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GRENADA

ACT NO. 1 OF 2012**I assent,**

CARLYLE ARNOLD GLEAN
Governor-General.

5th January, 2012.

An Act to make new provision for registration of
 trademarks in Grenada.

[13th January, 2012].

BE IT ENACTED by the Queen's Most Excellent Majesty,
 by and with the advice and consent of the Senate and House
 of Representatives, and by the authority of the same as
 follows—

PART 1

PRELIMINARY PROVISIONS

Short title.

1. This Act may be cited as the

TRADEMARKS ACT, 2012.

Interpretation.

2.—(1) In this Act—

“attorney-at-law” means an Attorney-at-law admitted to
 practice before the Eastern Caribbean Supreme
 Court in Grenada;

“business” includes a trade or profession;

“CAIPO” means, the Corporate Affairs and Intellectual Property Office established, pursuant to the Corporate Affairs and Intellectual Property Office Act No. 19 of 2009;

“certification mark” means a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the trademark in respect of origin, material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics;

“collective mark” means, a mark distinguishing the goods or services of members of the association which is the proprietor of the trademark from those of other undertakings;

“court” means the High Court;

“domain name” means, any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet;

“infringing articles”, in relation to a registered trademark means, articles—

- (a) which are specifically designed or adapted for making copies of a sign identical or similar to that trademark; and
- (b) which a person has in his possession, custody or control, knowing or having reason to believe, that they have been, or

are to be used to produce infringing goods or infringing material;

“infringing goods”, in relation to a registered trademark means, goods which bear, or the packaging of which bears, a sign identical or similar to that trademark and—

- (a) the application of the sign to the goods or their packaging, was an infringement of the registered trademark;
- (b) the goods are proposed to be imported into Grenada, and the application of the sign in Grenada to them or their packaging, would be an infringement of the registered trademark; or
- (c) the sign has otherwise been used in relation to the goods in such a way, as to infringe the registered trademark;

“infringing material”, in relation to a registered trademark means, material which bears a sign identical or similar to that trademark and either—

- (a) it is used for labelling or packaging goods, as a business paper, or for advertising goods or services, in such a way, as to infringe the registered trademark; or
- (b) it is intended to be so used, and such use would infringe the registered trademark;

“International Convention” means, the Paris Convention and any other Treaty relating to Trademarks, collective marks and certification marks to which Grenada may become a party;

“Internet” means the worldwide system of computer networks;

“Minister” means the Minister to whom responsibility for intellectual property has been assigned;

“Paris Convention” means, the Paris Convention for the Protection of Industrial Property signed in Paris on the 20th day of March, 1883 as amended from time to time;

“publish” includes publication on the Internet;

“prescribe” means prescribe under 41(1)(a);

“register” means enter in the Register;

“Register” means the Register of Trademarks maintained pursuant to section 4;

“registered proprietor” means, any person for the time being entered in the Register as a proprietor of the trademark;

“registered trademark” means a trademark that is currently entered in the Register;

“Registrar” means the Registrar of Trademarks appointed pursuant to section 3, and “his seal”, in relation to the Registrar, means a seal prepared under that section;

“regulations” means regulations made under section 41;

“trademark” means—

- (a) any sign capable of being represented graphically, which is capable of distinguishing goods or services of one undertaking from those of other undertakings;
- (b) a collective mark; or
- (c) a certification mark,

and may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging;

“trade name” means the name or designation identifying and distinguishing an enterprise;

(2) References in this Act to use (or to any particular description of use) of a trademark, or of a sign identical with, similar to, or likely to be mistaken for a trademark, include use (or that description of use) otherwise than by means of a graphic representation.

PART 2

REGISTERED TRADEMARKS

Registrar and
other officers.

3.—(1) The Registrar at the Office of Corporate Affairs and Intellectual Property shall be the Registrar of Trademarks.

(2) The Registrar may direct a seal or seals to be prepared for the authentication of documents required for, or in connection with the registration of trademarks.

(3) Any functions of the Registrar under this Act may be performed by the Deputy Registrar, and, to the extent authorised by the Registrar, be exercised by a senior officer on his staff.

Register of
Trademarks.

4.—(1) There shall be maintained at the Office of Corporate Affairs and Intellectual Property, a Register of Trademarks in which there shall be entered—

- (a) all trademarks together with the names and addresses of their proprietors;
- (b) particulars of assignments and transmissions of registered trademarks;
- (c) the names and addresses of all registered licensees; and
- (d) such other matters relating to trademarks as may be prescribed, or as the Registrar may think fit.

(2) Save as may otherwise be prescribed, the Register shall, at all convenient times, be open to inspection by the public, and certified copies of any entry in the Register shall be given to any person requiring them on payment of the prescribed fee.

(3) The Register shall be *prima facie* evidence of any matters required, or authorised by, or under this Act to be entered therein.

(4) The Registrar shall publish in the *Gazette*, or in an intellectual property journal or publication published under the authority of the Registrar, or in both, all the publications provided for in this Act.

(5) No notice of any trust, whether express, implied or constructive, shall be entered in the Register and the Registrar shall not be affected by any such notice.

Acquisition of the exclusive right to a trademark..

5. The exclusive right to a trademark, as conferred by this Act, shall be acquired by registration in accordance with the provisions thereof.

Registrability.

6. A trademark shall not be validly registered if it is—

- (a) incapable of distinguishing the goods or services of one enterprise from those of other enterprises;
- (b) contrary to public order or morality;
- (c) likely to mislead the public or trade circles, in particular as regards the geographical origin of the goods or services concerned, or their nature or characteristics;
- (d) identical with, or is an imitation of, or contains as an element, an armorial bearing, flag or other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organisation or organisation created by an international convention, unless authorised by the competent authority of that State or organisation;

- (e) identical with, or confusingly similar to, or constitutes a translation of, a trademark or trade name which is well known in Grenada for identical or similar goods or services of another enterprise;
- (f) well known and registered in Grenada for goods or services which are not identical or similar to those in respect of which registration is applied for if, in the latter case, use of the trademark in relation to those goods or services would indicate a connection between those goods or services and the owner of the well-known trademark, and that the interests of the owner of the well-known trademark are likely to be damaged by such use; or
- (g) identical with a trademark belonging to a different proprietor and already on the Register, or with an earlier filing or priority date, in respect of the same goods or services or closely related goods or services, or if it so nearly resembles such a trademark as to be likely to deceive or cause confusion.

Application for
registration.

7.—(1) Every application for registration of a trademark shall be filed with the Registrar and shall be subject to the payment of the prescribed fee.

(2) Every application shall contain a—

- (a) request for such registration;
- (b) reproduction of the trademark requested;
and

- (c) list of the goods or services for which registration of the trademark is requested, listed under the applicable class or classes of the International Classification.

(3) In the case of an application for registration of a collective mark or certification mark, the Registrar shall designate the mark as a collective mark or certification mark, and the application shall be accompanied by a copy of the regulations governing the use of the collective mark.

Priority.

8.—(1) An application for registration of a trademark may contain a declaration claiming the priority, as provided for in the Paris Convention, of an earlier national or regional application filed by the applicant or his predecessor in title.

(2) Where an application contains a declaration under this section, the Registrar may require that the applicant furnish, within the prescribed time, a copy of the earlier application certified as correct by the registry with which it was filed.

(3) The effect of the declaration shall be as provided in the Paris Convention.

(4) Where the Registrar finds that the requirements under this section and the regulations have not been fulfilled, the declaration shall be considered to have not been made.

Withdrawal and
cancellation.

9.—(1) An applicant for the registration of a trademark may withdraw the application at any time during its pendency.

(2) A proprietor may apply to the Registrar to have his trademark cancelled upon payment of the prescribed fee.

Examination.

10.—(1) The Registrar shall—

- (a) examine whether the application complies with the requirements of section 7 and the regulations pertaining thereto; and
- (b) examine and determine whether the mark is a trademark and is registrable under section 6.

(2) Where the Registrar finds that the requirements referred to in subsection (1) are fulfilled, he shall forthwith cause the application, as accepted, to be published in the prescribed manner.

Opposition.

11.—(1) Any person may, within the prescribed period and in the prescribed manner, give notice to the Registrar of any opposition to the registration of a trademark, on the grounds that one or more of the requirements of the definitions of a trademark, or where the grounds listed under section 5 and the regulations are not fulfilled.

(2) The Registrar shall send forthwith a copy of the notice to the applicant, and, within the prescribed period and in the prescribed manner, the applicant shall send to the Registrar, a counter-statement of the grounds on which he relies for his application; if he does not do so, he shall be deemed to have abandoned the application.

(3) If the applicant sends a counter-statement, the Registrar shall furnish a copy thereof to the person giving notice of opposition and, after hearing the parties, if either or both wish to be heard, shall decide whether the trademark should be registered.

Rights before
registration.

12. After an application for the registration of a trademark is published, and until the registration of the trademark is complete, the applicant has the same privileges and rights as he would have if the trademark had been registered; however, it shall be a valid defence to an action brought hereunder, in respect of an act done after the application was published, if the defendant establishes that the trademark could not validly have been registered at the time the act was done.

Registration of
trademark.

13. Where the Registrar finds that the conditions referred to in section 10 are fulfilled, and either—

- (a) the registration of the trademark has not been opposed within the prescribed time limit; or
- (b) the registration of the trademark has been opposed, and the opposition has been decided in the applicant's favour;

he shall register the trademark, publish a reference to the registration, and issue to the applicant a certificate of registration. Otherwise, he shall refuse the application.

Rights conferred
by registration.

14.—(1) The use of a registered trademark, in relation to any goods or services for which it has been registered, by any person other than the registered owner, shall require the agreement of the registered owner.

(2) A registered owner of a trademark shall, in addition to any other rights, remedies or actions available to him under this Act, have the right to institute Court proceedings against any person who infringes the trademark by—

- (a) using the trademark without the consent of the registered owner; or

- (b) performing acts involving the trademark which make it likely that infringement will occur.

(3) The right referred to in sub-section (2), shall extend to the use of a sign similar to the registered trademark, and such use in relation to goods and services similar to those for which the trademark has been registered, where such similarity is likely to cause confusion on the part of the public.

(4) The rights conferred by registration of a trademark, shall not extend to acts in respect to articles which have been put on the market in Grenada by the registered owner of the trademark, or articles which have been put on the market with his consent.

Duration and
renewal.

15.—(1) The registration of a trademark shall be for a period of 10 years from the filing date of the application for registration.

(2) The registration of a trademark may, upon request, be renewed for consecutive periods of 10 years, if the registered owner pays the prescribed renewal fee.

(3) A grace period of 6 months shall be allowed for the late payment of the renewal fee on payment of the prescribed surcharge.

Invalidation.

16.—(1) Any person may request the Registrar to invalidate the registration of a trademark.

(2) The Registrar shall invalidate the registration, if the person requesting the invalidation proves that the mark is not a validly registered trademark.

(3) In addition to the grounds provided in subsection (2), the Registrar shall invalidate the registration of a collective mark, if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in section 7(2)(b), or that he uses or permits its use in a manner liable to deceive trade circles or the public, as to the origin or any other common characteristics of the goods or services concerned.

(4) Any invalidation of a registration of a trademark shall be deemed to have been effective as of the date of registration, and the Registrar shall record and publish a reference thereto as soon as possible pursuant to section 4(4).

Removal on
grounds of non-
use.

17. Any interested person may request the Registrar to remove a trademark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the trademark had, after its registration, not been used by the registered owner or a licensee during a continuous period of 3 years or longer, but a trademark shall not be removed if it is shown that special circumstances prevented the use of the trademark, and that there was no intention not to use or to abandon the same in respect of those goods or services.

Collective
marks.

18.—(1) Subject to subsections (2) and (3), sections 5 to 16 shall apply to collective marks.

(2) An application for registration of a collective mark shall designate the mark as a collective mark, and shall be accompanied by a copy of the regulations governing the use of the collective mark.

(3) The registered owner of a collective mark shall notify the Registrar of any changes made in respect of the regulations referred to in subsection (2).

(4) In addition to the grounds provided in section 16(2), the Registrar shall invalidate the registration of a collective mark, if the person requesting the invalidation proves that only the registered owner uses the mark, or that he uses or permits its use in contravention of the regulations referred to in subsection (2), or that he permits its use in a manner liable to deceive trade circles or the public as to the origin or any other common characteristics of the goods or services concerned.

Licensing of trademarks.

19.—(1) Any licence contract concerning the registration of a trademark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee, in connection with which the trademark is used. If the licence contract does not provide for such quality control or, if such quality control is not effectively carried out, the licence contract shall not be valid.

(2) The registration of a collective mark, or an application therefor, may not be the subject of a licence contract.

Trade names.

20.—(1) A name or designation shall not be used as a trade name, if by its nature or the use to which it is put, it is contrary to public order or morality and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

(2) Notwithstanding any Act or regulation providing for any obligation to register trade names, such names shall be

protected, even prior to or without registration, against any unlawful act committed by third parties. In particular, any subsequent use of the trade name by a third party, whether as a trade name or a trademark or collective mark, or any such use of a similar trade name or trademark, likely to mislead the public, shall be deemed unlawful.

Changes in ownership.

21.—(1) Any change in the ownership of the registration of a trademark, or in the ownership of an application therefor, shall be in writing and shall, at the request of any interested party made to the Registrar, be recorded and, except in the case of an application, published by the Registrar. Such change shall have no effect against third parties until such recording is effected.

(2) Any change in the ownership of the registration of a collective mark, or in the ownership of an application therefor, shall require previous approval by the Minister.

(3) Any change in the ownership of a trade name must be made with the transfer of the enterprise or part thereof identified by that name, and shall be in writing.

(4) A change in ownership of the registration of a trademark shall, however, be invalid, if it is likely to deceive or cause confusion, particularly in regard to the nature, origin, manufacturing process, characteristics, or suitability for their purpose, of the goods or services in relation to which the trademark is intended to be used or is being used.

(5) Any licence contract concerning a registered trademark, or an application therefor, shall be submitted to the Registrar who shall keep its contents confidential, but shall record it and publish a reference thereto. The licence contract shall have no effect against third parties until such recording is effected.

Agents.

22. Where an applicant's ordinary residence or principal place of business is outside Grenada, he shall be represented by an agent or an attorney-at-Law.

Correction of errors and extension of time.

23.—(1) The Registrar may, subject to any provision in the regulations, correct any error of translation or transcription, clerical error or mistake, in any application or document filed with the Registrar, or in any recording effected pursuant to this Act or the regulations.

(2) If the Registrar is satisfied that the circumstances justify it, he may, upon receiving a written request, extend the time for doing any act or taking any proceeding under this Act and the regulations, upon notice to the parties concerned, and upon such terms as he may direct. The extension may be granted, though the time for doing the act or taking the proceeding has expired.

Exercise of discretionary power.

24. The Registrar shall give any party to a proceeding before him, an opportunity of being heard, before exercising adversely to that party, any discretionary power vested in him by this Act or the regulations.

Competence of Court and appeals.

25.—(1) The Court shall have jurisdiction in cases of dispute relating to the application of this Act and the regulations, and in matters which, under this Act and the regulations are to be referred to the Court.

(2) Any decision taken by the Registrar under this Act, in particular the registration of a trademark, or the refusal of an application for such registration, may be the subject of an appeal by any interested party to the Court, and such appeal shall be filed within 2 months of the date of the decision.

PART 3**ADMINISTRATION AND OTHER SUPPLEMENTARY PROVISIONS**

Restrictions on recovery of damages for infringement of a registered trademark.

26.—(1) Damages shall not be awarded in proceedings for the infringement of a registered trademark against a defendant who proves, that at the date of the infringement he was not aware, and had no reasonable ground for supposing, that the trademark was registered.

(2) A person shall not be deemed to have been aware or to have had reasonable grounds for supposing that the trademark was registered, by reason only of the application of the word “Registered”, or any other word or words referring expressly or impliedly to registration, unless the words “in Grenada” followed the word “Registered”, or the words “Registered in Grenada” accompanied that other word or those other words.

(3) Nothing in this section shall affect the power of the Court to grant an injunction in any proceedings for infringement of a registered trademark.

Infringement and offences.

27.—(1) Subject to the provisions of section 14(3), the performance of any of the acts referred to in section 14, in Grenada, by a person, other than the owner of the title of the trademark and without the agreement of the latter, shall constitute an infringement.

(2) On the request of the owner of the title of the trademark, or of a licensee, if he has requested the owner to institute court proceedings for specific relief, and the owner has refused or failed to do so, the Court may grant an injunction to prevent infringement, an imminent infringement or an unlawful act referred to in section 20(2), and may award

damages and grant any other remedy provided for in the general law.

(3) Any person who knowingly performs an act which constitutes an infringement as defined in subsection(1), or an unlawful act as defined in section 20, commits an offence, and is liable to a fine of \$10,000 or to imprisonment for a term not exceeding five years, or to both.

Remedy for
groundless
threats of in-
fringement pro-
ceedings.

28.—(1) Where a person threatens another with proceedings for infringement of a registered trademark other than—

- (a) the application of that trademark to goods or their packaging;
- (b) the importation of goods to which, or to the packaging to which the trademark has been applied; or
- (c) the supply of services under the trademark,

any person aggrieved by such a threat, may bring proceedings in the Court for relief under this section.

(2) The relief available under this section to such an aggrieved person shall consist of—

- (a) a declaration that the threats are unjustifiable;
- (b) an injunction against the continuance of the threats; and
- (c) damages in respect of any loss sustained due to the threats.

(3) The claimant shall be entitled to such relief unless—

- (a) the defendant shows that the acts in respect of which proceedings were threatened constitute, or, if done, would constitute, an infringement of the trademark concerned; and
- (b) the claimant is unable to show that the registration of the trademark is invalid or liable to be revoked in a relevant respect.

(4) The mere notification that a trademark is registered, or that an application for registration has been made, does not constitute a threat of proceedings for the purposes of this section.

Privilege for communications with trademark agents or professional representatives.

29.—(1) Any communication under this Act between a person and a person he has instructed as an agent, shall be privileged from disclosure, in the same way as any communication between a person and his Attorney-at-Law.

(2) Any communication for the purpose of obtaining, or in response to a request for information which a person is seeking for the purpose of instructing a person described in subsection (1), in relation to the protection of any trademark or any matter involving passing off, shall be privileged from disclosure, in the same way as a communication for the purpose of obtaining, or in response to a request for, information which a person is seeking for the purpose of instructing his attorney-at-law.

Use of trademark for export trade.

30. The application in Grenada of a trademark to goods or services to be exported from Grenada, and any other act done in Grenada in relation to goods or services to be so

exported which, if done in relation to goods or services to be sold or otherwise traded in within Grenada, would constitute use of a trademark therein, shall be deemed to constitute use of the trademark in relation to those goods or services for any purpose for which such use is material under this Act or under the customary law.

Infringing goods may be treated as prohibited goods.

31.—(1) The proprietor or licensee of a registered trademark may give notice, in writing, to the Comptroller of Customs—

- (a) that he is the proprietor or a licensee of that trademark, as the case may be;
- (b) that, at a time and place specified in the notice, goods which are, in relation to the trademark, infringing goods, being counterfeit and pirated goods, are expected to arrive in Grenada; and
- (c) that he requests the Comptroller of Customs to treat them as prohibited goods.

(2) Where a notice is in force under this section, any goods to which the notice relates which are imported otherwise than by a person for his private and domestic use, shall be treated as prohibited.

Orders concerning the importation of infringing goods.

32. The notice referred to in section 31 shall be—

- (a) in the prescribed form and subject to any prescribed conditions;
- (b) accompanied by security in the form and amount;
- (c) an indemnity in the form required by the Registrar; and

- (d) be accompanied by the prescribed fee.

Power of
Comptroller of
Customs to
disclose
information.

33. Where information relating to infringing goods has been obtained by the Comptroller of Customs for the purposes of, or in connection with, the exercise of his functions in relation to imported goods, he may authorise the disclosure of that information for the purpose of facilitating the exercise, by any person, of any function, in connection with the investigation or prosecution of an offence under section 35, or any enactment relating to trade descriptions.

Falsification
of
Register.

34. A person who makes or causes to be made—

- (i) a false entry in the Register;
- (ii) anything falsely purporting to be a copy of an entry in that Register; or
- (iii) produces, or tenders or causes to be produced or tendered in evidence, any such thing,

knowingly, or having reason to believe the entry or thing to be false, commits an offence, and is liable to imprisonment for a term not exceeding five years or to a fine not exceeding \$10,000, or to both.

False repre-
sentations in
respect of
trademarks.

35.—(1) A person who—

- (a) falsely represents that a trademark is a registered trademark; or
- (b) makes a false representation as to the goods or services for which such a trademark is registered,

knowingly, or having reason to believe the representation to be false, commits an offence, and is liable to pay a fine of \$8,000.

(2) For the purposes of this section, the use in Grenada, in relation to a trademark of the words “Registered in Grenada”, or of any other word or symbol referring, whether expressly or impliedly, to registration, shall be deemed to import a reference to registration in the Register.

Forfeiture.

36.—(1) Where, in connection with the investigation or prosecution of a relevant offence—

- (a) goods which, or the packaging of which, bears a sign identical to or likely to be mistaken for a registered trademark ;
- (b) material bearing such a sign and intended to be used for labelling or packaging goods, as a business paper in relation to goods, or for advertising goods; or
- (c) articles specifically designed or adapted for making copies of such a sign,

have come into the possession of any person, he may apply to the Court for an order for the forfeiture of the goods, material or articles, and where the Court is satisfied that such an offence has been committed, it shall make such an order.

(2) For the purposes of this section, the Court may infer that a relevant offence has been committed in relation to any goods, material or articles, if it is satisfied that such an offence has been committed in relation to goods, material or

articles which are representative of them, whether by reason of being of the same design or part of the same consignment or batch, or otherwise.

(3) Where any goods, material or articles are forfeited under this section, the Court shall—

- (a) direct that they be destroyed in accordance with such directions as it may give; or
- (b) if it considers it appropriate to do so, direct that they shall be released to such person it may specify, on condition that that person—
 - (i) causes the offending sign to be erased, removed or obliterated, and
 - (ii) complies with any order to pay costs which has been made against him in the proceedings for the order for forfeiture.

(4) In this section, “relevant offence” means—

- (a) an offence under section 27;
- (b) an offence under any enactment relating to trades descriptions; or
- (c) any offence involving dishonesty or deception.

Cyberpiracy
prevention.

37.—(1) A person shall be liable in a civil action by the owner of a trademark, without regard to the goods or services of the parties, if that person—

- (a) intends to profit from that trademark in bad faith; and
- (b) registers, traffics in, or uses a domain name that, in the case of a—
 - (i) trademark that is distinctive at the time of registration of the domain name, is identical to or confusingly similar to such trademark; or
 - (ii) famous trademark that is famous at the time of registration of the domain name, is identical or confusingly similar to, or dilutive of, that trademark.

(2) In determining whether a person has an intent described under sub-section (1)(a), the Court may consider in particular the following factors—

- (a) the trademark or other intellectual property rights of the person, if any, in the domain name;
- (b) the extent to which the domain name consists of the legal name of the person, or a name that is otherwise commonly used to identify that person;
- (c) the person's prior use, if any, of the domain name in connection with the *bona fide* offering of any goods or services;
- (d) the person's *bona fide* non-commercial or fair use of the trademark in a site accessible under the domain name;

- (e) the person's intent to divert consumers from the trademark owner's online location, to a site accessible under the domain name that could harm the goodwill represented by the trademark, either for commercial gain, or with the intent to tarnish or disparage the trademark, by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the site;
- (f) the person's offer to transfer, sell, or otherwise assign the domain name to the trademark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the *bona fide* offering of any goods or services;
- (g) the person's provision of material and misleading false contact information when applying for the registration of the domain name; and
- (h) the person's registration or acquisition of multiple domain names, which are identical or confusingly similar to trademarks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of such persons.

(3) In any civil action involving the registration, trafficking, or use of a domain name under this section, the Court may order the forfeiture or cancellation of the domain

name, or the transfer of the domain name to the owner of the trademark.

(4) The use of a domain name under subsection (1) shall be limited to a use of a domain name by the domain name registrant or the domain name registrant's authorised licensee.

(5) The use of the domain name Registrar or registry or other domain name of such an authority under this Act, shall not be liable for injunctive or monetary relief under this section, except in cases where they are used in bad faith or reckless disregard, which includes a wilful failure to comply with a Court order referred to in subsection (3).

(6) The civil action established under subsection (1), shall be in addition to any other civil action or remedy otherwise applicable.

PART 4

MISCELLANEOUS

Offences by
partnerships and
bodies corporate.

38.—(1) Proceedings for an offence under this Act alleged to have been committed by a partnership, shall be brought against the partnership in the name of the firm and not that of the partners, but without prejudice to any liability of the partners under subsection (3).

(2) A fine imposed on a partnership on its conviction in proceedings for an offence under this Act, shall be paid out of the assets of the partnership.

(3) Where a partnership commits an offence under this Act, every partner, other than a partner who is proved to have been unaware of or to have attempted to prevent the

commission of the offence, commits the offence and is liable to be proceeded against and punished accordingly.

(4) Where an offence under this Act committed by a body corporate is proved to have been committed with the consent or connivance of a director, manager, secretary or other similar officer of the body corporate, or any person purporting to act in any such capacity, he (as well as the body corporate) commits an offence, and is liable to be proceeded against and punished accordingly.

39. A person who aids, abets, counsels or procures the commission of an offence under this Act, shall be liable to be dealt with, tried and punished as a principal offender. Accessories and abettors.

40. The Minister may, by order, provide for reciprocal treatment in relation to the trademarks, to be given to any country that provides similar protection for the protection of trademarks registered in Grenada, and to applications for registration of the protection of trademarks in Grenada, as that given by this Act. Reciprocity.

41.—(1) The Minister may make regulations for the purpose of carrying this Act into effect including regulations— Regulations.

- (a) prescribing any matter which may be prescribed under this Act;
- (b) requiring the payment of fees in respect of any action that the Registrar is required or authorised to take under this Act, other than any action for which a fee is to be prescribed under paragraph (a), and prescribing their amount;

- (c) prescribing the methods of filing of applications and other documents;
- (d) requiring and regulating the translation of documents and the filing and authentication of any translation; and
- (e) prescribing the methods of service of documents.

(2) The Minister, in making regulations under subsection (1) may—

- (a) make different provisions in relation to different cases or circumstances; and
- (b) place within the regulations, such incidental, supplementary or transitional provisions as the Minister may consider necessary or expedient.

Saving of vested rights.

42. Nothing in this Act shall entitle the registered proprietor or a registered licensee of a registered trademark, to interfere with or restrain the use by any person of a trademark identical with, or similar to it, in relation to goods or services for which that person or a predecessor in title of his, has continuously used that trademark from a date prior to the registration in the United Kingdom of the first-mentioned trademark, in respect of those goods in the name of the registered proprietor or a predecessor in title of his.

Saving of rights of action for passing off.

43. Nothing in this Act shall affect rights of action against any person for passing off or the remedies in respect thereof.

44. The provisions of any treaty or international convention in respect of trademarks which are extended to Grenada, shall apply to matters dealt with by this Act and, in case of conflict with provisions of this Act, the treaty or international convention shall prevail over this Act.

Application of treaties and international conventions.

45. The Registrar may issue administrative instructions relating to the procedures under this Act and its regulations.

Administrative instructions.

46.—(1) Trademarks registered in accordance with the United Kingdom Designs Protection Act Cap. 333, shall be due for next renewal within the same period as under that Act and, upon renewal, shall be reclassified in accordance with the International Classification.

Transitional provisions.

(2) On the commencement of this Act—

- (a) any registered trademark registered in accordance with the United Kingdom Designs Protection Act Cap. 333, before the commencement of this Act, shall have effect as if registered under this Act;
- (b) an application for the registration of a trademark made under the United Kingdom Designs Protection Act Cap. 333 and not yet determined, shall be treated as an application under section 7 of this Act; and
- (c) a disclaimer or limitation or an assignment or transmission entered in the register of trademarks kept under the

United Kingdom Designs Protection Act, shall have effect as if entered in the Register maintained under section 4 of this Act.

Repeal. **47.** The United Kingdom Designs Protection Act Cap. 333 is hereby repealed.

Passed by the House of Representatives this 18th day of November, 2011.

RAPHAEL DONALD
Acting Clerk to the House of Representatives.

Passed by the Senate this 1st day of December, 2011.

RAPHAEL DONALD
Acting Clerk to the Senate.

GRENADA