

**BRITISH VIRGIN ISLANDS
FINANCIAL SERVICES COMMISSION**



TRADE MARK AGENT GUIDELINES

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INTRODUCTION

The Trade Marks Act, 2013 (“the Act”) was enacted to modernise the existing trade marks regime which has been in existence since 1887. Under the 1887 Act persons could independently apply for the registration of a trade mark. This independent registration meant that individuals who may not be fully *au fait* with the requirements for successful registration of a trade mark could submit applications for registration. In such circumstances, applications might not fully comply with the tenets of the law, resulting in prolonging the registration process while the deficiencies in the application are being addressed.

The new Act now requires trade mark registrations to be filed through an approved trade mark agent. A trade mark agent can be an individual, a partnership or a legal person, but must be approved by the Financial Services Commission (“the Commission”) and must have an appreciable knowledge of trade mark law. All applicants must meet the requirements for approval outlined in section 34 of the Act as well as meet the Commission’s fit and proper test. It is considered, therefore, that once approved these agents, having the relevant knowledge and experience in trade mark law, would assist in facilitating the processing of applications received by the Registrar of Trade Marks, Copyrights and Patents and aid in reducing the time taken to consider and register a trade mark.

These Guidelines are designed to outline the procedure to be used by the Commission to assess applications submitted by persons applying to be approved and registered as trade mark agents, and to determine the fitness and propriety of such persons. Guidance is provided on what should be included with applications that are submitted. Guidance is also provided on what is required to meet the Commission’s fit and proper criteria, as well as the responsibilities of both the trade mark agent and the Commission in instances where the trade mark agent is no longer considered fit and proper. The Guidelines also provide for instances where an application is withdrawn by the applicant or refused by the Commission.

1. Application for approval of a trade mark agent and payment of fees

A person (“applicant”) wishing to be approved as a trade mark agent must be qualified and have appropriate experience, and must demonstrate competence and integrity as outlined in Part III of the Trade Marks Act, 2013 (“the Act”).

An application for approval as a trade mark agent must be submitted using either **Form TM22-A or Form TM22-B** of the Trade Marks Rules, 2015. A non-refundable application fee of three hundred and fifty dollars (\$350.00) (or such other amount as may be prescribed in the future pursuant to the Financial Services Commission Act, 2001 and the Trade Marks Act, 2013) must be submitted with the application for approval as a trade mark agent. No application for approval as a trade mark agent shall be processed by the Commission unless the application is accompanied by the requisite fee.

1.1 Approval of an individual to act as a trade mark agent

1.1.1 Each application submitted by an individual for approval to act as a trade mark agent must highlight the applicant’s qualification, experience, competence and integrity and be accompanied by supporting evidence as provided for in **Form TM22-A** and these Guidelines. These must include the following:

- (a) certified copies of identification documents;
- (b) certified copies of professional and educational qualifications; and
- (c) any other documentation which the applicant considers would assist the Commission in properly considering and determining the applicant’s qualification and experience.

1.1.2 An applicant is also required to meet the Commission’s fit and proper test as specified in section 2 of these Guidelines in order to be approved as a trade mark agent.

1.1.3 **Form TM22-A** must not be used unless it is the applicant’s intention to act in his or her independent capacity if approved by the Commission. An individual who is approved by the Commission and registered as a trade mark agent cannot act in the name of a company or a partnership. He or she effectively acts as a sole proprietorship in functioning as a trade mark agent.

1.2 Approval of a partnership or legal person to act as a trade mark agent

1.2.1 Each application submitted by a partnership or legal person for approval to act as a trade mark agent must highlight the applicant’s qualifications, experience, competence and integrity and be accompanied by supporting evidence as provided in **Form TM22-B** and these Guidelines. These must include the following:

- (a) proof of:
 - i) registration under the Partnership Act, 1996; or

ii) licensing by the Commission as a registered agent under the Banks and Trust Companies Act, 1990; or

iii) incorporation or continuation as a company under the BVI Business Companies Act, 2004; and

(b) certified copies of identification documents; and

(c) any other documentation which the applicant considers would assist the Commission in properly considering and determining the applicant's qualification and experience.

1.2.2 In addition to meeting the general requirements in respect of qualification, experience, competence and integrity, an application submitted by a partnership or legal person for approval to act as a trade mark agent must identify at least one individual within the partnership or legal person who has an appreciable knowledge of trade mark law. What constitutes "appreciable knowledge of trade mark law" is determined by the Commission in its discretion. However, as a guide, the Commission will consider any of the following:

(a) Whether any of the qualifications of the individual is in the area of or relates to intellectual property law;

(b) Whether the individual had previously carried out any work in the area of intellectual property law or administration, whether in an office setting or otherwise;

(c) Whether the individual is currently pursuing any form of training in any area of intellectual property;

(d) Having regard to the individual's qualification, experience and knowledge, the Commission is satisfied that the individual is capable of discharging the duties and responsibilities of a registered trade mark agent.

1.2.3 The individual identified by a partnership or legal person must attest to the accuracy and truthfulness of the responses provided in **sections 5 through 9** of **Form TM22-B** and provide the supporting documents outlined in paragraph 1.1.1 above.

1.2.4 Partnerships and legal persons applying to act as trade mark agents, as well as the individual identified as having an appreciable knowledge of trade mark law are all required to meet the Commission's fit and proper criteria as specified in **section 2** of these Guidelines in order to be approved as a trade mark agent. The same applies to an individual applicant for approval as a registered trade mark agent.

2. Meeting the Commission's fit and proper criteria

2.1 Fitness and Propriety of Individual Applicants

2.1.1 Before granting approval as a trade mark agent, the Commission must be satisfied that the applicant is fit and proper in accordance with Schedule 1A of the Regulatory Code, 2009 ("Schedule 1A"). The Commission exercises judgement and discretion when assessing fitness and propriety, and takes into account the following matters:

- honesty
- integrity
- reputation
- competence
- expertise
- experience
- capability
- financial soundness

2.1.2 The character and integrity of a proposed trade mark agent are key determining factors in the processing of an application for approval. It is also the responsibility of the applicant to demonstrate that he/she has the relevant skills and experience to perform the duties of a trade mark agent.

2.1.3 In order for the Commission to be able to assess the fitness and propriety of an individual applying to be a registered trade mark agent, all applicants must complete **section 6 of Form TM22-A**. The questions listed in **section 6** embody the requirements set out in Schedule 1A and will allow the Commission to make a sound determination as to the applicant's ability to perform the duties of a registered trade mark agent.

2.2 Fitness and Propriety of Partnerships and Legal Persons

2.2.1 In the case of a partnership or legal person applying for approval as a trade mark agent, at least one individual within the partnership or legal person with knowledge of trade mark law must be identified. Partnerships and legal persons approved as trade mark agents will be held directly responsible for the conduct of any individual identified in their applications.

2.2.2 The Commission, in considering an application from a partnership or legal person will assess the fitness and propriety of the partnership or legal person in addition to any individual(s) identified in the application. In assessing the fitness and propriety of a partnership or legal person, the Commission will take into account the requirements set out in Schedule 1A and conduct the necessary regulatory checks to satisfy itself that the applicant meets the following fit and proper criteria:

- honesty and integrity

- competence and capability
 - financial soundness
- 2.2.3 The individual identified by the partnership or legal person in its application is required to complete **section 9 of Form TM22-B** and attest to the accuracy and truthfulness of the responses provided to **questions 5 through 9 of Form TM22-B**. All necessary supporting documentation must be provided to enable the Commission to properly assess the application.
- 2.2.4 Where a person submits an application for licensing or other approval as a regulated person at the same time or around the same time as the application for approval as a trade mark agent, the Commission may consider and take a decision on both applications at the same time. The fit and proper criteria will be independently applied in respect of both applications.
- 2.2.5 The approval of one application may not necessarily translate into approval of the other. This may be the case, for instance, where the person (being a legal person) satisfies the fit and proper criteria, but the individual identified in an application for approval as a trade mark agent is found not to have an appreciable knowledge of trade mark law or is not competent. Similarly, one application may meet all the necessary requirements of the law, while another may be deficient on the evidence provided. It is therefore the responsibility of all applicants to ensure that they review and satisfy themselves of the completeness of their applications before making a submission to the Commission.

3. Consequence of registration as a trade mark agent

- 3.1 Once an applicant's application is considered and approved by the Commission, the applicant will be registered as a trade mark agent and notified accordingly. Registration as a trade mark agent effectively entitles a person to practice as a trade mark agent. This practice is not restricted to filing applications and processing other documentation with or through the Office of Trade Marks, Patents and Copyrights pursuant to the Trade Marks Act and subsidiary legislation made thereunder; the registration entitles every trade mark agent to perform duties as may be ascribed to or ordinarily performed by a trade mark agent under the Patents Act, Copyright Act and all other intellectual property legislation.

4. Trade mark agent ceasing to be fit and proper

- 4.1 The onus is on the registered trade mark agent to ensure that he or she meets the fit and proper criteria at the application stage and on an ongoing basis. If at any point during the currency of a valid registration the trade mark agent ceases to be fit and proper, he or she is obligated to notify the Commission in writing of that fact immediately. This obligation also extends to any individual identified by a partnership or legal person and approved by the Commission as having an appreciable knowledge of trade mark law.
- 4.2 Where a registered trade mark agent who no longer meets the fit and proper criteria fails to notify the Commission of that fact as outlined in paragraph 4.1 above, the Commission will, upon becoming aware of that fact, suspend, cancel or revoke the

registration. If the registered trade mark agent is also a regulated person under any financial services legislation, the Commission may consider further action pursuant to the Financial Services Commission Act (“FSC Act”). Any of these actions against a registered trade mark agent will likely make it difficult to obtain future approval from the Commission for registration as a trade mark agent. It is therefore important that registered trade mark agents that no longer meet the fit and proper criteria immediately notify the Commission of that fact. In providing the notification, they may include information on the steps they are taking to meet the fit and proper criteria and when they expect they will be able to do so. This will assist the Commission in making an appropriate decision on the notification.

- 4.3 In circumstances where the individual identified by a partnership or legal person as having an appreciable knowledge of trade mark law is no longer fit and proper, the Commission may, instead of suspending, cancelling or revoking the registration of the partnership or legal person as a trade mark agent, require the partnership or legal person to replace the individual within such period as the Commission may, in its discretion, specify. The exercise of the discretion will be guided in large measure by the number of transactions the partnership or legal person performs as a trade mark agent and the frequency thereof. The higher the transactions and frequency, the more likely that a shorter period will be applied for requiring a replacement of the individual.
- 4.4 If a trade mark agent’s approval is suspended, cancelled or revoked or, in the case of a partnership or legal person the individual identified and approved as having an appreciable knowledge of trade mark law is no longer considered fit and proper, by the Commission, the trade mark agent shall immediately cease functioning as a trade mark agent. If any transaction by the trade mark agent is outstanding at the time of suspension, cancellation or revocation of its registration, the trade mark agent shall make necessary arrangements to transfer the conduct of the transaction or make other suitable arrangements so as not to unduly affect the interests of an owner of a trade mark or patent, or a person with a copyright interest or other intellectual property right.

5. **Withdrawal, resignation and refusal**

- 5.1 An applicant can withdraw an application for approval as a trade mark agent at any time before the Commission has reached a decision. The withdrawal must be made in writing addressed to the Commission and submitted through the Office of Trade Marks, Patents and Copyright. Although there is no requirement for reasons to be given for a withdrawal of an application, applicants may consider it prudent to give reasons, especially if they intend to submit an application in the future for approval; otherwise, questions will necessarily arise with regard to the reasons for withdrawal of an earlier application and the applicant will need to provide reasons as a result.
- 5.2 Furthermore, a registered trade mark agent may at any time submit an application to the Commission seeking the cancellation or revocation of his or her registration. This must be done using **Form TM23** and reasons must be provided for the application. The Commission will consider the application for cancellation or revocation, along with the reasons provided therewith, and grant approval if it is satisfied that the trade mark agent does not have any pending matter in relation to a trade mark, or that the

trade mark agent has made appropriate arrangements for any pending matter, and a cancellation or revocation would not prejudice any person with regard to those arrangements. It is therefore important that at the time of submitting an application for cancellation or revocation as a trade mark agent, sufficient information is provided with regard to the status of any trade mark matter that the trade mark agent may have pending. Where the trade mark agent does not have any pending matter, this fact should be stated clearly.

5.3 A trade mark agent may at any time resign as a trade mark agent of an owner of a trade mark, patent or copyright. However, before doing so, the trade mark agent must, at least 60 days before the intended date of resignation, notify the owner of the trade mark, patent or copyright of his intention in writing. The registered trade mark agent must at the same time notify the Registrar of this intention in writing, confirming that the owner of the trade mark, patent or copyright has been notified of the intention, and the date when that notification was given.

5.4 A notification by a trade mark agent to resign takes effect in one of two ways:

- i) on the date of resignation specified in the notification to the Registrar, provided the date of resignation is not less than 60 days from the date the Registrar receives the notification;
- ii) if the notification does not specify a date of resignation, the effective date is 60 days from the date the Registrar receives the notification.

Any trade mark agent wishing to resign from representing an owner of a trade mark, patent or copyright should therefore bear these effective dates in mind and act accordingly. There is no short cut to the effective dates which must be fully complied with in order to enable the owner sufficient time to appoint another trade mark agent.

5.5 Where the Commission refuses an application, this will be communicated in writing to the applicant. The Commission will provide its reason(s) for refusing an application. An applicant whose application has been refused may appeal the Commission's decision to the Financial Services Appeal Board in accordance with the FSC Act (or any substituting legislation).

6. Approval not conclusive of a future approval

6.1 The Commission evaluates applications for the appointment of a trade mark agent on an individual basis. In approving applications, the Commission takes the position that approval as a trade mark agent is not an indication that, should the individual, partnership or legal person cease to act as a trade mark agent, they will be approved to act as a trade mark agent in the future should another application be received by the Commission. Any future application will be considered and determined on its own merit.

7. Failure to pay annual renewal fee

7.1 When a person is approved by the Commission to act as a trade mark agent, the person is entitled to practice as such so long as he or she continues to be fit and proper

and pays the requisite renewal fee. The renewal fee is payable each year on the anniversary of the registration as a trade mark agent. The Commission will allow a trade mark agent up to a maximum of one month from the date when the renewal fee was due to effect payment of the fee.

- 7.2 Where a trade mark agent fails to pay the requisite annual renewal fee, the trade mark agent will cease to be an approved trade mark agent and shall be de-registered as such. If at any future time the individual, partnership or legal person wishes to be approved as a trade mark agent, a new application would have to be submitted to the Commission.

8. Registration not transferable

- 8.1 The approval and registration of a person as a trade mark agent is personal and not transferable. A trade mark agent cannot therefore transfer or allow another person to use or act on its approval and registration to carry out the duties of trade mark agent. A trade mark agent that allows any such activity will be considered by the Commission to be no longer fit and proper to act as a trade mark agent.

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[sgd:] Robert A. Mathavious
Managing Director/CEO
BVI Financial Services Commission