

# HARNEYS

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## Registration of Trade Marks In the British Virgin Islands

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### 1. Introduction

#### 1.1 Paris Convention Not Applicable

The British Virgin Islands is not a Convention country and protection of a trade mark in the British Virgin Islands depends exclusively on registration of that trade mark in the British Virgin Islands. This is so no matter how well-known the mark is.

There are two statutes in the British Virgin Islands under which trade marks may be registered. These are -

- **The Trade Marks Act (Cap 158)** - under which trade marks are registered generally; and
- **The Registration of United Kingdom Trade Marks Act (Cap 157)** - which provides for the registration in the British Virgin Islands of trade marks that are already registered in the United Kingdom.

### 2. Registration of Trade Marks under the Trade Marks Act

#### 2.1 General

As a general rule, a trade mark may not be registered under the Trade Marks Act if:

- (a) it is identical with a trade mark already on the register with respect to the same goods or description of goods; or
- (b) it is deceptive or calculated to deceive; or
- (c) it is of a scandalous design; or
- (d) it is descriptive of the goods to which it relates.

#### 2.2 Particulars of Trade Mark

A trade mark may consist of any of the following:-

- (a) a name of an individual or firm printed, impressed or woven in some particular or distinctive manner;
- (b) a written signature, or a copy of a written signature, of the individual or firm applying for registration thereof;
- (c) a distinctive device, mark, brand, heading, label or ticket;
- (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.

Service marks are not provided for in the legislation (but see paragraph 3 below for the method employed in accommodating these marks).

### **2.3 Applications for Registration of Trade Marks**

An application for registration of a trade mark must be made through a trade mark agent in the prescribed form and lodged with the Registrar of Trade Marks. The application must include the following:

- (a) a Statement of Application in the prescribed form;
- (b) a notarized Declaration (also in the prescribed form) which must accompany the Statement of Application;
- (c) a power of attorney or authorisation empowering the agent to act for the purpose of registration of the trade mark; and
- (d) the prescribed fee (currently US\$64.00, with a US\$2.00 charge for each additional class).

If a power of attorney has been given in favour of the agent, he may prepare the other two documents ((a)&(b)) provided that he has been furnished with a copy of the mark, a description of the goods and the name and address of the owner of the mark.

The classification of classes of mark are contained in the Act itself. The international classification of classes does not apply to the British Virgin Islands. A trade mark may be registered in more than one class.

### **2.4 Opposition**

After the application for registration of a trade mark has been lodged with the Registrar, a notice of the application is advertised in the Official Gazette. The purpose of the advertisement is to invite opposition to the application.

If, after a period of three months has elapsed from the date of publication of the advertisement, there is no opposition to the application, the mark is registered. Registration is valid for fourteen years and is renewable for further consecutive periods of fourteen years upon payment of the relevant fee.

### **3. Registration under the Registration of United Kingdom Trade Marks Act**

The Registration of United Kingdom Trade Marks Act was specifically enacted in the British Virgin Islands to accommodate the registration in the British Virgin Islands of trade marks that have been already registered in the United Kingdom. To register such a mark in the British Virgin Islands, the following must be submitted to the British Virgin Islands Registrar of Trade Marks:

- (a) a certified extract of the United Kingdom trade mark register showing the registration of the mark therein;
- (b) a power of attorney authorising the agent in the British Virgin Islands to register the mark; and
- (c) the prescribed fee (currently US\$15.00).

The British Virgin Islands Courts may construe the provisions of this Act as accommodating service marks that are registered in the United Kingdom, thus allowing service marks to be registered in the British Virgin Islands. The Act, therefore, provides the only method of registering service marks in the British Virgin Islands.

When a mark has been registered pursuant to the Act, the registration is valid for the remainder of the mark's original registration period in the United Kingdom. Renewals are dependant on the renewal of the mark in the United Kingdom, and payment of a renewal fee in the British Virgin Islands.

No decision has yet been taken as to whether this Act accommodates European Community marks but the consensus of opinion is that it does not.

**If you would like further information on trade marks in the British Virgin Islands or details of how Harney Westwood & Riegels can help you with your trade mark or patent enquiries, please contact [ip@harneys.com](mailto:ip@harneys.com) or your usual Harney Westwood & Riegels lawyer. Alternatively, you can visit our website at [www.harneys.com](http://www.harneys.com).**

*This Guide is general in scope and is not intended to be comprehensive. It is not a substitute for legal advice.*

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