



# Maintaining your Caribbean trade marks with certainty

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While some countries in the Caribbean have an efficient trade mark renewal process, for the most part renewals cannot be filed electronically and can be more time-consuming than brand owners and foreign trade mark practitioners may expect based on their own local practice. Ashleigh Miller, a paralegal in Ogier's Intellectual Property group, encourages brand owners to start thinking about their Caribbean renewal strategy at least 12 months before expiry and provide renewal instructions as early as six months prior to the deadline for the following reasons:

## 1. Unclear status of registrations

Sometimes we receive instructions to renew trade mark registrations which, upon further investigation, have already expired, occasionally due to a prior renewal application filed by a third party going unprocessed due to incompleteness or one or more miscalculations of the next renewal deadline based on a misreading of the registration certificate leading to incorrect docketing.

While a 10-year renewal period is common, renewals do not always fall due every 10 years in the Caribbean. Indeed, terms of registration and renewal vary throughout the region and some countries have registration and renewal terms which vary depending on the type of application initially filed. To provide a flavour of the variety of registration and renewal terms that one may encounter, here are some examples by reference to particular Caribbean countries:

- In Bermuda, the first renewal falls due seven years from the filing date of the trade mark application, which is also deemed to be the effective date of registration. Subsequent renewals are then due every 14 years thereafter
- In the Bahamas, renewals fall due every 14 years from the filing date, which is also deemed to be the effective date of registration
- In Barbados, where applications can take several years to progress from filing through to registration due to delays in the publication process, the renewal clock does not start ticking until an application progresses to registration. Renewals are due every 10 years from the

registration date (which is distinct from the filing date)

- In the British Virgin Islands, prior to 1 September 2015, it was possible to file applications based on a UK trade mark registration and in such cases the BVI trade mark renewal deadline would fall at the same time as that of the UK trade mark registration. Prior to 1 September 2015, national applications would fall due for renewal every 14 years. On 1 September 2015, the registration term for newly filed national applications changed to 10 years from the filing date, which is also deemed to be the effective date of registration. National registrations filed before 1 September 2015 continued to have a 14 year term, but future renewals filed on or after 1 September 2015 would be processed for a period of 10 years going forward

## **2. Late renewal periods and rules vary**

In some cases it may be possible to late-renew and/or restore trade mark registrations even long after the last renewal deadline. In other cases, it may be that the brand owner has banked on filing a renewal in a grace period that is shorter than anticipated or no longer exists. For example, and this is the worst case scenario, but it happens(!), in January 2022 the Director of the Ministry of Commerce and Industry in Haiti made a surprising decision to cancel the longstanding application of the six-month late-renewal grace period which previously applied in Haiti. While it is yet to be seen if this will be deemed legally binding, this type of decision creates an unnecessary level of uncertainty and further encourages early renewal planning and filing.

While many Caribbean countries offer a six-month late renewal grace period, grace periods do vary. For example, Aruba offers a three-month late renewal grace period, the Turks and Caicos offers a one-month grace period followed by a further late renewal and restoration period, whereas St. Lucia offers a 12-month late renewal grace period and no option for restoration. On the other hand, Belize offers a six-month late renewal grace period followed by "restoration", but the Belizean form of restoration equates to a re-filing in respect of which the original registration number is retained, but notably the original priority filing date is lost. During the early part of the Covid-19 pandemic, it became a common strategy to delay the instruction of renewals until the start of the grace period to push back the renewal cost as far as possible, but in some cases, this ultimately cost brand owners their valuable trade mark rights in countries where the grace period is shorter than expected, original documents with formalities such as notarisation and/or legalisation are required for filing, and/or there were other unforeseen issues which needed to be addressed before renewal applications could be successfully filed or processed.

## **3. Chain of title recordal issues**

We also commonly receive instructions to renew trade mark registrations in a particular name and address only to discover on closer inspection that a prior application to record a change of name/address or file an assignment was never processed by the Registry, perhaps due to incompleteness and/or a formality error and, has therefore not yet been recorded. This is most often the case in countries where the Registry takes several years to process recordal applications

and such applications have not been monitored closely enough. For example, in Antigua and Barbuda, unresolved office actions or requisitions issued in respect of renewal and recordal documents filed before the Antigua and Barbuda Intellectual Property and Commerce Office (ABICO) are very common due to: (a) small variations in the spelling of proprietor names and addresses, which ABICO tends to query; and/or (b) documents being signed by persons who are not officers of the relevant company and making filings without submitting sufficient proof of their authority to sign.

In other cases, brand owners have opted not to keep their name and address current before the relevant trade mark Registry, perhaps due to the requirement for original documents with onerous formalities and/or the cost of recording updates as and when they occur. In such circumstances it is necessary to try to gather the relevant documents and signatures to record such updates at the same time as renewal, which can be difficult in cases where original signatures are required from companies which have since dissolved. In such circumstances, we must find innovative ways to compile the requisite evidence that a change or assignment has taken place in a form that the relevant Registry will accept.

Given the possible issues outlined above, when we receive renewal instructions, the first thing we do is ask the brand owner to provide us with copies of the registration certificate, last-issued renewal and/or recordal certificate and any applications which may still be pending at the Registry in respect of the trade mark to be renewed. If the brand owner does not have the documents to hand we can order them from the relevant Registry. If we see that there are potential gaps in the records, we strongly recommend a trade mark Registry search is conducted, which may require a physical audit of the file at the trade mark Registry in countries where electronic searching is not possible. This is to ensure that before we make any new filings on the brand owner's behalf, we know the details of: (a) the current proprietor name and address on record; (b) whether there are any pending recordal applications that are incomplete or not yet processed; and (c) the desired proprietor name and address so that we can advise on any additional recordal documents that need to be filed at the same time of renewal to ensure that the renewal application is accepted without an office action or objection arising due to gaps in the chain of title.

It is prudent to keep proprietor details up to date on the Register at all times to seek to avoid the types of issues outlined above at the time of renewal and the potential last-minute rush to compile and execute the relevant documents prior to the renewal deadline.

#### **4. Time to conduct status and verification searches**

Where physical searches of trade mark records must be conducted in order to ascertain the current status of a registration and/or the proprietor details on file to ensure that a renewal is filed correctly, additional time is required to gather the relevant information. In certain countries, it is not possible for the local trade mark agent to conduct the search themselves and it can take weeks or even months for the Registry to provide search results.

## **5. Reclassification is required**

In cases where there has been an update to the local classification system or Nice classification edition used at some point between the registration of a trade mark and the time of renewal, it may be necessary to file an application for reclassification on renewal. In most cases, this is relatively straight forward. However, in other cases, for example, where there has been a change of the classification used in a country previously using the old pre-1938 British classification system consisting of 50 goods classes and moving to a newer edition of Nice, each item within the specification needs to be examined and reclassified carefully, which can take some time depending on the length of the specification.

## **6. Requirement for original documents with formalities**

Even in the age of electronic signatures, many Caribbean countries call for original signed and notarised and/or legalised powers of attorney and other evidentiary documents, such as affidavits, declarations and/or Companies House/Registry certificates e.g. filed in support of an update to a proprietor name or address. It can take more time than brand owners may plan for to get these documents ready for submission as much depends on the availability of the relevant signatory and their capacity to get before a notary, especially in these times of increased remote working. Therefore, we would always recommend allowing a good window of time for any unexpected delays in the process to ensure that the renewal timeline is not adversely affected.

## **7. UK or US base registration must be renewed first**

In some Caribbean countries, where local trade mark registrations are re-registrations of an existing US federal trade mark registration or a UK trade mark registration, it is necessary to complete the renewal process in the home jurisdiction first, before ordering certified copies of the relevant documents for filing in the re-registration country. For example, this is the case in the US Virgin Islands and some of the Islands where UK re-registrations are accepted, e.g. Anguilla, Guyana and Montserrat. It can take additional time to order and send these documents to the relevant Island for submission with the renewal application.

## **8. Annual fees and/or proof of use must be filed with the renewal application**

In addition to renewals filed to extend the life of a trade mark registration, in the Cayman Islands, Honduras and the Turks and Caicos Islands it is also necessary to pay an annual fee each year for the life of the trade mark in order to keep it in good standing and enforceable against third parties at all times. In Honduras and Turks and Caicos, renewal applications cannot be filed until all outstanding annual fees are paid up to date. While the process of making annual fee payments is relatively quick, depending on the value of the fees to be paid, prepayment may be required at the agent level and therefore the time it takes to arrange and submit the payment should also be a factor to consider when sending renewal and annual fee payment instructions.

In Islands such as Puerto Rico, it is also necessary to file a Declaration of Continued Use on renewal and therefore brand owners should also make an allowance for the time it may take to liaise with sales or marketing teams responsible for the relevant market in order for specimens of use to be collated for the relevant goods or services, as well as for an assessment of their suitability to be performed by counsel.

In Haiti, proof of use or a declaration of non-use is not due on renewal but rather within the first three months of the sixth year following registration or renewal. In cases where such evidence was not filed, registered rights will have since lapsed and it will not be possible to further renew the registration. We encourage brand owners to check their historic records in this regard before instructing a renewal application to ensure that their registration is still alive. In circumstances where proof of use has been overlooked or it is unclear whether it was filed or processed in a timely fashion, we would recommend that a renewal application is filed in conjunction with a fresh trade mark application to cover all bases and ensure that the brand owner is protected.

At Ogier, we ensure that your valuable trade mark rights are maintained with certainty. Should you have any questions regarding the issues raised in the above article please contact Sophie Peat, partner, at [sophie.peat@ogier.com](mailto:sophie.peat@ogier.com) or Ashleigh Miller, paralegal at [ashleigh.miller@ogier.com](mailto:ashleigh.miller@ogier.com).

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