

New Trade Marks & Design Laws Cayman Islands

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Agenda

What is Intellectual Property ('IP')?

Where do I register my IP in the Cayman Islands?

Trade Marks

Designs

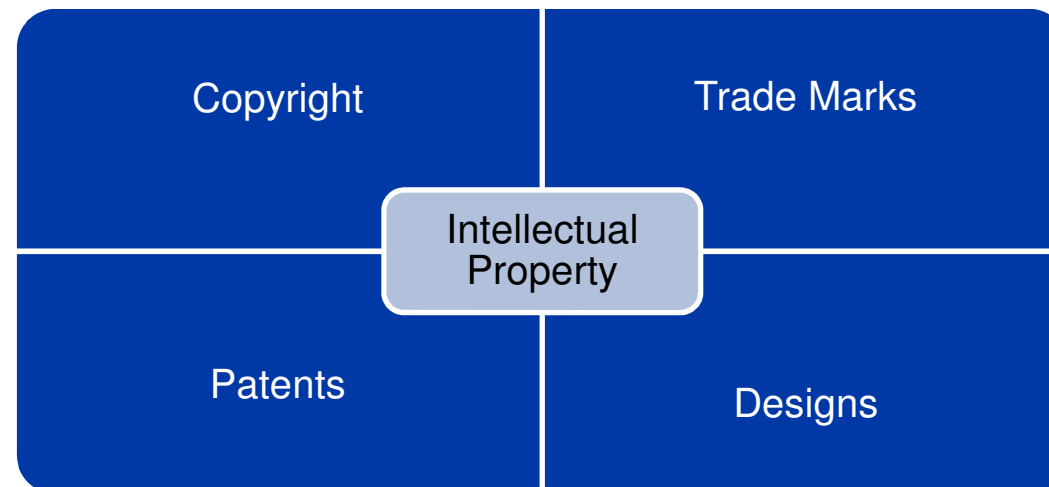
What are the Benefits of Protecting Trade Marks and Designs?



What is Intellectual Property?

“Intellectual property (IP) refers to creations of the mind. These include inventions, literary and artistic works, and symbols, names and images used in commerce.”

- World Intellectual Property Organisation





Where do I apply to register my IP?

- CIIPO – Cayman Islands Intellectual Property Office:
 - Unit of the General Registry
 - Administers IP rights
 - www.ciipo.ky



Trade Marks

The current situation

No national
registration
route

Extensions
accepted:
UK / CTM /
UK
designations
of
International
Registrations

No
substantive
examination
procedure

No
opposition
procedure

Validity of
Cayman
registrations

Annual fees



Trade Marks

As of 1 August 2017

New
legislation

A national
registration
route

No further
extensions
of foreign
registration

Absolute
grounds
examination

Opposition
procedure

No use
requirement

Annual fees



Trade Marks

What is a trade mark?

Sign

Represented
graphically

Used to **distinguish**
goods and services
provided by one
trader from those of
another

Must be
DISTINCTIVE

Must not be
DESCRIPTIVE



Marks must be clearly defined

The mark consists of the **colour purple** as shown on the form of application, applied to the whole visible surface, **or being the predominant colour applied to the whole visible surface**, of the packaging of the goods.





Marks cannot be descriptive I

Mark: **DUCK**

Specification: “Cleaning preparations; cosmetics; preparations for the hair; but not including soaps.”

Mark: **FLOWERS**

Specification: “Cosmetics, perfumes, toiletries; but not including any such goods scented to smell like flowers.”



Marks cannot be descriptive II

Mark: **200**

Specification: “Cigarettes”

Mark: **5.5%**

Specification: “Larger”

Mark: **bet365**

Specification: “Betting and gaming services”.



Marks must be distinctive

Mark: **SOAP**

Specification: “Soap.”

Mark: **APPLE**

Specification: “phones.”



Non-distinctive marks may acquire distinctiveness

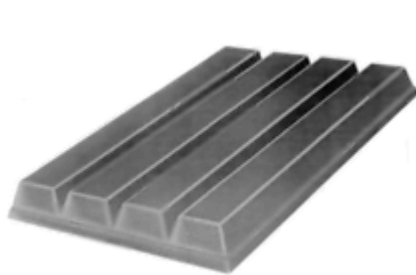
- Market share in the Cayman Islands
- Intensity of use in the Cayman Islands
- \$ invested in promoting the mark in the Cayman Islands
- \$ generated through sales under the mark in the Cayman Islands



Alexander McQueen

ALEXANDER
MCQUEEN

Google



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Name / Representation of a Person

- ELVIS PRESLEY





Disclaimers

- No exclusive right to a particular descriptive / non-distinctive element of the mark
- Can be disclaimed on the application form or later on

Example:

Mark: **SOPHIE'S HOT CHOCOLATE**

Specification: "hot chocolate".



Special types of marks I: Collective marks

A collective mark is a mark distinguishing the goods or services of members of the **association** which is the proprietor of the mark from those of other undertakings.

Example:





Special types of marks II: Certification marks

A collective mark is a mark indicating that the goods or services in connection with which it is used are **certified by the proprietor of the mark** in respect of origin, materials, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

Example:



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Trade Marks Classification

- 45 Classes

...

- Internationally accepted

- Classes
1 – 34 =
Goods
classes

...

- Classes
35 – 45 =
Service
classes



Class Headings / Broad Terms

Class: **15**

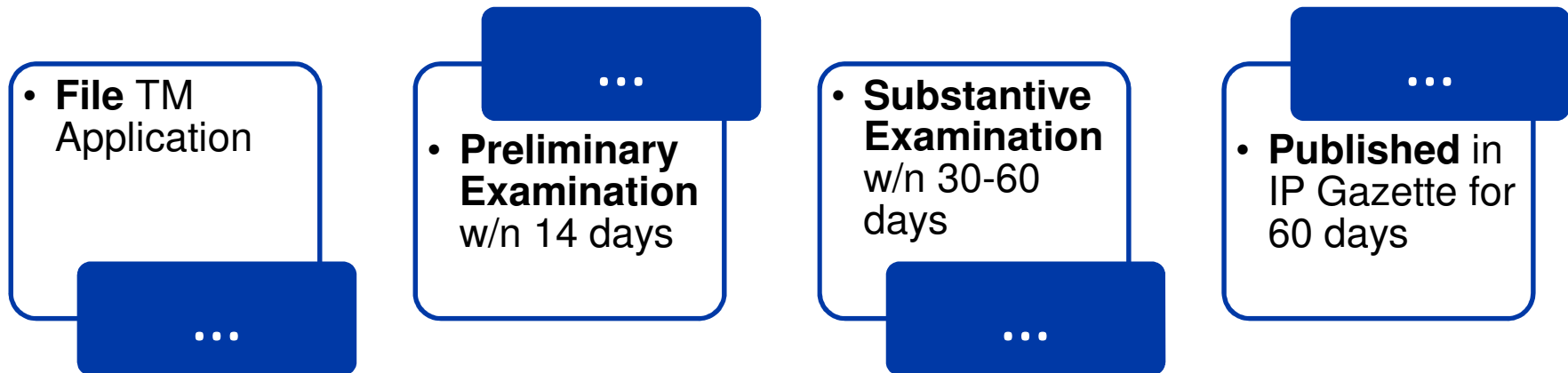
Class heading: “Musical instruments”

Class: **41**

Class heading: “Education; providing of training; entertainment; sporting and cultural activities.”



Examination Timeline





Trade Mark Oppositions

- Who can file an opposition?
- What is the legal basis for filing an opposition?



Double identity

- Identical marks
- Identical goods / services
- No likelihood of confusion is necessary



Similar marks + likelihood of confusion

- Similar / identical marks
- Similar / identical goods / services
- Likelihood of confusion is necessary



Goods and Services - relevant factors to establish similarity:

- Nature
- Intended purpose
- Competing goods / interchangeable
- Distribution Channels / points of sale
- Relevant public



Signs - relevant factors to establish similarity:

- Visual comparison
- Aural comparison
- Conceptual comparison



Likelihood of Confusion

- Risk
- Relevant public might believe
- Goods and services
- Originate from
- The same / economically-linked undertakings



Duration of a trade mark registration

- 10 years from filing date
- Renewable every 10 years for further 10 year periods
- Assuming annual fees are paid up to date
- Series marks registered under current law must be divided before renewal.



Late Renewal and Restoration

- 6 month grace period for **late renewal** after expiry
- **Restoration** is available at any time after the end of the grace period.



Recordal of Registrable Transactions

- Assignment
- Licence
- Security interest
- Order of the Court



Things to consider before 1 August 2017

- Extension of existing UK/EU trade marks (fast track)
- Clearance searches in preparation for new filings
- Scope of new national filings to be made on 1 August
- Division of series marks on next renewal



Designs

What is a design?

Design refers to the ornamental or aesthetic aspects of an article

To be protected a design must be new / original and non-functional

Technical features are not protected (they could instead be protected by a patent)

The initial term of protection is usually 5 years

Designs can generally be renewed for up a further 15 years



Designs

What kinds of designs can be protected?

Watches

Jewelry

Electrical
Items

Vehicles

Textile
designs

Medical
instruments

Phones



Designs

Where do you file a design application?

- National intellectual property offices
- Regional intellectual property offices (e.g. EUIPO)
- The Hague Agreement Concerning the International Registration of Industrial Designs offers a procedure for international registration of designs



Designs

4022177



| | |
|---------------------------|-------------------------------|
| Indication of the product | IPad cover |
| Design number | 4022177 |
| Owner name | DG International Holdings Ltd |
| Filing date | 1-11-2011 |

D078723-0003



| | |
|---------------------------|--|
| Indication of the product | 1. Base unit; 2. Water kettle; 3. Electric water kettle; 4. Water kettle |
| Design number | D078723-0003 |
| Owner name | KONINKLIJKE PHILIPS ELECTRONICS N.V. |
| Filing date | 16-7-2012 |
| Status | Registered and fully published |

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Designs

The current situation

- No protection





Designs

The future

New
legislation
1 August

Introducing
a UK/EU
Re-
Registration
Route

No
examination

Validity
depending
on UK/EU
Registered
Design

Annual fees



Benefits of Protecting Trade Marks and Designs?



Exclusive right to use the mark



Name Reservation/Brand Planning



Costs of Litigation



Economic Value



Benefits of Protecting Trade Marks and Designs?



Deterrence



Licensing



Domain Names



Criminal sanctions/customs seizure

Questions?



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