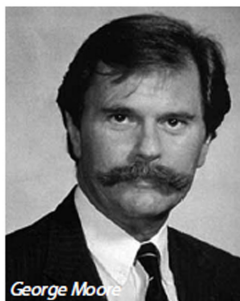


Dominica overhauls its trade mark law



George Moore

Ten years following its enactment, Dominica put into force on February 2, 2009 its Marks, Collective Marks and Trade Names Act 1999. A sweeping replacement of its previous trademark laws, which were repealed, the Act incorporates the 9th edition of the Nice Classification, provides for registration of service marks and permits multi-class applications. A lush eco-tourist destination sandwiched between Guadeloupe and Martinique in the eastern Caribbean, the "Commonwealth of Dominica" is an English common law jurisdiction, independent since 1978 – and not to be confused with the Dominican Republic, also located in the Caribbean, on the eastern half of Hispaniola. **George Moore** reports...

Decades Long Connection with UK System Severed

Administered by the Registrar of Companies and Intellectual Property, the Act severs, following transition, the island's decades long connection with the UK trademark regime and immediately dispenses with the old British Classification system of 1938 which covered local registrations in Dominica and made no provision for service marks. Instead, Paris Convention priority and well-known, service and collective marks have all made their debut.

Simplified Filing Requirements

Electronic and fax filing is now permitted provided the original documentation is filed within one month, and dispensed with are the archaic Statement A and Declaration forms which both required the signature of all applicants. Now, an applicant need sign only an authorisation form, before a witness who then signs before a notary, with no requirement for legalisation.

Retention of Common Law Doctrines

Retained, on the other hand, are official examination for absolute and relative grounds of refusal, the common law doctrine of passing off, and "honest concurrent user" – as well as the British Commonwealth practice of according legal priority to the first user rather than the first to file.

Use and Non-use

Prior use, however, is not required; an applicant need only declare an intent to use. Removal from the register for non-use can be sought by an interested third party, but only after three years of continuous non-use following registration – which may be forgiven in special circumstances and upon a showing that there was no intent to abandon or not to use the mark.

UK Marks During Transition

Dominica's newly independent trademark system protects its existing UK-based and local registrations for the full remainder of their terms (14 years for local registrations) and, during the one year transition period which ends February 11, 2010, any applicant or owner of a UK registration may file an application to register the same mark in Dominica and thereby obtain the same filing/registration date in Dominica as for the UK mark.

Opposition and Extensions of Time

The period of opposition is two months following publication which, along with other deadlines, can be extended within the discretion of the Registrar for good cause, even after expiration, but an application for extension must be filed no later than two months after expiration.

Renewals and Late Renewals

The term of new registrations is ten

years, with renewals for like periods. Renewal of local registrations will involve re-classification from the old British to the International Classification system.

Late renewal may be sought within the grace period of six months for an additional fee and, curiously, another provision allows a further month for payment of the renewal fees – with there being yet an additional avenue for late comers: restoration, which may be sought within 12 months of a mark's removal from the register. However, restoration is discretionary and requires a further fee.

Assignments and Licenses - Mandatory Recording

Recordal of assignments and licenses is not only permitted but required, failing which they are ineffective as to third parties. An assignment need not convey goodwill but a license must include quality control. A security interest may also be recorded.

Infringement, Remedies and Customs

Infringement of registered marks constitutes an offence and carries stiff penalties – fines up to EC\$40,000 and imprisonment up to 12 years or both, as well as seizure, forfeiture or destruction of infringing goods. Civil remedies, injunctions and damages, are also available.

On January 26, 2009, Dominica's Customs and Excise Division official launched the Automated System for

Customs Data (ASYCUDA) project and opened its new project office, which will facilitate discovery of restricted and prohibited imports.

Lingering Nuisances: Forms, Formalities and Paper Requirements

Still nettlesome for trademark applicants in Dominica, however, general powers of attorney are not permitted by the registry and every application requires a separate, signed authorisation form that identifies each mark's respective class(es) and goods and/or services. Another nuisance, this one contained within the new regulations and running counter to the "green revolution," – but now eliminated – was that all documents presented to the registry must be on only "strong" A4 size paper, a requirement that the Registrar agreed on March 2, 2009 to waive – since many trademark proprietors have no A4 heavyweight deed paper and airmailing such stock to and from points around the world would have proven to be needlessly inconvenient and costly.

Potential for Relief

A schedule to the Regulations contains numerous forms but curiously omits an authorisation of agent form and perhaps the registry might be persuaded also to relent from its office policy of refusing to accept general powers of attorney – which are accepted in the great majority of other Commonwealth Caribbean jurisdictions.

Finally, it remains to be seen if the registry will still insist, during the one year transition, that UK-based applications be accompanied not by a normal certified copy of the corresponding UK Certificate of Registration but, instead, by a certified copy that bears a "raised seal" – something the UK IPO ceased providing years ago except to meet what it has described as the unfounded demand of the Dominica registry, maintained in violation of the Hague Convention on documents. Relatively soon, however, with the end of transition, this old nuisance will at last be relegated to history.

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