



Trade Marks (Filing) Guidelines, 2018

Issued by the Financial Services Commission under the Trade Marks Rules, 2015.

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INTRODUCTION

Rule 117 of the Trade Marks Rules, 2015 (the “Rules”) empowers the Registrar of Trade Marks, Patents and Copyright (the “Registrar”) to prepare and issue guidelines to ensure proper completion of any of the forms in the Schedule of the Rules (the “Forms”), as well as the timely processing of applications, notices, requests and other matters under the Rules. The Trade Marks (Filing) Guidelines, 2018 (the “Guidelines”) are designed to assist with the efficient and effective processing of applications, requests and other documents within the Office of the Registrar (the “Registry”).

The Guidelines have been developed to outline the business hours of the Registry for inspecting the Register of Trade Marks (the “Register”) and the assignment of filing dates. Guidance is provided on the standard address format on forms, as well as, which forms must be completed when making amendments to filed forms. Guidance is also provided on the completion of forms and the treatment of incomplete forms. The Guidelines outline filing requirements related to stamp duty, descriptions of trade marks, reclassification of trade marks under the Nice Classification and registrable transactions, mergers or other operations of law, including how fees are to be paid for filing changes to trade mark registrations. The Guidelines also provide clarity on submission of trade mark representations and description of goods and services.

To avoid unnecessary delays at the application processing stage, applicants are urged to adhere closely to the Guidelines as the Registry will rely on them in processing any requests or filings. The Guidelines should be read in conjunction with the Trade Marks Act, 2013 (the “Act”) and the Rules in order to have a better understanding of the obligations in relation to the Trade Marks regime. Where there is uncertainty as to the requirements or meaning of any subject contained in or connected with any Form in the Schedule, the applicant should consult the Registrar. The Guidelines may be amended if there are any changes to the existing Trade Marks regime or in any other circumstance in which the Registrar deems it necessary.

GUIDELINES

1. *Business Hours*

- 1.1. The Registry is open to the public Mondays through Fridays (business days), except for public holidays, from 8:30 a.m. until 4:00 p.m. Inspections of the Register can be made from 8:30 a.m. to 4:00 p.m. during business days.
- 1.2. Any requests or filings made after 4:00 p.m. on a business day will receive a filing date of the following business day.

2. *Forms of Address*

- 2.1. All addresses should include street or postal address, city, post code/ zip code and country. Failure to include a full address on any form for which an address is required may result in the form being treated as an incomplete form as per the Guidelines.
- 2.2. The standard address format for the relevant country as prescribed by its post office or equivalent authorising agency will be used by the Registry for all correspondence.

Example: State abbreviations and street name and number in the United States of America will be expected to be the standard address format for that country as shown below:

4000 University Drive
Fairfax, VA 22030
United States of America

For a country that does not provide a post code/zip code or a comprehensive address system, the absence of this requirement will not be an impediment to the processing of an application so long as the standard address format of the country concerned is fully adhered to.

3. *Completion of Forms*

- 3.1. Where there is provision for the selection of any matter within a form prescribed by the Rules or by the Registry, all irrelevant information should be struck out. Failure to strike out irrelevant information may result in the form being treated as an incomplete form.

4. *Incomplete Forms*

- 4.1. Any form submitted to the Registry which is not completed in accordance with these Guidelines and the policies and procedures of the Registry will not be processed. The Registry shall issue a notice of deficiency in respect of any Incomplete Form to the Applicant.
- 4.2. This includes, but is not limited to, the striking out of irrelevant information on the relevant form.

5. *Amendment to Forms*

- 5.1. Requests to amend Form TM 1 should be processed using the prescribed Form TM 2. In any other case a request to the Registrar in writing which clearly outlines the desired amendment and the reason for the amendment should be made.
- 5.2. The requisite fees for each request for amendment will be in accordance with the Financial Services (Trade Marks Fees) Regulations, 2015.

6. *Stamp Duty*

- 6.1. Stamp duty as prescribed by the laws of the Virgin Islands must be paid on all conveyances, including assignments and other registrable transactions before being filed with the Registry.
- 6.2. Failure to submit proof of payment of the stamp duty will result in the application being treated as incomplete.
- 6.3. Proof of payment may be established through a receipt, the original conveyance, assignment or other transaction with the original stamps affixed thereon, or a stamped mark embossed on such conveyance, assignment or other transaction. The Registrar may accept other forms of proof of payment if satisfied that such forms are authentic and are a true representation of proof of payment.

7. *Filing of Registrable Transactions under the Trade Marks Act, 2013, Mergers and other operations of law*

- 7.1. An applicant wishing to register a registrable transaction, merger or other transaction in relation to a trade mark registration must conduct a search of the Register prior to making an application, if the applicant is not the registered proprietor or the registered Trade Mark Agent (“Agent”) on record.

- 7.2. Any schedule filed in support of an application to register a registrable transaction, merger or other transaction which includes an inaccurate date of registration and/or trade mark registration number or any other information which could be obtained from a search of the Register will not be accepted. The application which accompanies that schedule will be treated as incomplete and will not be processed without an amendment in accordance with the Guidelines.
- 7.3. Where a schedule filed in support of an application to register a registrable transaction, merger or other transaction (the "Transaction") refers to multiple BVI trade mark registrations and the applicant does not wish to register the Transaction against all BVI trade mark registrations, the Agent must provide notice to the Registrar in writing as to this intent.
- 7.4 An applicant wishing to record multiple registrable transactions, mergers or other transactions against the same trade mark registration and on the same date should file separate Forms with an accompanying cover letter indicating the order in which the transactions should be registered.

8. Fees for filing changes to a Trade Mark Registration

- 8.1. Fees payable upon filing Form TM 19 or any other relevant Form pursuant to the Financial Services (Trade Marks Fees) Regulations, 2015 are in respect of each change which is made to a singular trade mark registration.

Example: Changes to the service address, trade mark owner's address, and trade mark owner's name will attract separate fees for each registration.

9. Submission of Representations of Trade Marks and Descriptions of Goods and Services

- 9.1. An applicant is required to submit an electronic copy of the trade mark representation in either jpg. or png. format in support of every application for the registration of a trade mark along with the corresponding specification of goods and/or services in word format to the Registry's designated email address upon filing Form TM 1.
- 9.2. The Registry may specify further requirements for the improvement of the quality of the trade mark representations submitted, including but not limited to a change in the file format.
- 9.3. Failure to submit the electronic copies as set out in these Guidelines will result in the application being treated as incomplete.

10. Descriptions of Trade Marks

- 10.1. An application for the registration of a trade mark, other than a mark which consists exclusively of letters, must include a detailed description.
- 10.2. Where an application for the registration of a trade mark makes a claim for colour as an element of the trade mark, the application must include details as to the colours claimed and the configuration of the colours, which may include but are not limited to, Pantone or RGB colour specifications, in the trade mark, if applicable.
- 10.3. Where an applicant seeks to register a 3-dimensional shape, the applicant must provide details as to the dimensions of the mark along with supporting documentation which would distinguish the 3-dimensional shape from other marks which may be in use or come into use in the market.

11. Proposals for Reclassification from Registered Trade Mark Agent

- 11.1. An Agent may propose that a trade mark registration, which has not yet been reclassified by the Registrar under section 95 of the Act and which has not been the subject of a Notice of Proposed Change to Classification be reclassified in accordance with the latest edition of the Nice Classification.
- 11.2. A proposal for reclassification from an Agent must be made to the Registrar in writing accompanied by the prescribed fee.

12. Post Registration Defectives

- 12.1. Post-Registration Notices of Deficiency issued by the Office in respect of post-registration filings should be addressed within 2 months of the date of the notice of deficiency.
- 12.2. Failure to address the deficiency contained in a post-registration Notice of Deficiency to the satisfaction of the Registrar within the time prescribed will result in the application or request being treated as abandoned.
- 12.3. Fees paid in respect of a filing or request which has been treated as abandoned by virtue of this paragraph shall not be refunded.
- 12.4. Nothing in this paragraph prevents an applicant from presenting a new application or request in respect of any matter which was the subject of a filing or request which was treated as abandoned under this paragraph

13. Distinction between former UK trade mark registrations and local trade mark registrations

13.1 The Office shall distinguish all trade mark registrations previously registered in the territory under the Registration of United Kingdom Trade Marks Act (Cap. 157 of the Laws of the Virgin Islands) (“Cap. 157”) by including the prefix “UK” before the trade mark registration number.

13.2. An applicant is asked to use the prefix “UK” when referring to trade mark registrations which were originally re-registered under Cap. 157 in all correspondence with the Office, including but not limited to any prescribed forms.

Issued this 15th day of November, 2018.

Registrar
Trade Marks, Patents and Copyright