
**Council for Trade-Related Aspects of
Intellectual Property Rights**

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**MAIN DEDICATED INTELLECTUAL PROPERTY
LAWS AND REGULATIONS NOTIFIED UNDER
ARTICLE 63.2 OF THE AGREEMENT**

ANTIGUA AND BARBUDA

The present document reproduces the text¹ of the Trade Marks Bill 2001, as notified by Antigua and Barbuda under Article 63.2 of the Agreement (see document IP/N/1/ATG/1).

**Conseil des aspects des droits de propriété
intellectuelle qui touchent au commerce**

**PRINCIPALES LOIS ET REGLEMENTATIONS CONSACREES A LA
PROPRIETE INTELLECTUELLE NOTIFIEES AU TITRE
DE L'ARTICLE 63:2 DE L'ACCORD**

ANTIGUA-ET-BARBUDA

Le présent document contient le texte¹ du projet de loi sur les marques, 2001, notifié par Antigua-et-Barbuda au titre de l'article 63:2 de l'Accord (voir le document IP/N/1/ATG/1).

**Consejo de los Aspectos de los Derechos de Propiedad
Intellectual relacionados con el Comercio**

**PRINCIPALES LEYES Y REGLAMENTOS DEDICADOS A LA
PROPIEDAD INTELECTUAL NOTIFICADOS EN VIRTUD
DEL PÁRRAFO 2 DEL ARTÍCULO 63 DEL ACUERDO**

ANTIGUA Y BARBUDA

En el presente documento se reproduce el texto¹ del proyecto de ley de marcas de fábrica o de comercio de 2001, que Antigua y Barbuda notificó de conformidad con lo dispuesto en el párrafo 2 del artículo 63 del Acuerdo (véase el documento IP/N/1/ATG/1).

¹ In English only./En anglais seulement./En inglés solamente.

ANTIGUA AND BARBUDA
TRADE MARKS ACT 2001

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ANTIGUA AND BARBUDA

TRADE MARKS ACT

NO OF 2001

BILL FOR

AN ACT to make provision for the registration of trade marks and other purposes related thereto

[]

ENACTED by the Parliament of Antigua and Barbuda as follows –

Short title and
commencement.

1. This Act may be cited as the Trade Marks Act 2001
and comes into force on a day fixed by the Minister by Order
published in the *Gazette*

Interpretation.

2. In this Act,

“collective mark” means any visible sign designated
as such in the application for registration and capable
of distinguishing the origin or any other common
characteristics, including the quality, of goods or
services of different enterprises which use the sign
under the control of the registered owner of the
collective mark;

“Court” means the High Court;

“International Classification” means the
classification according to the Nice Agreement
Concerning the International Classification of
Goods and Services for the Purposes of the
Registration of Marks, of June 15, 1997 as last
revised;

“mark” means any visible sign capable of
distinguishing the goods (“trademark”) or services
(“service mark”) of an enterprise;

“Minister” means the Minister responsible for
intellectual property;

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

“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;

“Register” means the register maintained by the Registrar under section 19;

“Registrar” means the Registrar of Intellectual Property appointed under the Registrar of Intellectual Property Act 2001;

“trade name” means the name or designation identifying and distinguishing an enterprise.

Acquisition of the exclusive right to a mark and Registrability.

3. (1) The exclusive right to a mark, as conferred by this Act, shall be acquired by registration in accordance with the provisions thereof.

(2) A mark cannot be validly registered:

- (i) if it is incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (ii) if it is contrary to public order or morality;
- (iii) if it is likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned or their nature or characteristics;
- (iv) if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorized by the competent authority of that State or organisation;
- (v) if it is identical with, or confusingly similar to, or constitutes a translation of,

a mark or trade name which is well known in Antigua and Barbuda for identical or similar goods or services of another enterprise, or if it is well known and registered in Antigua and Barbuda for goods or services which are not identical or similar to those in respect of which registration is applied for, provided, in the latter case, that use of the mark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known mark and that the interests of the owner of the well-known mark are likely to be damaged by such use;

- (vi) if it is identical with a mark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a mark as to be likely to deceive or cause confusion.

Application for registration.

4.(1) The application for registration of a mark shall be filed with the Registrar and shall contain a request, a reproduction of the mark and a list of the goods or services for which registration of the mark is requested, listed under the applicable class or classes of the International Classification; and it shall be subject to the payment of the prescribed application fee.

(2) The application may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or his predecessor in title in or for any State party to the Convention or any member of the World Trade Organisation in which case, the Registrar may require that the applicant furnish, within the prescribed time limit, a copy of the earlier application, certified as correct by the Office with which it was filed.

(3) The effect of the said declaration shall be as provided in the Paris Convention and if the Registrar finds that the requirements under this subsection and

the Regulations pertaining thereto have not been fulfilled, the declaration shall be considered not to have been made.

(4) The applicant may withdraw the application at any time during its pendency.

Examination,
Opposition and
Registration of Mark

5.(1) The Registrar shall examine whether the application complies with the requirements of section 4(1) and the Regulations pertaining thereto.

(2) The Registrar shall examine and determine whether the mark is a mark as defined in section 2 and is registrable under section 3(2).

(3) Where the Registrar finds that the conditions referred to in subsection (1) and (2) hereof are fulfilled, he shall forthwith cause the application, as accepted, to be published in the prescribed manner.

(4) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the registration of the mark on the grounds that one or more of the requirements of sections 2 and 3(2) and the Regulations pertaining thereto are not fulfilled.

(5) The Registrar shall send forthwith a copy of a notice referred to in subsection (4) to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar a counter-statement of the grounds on which he relies for his application and if he does not do so, he shall be deemed to have abandoned the application.

(6) If the applicant sends a counter-statement, the Registrar shall furnish a copy of it to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, and considering the merits of the case, shall decide whether the mark should be registered.

(7) After an application is published and until the registration of the mark, the applicant has the same privileges and rights as he would have if the mark had been registered; however, it shall be a valid defence to an action brought hereunder in respect of an act done

after the application was published, if the defendant establishes that the mark could not validly have been registered at the time the act was done.

(8) Where the Registrar finds that the conditions referred to in subsections (1) and (2) are fulfilled, and either:

- (i) the registration of the mark has not been opposed within the prescribed time limit; or
- (ii) the registration of the mark has been opposed and the opposition has been decided in the applicant's favor,

he shall register the mark, publish a reference to the registration and issue to the applicant a certificate of registration; otherwise he shall refuse the application.

Rights Conferred
by Registration;
Duration; Renewal.

6.(1) The use of a registered mark, in relation to any goods or services for which it has been registered, by any person other than the registered owner shall require the agreement of the latter.

(2) The registered owner of a mark shall, in addition to any other rights, remedies or actions available to him, have the right to institute court proceedings against any person who infringes the mark by using the mark, without his agreement, or who performs acts which make it likely that infringement will occur; and the right shall extend to the use of a sign similar to the registered mark and use in relation to goods and services similar to those for which the mark has been registered, where confusion may arise in the public. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

(3) The rights conferred by registration of a mark shall not extend to acts in respect of articles which have been put on the market in [Antigua and Barbuda] [in any country]* by the registered owner or with his consent.

* Article 6 of the TRIPS Agreement leaves members to choose the level of exhaustion (see attached note on exhaustion).

(4) The provisions of Section 3(2)(v) shall apply, *mutatis mutandis*, in any action instituted by the owner of a well-known mark against any person in respect of the unlawful use of the well-known mark.

(5) The registration of a mark shall be for a period of ten years from the filing date of the application for registration.

(6) The registration of a mark may, upon request, be renewed for consecutive periods of ten years, provided that the registered owner pays the prescribed renewal fee.

(7) A period of grace of six months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation,
Removal on Grounds
of Non-Use.

7.(1) Any interested person may request the Registrar to invalidate the registration of a mark.

(2) The Registrar shall invalidate the registration if the person requesting the invalidation proves that any of the requirements of sections 2 or 3(2) are not fulfilled.

(3) Any invalidation of a registration of a mark shall be deemed to have been effective as of the date of registration, and it shall be recorded and a reference thereto published as soon as possible.

(4) Any interested person may request the Registrar to remove a mark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of three years or longer; but a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.

Collective Marks

8.(1) Subject to subsections (2) and (3), Sections 3 to 7 and 12 to 16 shall apply to collective marks.

(2) An application for registration of a collective mark shall designate the mark as a collective mark and shall be accompanied by a copy of the regulations governing the use of the collective mark.

(3) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in subsection (2).

(4) In addition to the grounds provided in section 7(2), the Registrar shall invalidate the registration of a collective mark if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in subsection (2) or that he uses or permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Licensing of Marks and Collective Marks

9.(1) Any licence contract concerning the registration of a mark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used. If the licence contract does not provide for such quality control or if such quality control is not effectively carried out, the licence contract shall not be valid.

(2) The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

Trade Names

10.(1) A name or designation may not be used as a trade name if by its nature or the use to which it may be put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

(2) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(3) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, that is likely to mislead the public, shall be deemed unlawful.

Interpretation of terms
concerning the Madrid Protocol

11. For the purposes of this Act:

“Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted at Madrid on June 27, 1989;

“Common Regulations” means the Common Regulations under the Madrid Agreement and Madrid Protocol;

“international application”, “international registration”, “International Bureau”, “holder”, “designation” “subsequent designation”, “date of international registration” and “date of subsequent designation” have the same meaning as in the Madrid Protocol or the Common Regulations, as the case may be.

“designation of Antigua and Barbuda” means request made in relation to an international registration (either in the international application or subsequently) for extension of protection to Antigua and Barbuda under Article 3^{ter}(1) or (2) of the Madrid Protocol;

“date of the designation of Antigua and Barbuda” means the date of an international registration resulting from an international application in which Antigua and Barbuda was designated or the date of a subsequent designation of Antigua and Barbuda, as the case may be.

Effect of International
Registration as National
Application.

12. Where an international registration of a mark contains a designation of Antigua and Barbuda, the protection of the mark shall be the same, as from the date of the designation of Antigua and Barbuda, as if the mark had been the subject of an application for registration filed under Section 4.

National Processing of
International Registration

13.(1) Where the Registrar has been notified by the International Bureau that an international registration contains a designation of Antigua and Barbuda, he shall

proceed in accordance with Section 5(2).

(2) Where the Registrar finds that the conditions referred to in Section 5(2) are not fulfilled, he shall notify the International Bureau that, to the extent that the said conditions are not fulfilled, protection of the mark in Antigua and Barbuda is refused.

(3) Any interested person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of opposition to the protection of the mark on the grounds that one or more of the requirements of section 2 or 3(2) and the Regulations pertaining thereto are not fulfilled.

(4) The Registrar shall forthwith notify the International Bureau of an opposition under subsection(3) and subsequent procedure shall be in accordance with Section 5(5) and (6), references to the applicant being construed as references to the holder of the international registration.

(5) No notification in accordance with subsection (2) or (3) and (4) shall be sent to the International Bureau after the end of one year from the date on which the International Bureau notified the Registrar of the designation concerned.

Effect of International
Registration as National
Registration.

14. Where no notification of refusal or opposition has been sent to the International Bureau in accordance with section 13(2), (3), (4) and (5), or any such refusal has been withdrawn or any such opposition has been decided in favor of the holder of the international registration, the protection of the mark in Antigua and Barbuda shall, as from the date of the designation of Antigua and Barbuda, be the same as if the mark had been registered under Section 5(8) of this Act.

Further provisions concerning
international applications and
International Registrations.

15. Further details concerning international applications and international registrations, including the procedure to be followed and any fees to be paid in connection with the filing of an international application through the Intellectual Property Registry, may be included in the Regulations.

Conflict Between the Madrid
Protocol and this Act.

16. In the event of any conflict between, on the one hand, this Act or the Regulations and, on the other, the Madrid Protocol or the Common Regulations, the latter shall

prevail.

Changes in ownership and
Licence contracts

17. (1) Any change in the ownership of or the registration of a mark or collective mark, or in the ownership of an application therefor, shall be in writing and shall, at the request of any interested party, to the Registrar, be recorded and, except in the case of an application, published by the Registrar; but such change shall have no effect against third parties until such recording is effected.

(2) Any change in the ownership of the registration of a collective mark, or in the ownership of an application therefor, shall require previous approval by the Minister.

(3) Any change in the ownership of a trade name must be made with the transfer of the enterprise or part thereof identified by that name and shall be in writing.

(4) A change in ownership of the registration of a mark or a collective mark shall be invalid if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services to which the mark is applied.

(5) Any licence contract concerning a registered mark, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential but shall record it and publish a reference thereto; and the licence contract shall have no effect against third parties until such submission has been made.

Agents.

18. Where an applicant's ordinary residence or principal place of business is outside Antigua and Barbuda, he shall be represented by an attorney at law resident and practising in Antigua and Barbuda.

Register.

19.(1) The Registrar shall maintain a register for Marks to be called the Register of Marks; and all the recordings provided for in this Act shall be effected in the Register.

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(2) Collective marks shall be registered in a special section of the Register of Marks.

(3) The Register may be consulted by any person, and any person may obtain extracts therefrom, under the conditions prescribed in the Regulations.

(4) The Registrar shall publish in the Gazette all the publications provided for in this Act.

Corrections of Errors and Extension of Time

20.(1) The Registrar may, subject to any provision in the Regulations, correct any error of translation or transcription, clerical error or mistake in any application or document filed with the Registrar or in any recording effected pursuant to this Act or the Regulations.

(2) If the Registrar is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the Regulations, upon notice to the parties concerned and upon such terms as he may direct; and such extension may be granted though the time for doing the act or taking the proceeding has expired.

Exercise of Discretionary Powers

21. The Registrar shall give any party to a proceeding before him an opportunity of being heard before exercising adversely to that party any discretionary power vested in him by this Act or the Regulations.

Competence of Court and Appeals

22.(1) The High Court shall have jurisdiction in cases of dispute relating to the application of this Act and the Regulations and in matters which under this Act are to be referred to the court.

(2) Any decision taken by the Registrar under this Act, in particular the registration of a mark or collective mark, or the refusal of an application for such a grant or registration, may be the subject of an appeal by any interested party before the Court and such appeal shall be filed within two months of the date of the decision.

Infringement, Unlawful Acts and

23.(1) Subject to section 6(3), an infringement shall consist of the performance of any act

Offences.	<p>referred to in section 6 in Antigua and Barbuda by a person other than the owner of the title of protection and without the agreement of the latter.</p> <p>(2) On the request of the owner of the title of protection, or of a licensee if he has requested the owner to institute court proceedings for a specific relief and the owner has refused or failed to do so, the court may grant an injunction to prevent infringement, an imminent infringement, or an unlawful act referred to in section 10(2) and (3), award damages and grant any other remedy provided for in the general law.</p> <p>(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection (1) or an unlawful act as defined in section 10(2) and (3) is guilty of an offence and is liable on summary conviction to a fine of \$100,000 or to imprisonment for a term of five years, or to both.</p>
Application of International Treaties.	<p>24. The provisions of any international treaties in respect of intellectual property to which Antigua and Barbuda is a party shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, shall prevail over the latter.</p>
Regulations.	<p>25 The Minister may make Regulations prescribing details for the implementation of this Act and the Regulations may, in particular, provide for the payment of fees in connection with applications for the registration of marks and collective marks and matters related thereto.</p>
Repeals; Transitional Provisions	<p>26. (1) The Registration of the United Kingdom Trade Marks Act, Cap 377A and the Trade Marks Act, Cap 435 are repealed.</p> <p>(2) Notwithstanding the repeal of the Acts referred to in subsection (1), trademarks registered under those Acts shall remain in force but shall, subject to subsection (3), be deemed to have been granted or registered under this Act.</p> <p>(3) Trademarks registered under the Acts referred to in subsection (1) shall be due for renewal within the same period as under those Acts or 10 years from the</p>

entry into force of this Act, whichever period first expires, and, upon renewal, shall be reclassified in accordance with the International Classification.

(4) Within 18 months from the entry into force of this Act, the Minister may, by notice* in the *Gazette*, make any further transitional or saving provisions which appear to him to be necessary or desirable.

Passed the House of Representatives this
Day of 2001

Speaker

Passed the Senate this
day of 2001

President

Clerk to the House of Representatives

Clerk to the Senate

²⁸ ~~to check whether Constitution permits.~~