

Zoom Series
Session 3

World Intellectual Property Day - April 26, 2023

Women and intellectual property

Accelerating innovation
and creativity

HSM IP



Everything You Need to Know About **TRADE MARKS**

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18 April 2023

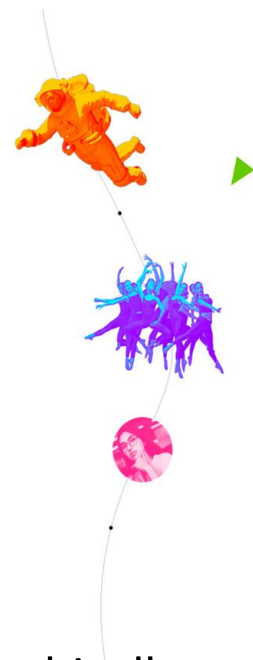
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What is a Trade Mark?

THE TRADE MARKS ACT, 2016:

"Trade Mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings and it may, in particular, consist of words (including personal names) designs, numerals, letters or the shape of goods or their packaging.



Absolute Grounds for Refusal



Section 23 of the Act:

- Signs which do not satisfy the requirements of the definition of a trade mark
- Trade marks which are devoid of any distinctive character
- Trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services (unless acquired distinction through use by applicant)
- Trade marks which consist exclusively of signs or indications which have become customary in the current language or in *bona fide* and established practices of the trade
- Trade marks consisting exclusively of the word “Cayman”, “Cayman Islands”, “Grand Cayman”, “Cayman Brac”, “Brac” or “Little Cayman”

Absolute Grounds for Refusal (Cont.)

A sign shall not be registered as a trade mark if it consists exclusively of:

- The shape which results from the nature of the goods themselves
- The shape of goods which is necessary to obtain a technical result
- The shape which gives substantial value to the goods

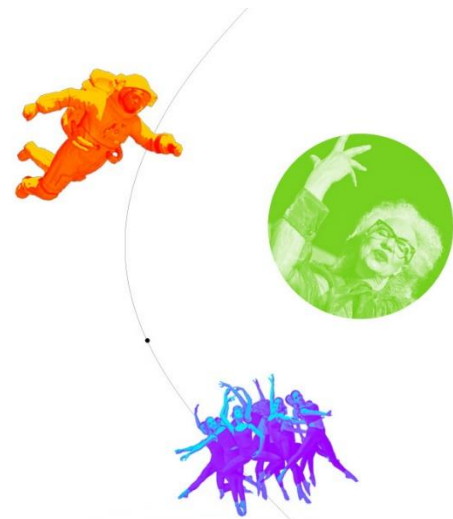
A trade mark shall not be registered if it is:

- Contrary to public policy or to accepted principles of morality
- Of such nature as to deceive the public as to the nature, quality, geographical origin of the goods or service or any other feature of the goods or service
- Any word, letter or device specified by the Registrar as a restricted or prohibited word, letter or device, such word, letter or device being published by the Registrar by notice in the Gazette as a restricted or prohibited word, letter or device
- A trade mark shall not be registered if its use is prohibited in the Islands by any law.
- A trade mark shall not be registered if or to the extent that the application for registration is made in bad faith

Absolute Grounds for Refusal (Cont.)

A trade mark which consists of or contains -

- national flags, insignia of royalty, insignia of international organisations and national emblems or the design of such flags, insignia or emblems
- words, letters or devices likely to lead persons to think that the applicant either has or recently has had Government patronage or authorisation, may only be registered where the Registrar is satisfied that consent has been given by or on behalf of the respective Government or international organisation



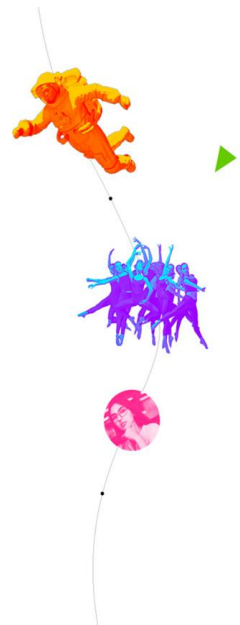
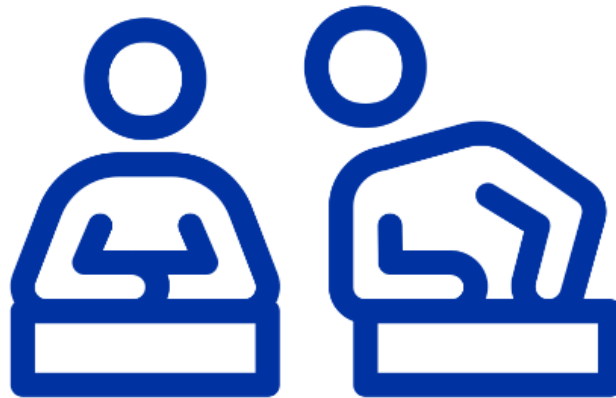
Relative Grounds for Consideration (Similar or Identical Marks)

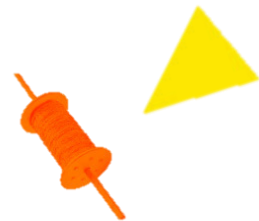
Section 25 of the Act:

- A trade mark shall not be registered where it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- A trade mark shall not be registered where -
 - It is identical with an earlier trade mark and the goods or services for which it is to be registered are similar to those for which the earlier trade mark is protected; or
 - It is similar to an earlier trade mark and the goods or services for which it is to be registered are identical with or similar to those for which the earlier trade mark is protected,
 - and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

Relative Grounds for Consideration (Similar or Identical Marks) (Cont.)

- A trade mark which is identical to or similar to an earlier trade mark shall not be registered where the earlier trade mark has a reputation in the Islands and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
- A trade mark shall not be registered if, or to the extent that, its use in the Islands is liable to be prevented by virtue of the law of passing off or any law that protects an unregistered trade mark or other sign used in the course of trade.





Duration of Protection

- 10 years from the date of registration (which in Cayman Islands is the same as the date of application).
- On expiry the applicant has the option to renew the registration for further periods of 10 years (six-month grace period and option to restore and late renew thereafter if the registration expires without having been renewed).



How to Apply and Trade Mark Application Process

- A trade mark agent is required in order to conduct any dealings with the Cayman Islands Intellectual Property Office (CIPO).
- Brand owners may wish to ascertain the availability of a trade mark they propose to apply to register by conducting an official search of the Register pre-filing.
- Once the applicant is ready to file, a TM1 is completed including:

The mark to be registered (high resolution .JPEG preferred if an image mark)

The Class(es) of goods and services, including a detailed specification of the goods and / or services

The proprietor details (name, address and type of applicant)

Optional description if the mark is not “traditional”, i.e. 3-D mark or hologram

Optional limitation if the mark is to be registered in respect of only certain colours, for example

Optional disclaimer

Translation or transliteration of any mark not in English / Latin characters

How to Apply and Trade Mark Application Process (Cont.)

- CIPO examines the application and notifies the applicant of any issues it wishes to see rectified or clarified by way of handing down an Office Action – no mandated limit on the number of Office Actions that may be issued, but the fee to respond to the OA covers submission of responses to the first four.
- A response to an Office Action may require the completion of Form TM9A, which allows the applicant to amend the specification of goods and / or services (though not to expand the scope of protection), add a disclaimer, a limitation (for example, to a specific colour/s) and / or a translation / transliteration of any mark not in the English language or Latin characters.
- Once CIPO is satisfied that the application meets the statutory requirements, it is published in the Cayman Islands Official Gazette which is issued roughly once every *2-3 weeks*.
- The publication opens a *60-day window* within which any third party may oppose the trade mark application, in writing to CIPO.
- If the application is not opposed, once the opposition deadline expires, CIPO will issue the Certificate of Registration (electronic-only).



What is Infringement of a Trade Mark?



Section 30 of the Act:

- A person who is not the registered proprietor or licensee infringes a registered trade mark if the person uses in the course of trade a sign or mark which is identical to a registered trade mark and that sign or mark is used in relation to goods or services which are identical to those goods and services for which it is registered.
- **A person infringes a registered trade mark if the person uses in the course of trade a sign, such sign being -**
 - (a) identical to the registered trade mark and is used in relation to goods or services similar to those for which the trade mark is registered; or
 - (b) similar to the registered trade mark and is used in relation to goods or services identical to or similar to those for which the trade mark is registered and because of this there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the registered trade mark.
- A person infringes a registered trade mark if the person in the course of trade in relation to goods and services uses a sign which is identical to or similar to a registered trade mark, where the trade mark has a reputation in the Islands and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.



What is Infringement of a Trade Mark? (Cont.)

- **For the purpose of this section, a person uses a sign if the person –**
 - affixes it to goods or the packaging thereof;
 - offers or exposes goods for sale, puts them on the market or stocks them for those purposes under the sign, or offers or supplies services under the sign;
 - imports or exports goods under the sign; or
 - uses the sign on business papers or in advertising.
- **A person who applies a registered trade mark to material intended to be used –**
 - for labelling or packaging goods or services;
 - as a business paper; or
 - for advertising goods or services,

shall be treated as a party to any use of the material which infringes the registered trade mark if when the person applied the mark the person knew or had reason to believe that the application of the trade mark was not duly authorized by the proprietor or a licensee of the registered trade mark.

- Nothing in this section shall be construed as preventing the use of a registered trade mark by any person for the purpose of identifying goods or services as those of the proprietor or a licensee, but any such use otherwise than in accordance with honest practices in industrial and commercial matters shall be treated as infringing the registered trade mark if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the registered trade mark.



Civil Remedies Under the Act

Section 47, 48 and 49 of the Act:

- An infringement of a registered trade mark is actionable by the proprietor or registered licensee of the trade mark.
- In an action for infringement all such relief by way of damages, injunctions, accounts or otherwise is available to the applicant as is available in respect of the infringement of any other property right.
- Where a person is found to have infringed a registered trade mark, the Court may make an order requiring the person -
 - to cause the offending sign to be erased, removed or obliterated from any infringing goods, material or articles in the person's possession, custody or control; or
 - where it is not reasonably practicable for the offending sign to be erased, removed or obliterated, to secure the destruction of the infringing goods, material or articles in question.
- The proprietor of a registered trade mark may apply to the Court for an order for the delivery up to the proprietor, or such other person as the Court may direct, of any infringing goods, material, or articles which a person has possession, custody or control of in the course of business.

Criminal Remedies Under the Act

Section 62 of the Act:

- A person who contravenes this section commits an offence and is liable-
 - On summary conviction to a fine of ten thousand dollars or to imprisonment for a term of three years or to both; or
 - On conviction on indictment to a fine of fifty thousand dollars or to imprisonment for a term of ten years, or to both.



Cayman Trade Mark Examples

HSM IP proudly works with many creative brands in the Cayman Islands, including:



WORLD IP DAY 2023

QUESTIONS?



WEDNESDAY, 26 APRIL