

CONYERS

A photograph of a modern glass skyscraper with a grid-like facade, reflecting the sky and surrounding environment. The building is partially obscured by a semi-transparent blue overlay containing text. The foreground shows a paved plaza with geometric patterns and a few small, cylindrical metal bollards.

Intellectual Property and Trade Mark Protection in Bermuda

Preface

This publication has been prepared for the assistance of those who are seeking information on the protection and enforcement of intellectual property rights in Bermuda, and deals in broad terms with the statutory regime and procedure for the registration of trade marks, patents, copyrights and designs. It is not intended to be exhaustive, but provides brief details and information which we hope will be of use to our clients.

Conyers Dill & Pearman

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1. INTELLECTUAL PROPERTY PROTECTION IN BERMUDA

Bermuda has comprehensive legislation protecting all aspects of intellectual property (“IP”). Bermudian IP laws largely derive from their UK equivalents. The legal system is common law, and continues to evolve to meet the needs of technological developments and trends. Bermuda is not a signatory to the Paris Convention or the Patent Cooperation Treaty, nor is it party to the GATT Trips agreement.

Relief available for IP infringement includes emergency and permanent injunctions, Anton Piller orders, delivery up and/or destruction of infringing articles, discovery upon oath, damages, an enquiry as to damages or an account of profits. Costs will usually be awarded to the winning party.

1.1. Copyright Protection in Bermuda

Copyright is protected in Bermuda under the Copyright and Designs Act 2004 (the “2004 Act”). Under the 2004 Act, copyrights subsist in original qualifying literary, dramatic, musical and artistic works, sound recordings, films, broadcasts, cable programmes, typographical arrangements and databases.

The author of the work is usually the first owner of copyright. Protection takes effect from the time the work was created without the need for further formality. Registration of copyright is neither required nor even possible in Bermuda.

1.2. Design Protection in Bermuda

Qualifying designs can be protected in three ways in Bermuda.

- (1) Under the 2004 Act, copyrights in a design are protected for up to 15 years without the need for further formality.
- (2) A Bermuda Design registration is available under the Patents and Designs Act 1930 (the “1930 Act”) in relation to specific goods. During the period of registration the proprietor has exclusive rights to manufacture and publish the design.
- (3) Under the 1930 Act, the rights and privileges attaching to a UK design registration automatically extend to Bermuda.

1.3. Patent Registration in Bermuda

Patent protection is available in Bermuda under the 1930 Act. Local applications can be filed which confer protection for an extendable period of 16 years.

The Registry currently requires that the application be sent to the UK for search and examination. The most straight forward method of securing protection is simply to re-register a UK patent (granted out of the UK patent office, or a European patent designating the UK) within three years of grant. Privileges and rights attaching to that patent are then extended to Bermuda.

1.4. Trade Mark Registration in Bermuda

Trade and Service Marks are registrable under the Trade Marks Act 1974 (as amended) (the “1974 Act”). Registration gives the owner exclusive rights to use the mark on the goods/services listed in the specification.

An unregistered trade mark may still be protected at common law under the tort of passing off.

Enforcement proceedings in relation to trade mark infringement tend to be more straight forward and substantially cheaper where a mark is registered and protected by statute.

2. THE REGISTRATION OF TRADE MARKS IN BERMUDA

2.1. Statutory Regime

The 1974 Act is largely derived from the UK Trade Marks Act 1938. Currently, Bermuda is not party to any international convention or treaty on the protection of trade marks and priority cannot be claimed based on an earlier filing in another jurisdiction. However, new legislation is expected to be introduced later this year which will more closely reflect the UK Act of 1994 (as amended).

Unlike some British Overseas Territories, Bermuda operates an independent Register and it is not possible to simply “extend” a UK registration. The 1974 Act provides for the filing of single class applications using the WIPO international classification of goods and services (currently the 10th edition of the Nice Classification).

Usually the Registry will accept full class headings as specifications. Registration of trade marks in series with very minor differences is permissible.

It is not necessary to establish use of a trade mark in Bermuda to secure registration. However, a registration may become vulnerable to cancellation by an aggrieved third party following five years continuous non-use.

A registration is valid for an initial seven year period and may be renewed for further fourteen year periods on payment of a fee.

2.2. The Register

The Register is divided into Parts A and B. Part A is reserved for those marks considered inherently distinctive whilst Part B is for less distinctive marks.

Marks in Part A are deemed conclusively valid after seven years and can only be challenged on very limited grounds. The infringer of a Part A mark cannot rely on the statutory defence that there is no likelihood of confusion, a defence available to the infringer of a Part B mark.

2.3. Procedure

Each application requires the full name and address of the applicant, a clear copy of the mark (unless it is a word only mark) and a list of the goods/services to be covered. A separate application is required

for each class of interest. An Authorization of Agent (Form TM-13) simply signed by the applicant, which appoints an agent with a local address for service, must accompany the application.

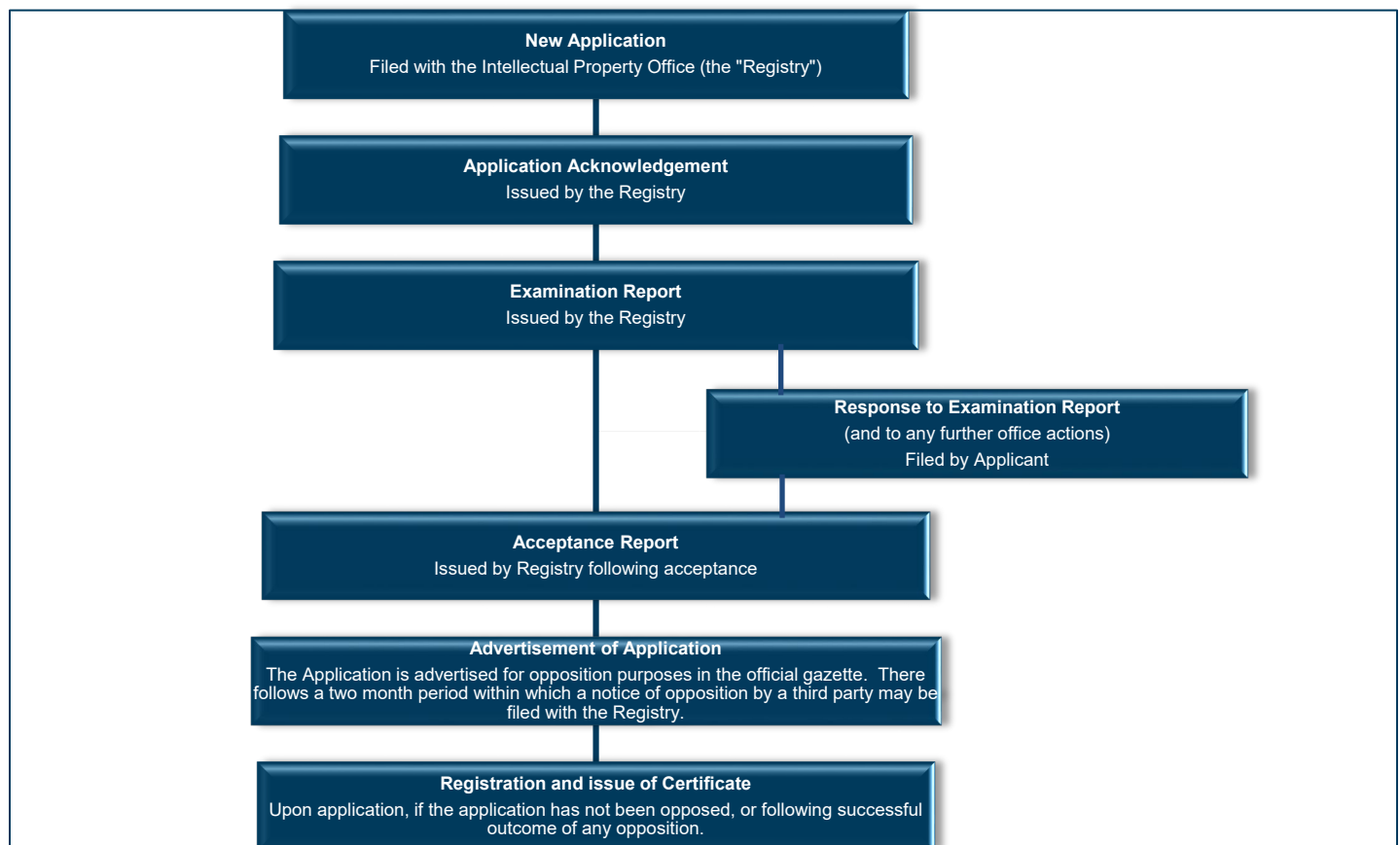
Following receipt of the application, the Registry will issue an Application Acknowledgement (an official filing receipt) confirming the filing particulars and allocating an application number. The application number will eventually mature into the registration number.

An examination report will usually issue within four months of filing. The application will either be accepted unconditionally, given a conditional acceptance or rejected. Applicants are given six months to respond. Time extensions are available in two month blocks.

Following acceptance, a mark is advertised for opposition purposes. If no third party opposition is filed within the statutory two month period, application is made for entry of the mark on the Register and issue of the registration certificate. Application for entry must be filed within 12 months of advertisement.

In a straight forward case, we would expect the registration certificate to issue within 18 months of filing the application.

The application procedure is summarised in chart form below.



This publication should not be construed as legal advice and is not intended to be relied upon in relation to any specific matter. It deals in broad terms only and is intended merely to provide a brief overview and give general information.

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