

Implementation date for new IP laws confirmed International - Caribbean IP

Registration National procedures

July 13 2017

New IP laws will enter into effect in the Cayman Islands on August 1 2017, including the Trademarks Law 2016 and the Trademarks Regulations 2017. Additional regulations are expected later this summer to officially establish how previously registered marks and pending applications will transition to the new regime, as the existing law and regulations do not address transitional provisions.

The Cayman Islands' existing trademark system requires mark owners to obtain local rights based on an extension of either a UK (including via the Madrid system) or an EU trademark. No local registration system exists, which has been a point of frustration for mark owners interested in a Cayman Islands registration but lacking a UK or EU registration. While the Cayman Islands is one of six British Overseas Territories in the Caribbean region, it is the last to maintain a trademark system completely dependent on some sort of European rights. The British Virgin Islands adopted a local-only registration system in 2015, doing away with its former dual system of trademark protection (ie, UK-based and local).

On August 1 2017 the Cayman Islands trademark system will transition to a purely local system. Thus, all brand owners will be on an equal footing as foreign rights will neither be required nor provide an advantageous route to registration. On the other hand, brand owners who hold a UK or EU registration and are interested in the Caymans Islands may wish to proactively extend their registrations before the end of July. By following this tactic, brand owners can avoid more stringent examination and possible oppositions and benefit from a relatively fast track to registration. At the same time, prudent brand owners may wish to wait to see the details of the expected transitional regulations.

Under the new laws, the Cayman Islands will institute formal and substantive examination and opposition procedures – features not found in the present law (the Patent and Trademarks Law 2011). All marks will have a 10-year initial term, renewable for successive 10-year terms. Other details of the law have been established for some months now (for further details please see ["New legislation will alter scope of trademark protection"](#)). However, greater detail has been added by the recent adoption and publication of the regulations. The regulations supplement the law by providing further deadlines, adopting the latest edition of the Nice Classification system and establishing the bounds of the registrar's discretionary authority to extend deadlines. The regulations also establish the fee schedule (which is largely in line with the existing fee schedule) and provide the required forms for various actions before the registry.

On application, the registrar will perform a search and substantive examination, followed by an absolute or conditional acceptance or an objection. The registrar may also seek disclaimers under the new system. Once a mark is accepted, it will be published for opposition. The law establishes a 60-day opposition period. The regulations supplement this deadline with a 60-day time limit for filing counterstatements and successive 90-day time limits for filing evidence relevant to the opposition. Although extensions of time are generally available within the registrar's discretion for most activities, the regulations explicitly forbid extensions of time for notices of opposition or counterstatements.

The regulations establish similar procedures and deadlines for actions before the registry to revoke a mark. In both opposition and revocation proceedings, the registrar may award costs to the prevailing party and require a bond to maintain a proceeding or appeal.

The law provides mark owners a means to seek damages, injunctive relief and accountings in enforcement proceedings. It also provides for criminal and customs-based enforcement, along with destruction or delivery up of infringing goods. While registration will be required to access the remedies provided for by the law, the law of passing off will remain unaffected and separate from the new trademark law.

The payment of annual maintenance fees serves as a consistent feature of the current and soon-to-be-implemented systems. The fees will remain the same: approximately \$244 for a first class, \$122 for additional classes and \$122 for late payment (per year in default). Failure to timely pay these annuities not only incurs late fees, but also results in the "rights protected by the registration... be[ing] in abeyance". The fees must be paid annually during the first quarter and cannot be paid in bulk or in advance.

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