

Rectification of registers by Court.

any register kept under this Act, or by any entry made, without sufficient cause, in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and, in either case, may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2) The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register; and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the Registrar.

Power to Registrar to correct clerical errors.

32. The Registrar may, on request in writing accompanied by the prescribed fee—

(a) correct any clerical error in, or in connection with, an application for registration of a trade mark, or

(b) correct any clerical error in the name, style or address of the registered proprietor of the trade mark, or

(c) cancel the entry, or part of the entry, of a trade mark on the register, or

(d) permit an applicant for registration of a trade mark to amend his application by omitting any particular goods or classes of goods, in connection with which he has desired the trade mark to be registered:

Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

Alteration of registered trade mark.

33. (1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act; and the Court may refuse or grant leave on such terms as it may think fit.

(2) Notice of any intended application to the Court under this section shall be given to the Registrar by the applicant; and the Registrar shall be entitled to be heard on the application.

(3) If the Court grants leave, the Registrar shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

34. If any person makes, or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanour. **Falsification of entries in registers.**

35. Where any discretionary power is by this Act given to the Registrar, he shall not exercise that power adversely to the applicant for the registration of the trade mark, without giving the applicant an opportunity of being heard personally or by his agent. **Exercise of discretionary power by Registrar.**

36. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to the Attorney-General for directions in the matter. **Registrar may apply to Attorney-General.**

37. A certificate purporting to be under the hand of the Registrar, as to any entry, matter, or thing which he is authorized by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. **Certificate of Registrar to be evidence.**

38. (1) Any application, notice, or other document authorized or required to be left, made, or given at the Trade Marks Office, or to the Registrar, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post. **Applications and notices by post.**

(2) In providing such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at office.

Cap. 354.

Declaration by infant, person of unsound mind, &c.

Power of Cabinet to make general rules for classifying goods and regulating business of Trade Marks Office.

39. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document, or paying any fee, at the Trade Marks Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday under the Public Holidays Act, or any day observed as a day of public fast or general thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document, or to pay such fee, on the day following such excluded day, or days, if two or more of them occur consecutively.

40. If any person is, by reason of infancy, unsoundness of mind, or other inability, incapable of making any declaration or of doing anything required or permitted by this Act, or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or Judge possessing jurisdiction in respect to the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making of any such declaration or doing any such thing, may make such declaration, or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall, for the purposes of this Act, be as effectual as if done by the person for whom he is substituted.

41. (1) The Cabinet may, from time to time, make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a) for regulating the practice of registration under this Act;

(b) for classifying goods for the purposes of trade marks;

(c) for making or requiring duplicates of any documents;

(d) for securing and regulating the publishing and selling of copies, at such prices and in such manner as the Cabinet may think fit, of any documents in the Trade Marks Office;

(e) for securing and regulating the making, printing, publishing, and selling of indexes to, and abridgements of, any documents in the Trade Marks Office; and providing for the inspection of indexes and abridgements, and other documents;

(f) generally for regulating the business of the Trade Marks Office and all things by this Act placed under the direction or control of the Registrar, or of the Cabinet.

(2) The Form in the Schedule may be altered or amended by rules made by the Cabinet.

(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act; and shall (subject as is hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4) Any rules made in pursuance of this section shall be laid before Parliament if Parliament be in session at the time of the making thereof, or if not, then as soon as practicable after the beginning of the next session of Parliament; and they shall be advertised twice in the *Gazette*.

(5) If Parliament resolve that such rules or any of them ought to be annulled, the same shall, after the date of such resolution, be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule, or to the making of any new rules or rule.

42. Any person authorized by any law in force in Antigua and Barbuda to take affidavits may take a declaration authorized or required to be made under this Act. **Authority for taking declarations.**
