



BERMUDA

1991 : No. 39

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**THE TRADE MARKS  
(MODIFICATION AND  
AMENDMENT) ACT 1991**

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[Date of Assent: 12th July, 1991]

[Operative Date 18/6/93 ]

WHEREAS it is expedient to amend the Trade Marks Act 1974, to afford registration for service marks and to modify and make other amendments to the Trade Marks Act 1974:

Be it enacted by The Queen's Most Excellent Majesty, by and with the advice and consent of the Senate and the House of Assembly, and by the authority of the same, as follows:-

1. This Act may be cited as the Trade Marks (Modification and Amendment) Act 1991 and shall come into operation on such date as the Minister charged with responsibility for trade marks may appoint by notice published in the Gazette.

Short title and commencement.

2. (1) Subject to subsection (2), the Trade Marks Act 1974 (hereafter referred to as "the 1974 Act") shall have effect with respect to service marks as it has effect with respect to trade marks (references to goods having effect as references to services).

Application of the 1974 Act to service marks.

(2) The 1974 Act shall have effect in relation to service marks as mentioned in the First Schedule to this Act.

First Schedule.

Second  
Schedule.

(3) In consequence of subsections (1) and (2), the 1974 Act shall have effect, in cases where it applies otherwise than by virtue of subsections (1) and (2), with the amendments specified in the Second Schedule to this Act.

(4) In the application by virtue of subsection (1) above of section 8 of the 1974 Act (restrictions on exclusive right conferred by registration) the references in that section to the use of the mark by a person's predecessors in title shall, as respects use before this Act comes into operation, be construed as references to use by any predecessor of his in business.

(5) In this Act "service mark" means a mark (including a device, name, signature, word, letter, numeral, or any combination thereof) used or proposed to be used in relation to services for the purpose of indicating, or so as to indicate, that a particular person is connected, in the course of business, with the provision of those services, whether with or without any indication of the identity of that person.

Third  
Schedule.

(6) The laws mentioned in the Third Schedule shall have effect subject to the amendments specified in that Schedule.

Amendments  
to 1974 Act.

3. The 1974 Act is amended as follows:

(a) in section 1, insert immediately after subsection (2) thereof the following subsections:

" (3) For the purposes of this Act goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.

(4) References in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.";

(b) in section 2 -

(i) for subsection (1) there shall be substituted the following:

" (1) For the purpose of this Act the Registrar shall keep a record called the register of trade marks, in which shall be entered -

- (a) all registered trade marks with the dates of their registration, the names and addresses of their proprietors and the proprietors' agents;
- (b) notifications of assignments and transmissions;
- (c) the name and addresses of all registered user and registered users' agents;
- (d) disclaimers, conditions and limitations; and
- (e) such other matters relating to registered trade marks as may be prescribed.”;

(ii) renumber subsection (6) as subsection (7) and for subsection (5) substitute the following:

“ (5) The register need not be kept in documentary form.

(6) Subject to the regulations the public shall have a right to inspect the register at all convenient times.”;

(c) insert immediately after section 9 the following:

**“THE REFEREE**

Appointment  
of referee.

9A. (1) The Minister may by instrument in writing published in the Gazette appoint a person who by reason of his qualifications and experience to be a referee to determine any case or matter referred to him under this Act.

(2) The person appointed under subsection (1) shall hold office for a period of one year beginning on such day as the Minister may determine and may be re-appointed from time to time for a like period.

(3) The Minister may, at any time by notification in the Gazette, appoint any person to act temporarily in the place of the referee if the referee is absent from Bermuda or is for any reason unable to discharge his functions under this Act.

(4) The referee may at any time resign his appointment by notice in writing addressed to the Minister.

(5) The referee appointed under this section shall have such powers and shall perform such duties as are assigned to him under this Act and the Regulations made thereunder.

Case or  
matter  
may be  
referred to  
referee.

9B. (1) Where a notice of opposition and a counter-notice are sent to the Registrar under section 19(2) and (4) respectively, in any case, the Registrar may instead of, pursuant to section 19(5), hearing the parties, considering the evidence and making a decision, refer the case to the referee for the referee to deal with it on his behalf.

- (2) Where an application is made to the Registrar -
- (a) by a person aggrieved under sections 29(1), 34(1) or 35; or
- (b) by a registered proprietor of a trade mark under section 36(1) or 37(1),

then the Registrar may, instead of himself dealing with the application, refer the application to the referee to deal with it on his behalf.

Powers and  
duties of  
referee.

9C. The referee, in the discharge of his functions in relation to any case or matter referred to him under section 9B shall have the same powers and duties of the Registrar that the Registrar would have had under the Act or any Regulations made thereunder in relation to the case or matter, including the power to award costs under section 43, and anything done by the referee within the scope of his authority shall, for the purposes of this Act or any Regulations made thereunder, be deemed to have been done by the Registrar himself.”;

- (d) in section 18(4), insert immediately after the words “of the United Kingdom,” the words “as amended from time to time or under any legislation of the United Kingdom that replaces that Act,” and insert immediately after section 18(4) the following:

“(4A) Where a person makes application for the registration of a trade mark and the country of origin of the applicant is not Bermuda, then the country of origin of the applicant

shall be the country where the applicant has a bona fide and effective industrial or commercial establishment in that country, or if he has not such an establishment, the country in which he is domiciled, or if he is not domiciled in that country, the country of which he is a national.

(4B) A mark duly registered in the country indicated in subsection (4A) may be registered in Bermuda by any applicant whose country of origin is not Bermuda and the application shall be accompanied by a certification or a certified copy of the registration of the country indicated in subsection (4A).

(4C) The registration of a mark under subsection (4B) shall be independent of the registration in the country of origin of the applicant and the registrability, duration, validity or transfer in Bermuda of such registration shall be governed by the provisions of this Act.

(4D) For the removal of doubt this Act applies to any person whose country of origin is not Bermuda.”;

- (e) in section 19, delete subsections (12) and (13) thereof;
- (f) insert immediately after section 31 the following:

“Proposed use of trade mark by corporation to be constituted, etc.

31 A (1) No application for the registration of a trade mark in respect of any goods shall be refused, nor shall permission for such registration be withheld, on the ground only that it appears that the applicant does not use or propose to use the trade mark -

- (a) if the Court or the Registrar is satisfied that a body corporate is about to be constituted, and that the applicant intends to assign the trade mark to the corporation with a view to the use thereof in relation to those goods by the corporation; or
- (b) if the application is accompanied by an application for the registration of a person as a registered user of the trade mark, and the Court or the Registrar is satisfied that the proprietor intends it to be used by that person in relation to those goods and the Court or the Registrar is also satisfied that that

person will be registered as a registered user thereof immediately after the registration of the trade mark.

(2) The provisions of section 29 have effect, in relation to a trade mark registered under the power conferred by subsection (1), as if for the reference, in subsection (1)(a), to an intention on the part of an applicant for registration that a trade mark should be used by him there were substituted a reference to an intention on his part that it should be used by the corporation or registered user concerned.

(3) The Court or the Registrar may, as a condition of the exercise of the power conferred by subsection (1) in favour of an applicant who relies on intention to assign to a corporation as aforesaid, require him to give security for the costs of any proceedings before the Court or the Registrar relative to any opposition or appeal, and in default of such security being duly given may treat the application as abandoned.

(4) Where a trade mark is registered in respect of any goods under the power conferred by subsection (1) in the name of an applicant who relies on intention to assign to a corporation as aforesaid, then, unless within such period as may be prescribed, or within such further period not exceeding six months as the Registrar may on application being made to him in the prescribed manner allow, the corporation has been registered as the proprietor of the trade mark in respect of those goods, the registration shall cease to have effect in respect thereof at the expiration of that period, and the Registrar shall amend the register accordingly.”;

(g) in section 36(1)(b) and (2), for the words “name, address or description” wherever they appear substitute the words “name or address”;

(h) in section 52 -

(i) in subsection (1), insert immediately after the word “register” the words “or an extract from the register which is obtained pursuant to subsection (2)”;

- (ii) in subsection (2), insert immediately after the word “copy” the words “or an extract”;
- (iii) insert immediately after subsection (2) the following:  
  
“ (3) In relation to any portion of the register kept otherwise than in documentary form -  
  
(a) the right of inspection conferred by section 2(6) is a right to inspect the material on the register; and  
  
(b) the right to a copy or extract conferred by this section or the Regulations is a right to a copy or extract in a form in which it can be taken away and in which it is visible and legible.”.

## FIRST SCHEDULE

## Section 2(2)

Modifications of Trade Marks Act 1974  
in Application to Service Marks

## Section 1

1. Section 1 shall be modified as follows:
  - (a) in subsection (1) thereof -
    - (i) in the definition of the expression “limitations”, for all the words appearing immediately after the words “relation to” where they appear the first time there shall be substituted the words “services for use or available for acceptance within Bermuda or in relation to services for use outside Bermuda.”;
    - (ii) in the definition of the expression “mark” there shall be omitted the words “brand, heading, label, ticket.”;
    - (iii) insert immediately after the definition of the expression “prescribed” the following definition:

“provision”, in relation to services, means their provision for money or money’s worth;’;

- (b) in subsection (2) thereof, for all the words appearing immediately after the words “in relation to” there shall be substituted the words “services shall be construed as references to the use of the mark as or as part of any statement about the availability or performance of services or otherwise in relation to services.”.

### Section 5

2. Section 5 shall be modified as follows:

- (a) for subsection (1) thereof, there shall be substituted the following:

“ (1) Subject to subsections (2) and (4) and sections 3 and 9, the registration after the coming into operation of the Trade Marks (Modification and Amendment) Act 1991 of a person in part A of the register as a proprietor of a service mark in respect of any services shall, if valid, give to that person the exclusive right to the use of the mark in relation to those services and, without prejudice to the generality of the foregoing words, that right shall be deemed to be infringed by any person who, not being the proprietor of the mark or registered user thereof using by way of the permitted use, uses in connection with the provision of any services a mark identical with or nearly resembling it in relation to any services in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either -

- (a) as being use as a mark; or
- (b) in a case in which the use is use at or near the place where the services are available for acceptance or performed in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as a proprietor or as registered user to use the mark or to services with the provision of which such a person as aforesaid is connected in the course of business.”;

- (b) in subsection (2) thereof, for the words from “goods to be sold” to “any market” there shall be substituted the words “services for use or available for acceptance in any place, country or territory”;
- (c) in subsection (3) thereof, for paragraphs (a) and (b), there shall be substituted the following paragraphs:

“ (a) in relation to services to which the proprietor of the mark or a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark; or

(b) in relation to services the provision of which is connected in the course of business with the proprietor or a registered user of the mark, where the proprietor or registered user has at any time expressly or impliedly consented to the use of the mark; or

(c) in relation to services available for use with other services in relation to which the mark has been used without infringement of the right given by registration or might for the time being be so used, if -

- (i) the use of the mark is reasonably necessary in order to indicate that the services are available for such use; and
- (ii) neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact a connection in the course of business between any person and the provision of those services.”.

### Section 6

#### 3. Section 6 shall be modified as follows:

- (a) in subsection (1) thereof -
  - (i) there shall be inserted immediately before the words “of a person” the words “after the coming into operation of the Trade Marks (Modification and Amendment) Act 1991”;

- (ii) there shall be omitted the words “or be deemed to have given”;
- (b) in subsection (2) thereof -
- (i) there shall be omitted the words from “otherwise” to “section 7,”;
  - (ii) for all the words immediately after the words “as indicating” there shall be substituted the words “that a person having the right either as proprietor or as registered user to use the mark is connected in the course of business with the provision of the services”.

#### Section 7

4. Section 7 shall be omitted.

#### Section 10

5. In section 10(2), for the words from “distinguish” to “subsists” there shall be substituted the words “distinguish services with the provision of which the proprietor is or may be connected, in the course of business, from services with the provision of which he is not so connected”.

#### Section 11

6. In section 11(1), for the words from “distinguishing” to “subsists” there shall be substituted the words “distinguishing services with the provision of which the proprietor of the mark is or may be connected in the course of business from services with the provision of which he is not so connected”.

#### Section 13

7. Section 13 shall be modified as follows:
- (a) in subsection (1) thereof, for the words immediately after the words “identical with” there shall be substituted the words “or nearly resembles a mark belonging to a different proprietor and already on the register in respect of the same services, the same description of services, or goods or a description of goods which are associated with those services or services of that description.”;

- (b) in subsection (2) thereof, for the words immediately after the words “the registration” there shall be substituted the following:

“by the more than one proprietor, in respect of -

- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other,

of marks that are identical or nearly resemble each other, subject to such conditions and limitations, if any, as the Court or the Registrar, as the case may be, may think it right to impose.”;

- (c) in subsection (3) thereof, for the words immediately after the words “respectively of” there shall be substituted the following:

“marks that are identical or nearly resemble each other, in respect of -

- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other,

the Registrar may refuse to register any of them until their rights have been determined by the Court, or have been settled by agreement in a manner approved by him or, on an appeal, by the Court.”.

#### Section 15

8. In section 15(1)(b), for the words “the trade” there shall be substituted the words “the provision of services of that description”.

#### Section 16

9. Section 16 shall be modified as follows:

- (a) in subsection (1) thereof, for the words “an article or substance” there shall be substituted the words “some activity”;
- (b) for subsection (2), there shall be substituted the following subsection:
  - “(2) If it is proved that there is a well-known and established use of the word or words as the name or description of some activity by a person or persons providing services which include that activity, not being use in relation to services with the provision of which the proprietor or a registered user of the mark is connected in the course of business, subsection (3) shall have effect.”;
- (c) in subsection (3) thereof –
  - (i) there shall be omitted the words “paragraph (a) or (b) of”;
  - (ii) in paragraph (a), for the words “article or substance in question or of any goods of the same description” there shall be substituted the words “activity in question”;
  - (iii) in paragraph (b), for the words “article or substance in question and of any goods of the same description” there shall be substituted the words “activity in question” and for the words “that article or substance and any goods of the same description” there shall be substituted the words “that activity”;
- (d) in subsection (4) thereof, for the words “article or substance in question or to any goods of the same description” there shall be substituted the words “activity in question” and there shall be omitted the words “paragraph (a) of” and the words appearing immediately after the word “established”.

### Section 23

10. Section 23 shall be modified as follows:

- (a) in subsection (1) thereof, there shall be omitted the proviso thereto;
- (b) in subsection (4) thereof, in paragraph (a) of the proviso thereto, for the words "trade use" there shall be substituted the words "business use".

### Section 26

#### 11. Section 26 shall be modified as follows:

- (a) in subsection (1) thereof, there shall be omitted the words from "Notwithstanding" to "contrary," and the words ", and shall be deemed always to have been,";
- (b) in subsection (2) thereof, there shall be omitted the words ", and shall be deemed always to have been" and the words ", or was registered, as the case may be,";
- (c) in subsection (3) thereof, there shall be omitted the words "or was" wherever they appear;
- (d) for subsection (4), there shall be substituted the following subsection:

"(4) Notwithstanding anything in subsections (1) to (3) (inclusive) a mark shall not be assignable or transmissible in a case in which as a result of an assignment or transmission there would in the circumstances subsist, whether under the common law or by registration, exclusive rights in more than one of the persons concerned to the use, in relation to -

- (a) the same services,
- (b) the same description of services, or
- (c) services and goods or descriptions of services and goods which are associated with each other,

of marks nearly resembling each other or of identical marks, if, having regard to the similarity of the services or the asso-

ciation of the goods and services or description of goods and services, and to the similarity of the marks, the use of the marks in exercise of those rights would be likely to deceive or cause confusion:

Provided that, where a mark is assigned or transmitted in such a case, the assignment or transmission shall not be deemed to be invalid under this subsection if the exclusive rights subsisting as a result thereof in the persons concerned respectively are, having regard to limitations imposed thereon, such as not to be exercisable by two or more of those persons in relation to services for use in Bermuda, in relation to services for use in the same country or territory outside Bermuda or in relation to services available for acceptance in Bermuda (wherever they are to be used).”;

- (e) in subsection (6) thereof, for the words from “in those goods is made, on or after the appointed day” there shall be substituted the words “of providing those services is made”.

### Section 29

12. Section 29 shall be modified as follows:

- (a) in subsection (1) thereof, there shall be omitted the words “Subject to section 30,”;
- (b) in subsection (2) thereof, for the words immediately after the words “bona fide use” there shall be substituted the words “of the mark by the proprietor thereof for the time being in relation to -
  - (a) services of the same description, or
  - (b) goods associated with those services or services of that description,
 being services or, as the case may be, goods in respect of which the mark is registered.”;
- (c) in subsection (3) thereof, for the words “that is shown to have been due to special circumstances in the trade” there shall be substituted the words “in relation to particular

services that is shown to have been due to special circumstances affecting the provisions of those services”.

#### Section 30

13. Section 30 shall be omitted.

#### Section 31

14. Section 31 shall be modified as follows:

- (a) in subsection (1) thereof, there shall be omitted the words “(otherwise than as a defensive trade mark)”;
- (b) in subsection (2) thereof, for the words “goods with which he is connected in the course of trade” there shall be substituted the words “services with the provision of which he is connected in the course of business”;
- (c) in subsection (9) thereof, for the word “trade” there shall be substituted the word “business”.

#### Section 33

15. For section 33 there shall be substituted the following section:

“ 33. Any act done in Bermuda in relation to services for use outside Bermuda which, if done in relation to services provided within Bermuda for use there, would constitute use of a mark in Bermuda, shall be deemed to constitute use of the mark in relation to those services for any purpose for which such use is material under this Act or at common law.”

#### Section 46

16. In section 46, for the words “trade name” there shall be substituted the words “business name” and for the words “usages of the trade concerned” there shall be substituted the words “business usages in the provisions of the services in question”.

#### Section 55

17. In section 55(2)(c), for the words “goods to be exported to that country” there shall be substituted the words “services for use in that country”.

## Section 56

18. In section 56 -

- (a) for the words “goods between”, wherever they appear, there shall be substituted the words “services between the provision of”;
- (b) for the words “trade subsists” there shall be substituted the words “business subsists” and for the words “trade subsisted” there shall be substituted the words “business subsisted”.

## Section 57

19. Section 57, for paragraph (b) thereof there shall be substituted the following paragraph:

“ (b) in relation to services with the provision of which both or all of them are connected in the course of business.”

## Section 60

20. Section 60 shall be omitted.

## SECOND SCHEDULE

Section 2(3)

Amendments of the Trade Marks Act 1974 in

Application to Trade Marks for Goods

## Section 5

1. In section 5(1), for the words from “a mark identical” to “in the course of trade” there shall be substituted the words “in the course of trade a mark identical with or nearly resembling it”.

## Section 50

8. In section 50(b), for the word “Court” where it appears for the first time there shall be substituted the word “referee”.

## Section 13

## 2. Section 13 is amended as follows:

- (a) in subsection (1) thereof, for the words from “a trade mark belonging” to the end there shall be substituted the words “or nearly resembles a mark belonging to a different proprietor and already on the register in respect of -
  - (a) the same goods,
  - (b) the same description of goods, or
  - (c) services or a description of services which are associated with those goods or goods of that description.”;
- (b) in subsection (2) thereof, for the words from “of trade marks” to “proprietor” there shall be substituted the words “by more than one proprietor, in respect of -
  - (a) the same goods,
  - (b) the same description of goods, or
  - (c) goods and services or descriptions of goods and services which are associated with each other,of marks that are identical or nearly resemble each other.”;
- (c) in subsection (3) thereof, for the words from “trade marks” to “description of goods” there shall be substituted the words “marks that are identical or nearly resemble each other, in respect of -
  - (a) the same goods,
  - (b) the same description of goods, or
  - (c) goods and services or descriptions of goods and services which are associated with each other.”.

## Section 26

3. Section 26 is amended as follows:

(a) in subsection (4) thereof -

(i) for the words “the same goods or description of goods” there shall be substituted the following words:

“(a) the same goods,

(b) the same description of goods, or

(c) goods and services or descriptions of goods and services which are associated with each other”;

(ii) for the words “and of the trade marks” there shall be substituted the words “or the association of the goods and services or description of goods and services and to the similarity of the trade marks”.

## Section 29

4. In section 29(2) for the words immediately after the words “bona fide use” there shall be substituted the words “of the mark by the proprietor thereof for the time being in relation to -

(i) goods of the same description; or

(ii) services associated with those goods or goods of that description,

being goods or, as the case may be, services in respect of which the mark is registered.”.

## THIRD SCHEDULE

## Section 2(6)

## Service Marks

1. (1) Any reference to a trade mark in a provision to which this paragraph applies shall include a reference to a service mark and accordingly any reference to a registered trade mark includes a reference to a registered service mark.

- (2) The provisions to which this paragraph applies are -
  - (a) in The Crown Proceedings Act, 1966, section 4(1) and (2);
  - (b) in The Companies Act 1981 -
    - (a) First Schedule, paragraph 3;
    - (b) Second Schedule, paragraph (q).

