

CAYMAN ISLANDS



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**A BILL FOR A LAW TO REPEAL AND REPLACE THE PATENTS AND
TRADE MARKS LAW (2010 REVISION) TO PROVIDE FOR THE
MODERN REGULATION OF THE PRACTICE AT THE REGISTRY OF
PATENTS AND TRADE MARKS; AND TO PROVIDE FOR
INCIDENTAL AND CONNECTED PURPOSES**

THE PATENTS AND TRADE MARKS BILL, 2011

MEMORANDUM OF OBJECTS AND REASONS

This Bill seeks to repeal and replace the Patents and Trade Marks Law (2010 Revision) in order to provide for the modern regulation of the practice at the Registry of Patents and Trade Marks and to make provision for inactive patents and trade marks, registered agents and certificates of good standing.

Clause 1 contains the short title.

Clause 2 contains definitions.

Clause 3 provides for the continuation of the Registry of Patents and Trade Marks under the management of the Registrar.

Clause 4 provides for the Registry to continue to be managed by a Registrar of Patents and Trade Marks who is to be assisted by such other public officers as are necessary for the proper functioning of the Registry.

Clause 5 provides for the duties of the Registrar to include the management of the Registry and its staff; receipt of applications for recording patent and trade mark rights and the acceptance or rejection of such applications; collection of appropriate fees payable upon applications; recordings and searches; and maintaining a register of persons who may act as registered agents in the Islands.

Clause 6 provides that only a registered agent can transact business with the Registry so that an owner of a patent or trade mark recorded at the Registry is required to appoint a registered agent when next dealing with the Registry in relation to the patent or trade mark or upon payment of the next annual fee.

Clause 7 provides for the recording of an extension of a patent or trade mark right to the Islands.

Clause 8 provides for the mode of recording a right in or to a patent or trade mark.

Clause 9 provides for the effect of the recording of an extension to the Islands of a right in or to a patent to be such that the owner of such a right has the equivalent rights and remedies available to him in respect of the patent in the United Kingdom.

Clause 10 provides for the effect of the recording of an extension to the Islands of a right in or to a trade mark to be such that the owner of such a right has the protection and rights afforded to the owner by virtue of the Merchandise Marks Law (1997 Revision) and all equivalent rights and remedies available to such owner in respect of the patent in the United Kingdom.

Clause 11 makes provision for the protection and rights relating to patents and trade marks that are extended to the Islands to continue in force in the Islands so long as the protection and rights remain in force in the United Kingdom, however an action for infringement is not to be entertained in respect of any use of the right or protection prior to the time of recording the right in the patent or trade mark in the Islands. Clause 11 also makes provision for the issuing of a certificate of good standing by the Registrar where a request is made by a registered agent.

Clause 12 requires the owner of a patent or trade mark recorded in the Registry to pay an annual fee. A default in payment by 31st March causes the rights protected by the recorded entry to be in abeyance as against the person in default from the 1st April until the annual fee and penalty fee have been paid.

Clause 13 provides for the procedure for recording a change in the particulars of a grant or registration of a right recorded in the Registry where the modification or change occurs in the United Kingdom or the European Community or where there is a change of the registered agent.

Clause 14 provides for the procedure for renewal of a patent or trade mark recorded in the Registry if the rights have been renewed in the United Kingdom.

Clause 15 makes provision for the abandonment of a patent or trade mark and for re-activation of an abandoned patent or trade mark.

Clause 16 provides for the cancellation of a record where there is default in payment of the annual fees and penalties or resignation of the registered agent. The clause also provides for reapplication.

Clause 17 provides for publication in the Gazette of all recordings and cancellations of records made in the Registry (other than the recording of the expiry or abandonment of a patent or trade mark or the appointment of a registered agent in respect of any patent or trade mark).

Clause 18 provides for the Grand Court to have jurisdiction in all matters affecting the rights and remedies of the owner of a right in or to a patent or trade mark.

Clause 19 provides for searches by any member of the public in the Registry for particulars of any recording.

Clause 20 empowers the Governor in Cabinet to make regulations generally and, in particular, for prescribing forms and procedures for the conduct of business in the Registry.

Clause 21 repeals the Patents and Trade Marks Law (2010 Revision).

Clause 22 empowers the Governor in Cabinet to amend the Schedule.

Clause 23 makes provision for savings, transitional and consequential matters.

THE PATENTS AND TRADE MARKS BILL, 2011

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CAYMAN ISLANDS

**A BILL FOR A LAW TO REPEAL AND REPLACE THE PATENTS AND
TRADE MARKS LAW (2010 REVISION) TO PROVIDE FOR THE
MODERN REGULATION OF THE PRACTICE AT THE REGISTRY OF
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ENACTED by the Legislature of the Cayman Islands.

1. This Law may be cited as the Patents and Trade Marks Law, 2011.

Short title

2. (1) In this Law -

Interpretation

“Community trade mark” means a mark used in relation to goods or services which is registered as such in the United Kingdom in accordance with the conditions contained, and in the manner provided, in the Regulation (EC) No. 40/94 made by the Council of the European Union on 20th December, 1993;

“extension”, with respect to a patent or trade mark right held in the United Kingdom, means the extension of such right to the Cayman Islands;

“International trade mark” means a mark used in relation to goods or services which is registered as such in the United Kingdom in accordance with the conditions contained, and in the manner provided, under the provisions of the Madrid Protocol implemented in the United Kingdom;

“Madrid Protocol” means the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks of 14th April, 1891;

“owner”, with respect to a patent or trade mark right, includes a part owner and relates to ownership or proprietorship acquired directly or by assignment or otherwise and currently recognized in the United Kingdom;

“patent” means a current and effective grant in the United Kingdom of a monopoly in respect of an invention;

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“public officer” has the meaning assigned to that expression under section 124 of Schedule 2 to the Cayman Islands Constitution Order, 2009;

“recording” means the making of an entry in one or more of the registers maintained by the Registry;

“registered agent” means a person whose name is entered on the register of agents maintained by the Registrar pursuant to section 5(d);

“Registrar” means the Registrar of Patents and Trade Marks continued under section 4;

“Registry” means the combined Registry of Patents and Trade Marks continued under section 3;

(2010 Revision)

“repealed Law” means Patents and Trade Marks Law (2010 Revision);

“right” with respect to a patent or trade mark means a right currently held in the United Kingdom derived from a grant or registration thereof as the case may be according to the law there from time to time governing patents and trade marks; and

“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 which is currently registered as such in the United Kingdom and includes -

- (a) a Community trade mark; and
- (b) an International trade mark.

(2) For the purposes of this Law -

- (a) a patent granted under the Convention on the Grant of European Patents designating the United Kingdom, and which under the

law of the United Kingdom is treated as if it were a patent granted under such law; or

- (b) a patent granted under the Community Patent Convention,

shall be deemed to be a patent granted in the United Kingdom.

3. The combined Registry of Patents and Trade Marks shall continue in being, subject to this Law. Continuation of Registry

4. The Registry shall continue to be managed by the Registrar of Patents and Trade Marks who shall be public officer and who shall be assisted by such other public officers as may be necessary for the proper functioning of the Registry. Continuation of Registrar and staff

5. The duties of the Registrar include - Duties of Registrar

- (a) management of the Registry and its staff;
- (b) receipt of applications for recording patent and trade mark rights under this Law and the acceptance or rejection of such applications;
- (c) collection of appropriate fees payable upon applications, recordings and searches and accounting therefor to the general revenue of the Islands; and
- (d) maintenance of a register of persons who may act as registered agents in the Islands and who are recognised as such pursuant to section 6.

6. (1) Subject to section 19, only a registered agent may transact business with the Registry under this Law. Requirement for registered agent

(2) Subject to subsection (3), a person legally and ordinarily resident in the Islands desirous of being recognised as a registered agent shall apply in writing to the Registrar and the Registrar shall determine the application in accordance with the regulations made under section 20.

(3) An application under subsection (2) shall be accompanied by the processing fee specified in the Schedule. Schedule

(4) A registered agent shall pay the registered agent annual fee specified in the Schedule.

(5) The owner of a patent or trade mark recorded at the Registry as at the date of commencement of this Law, shall appoint a registered agent upon -

- (a) the next dealing with the Registry in relation to such patent or trade mark; or

(b) the payment of the next annual fee specified in section 12.

(2010 Revision) (6) For the purpose of this section, legal and ordinary residence shall be determined in accordance with the Immigration Law (2010 Revision).

Recording of patents and trade marks 7. The owner of a patent or trade mark right may by his duly authorised registered agent, on payment of the fees specified in the Schedule, apply to the Registrar to have such right extended to the Islands, and the Registrar on being satisfied that such application is in order shall record the extension of such right accordingly.

Mode of recording rights 8. The recording of an extension to the Islands of a right in or to either a patent or trade mark shall be effected by an entry in the records of the Registry showing such particulars as may be prescribed.

Effect of recording a patent 9. The effect of the recording of an extension to the Islands of a right in or to a patent is to afford in the Islands to the owner of the right so recorded all the equivalent rights and remedies available to him in respect of such patent in the United Kingdom.

Effect of recording a trade mark (1997 Revision) 10. The effect of the recording of an extension to the Islands of a right in or to a trade mark is to afford in the Islands to the owner of the right so recorded, the protection and rights afforded to an owner of a trade mark by virtue of the Merchandise Marks Law (1997 Revision) and all the equivalent rights and remedies available to such owner in respect of such trade mark in the United Kingdom.

Period of validity and certificate of good standing 11. (1) The protection and rights in the Islands conferred by sections 9 and 10 shall date from the time such right arose in the United Kingdom and continue in force so long as the protection and rights remain in force in the United Kingdom except that no action for infringement of such right shall be entertained in the Islands in respect of any use of such protection or right prior to the time of the recording thereof in the Islands.

(2) Subject to subsection (3), the Registrar may, where a request is made by a registered agent, issue a certificate of good standing to evidence that a patent or trade mark has been recorded on the register and that all applicable annual fees and penalties have been paid.

(3) A request under subsection (2) shall be accompanied by the fee specified in the Schedule.

Annual fee

12. (1) The owner of a patent or trade mark recorded in the Registry shall, by his duly authorised registered agent, in January of each year, after the year of the initial recording, pay to the revenues of the Islands the annual fee specified in the Schedule.

(2) A default in the payment of the annual fee specified in the Schedule by 31st March causes the rights protected by the recorded entry to be in abeyance as against the person in default from the relevant 1st April until the annual fee and penalty fee specified in the Schedule have been paid.

13. (1) If the particulars of the grant or registration of a right recorded in the Registry are modified or changed in the United Kingdom or the European Community or there is a change of the registered agent, the owner thereof by his duly authorised registered agent shall notify the Registrar with full particulars and tender the fee specified in the Schedule for recording of a change of particulars and the Registrar shall record particulars of such change in the records of the Registry. Changes

(2) Notwithstanding subsection (1), a default in notification of a modification or change in the United Kingdom or European Community particulars referred to in subsection (1) within two months shall, until such notification is made, have the effect of causing the rights protected by the recorded entry to be in abeyance as against the person in default in respect of the period of default, such period being deemed to be from the date the change was recorded in the United Kingdom or the European Community until the date of the notification thereof to the Registrar with tender of the fee specified in the Schedule.

14. (1) A patent or trade mark currently recorded in the Islands may on the application of the registered agent and payment of the fees specified in the Schedule, be renewed at any time if the rights have been renewed in the United Kingdom, all applicable annual fees and penalties have been paid and any change in the particulars since the initial recording of the extension have been recorded in the Islands. Renewal of patent or trade mark

(2) If an application for renewal is filed more than two months after the expiry date recorded in the Islands a penalty fee shall be payable as specified in the Schedule.

15. (1) The owner of a patent or trade mark recorded in the Registry shall, by his duly authorised registered agent, notify the Registrar that a patent or trade mark has been abandoned whereupon the rights protected by the recorded entry Abandonment of patent or trade mark

shall be held in abeyance and the Registrar shall record the patent or trade mark as inactive.

(2) The obligation to pay an annual fee pursuant to section 12 shall be suspended while the trade mark is inactive.

(3) A registered agent may apply to re-activate a patent or trade mark that has been abandoned under subsection (1) upon payment of the reactivation fee specified in the Schedule and the payment of the annual fees specified in the Schedule for the period the patent or trade mark was suspended.

Cancellation of record

16. (1) Default in the payment of the annual fees and penalties for more than twelve months renders the record of a patent or trade mark liable to cancellation by the Registrar.

(2) The resignation of a registered agent with respect to a patent or trade mark shall cause the record of such patent or trade mark to be cancelled unless the owner of such patent or trade mark appoints a new registered agent within sixty days of the Registrar being notified of the registered agent's resignation.

(3) The owner of a patent or trade mark whose record in the Islands has been cancelled under subsection (1) or (2) may reapply for recording again as though it were being recorded for the first time in accordance with section 9 or 10.

(4) No liability shall attach for any act performed or thing done by the Registrar under this section.

Publication in Gazette

17. All recordings and cancellations of recordings made in the Registry (other than the recording of the expiry or abandonment of a patent or trade mark or the appointment of a registered agent in respect of any patent or trade mark) shall be published in the Gazette and such publication shall be prima facie evidence of the recordings and cancellations.

Jurisdiction of Grand Court

18. The Grand Court shall have jurisdiction in all matters affecting the rights and remedies in the Islands of the owner of a right in or to a patent or trade mark conferred by sections 9 and 10.

Searches

19. On payment of the fees specified in the Schedule, any member of the public may cause the Registrar to make search in the Registry for particulars of any recording contained in the Registry and the Registrar shall cause such search to be made and shall supply the applicant with the particulars for which he has so applied.

20. The Governor in Cabinet may make regulations prescribing all matters that are required or permitted under this Law to be prescribed, or are necessary or convenient to be prescribed for giving effect to the purposes of this Law and, in particular, for prescribing forms and procedures for the conduct of business in the Registry. Regulations
21. The Patents and Trade Marks Law (2010 Revision) is repealed. Repeal of Patents and Trade Marks Law (2010 Revision)
22. The Governor in Cabinet may by Order amend the Schedule. Amendment of Schedule
23. (1) Every application for recording of a patent or trade mark under section 7 or other matter under the repealed Law that has not been wholly dealt with by the Registry when this Law comes into force shall be taken to be an application made under this Law, and this Law shall apply accordingly. Savings, transitional and consequential provisions
- (2) Except as otherwise expressly provided in this Law every civil matter and proceeding commenced in any court under the repealed Law and pending or in progress immediately before this Law comes into force may be continued, completed and enforced under this Law.
- (3) All proceedings in respect of offences committed against the repealed Law prior to the coming into force of this Law may be commenced or continued as if this Law had not come into force.
- (4) Where any period of time specified in the repealed Law is current at the coming into force of this Law, and there is a corresponding provision in this Law, this Law shall have the effect as if that corresponding provision had been in force when that period began to run.
- (5) Notwithstanding section 20, the Governor in Cabinet may make regulations to provide for such further savings, transitional and consequential provisions to have effect in connection with the coming into operation of any provision of this Law as are necessary or expedient.
- (6) Regulations made under subsection (5) may be given retrospective operation to a day not earlier than the day this Law comes into force.
- (7) Subsections (5) and (6) shall expire one year after they come into force.
- (8) Regulations made under this section shall be subject to negative resolution.

SCHEDULE

(Sections 6, 7, 11, 12, 13, 14, 15, 19 and 22)

FEES

| Item | Particulars | Fee |
|---------------------------|--|---|
| Part 1-Patents | | |
| 1. | Application fee for extension of patent rights to the Islands | \$200 |
| 2. | Annual fee for patent | \$200 |
| 3. | Late payment of patent annual fee (for each year of default) | \$100 |
| 4. | Application fee to record a change of particulars of a patent right recorded in the Registry including recording a change of registered agent. | \$150 |
| 5. | Application fee to record renewal of a patent right recorded in the Registry | \$200 |
| 6. | Penalty for late filing of a renewal | \$100 |
| 7. | Reactivation fee for an abandoned patent | \$150 |
| Part 2-Trade Marks | | |
| 1. | Application fee for extension of trade mark rights to the Islands | \$200 for one class registered; \$100 for each additional class registered |
| 2. | Annual fee for trade mark rights | \$200 for one class registered; \$100 for each additional class registered |
| 3. | Late payment of trade mark annual fee | \$100 (in aggregate, per trade |

| | | |
|----|---|---|
| | (for each year of default) | mark, irrespective of the number of classes registered) |
| 4. | Application fee to record a change of particulars of a trade mark right recorded in the Registry including recording a change of registered agent | \$150 |
| 5. | Application to record renewal of trade mark rights recorded in the Registry | \$200 |
| 6. | Penalty for late filing of a renewal | \$100 |
| 7. | Reactivation fee for an abandoned trade mark | \$150 |

Part 3-General

| | | |
|----|---|--|
| 1. | Search fee | \$50 |
| 2. | Non-refundable processing fee accompanying an application to be recognised by the Registrar as a registered agent | \$75 |
| 3. | Registered agent annual fee: number of registered patents and trade marks as at 31 st December | Under 10: \$200 10-99: \$500 100-249: \$1,000 250-499: \$1,500 500+: \$2,000 |
| 4. | Issue of a Certificate of Good Standing in relation to a patent or trade mark. | \$100 |

Passed by the Legislative Assembly the day of , 2011.

Speaker.

Clerk of the Legislative Assembly.