



# 3<sup>rd</sup> Meeting of the Office of Trade Marks, Patents & Copyright with Trade Mark Agents

12 October 2022

## Question & Answer Segment

1. **How are marks treated that have not been renewed and restored within the six months after their due date, but have not been removed from the Register of Trade Marks? Can they be restored and renewed once they have not been removed?**
  - A. **Marks that have not been renewed or restored after their expiry date, are subject to removal from one (1) day after the date of expiration. If the marks have not been removed from the Register, the agent can still restore the mark by payment of the renewal, restoration, and penalty fees.**
  
2. **How does SPC's work in the BVI? Is it simply an actual re-registration of the UK SPC in the BVI or an actual Registration in the BVI under some specific laws for these types of Patent Matters?**
  - A. **There are no originating patents in the BVI. European Union (EU) and United Kingdom Patents are Re-Registered in the BVI as are their respective SPC's.**
  
3. **What about the Registration of Trade Mark Designs? How are they captured in the legislation?**
  - A. **The process of registering a trade mark design is the same as with any other trade mark registration. A high-quality JPEG Image of the mark is required and a description of the mark. The owner may also wish to claim protection for specific colors of the design element(s) of the mark.**
  
4. **What is the difference between "WORD" and "SCRIPT/WORD" on the TM1 Application?**
  - A. **A Trade mark that is a "WORD" is presented in BLOCK LETTERS and a Script/ Word is presented in fanciful/ stylised text (see Trade Mark Script Font).**
  
5. **What sort of description is sufficient where you have a mark that is not a word Mark?**
  - A. **The description of the mark is for the benefit of the mark's protection. It is in a trade mark owner's best interests to ensure that their mark is adequately described. The office cannot dictate what is sufficient or insufficient - that discretion is the owner's who may wish to have the benefit of legal advice.**
  
6. **Is the description of goods/ services recorded on the register in the new classes after reclassification?**

**A. Yes. Prior to the Mark being reclassified our Office would issue a Notice of Proposed Change of Classification to the Proprietor, via their agent. When a trade mark registration class has to be split, there will be a footnote on the Notice explaining which goods are now in which class (es).**

**7. Can the name of the trade mark be stated on the Notices issued by the Registry?**

**A. The single identifier for the Office is the Trade Mark Registration Number. If the objective is to easily identify the mark on any notice issued there may be an issue as not all marks are distinctly labeled with a name. For example, the Registry may have hundreds of marks named “Device” or “Figurative Mark”.**

**8. Why are application numbers not listed on the Record of Search?**

**A. If a Trade Mark/ Patent is already registered, the Registration No. will be listed on the Record of Search. If the Trade Mark/ Patent is not registered, then the application number will be listed.**

**9. Are there any future plans on doing searches or other applications online and not just email? If so, what is the time frame?**

**A. The Office does have plans to be fully digitised by 2024. We are currently looking at amendments to the VIRRGIN system which will make provisions for digital filings.**

**10. With respect to searches can a little more information be added to the search such as a description of classes, pending applications?**

**A. In some instances, the pending applications are provided on the Records of Search. Due to the vast expansive nature of many of the description of goods and services, they are often times excluded from the Records of Search.**

**11. With respect to assignments, if an agent is given power of Attorney, to act on behalf of the owner, why can't the agent make simple amendments to the assignment documents if required? Should the agent be given a Power of Attorney from both the Assignor/ Assignee to do this?**

**A. The Office cannot issue legal advice on the operation and/or limitation in the application of a Power of Attorney - what is meant by assignment documents? TM agents should ensure that clients obtain requisite legal advice prior to employing non- traditional approaches to filing.**

**12. When an Agent's address is changed or updated in the registry system, shouldn't that address be changed automatically for marks that the agent is already the agent for? Instead of submitting a new change for every trade mark?**

A. At present time, there are currently no provisions under the Trade Marks Fees Legislation for bulk filings.

**13. When will the new application forms be available to agents?**

A. The New PDF Fillable application forms have undergone a period of testing and fine tuning and they are finally ready to be made available on the Commission's website.

**14. Will the Forms be amended to include special characters?**

A. Adobe pdf does not have an option for enabling special characters, as it is not a word processor, but more of a form builder. To input special characters on the PDF Fillable forms, you would have to copy and paste your special character text from a word processor like MS Word which has special character features.

**15. Are hard copies of documents mandatory once submitted electronically?**

A. No. Once the documents have been submitted electronically, there is no need for the hard copies unless expressly requested by the Office.

**16. Will the Commission allow partnerships not registered under the Partnership Act, 1996 to act as a Registered Trade Mark Agent?**

A. No. Section 34(1) of the Trade Marks Act provides that "*A trade mark agent may be an individual, a partnership or a legal person.*" Section 34(3)(a)(i) specifically provides that "*Where an applicant for approval as a registered trade mark agent is a partnership, the Commission shall satisfy itself that— (a) the partnership — (i) is formed or registered under the Partnership Act;*".

If the Commission were to approve partnerships not registered under the Partnership Act, as trademarks agents, such approvals would be *ultra vires*, and in direct conflict with section 34(3) (a) (ii) of the Trade Marks Act.