

## Comprehensive New Trademark Act Adopted in Grenada

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Grenada has at last enacted a new trademark statute, the Trademarks Act, 2012, thereby becoming the last of 11 British Commonwealth nations in the Caribbean to adopt a comprehensive new trademark system to accommodate and deal with the world's burgeoning trademark business.

Enacted on January 13, 2012, the new Act went into operation on August 1, 2012, when the Corporate Affairs and Intellectual Property Office (CAIPO) commenced receiving applications under the Act.

An English common law jurisdiction, Grenada is identical to other common law nations in that it accords priority to the first to use over the first to file.

Cast off by the new Act is Grenada's years-long exclusive reliance upon UK-registered marks, previously the only path to registration of a trademark in Grenada, as without a preexisting UK registration no one could apply to register any mark in Grenada.

Meteoric is the more than twenty-fold increase in official fees, now among the highest in the Caribbean. A word mark now costs US \$248 to register in one class—and as many as seven questions need to be addressed to determine the applicable official fees for some applications.

Unique in the Commonwealth Caribbean, the Grenada statute provides for expedited examination, per Section 19, which sets a fee of \$19 for "expedited examination." Add to that the availability of electronic filing combined with a one-month opposition period and expedient examination, Grenada may prove to be enticing for innovative trademarks in search of a fast track to registration, irrespective of cost.

Documents filed electronically need to be supplemented by submission of the originals at the registry within one month, while the certified copy for any priority-based application needs to be submitted within two months.

Apart from the need to answer as many as seven different questions to determine the applicable official fees for a particular application, the formalities of preparing and processing an application in Grenada are few and simple—the appointment of an agent, for example, does not require any witnessing, notarization or legalization, and the appointment form can be filed up to two months after the initial date of filing—which is also unique within the 17 Commonwealth Caribbean jurisdictions.

Paris Convention priority is now in place, and well-known marks are recognized. The full range of goods and services can now be registered in accord with the latest version of the Nice International Classification system. However, Grenada is not a party to the Madrid Protocol.

All new registrations extend for a period of ten years and are renewable for like periods of ten years. All current registrations will run for the full remainder of their existing terms and thereafter be renewed for periods of ten years, with reclassification of goods and services at the time of renewal if appropriate.

All applications that were filed and remained pending under the repealed Act are being treated as applications under the new Act.

The new Act also provides for registration of collective marks as well as distinctive shapes of products and packaging. All applications are subject to absolute and relative grounds of refusal.

As indicated, the opposition period is one month from the date of publication, and it is possible to apply for an extension for the filing of a notice of opposition. All extensions can be applied for after the deadline, but at higher cost and risk, as approval lies within the discretion of the registrar.

Licenses of trademarks must be submitted to the registry, which will keep their contents confidential while noting the licenses' existence on the register. Effective quality control must be provided, absent which the license may be deemed void.

Prior use in Grenada is not necessary. Failure to use a registered mark within three years following the date the mark was actually registered in Grenada may render the mark vulnerable to a revocation action by a third party, but removal might be avoided if special circumstances prevented its use and there was no intention not to use the mark.

Late renewals may be applied for within six months of the date of expiration, with an increase in the official fee for a late filing, as well as additional charges per month per class for each month late.

Another relic of the past, now, is publication of marks under the Merchandise Marks Act of 1899, under which a number of proprietors published their marks locally in Grenada. Thus, there will be no more private publication fees but, instead, official publication fees, which appear rather complex and are by no means inexpensive, ranging from \$75 to \$93 for the first class.

In an amendment to the new Act, both the Merchandise Marks Act 1899 and the Registration of United Kingdom Trade Marks Act, which dates from 1939, are repealed.

The new Act confirms that nothing in it shall affect the common law right of action for passing off or related remedies.

Consistent with the TRIPS Agreement, the new Act provides that the proprietor or licensee of a registered mark may give notice to customs in Grenada to restrict importation of infringing goods, and the court may order the forfeiture and destruction of infringing goods. Strong penalties are provided for various offenses under the Act.

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