

CAYMAN ISLANDS



Trade Marks Law, 2016

TRADE MARKS (TRANSITIONAL PROVISIONS) REGULATIONS, 2017

(SL 62 of 2017)

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Arrangement of Regulations

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CAYMAN ISLANDS**Trade Marks Law, 2016**

TRADE MARKS (TRANSITIONAL PROVISIONS) REGULATIONS, 2017

(SL 62 of 2017)

In exercise of the powers conferred by section 71 of the Trade Marks Law, 2016, *Law 31 of 2016*, the Cabinet makes the following Regulations —

Citation and commencement

1. (1) These Regulations may be cited as the Trade Marks (Transitional Provisions) Regulations, 2017.
(2) These Regulations shall come into force immediately after the coming into force of the *Trade Marks Law, 2016*.

Transitional provisions

2. Schedule 1 shall have effect with respect to transitional matters.

Form

3. A request to divide a series mark registered in accordance with the repealed provisions shall be in the Form in Schedule 2.

SCHEDULE 1

(Regulation 2)

Transitional Provisions pursuant to section 71 of the Law

Interpretation

1. For the purposes of these Regulations -

“commencement date” means the date that the Law comes into force;

“existing trade mark” means the record of an extension to the Islands of a right in or to a trade mark registered in the United Kingdom by virtue of the repealed provisions;

“new Register” means the Register of Trade Marks under section 8 of the Law; and

“former Register” means the register under the repealed provisions.

Matters before Court or Registrar at commencement date

2. (1) Where prior to the commencement date a matter was pending before the Court or the Registrar for a decision, that matter shall continue to be dealt with under the repealed provisions, unless otherwise provided for in these Regulations.
- (2) For the purposes of these Regulations, a matter shall be considered as pending before the commencement date if the matter was -
- (a) before the Registrar but no written decision on the matter had been issued by the Registrar before the commencement date;
 - (b) the subject of a written decision issued by the Registrar under the repealed provisions before the commencement date but the decision was subject to appeal and the period for commencing the appeal had not expired at the commencement date;
 - (c) the subject of proceedings which were pending before a Court immediately before the commencement date; or
 - (d) the subject of an order made by a Court before the commencement date but the order was subject to appeal and the period for commencing the appeal had not expired at the commencement date.

Existing trade marks

3. (1) From the commencement date, existing trade marks shall be transferred to the new Register and, subject to these Regulations, shall be considered as registered under the Law until the renewal date under the repealed provisions except where steps are taken, in accordance with the Law, to remove the trade mark from the Register.
- (2) From the commencement date, existing trade marks that were registered as a series under the repealed provisions shall be transferred to the new Register and, subject to these Regulations, shall be considered as registered until the renewal date under the repealed provisions, except where steps are taken in accordance with the Law to remove the trade mark from the Register.
- (3) An application for renewal of a series mark under paragraph 2 shall be for the renewal of the registration of each trade mark in the series separately in the form set out in Schedule 2.
- (4) The Registrar shall take such steps as may be necessary to ensure that an existing trade mark is not at variance with the absolute grounds or the relative grounds for refusal of registration and that it is otherwise consistent with the Law.
- (5) Where invalidity proceedings are instituted as a result of the steps taken under paragraph (4), the provisions of section 45 apply.

Pending proceedings

4. Where on the commencement date there is an entry in the former Register of a disclaimer, condition or restriction which relates to an existing trade mark, that entry shall be transferred to the new Register and shall have effect as if entered in the new Register in accordance with the provisions of the Law.

Current infringements

5. (1) The repealed provisions shall apply in relation to any infringement committed before the commencement date.
- (2) It is not an infringement of -
 - (a) an existing trade mark; or
 - (b) a registered trade mark of which the distinctive elements are the same or substantially the same as those of an existing trade mark and which is registered for the same goods or services,to continue on or after the commencement date use which did not constitute an infringement of the existing trade mark under the repealed provisions.



Assignment and transmission of registered trade mark

6. (1) An existing entry in relation to an assignment or transmission of an existing trade mark made pursuant to the repealed provisions shall be transferred on the commencement date to the new Register and shall have effect as if made under section 38 of the Law.
- (2) The Registrar may record entries from the former Register of existing assignment or transmission of an existing trade mark in the same form as is required for new entries made in the new Register on or after the commencement date.
- (3) An application for the registration of an assignment or a transmission which is pending on the commencement date shall be considered as an application for registration under section 39 of the Law and shall be dealt with accordingly.
- (4) The Registrar may require the applicant to amend the application for registration in order to conform to the requirements of the Law.

Licensing

7. (1) An entry in relation to a licence granted pursuant to the repealed provisions shall be transferred to the new Register on the commencement date and shall have effect as if made under section 39(2)(b) of the Law.
- (2) For the avoidance of doubt, sections 41 and 42 of the Law apply only in relation to a licence granted on or after the commencement date.
- (3) The Registrar may record any entries from the former Register of existing licences in the same form as is required for new entries in the new Register after the commencement date.
- (4) An application made pursuant to the repealed provisions for registration as a licensee which is pending on the commencement date shall be considered as an application for registration of a licence under section 41(1) of the Law and shall be dealt with accordingly.
- (5) The Registrar may require the applicant to amend the application so that the application conforms to the requirements of the Law.
- (6) Where on the commencement date proceedings for variation or cancellation of registration as a licensee are pending, the proceedings shall be dealt with under the repealed provisions and the Registrar may make such alterations to the Register as may be necessary as a result of the proceedings.

Pending application for registration

8. Where an application for the recording of an extension to the Islands of a right in or to a trade mark that was pending before the commencement date is approved and the extension recorded, the recording of the extension shall be considered as an existing trade mark.

Conversion of pending application

9. (1) Where an application for the renewal of the recording of an extension to the Islands of a right in or to a trade mark that was pending before the commencement date is renewed, the renewed recording of the extension shall be considered as an existing trade mark.
- (2) Section 20 of the Law applies in relation to applications for the renewal of registration of a trade mark made on or after the commencement date.



SCHEDULE 2

(Regulation 3)

Form

Form TM7

Request to divide a series mark registered under former Register
Regulation 3

For official use only

Fee \$100.00

Use this form to divide a series marks registered under the former Register.
This form must be accompanied by Form TM7 for each trade mark to be renewed.

1. Trade mark application number

2. Name of applicant

3. Name of agent

The name of the agent attending the hearing

Address

Email address

4. Trade marks to be divided

Enter a representation of the trade mark(s) in the space provided or attach on a separate sheet.

Tick if attached ☐

5. Classes

List the class number and specifications of goods and/services to be transferred and renewed

Class number:	Specification of goods and/or services:

Total number of classes ☐



6. Declaration

I declare that the information furnished above on behalf of the applicant is true to the best of my knowledge.

Signature**Name****Date (dd/mm/yyyy)**

Number of sheets attached to this form

Made in Cabinet the 25th day of July, 2017.

Kim Bullings
Clerk of the Cabinet.

