
CHAPTER 322**TRADE MARKS****ARRANGEMENT OF SECTIONS**

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CHAPTER 322**TRADE MARKS****An Act for the registration and protection of trade marks.**

6 of 1906
57 of 1959
G.N. 172/1964
43 of 1964
46 of 1964
E.L.A.O., 1974
5 of 1987
 Short title.

[Commencement 29th May, 1906]

1. This Act may be cited as the Trade Marks Act.

PART I**REGISTRATION OF TRADE MARKS**

2. In this Act, unless the context otherwise requires — Interpretation.

“court” means the Supreme Court, and includes a judge sitting in chambers;

“covering” includes any stopper, cask, bottle, vessel, box, cover, capsule, case, frame or wrapper;

“goods” means anything which is the subject of trade, manufacture or merchandise;

“label” includes any band or ticket;

“mark” includes a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof;

“Minister” means the Minister responsible for Trade Marks; *E.L.A.O., 1974.*

“prescribed” means in relation to proceedings before the court, prescribed by rules of court, and, in other cases, prescribed by this Act or the rules thereunder;

“register” means the register of trade marks kept under the provisions of this Act;

“registered trade mark” means a trade mark which is actually upon the register;

“registrable trade mark” means a trade mark which is capable of registration under the provisions of this Act;

“Registrar” means the Registrar General;

“trade mark” means a mark used or proposed to be used upon or in connection with goods for the purpose of indicating that they are the goods of the proprietor of such trade mark by virtue of manufacture, selection, certification, dealing with or offering for sale.

Register of trade marks.

3. There shall be kept at the Registry of Records for the purposes of this Act a book called the Register of Trade Marks, wherein shall be entered all registered trade marks, with the names and addresses of their proprietors, notifications of assignments and transmissions, disclaimers, conditions, limitations and such other matters relating to such trade marks as may from time to time be prescribed. The register shall be kept under the control and management of the Registrar.

Trust not to be entered on register.

4. There shall not be entered in the register any notice of any trust expressed, implied or constructive, nor shall any such notice be receivable by the Registrar.

Inspection of and extract from register.

5. The register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such rules as may be prescribed; and certified copies, sealed with the seal of the office, of any entry in such register shall be given to any person requiring the same on payment of the prescribed fee.

Trade mark must be for particular goods.

6. A trade mark must be registered in respect of particular goods or classes of goods.

Registrable trade marks.

7. A registrable trade mark must contain or consist of at least one of the following essential particulars —

- (a) the name of a company, individual or firm represented in a special or particular manner;
- (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the above paragraph (a) to (d) shall not, except by order of the court, be deemed a distinctive mark.

For the purposes of this section, “distinctive” shall mean adapted to distinguish the goods of the proprietor of the trade mark from those of other persons.

In determining whether a trade mark is so adapted, the Registrar may, in the case of a trade mark in actual use, take into consideration the extent to which such user has rendered such trade mark in fact distinctive for the goods with respect to which it is registered or proposed to be registered.

43 of 1964, Third Sch.

8. A trade mark may be limited in whole or in part to one or more specified colours, and in such case the fact that it is so limited shall be taken into consideration by the Registrar having to decide on the distinctive character of such trade mark. If and so far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.

Coloured trade marks.

43 of 1964, Third Sch.

9. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would by reason of its being calculated to deceive or otherwise be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

Restriction on registration.

10. (1) Any person claiming to be the proprietor of a trade mark who is desirous of registering the same must apply in writing to the Registrar in the prescribed manner.

Application for registration.

(2) Subject to the provisions of this Act, the Registrar may refuse such application, or may accept it absolutely or subject to conditions, amendments or modifications.

(3) In case of any such refusal or conditional acceptance the Registrar shall, if required by the applicant, state in writing the grounds of his decision and the materials used by him in arriving at the same, and such decision shall be subject to appeal to the court at the option of the applicant.

(4) An appeal under this section shall be made in the prescribed manner, and on such appeal the court shall, if required, hear the applicant and the Registrar, and shall make an order determining whether, and subject to what conditions, amendments and modifications, if any, the application is to be accepted.

(5) Appeals under this section shall be heard on the materials so stated by the Registrar to have been used by him in arriving at his decision, and no further grounds of

objection to the acceptance of the application shall be allowed to be taken by the Registrar, other than those stated by him, except by leave of the court hearing the appeal. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of costs on giving notice as prescribed.

(6) The Registrar or the court, as the case may be, may at any time, whether before or after acceptance, correct any error in or in connection with the application, or may permit the applicant to amend his application upon such terms as may be thought fit.

Advertisement of application.

11. When an application for registration of a trade mark has been accepted, whether absolutely or subject to conditions, the Registrar shall, as soon as may be after such acceptance, cause the application as accepted to be advertised in the prescribed manner. Such advertisement shall set forth all conditions subject to which the application has been accepted.

Opposition to registration.

12. (1) Any person may, within the prescribed time from the date of the advertisement of an application for the registration of a trade mark, give notice to the Registrar of opposition to such registration.

(2) Such notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) The Registrar shall send a copy of such notice to the applicant, and, within the prescribed time after the receipt of such notice the applicant shall send to the Registrar, in the prescribed manner, a counterstatement of the grounds on which he relies for his application, and, if he does not do so, he shall be deemed to have abandoned his application.

(4) If the applicant send such counterstatement, the Registrar shall furnish a copy thereof to the persons giving notice of opposition, and shall, after hearing the parties, if so required, and considering the evidence, decide whether, and subject to what conditions, registration is to be permitted.

(5) The decision of the Registrar shall be subject to appeal to the court.

(6) An appeal under this section shall be made in the prescribed manner, and on such appeal the court shall, if required, hear the parties and the Registrar, and shall make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(7) On the hearing of any such appeal any party may, either in the manner prescribed, or by special leave of the court, bring forward further material for the consideration of the court.

(8) In proceedings under this section no further grounds of objection to the registration of a trade mark shall be allowed to be taken by the opponent or the Registrar other than those stated by the opponent as hereinabove provided, except by leave of the court. Where any further grounds of objection are taken the applicant shall be entitled to withdraw his application without payment of the costs of the opponent or giving notice as prescribed.

(9) In any appeal under this section, the court may, after hearing the Registrar, permit the trade mark proposed to be registered to be modified in any manner not substantially affecting the identity of such trade mark, but in such case the trade mark as so modified shall be advertised in the prescribed manner before being registered.

(10) The Registrar shall have power in proceedings under this section to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid.

(11) If a party giving notice of opposition or of appeal neither resides nor carries on business in The Bahamas, the court may require such party to give security for costs of the proceedings before it relative to such opposition or appeal and, in default of such security being duly given, may treat the opposition or appeal as abandoned.

13. If a trade mark contains parts not separately registered by a proprietor as trade marks, or if it contains matter common to the trade or otherwise of a non-distinctive character, the Registrar or the court, in deciding whether such trade mark shall be entered or shall remain upon the register, may require, as a condition of its being upon the register, that the proprietor shall disclaim any

Disclaimers.

right to the exclusive use of any part or parts of such trade marks, or of all or any portion of such matter, to the exclusive use of which they hold him not to be entitled, or that he shall make such other disclaimer as they may consider needful for the purpose of defining his rights under such registration:

Provided that no disclaimer upon the register shall affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made.

Date of registration.

14. When an application for registration of a trade mark has been accepted and has not been opposed, and the time for notice of opposition has expired, or having been opposed, the opposition has been decided in favour of the applicant, the Registrar shall register the said trade mark, and the trade mark when registered, shall be registered as of the date of the application for registration, and such date shall be deemed for the purposes of this Act to be the date of registration.

Certificate of registration.

15. On the registration of a trade mark the Registrar shall issue to the applicant a certificate in the prescribed form of the registration of such trade mark under the hand of the Registrar and sealed with the seal of the office.

Non-completion of registration.

16. Where registration of a trade mark is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Registrar may, after giving notice of the non-completion to the applicant in writing in the prescribed manner, treat the application as abandoned unless it is completed within the time specified in that behalf in such notice.

Identical trade marks.

17. Except by order of the court, no trade mark shall be registered in respect of any goods or description of goods which is identical with one belonging to a different proprietor which is already on the register with respect to such goods or description of goods, or so nearly resembling such a trade mark as to be calculated to deceive.

Rival claims to identical marks.

18. Where each of several persons claims to be proprietor of the same trade mark, or of nearly identical trade marks in respect of the same goods or description of

goods, and to be registered as such proprietor, 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.

19. In case of honest concurrent user or of other special circumstances which, in the opinion of the court, make it proper so to do, the court may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods or description of goods by more than one proprietor subject to such conditions and limitations, if any, as to mode or place of user, or otherwise, as it may think it right to impose.

Concurrent user.

20. A trade mark when registered shall be assigned and transmitted only in connection with the goodwill of the business concerned in the goods for which it has been registered, and shall be determinable with that goodwill. But nothing in this section contained shall be deemed to affect the right of the proprietor of a registered trade mark to assign the right to use the same in any country of the Commonwealth or foreign country in connection with any goods for which it is registered together with the goodwill of the business therein in such goods.

Assignment and transmission of trade marks.

43 of 1964, Third Sch.

21. In any case where from any cause, whether by reason of dissolution of partnership or otherwise, a person ceases to carry on business, and the goodwill of such person does not pass to one successor but is divided, the Registrar may (subject to the provisions of this Act as to associated trade marks) on the application of the parties interested, permit an apportionment of the registered trade marks of the person among the persons in fact continuing the business, subject to such conditions and modifications, if any, as he may think necessary in the public interest. Any decision of the Registrar under this section shall be subject to appeal to the court.

Apportionment of marks on dissolution of partnership.

43 of 1964, Third Sch.

22. If application be made for the registration of a trade mark so closely resembling a trade mark of the applicant already on the register for the same goods or description of goods as to be calculated to deceive or cause confusion if used by a person other than the applicant, the Registrar may require as a condition of registration that such trade marks shall be entered on the register as associated trade marks.

Associated trade marks.

43 of 1964, Third Sch.

Combined trade marks.

23. If the proprietor of a trade mark claims to be entitled to the exclusive use of any portion of such trade mark separately, he may apply to register the same as separate trade marks. Each such separate trade mark must satisfy all the conditions and shall have all the incidents of an independent trade mark, except that when registered it and the trade mark of which it forms a part shall be deemed to be associated trade marks and shall be entered on the register as such, but the user of the whole trade mark shall for the purposes of this Act be deemed to be also a user of such registered trade marks belonging to the same proprietor as it contains.

Series of trade marks.

24. When a person claiming to be the proprietor of several trade marks for the same description of goods which, while resembling each other in the material particulars thereof, yet differ in respect of —

- (a) statements of the goods for which they are respectively used or proposed to be used;
- (b) statements of number, price, quality or names of places;
- (c) other matter of a non-distinctive character which does not substantially affect the identity of the trade mark;
- (d) colour,

seeks to register such trade marks, they may be registered as a series in one registration. All the trade marks in a series of trade marks so registered shall be deemed to be, and shall be registered as, associated trade marks.

Assignment and user of associated trade marks.

25. Associated trade marks shall be assignable or transmissible only as a whole and not separately, but they shall for all other purposes be deemed to have been registered as separate trade marks:

43 of 1964, Third Sch.

Provided that, where under the provision of this Act user of a registered trade mark is required to be proved for any purpose, the Registrar may, if and so far as he shall think right, accept user of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for such user.

Duration of registration.

26. The registration of a trade mark shall be for a period of fourteen years, but may be renewed from time to time in accordance with the provisions of this Act.

27. The Registrar shall, on application made by the registered proprietor of a trade mark in the prescribed manner and within the prescribed period, renew the registration of such trade mark for a period of fourteen years from the expiration of the original registration or the last renewal of registration, as the case may be, which date is herein termed “the expiration of the last registration.”

Renewal of registration.

28. At the prescribed time, before the expiration of the last registration of a trade mark, the Registrar shall send notice in the prescribed manner to the registered proprietor at his registered address of the date at which the existing registration will expire and the conditions as to payment of fees and otherwise upon which a renewal of such registration may be obtained, and if, at the expiration of the time prescribed in that behalf, such conditions have not been duly complied with, the Registrar may remove such trade mark from the register, subject to such conditions (if any) as to its restoration to the register as may be prescribed.

Procedure on expiry of period of registration.

29. Where a trade mark has been removed from the register for non-payment of the fee for renewal, such trade mark shall, nevertheless, for the purpose of any application for registration during one year next after the date of such removal, be deemed to be a trade mark which is already registered, unless it is shown to the satisfaction of the Registrar that there has been no *bona fide* trade user of such trade mark during the two years immediately preceding such removal.

Status of unrenewed trade marks.

30. (1) The Registrar may, on request made in the prescribed manner by the registered proprietor or by some person entitled to law to act in his name —

Correction of register.

- (a) correct any error in the name or address of the registered proprietor of a trade mark;
- (b) enter any change in the name or address of the person who is registered as proprietor of a trade mark;
- (c) cancel the entry of a trade mark on the register;
- (d) strike out any goods or classes of goods from those for which a trade mark is registered;
- (e) enter a disclaimer or memorandum relating to a trade mark which does not in any way extend the rights given by the existing registration of such trade mark.

*G.N. 172/1964 s.
6.*

(2) Any decision of the Registrar under this section shall be subject to appeal to the court.

Registration of
assignments, etc.

31. Subject to the provisions of this Act, where a person becomes entitled to a registered trade mark by assignment, transmission or other operation of law, the Registrar shall, on request in the prescribed manner, and on proof of title to his satisfaction, cause the name and address of such person to be entered on the register as proprietor of the trade mark. Any decision of the Registrar under this section shall be subject to appeal to the court.

Alteration of
registered trade
mark.

*G.N. 172/1964, s.
6.*

32. The registered proprietor of any trade mark may apply in the prescribed manner to the Registrar for leave to add to or alter such trade mark in any manner not substantially affecting the identity of the same, and the Registrar may refuse such leave, or may grant the same on such terms as he may think fit, but any such refusal or conditional permission shall be subject to appeal to the court. If leave be granted, the trade mark as altered shall be advertised in the prescribed manner.

Rectification of
register.

33. Subject to the provisions of this Act —

- (a) the court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of any entry, or by any entry made in the register without sufficient cause, or by any entry wrongfully remaining on the register, or by an error or defect in any entry in the register, make such order for making, expunging, or varying such entry, as it may think fit;
- (b) the court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connection with the rectification of the register;
- (c) in case of fraud in the registration or transmission of a registered trade mark, the Registrar may himself apply to the court under the provisions of this section;
- (d) any order of the court rectifying the register shall direct that notice of the rectification shall be served upon the Registrar in the prescribed manner who shall upon receipt of such notice rectify the register accordingly.

34. A registered trade mark may, on the application to the court of any person aggrieved, be taken off the register in respect of any of the goods for which it is registered, on the ground that it was registered by the proprietor or a predecessor in title without any *bona fide* intention to use the same in connection with such goods, and there has in fact been no *bona fide* user of the same in connection therewith, or on the ground that there has been no *bona fide* user of such trade mark in connection with such goods during the five years immediately preceding the application, unless in either case such non-user is shown to be due to special circumstances in the trade, and not to any intention not to use or to abandon such trade mark in respect of such goods.

Non-user of trade mark.

35. (1) Where a trade mark consisting of an invented word or invented words has become so well known as respects any goods in respect of which it is registered and in relation to which it has been used that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first-mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in section 34, the trade mark may, on the application in the prescribed manner of the proprietor registered in respect of the first mentioned goods, be registered in his name in respect of those other goods as a defensive trade mark and, while so registered, shall not be liable to be taken off the register in respect of those goods under section 34.

Defensive registration of well known trade marks.

57 of 1959, s. 2.

(2) The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration.

(3) A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trade marks.

(4) On application by any person aggrieved to the court, or at the option of the applicant and subject to the provisions of section 53 of this Act, to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of subsection (1) of this section are no longer satisfied in respect of any goods in respect of which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in respect of which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in subsection (1) of this section.

(5) The Registrar may at any time cancel the registration as a defensive trade mark of a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark.

(6) Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trade marks as defensive trade marks and of trade marks so registered as they apply in other cases.

36. (1) Subject to the provisions of this section, a person other than the proprietor of a trade mark may be registered as a registered user thereof in respect of all or any of the goods in respect of which it is registered (otherwise than as a defensive trade mark) and either with or without conditions or restrictions.

The use of a trade mark by a registered user thereof in relation to goods with which he is connected in the course of trade and in respect of which for the time being the trade mark remains registered and he is registered as a registered user, being use such as to comply with any conditions or restrictions to which his registration is subject, is in this Act referred to as the “permitted use” thereof.

Registered users.
57 of 1959, s. 2.

(2) The permitted use of a trade mark shall be deemed to be use by the proprietor thereof, and shall be deemed not to be use by a person other than the proprietor, for the purposes of section 34 of this Act and for any other purpose for which such use is material under this Act or at common law.

(3) Subject to any agreement subsisting between the parties, a registered user of a trade mark shall be entitled to call upon the proprietor thereof to take proceedings to prevent infringement thereof, and, if the proprietor refuses or neglects to do so within two months after being so called upon, the registered user may institute proceedings for infringement in his own name as if he were the proprietor, making the proprietor a defendant.

A proprietor so added as defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

(4) Where it is proposed that a person should be registered as a registered user of a trade mark, the proprietor and the proposed registered user must apply in writing to the Registrar in the prescribed manner and must furnish him with a statutory declaration made by the proprietor, or by some person authorised to act on his behalf and approved by the Registrar —

- (a) giving particulars of the relationship, existing or proposed, between the proprietor and the proposed registered user, including particulars showing the degree of control by the proprietor over the permitted use which their relationship will confer and whether it is a term of their relationship that the proposed registered user shall be the sole registered user or that there shall be any other restriction as to persons for whose registration as registered users application may be made;
- (b) stating the goods in respect of which registration is proposed;
- (c) stating any conditions or restrictions proposed with respect to the characteristics of the goods, to the mode or place of permitted use, or to any other matter; and
- (d) stating whether the permitted use is to be for a period or without limit of period, and, if for a period, the duration thereof,

and with such further documents, information or evidence as may be required under the rules or by the Registrar.

(5) When the requirements of subsection (4) of this section have been complied with, if the Registrar after considering the information furnished to him under that subsection, is satisfied that in all the circumstances the use of the trade mark in relation to the proposed goods or any of them by the proposed registered user subject to any conditions or restrictions which the Registrar thinks proper would not be contrary to the public interest, the Registrar may register the proposed registered user as a registered user in respect of the goods as to which he is so satisfied subject as aforesaid.

(6) The Registrar shall refuse an application under the foregoing provisions of this section if it appears to him that the grant thereof would tend to facilitate trafficking in a trade mark.

(7) The Registrar shall, if so required by an applicant, take steps for securing that information given for the purposes of an application under the foregoing provisions of this section (other than matter entered in the register) is not disclosed to rivals in trade.

(8) Without prejudice to the provisions of section 33 of this Act, the registration of a person as a registered user —

- (a) may be varied by the Registrar as regards the goods in respect of which, or any conditions or restrictions subject to which, it has effect, on the application in writing in the prescribed manner of the registered proprietor of the trade mark to which the registration relates;
- (b) may be cancelled by the Registrar on the application in writing in the prescribed manner of the registered proprietor or of the registered user or of any other registered user of the trade mark; or
- (c) may be cancelled by the Registrar on the application in writing in the prescribed manner of any person on any of the following grounds, that is to say —
 - (i) that the registered user has used the trade mark otherwise than by way of the permitted use, or in such a way as to cause, or to be likely to cause, deception or confusion;

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- (ii) that the proprietor or the registered user misrepresented, or failed to disclose, some fact material to the application for the registration, or that the circumstances have materially changed since the date of the registration;
 - (iii) that the registration ought not to have been effected having regard to rights vested in the applicant by virtue of a contract in the performance of which he is interested.

(9) Provision shall be made by the rules of the notification of the registration of a person as a registered user to any other registered user of the trade mark, and for the notification of an application under subsection (8) of this section to the registered proprietor and each registered user (not being the applicant) of the trade mark, and for giving to the applicant on such an application, and to all persons to whom such an application is notified and who intervene in the proceedings in accordance with the rules, an opportunity of being heard.

(10) The Registrar may at any time cancel the registration of a person as a registered user of a trade mark in respect of any goods in respect of which the trade mark is no longer registered.

(11) Any decision of the Registrar under the foregoing provisions of this section shall be subject to appeal to the court.

(12) Nothing in this section shall confer on a registered user of a trade mark any assignable or transmissible right to the use thereof.

37. (1) A mark adapted in relation to any goods to distinguish in the course of trade goods certified by any person in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic, from goods not so certified shall be registrable as a certification trade mark in respect of those goods in the name, as proprietor thereof, of that person:

Certification
trade marks.

57 of 1959, s. 2.

Provided that a mark shall not be so registrable in the name of a person who carries on a trade in goods of the kind certified.

(2) In determining whether a mark is adapted to distinguish as aforesaid, the Registrar may have regard to the extent to which —

- (a) the mark is inherently adapted to distinguish as aforesaid in relation to the goods in question; and
- (b) by reason of the use of the mark or of any other circumstances, the mark is in fact adapted to distinguish as aforesaid in relation to the goods in question.

(3) Subject to the provisions of subsections (4) to (6) of this section, the registration of a person as proprietor of a certification trade mark in respect of any goods shall, if valid, give to that person the exclusive right to the use of the trade mark in relation to those goods, 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 trade mark or a person authorised by him under the regulations in that behalf using it in accordance therewith, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods 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 trade mark; or
- (b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or by his authorisation under the relevant regulations to use the trade mark or to goods certified by the proprietor.

(4) The right to the use of a certification trade mark given by registration as aforesaid shall be subject to any conditions or limitations entered on the register, and shall not be deemed to be infringed by the use of any such mark as aforesaid in any mode, in relation to goods to be sold or otherwise traded in in any place, in relation to goods to be exported to any market, or in any other circumstances, to which, having regard to any such limitations, the registration does not extend.

(5) The right to the use of a certification trade mark given by registration, as aforesaid shall not be deemed to be infringed by the use of any such mark as aforesaid by any person —

- (a) in relation to goods certified by the proprietor of the trade mark if, as to those goods or a bulk of which they form part, the proprietor or another in accordance with his authorisation under the relevant regulations has applied the trade mark and has not subsequently removed or obliterated it, or the proprietor has at any time expressly or impliedly consented to the use of the trade mark; or
- (b) in relation to goods adapted to form part of, or to be accessory to, other goods in relation to which the trade mark has been used without infringement of the right given as aforesaid or might for the time being be so used, if the use of the mark is reasonably necessary in order to indicate that the goods are so adapted and neither the purpose nor the effect of the use of the mark is to indicate otherwise than in accordance with the fact that the goods are certified by the proprietor:

Provided that paragraph (a) of this subsection shall not have effect in the case of use consisting of the application of any such mark as aforesaid to any goods, notwithstanding that they are such goods as are mentioned in that paragraph, if such application is contrary to the relevant regulations.

(6) Where a certification trade mark is one of two or more registered trade marks that are identical or nearly resemble each other, the use of any of those trade marks in exercise of the right to the use of that trade mark given by registration shall not be deemed to be an infringement of the right so given to the use of any other of those trade marks.

(7) There shall be deposited at the Registry of Records in respect of every trade mark registered under this section regulations approved by the Minister for governing the use thereof, which shall include provisions as to the cases in which the proprietor is to certify goods and to authorise the use of the trade mark, and may contain any other provisions that the Minister may require or permit to be

E.L.A.O., 1974.

E.L.A.O., 1974.

inserted therein (including provisions conferring a right of appeal to the Registrar against any refusal of the proprietor to certify goods or to authorise the use of the trade mark in accordance with the regulations). Regulations so deposited shall be open to inspection in like manner as the register.

(8) A certification trade mark shall not be assignable or transmissible otherwise than with the consent of the Registrar.

Powers of registered proprietor.

38. Subject to the provisions of this Act —

- (a) the person for the time being entered in the register as proprietor of a trade mark shall, subject to any right appearing from such register to be vested in any other person, have the power to assign the same, and to give effectual receipts for any consideration for such assignment;
- (b) any equities in respect of a trade mark may be enforced in like manner as in respect of any other personal property.

Rights of proprietor of trade mark.

39. Subject to the provisions of section 41 of this Act and to any limitations and conditions entered upon the register, the registration of a person as proprietor of a trade mark shall, if valid, give to such person the exclusive right to the use of such trade mark upon or in connection with the goods in respect of which it is registered:

Provided that where two or more persons are registered proprietors of the same (or substantially the same) trade mark in respect of the same goods, no rights of exclusive user of such trade mark shall (except so far as their respective rights shall have been defined by the court) be acquired by any one of such persons as against any other by the registration thereof, but each of such persons shall otherwise have the same rights as if he were the sole registered proprietor thereof.

Registration to be *prima facie* evidence of validity.

40. In all legal proceedings relating to a registered trade mark (including applications under section 33 of this Act) the fact that a person is registered as proprietor of such trade mark shall be *prima facie* evidence of the validity of the original registration of such trade mark and of all subsequent assignments and transmissions of the same.

41. In all legal proceedings relating to a registered trade mark (including applications under section 33 of this Act) the original registration of such trade mark shall after the expiration of seven years from the date of such original registration (or seven years from the passing of this Act, whichever shall last happen) be taken to be valid in all respects unless such original registration was obtained by fraud, or unless the trade mark offends against the provisions of section 9 of this Act:

Registration to be conclusive after seven years.

Provided that nothing in this Act shall entitle the proprietor of a registered trade mark to interfere with or restrain the user by any person of a similar trade mark upon or in connection with goods upon or in connection with which such person has, by himself or his predecessors in business, continuously used such trade mark from a date anterior to the user of the first mentioned trade mark by the proprietor thereof or his predecessors in business, or to object (on such user being proved) to such person being put upon the register for such similar trade mark in respect of such goods under the provisions of section 19 of this Act.

42. No person shall be entitled to institute any proceeding to prevent or to recover damages for the infringement of an unregistered trade mark.

Unregistered trade marks.

43. In an action for the infringement of a trade mark the court trying the question of infringement shall admit evidence of the usages of the trade in respect to the get-up of the goods for which the trade mark is registered, and of any trade marks or get-up legitimately used in connection with such goods by other persons.

Infringement.

44. No registration under this Act shall interfere with any *bona fide* use by a person of his own name or place of business or that of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods.

User of name, address or description of goods.

45. Nothing in this Act contained shall be deemed to affect rights of action against any person for passing off goods as those of another person or the remedies in respect thereof.

“Passing off” action.

46. In any legal proceeding in which the validity of the registration of a registered trade mark comes into question and is decided in favour of the proprietor of such trade

Certificate of validity.

mark, the court may certify the same, and if it so certifies then in any subsequent legal proceeding in which such validity comes into question the proprietor of the said trade mark, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between attorney and client, unless in such subsequent proceedings the court certifies that he ought not to have the same.

Registrar to have notice of proceedings for rectification.

47. In any legal proceedings in which the relief sought includes alteration or rectification of the register, the Registrar shall have the right to appear and be heard, and shall appear if so directed by the court. Unless otherwise directed by the court, the Registrar in lieu of appearing and being heard may submit to the court a statement in writing signed by him, giving particulars of the proceedings before him in relation to the matter in issue or of the grounds of any decision given by him affecting the same or of the practice of the office in like cases, or of such other matters relevant to the issues, and within his knowledge as such Registrar, as he shall think fit, and such statement shall be deemed to form part of the evidence in the proceeding.

Costs of proceedings before the court.

48. In all proceedings before the court under this Act the costs of the Registrar shall be in the discretion of the court, but the Registrar shall not be ordered to pay the costs of any other of the parties.

Mode of giving evidence
G.N. 172/1964,
s. 6.

43 of 1964, Third Sch.

49. In any proceeding under this Act before the Registrar the evidence shall be given by notarial declaration in the absence of directions to the contrary, but in any case in which he shall think right so to do, the Registrar may take evidence *viva voce* in lieu of or in addition to evidence by declaration. Any such notarial declaration may in the case of appeal be used before the court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

In case any part of the evidence is taken *viva voce* the Registrar shall in respect of requiring the attendance of witnesses and taking evidence on oath be in the same position in all respects as the court.

Sealed copies to be evidence.

50. Printed or written copies or extracts of or from the register, purporting to be certified by the Registrar and sealed with the seal of the office, shall be admitted in evidence in all proceedings without further proof or production of the originals.

51. A certificate purporting to be under the hand of the Registrar as to any entry, matter or thing which he is authorised by this Act, or rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or not done.

Certificate of Registrar to be evidence.

PART II PROCEDURE RELATING TO TRADE MARKS

52. Where any discretionary or other power is given to the Registrar by this Act or rules made thereunder, he shall not exercise that power adversely to the applicant for registration or the registered proprietor of the trade mark in question without (if duly required so to do within the prescribed time) giving such applicant or registered proprietor an opportunity of being heard.

Exercise of discretionary power by Registrar.

53. Except where expressly given by the provisions of this Act or rules made thereunder there shall be no appeal from a decision of the Registrar, but the court, in dealing with any question of the rectification of the register (including all applications under the provisions of section 33 of this Act), shall have power to review any decision of the Registrar relating to the entry in question or the correction sought to be made.

Appeal from Registrar.

G.N. 172/1964.

54. Where by this Act any act has to be done by or to any person in connection with a trade mark or proposed trade mark or any procedure relating thereto, such act may under and in accordance with rules made under this Act or in particular cases by special leave of the Minister be done by or to an agent of such party duly authorised in the prescribed manner.

Recognition of agents.

E.L.A.O., 1974.

55. The Registrar may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to the Attorney-General for directions in the matter.

Registrar may take directions from Attorney-General.

56. (1) Subject to the provisions of this Act the Minister may from time to time make such rules, prescribe such forms and generally do such things as may be thought expedient —

Power to make rules.
*E.L.A.O., 1974.;
46 of 1964, Sch.*

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- (a) for classifying goods for the purposes of registration of trade marks;
 - (b) for making or requiring duplicates of trade marks and other documents;
 - (c) for securing and regulating the publishing and selling or distributing, in such manner as the Minister thinks fit, of copies of trade marks and other documents;
 - (d) generally, for regulating the business of the office in relation to trade marks and all things by this Act placed under the direction or control of the Registrar or of the Minister.

E.L.A.O., 1974.

(2) Before making any rules under this section the Minister shall publish notice of the intention to make the rules and of the place where copies of the draft rules may be obtained in such manner as he may consider most expedient, so as to enable persons affected to make representations to the Minister before the rules are finally settled.

*46 of 1964, Sch.
Ch. 53.*

(3) It shall be lawful for rules of court to be made under section 76 of the Supreme Court Act regulating the conduct of legal proceedings under this Act either before the Registrar or the court.

Fees.

E.L.A.O., 1974.

57. There shall be paid in respect of applications and registration and other matters under this Act such fees as may be prescribed by Order by the Minister.

Standardisation,
etc., trade marks.
*43 of 1964, Third
Sch.*

58. Where any association or person undertakes the examination of any goods in respect of origin, material, mode of manufacture, quality, accuracy or other characteristic and certifies the result of such examination by mark used upon or in connection with such goods, the Registrar may, if he shall judge it to be to the public advantage, permit such association or person to register such mark as a trade mark in respect of such goods, whether or not such association or person be a trading association or trader or possessed of a good-will in connection with such examination and certifying. When so registered such trade mark shall be deemed in all respects to be a registered trade mark, and such association or person to be proprietor thereof, save that such trade mark shall be transmissible or assignable only by permission of the Registrar. Any decision of the Registrar under this section shall be subject to appeal to the court.

59. If any person makes or causes to be made a false entry in the register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing knowing the entry or writing to be false, he shall be guilty of an offence against this Act.

Falsification of entries in register.

60. (1) Any person who represents a trade mark as registered which is not so shall be liable for every offence on summary conviction to a fine of twenty dollars.

Penalty on falsely representing a trade mark.
5 of 1987, s. 2.

(2) A person shall be deemed for the purposes of this enactment to represent that a trade mark is registered if he uses in connection with the trade mark the word “registered” or any words expressing or implying that registration has been obtained for the trade mark.

61. Subject to any prior rights that may have been acquired by any local proprietor of a trade mark, the proprietor of any trade mark registered in England shall be entitled to the registration of such trade mark in The Bahamas, upon the production of a certificate of the registration of such trade mark in England under the hand of the Comptroller General of patents, designs and trade marks.

Right to register trade mark registered in England.

PART III PROTECTION OF TRADE MARKS

- 62.** Every person who —
- (a) forges any trade mark;
 - (b) falsely applies to goods any trade mark or any mark so nearly resembling a trade mark as to be calculated to deceive,

Forging or falsely applying trade marks.

shall, unless he proves that he acted without intent to defraud, be guilty of an offence against this Act.

63. Every person who sells, or exposes for sale, or has in his possession for sale, or any purpose of trade or manufacture, any goods or things to which any forged trade mark is applied, or to which any trade mark or mark so nearly resembling a trade mark as to be calculated to deceive is falsely applied, as the case may be, shall be guilty of an offence against this Act, unless he proves —

Selling goods to which false trade mark applied.

- (a) that having taken all reasonable precautions against committing an offence against this Act, he had at the time of the commission of the alleged offence no reason to suspect the genuineness of the trade mark;
- (b) that on demand made by or on behalf of the prosecutor, he gave all the information in his power with respect to the persons from whom he obtained such goods or things;
- (c) that otherwise he acted innocently.

Forging trade marks.

64. (1) A person shall be deemed to forge a trade mark who either —

- (a) without the assent of the proprietor of the trade mark makes that trade mark or mark so nearly resembling that trade mark as to be calculated to deceive;
- (b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.

(2) Any trade mark so made or falsified is in this Act referred to as a forged trade mark:

Provided that in any prosecution for forging a trade mark the burden of proving the assent of the proprietor shall lie on the defendant.

Applying trade marks.

65. (1) A person shall be deemed to apply a trade mark or mark to goods who —

- (a) applies it to the goods themselves;
- (b) applies it to any covering, label, reel or other thing in or with which the goods are sold or exposed or had in possession for any purpose of sale, trade or manufacture;
- (c) places, encloses or annexes any goods which are sold or exposed or had in possession for any purpose of sale, trade or manufacture, in, with or to any covering, label, reel or other thing to which a trade mark has been applied;
- (d) uses a trade mark or mark in any manner calculated to lead to the belief that the goods in connection with which it is used are designated by that trade mark or mark.

(2) A trade mark or mark shall be deemed to be applied whether it is woven, impressed or otherwise worked into or annexed, or affixed to the goods, or to any covering, label, reel or other thing.

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- 66.** A person shall be deemed falsely to apply to goods a trade mark or mark, who without the consent of the proprietor of a trade mark applies such trade mark, or a mark so nearly resembling it as to be calculated to deceive, but in any prosecution for falsely applying a trade mark or mark to goods the burden of proving the assent of the proprietor shall lie on the defendant. Falsely applying trade marks.
- 67.** Nothing in this Act shall be construed so as to render liable to any prosecution or punishment any servant of a master resident in The Bahamas who acts in good faith in obedience to the instructions of such master, and on demand made on behalf of the prosecutor has given full information as to his master. Protection of servants acting in good faith.
- 68.** Any person guilty of an offence against this Act shall be liable on summary conviction to a penalty of two hundred dollars and to the forfeiture of all goods in respect of which the offence was committed. Punishment of offence against Act.
5 of 1987, s. 2.