



**BERMUDA**

**TRADE MARKS REGULATIONS 2023**

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The Minister responsible for intellectual property, in exercise of the power conferred by section 94 of the Trade Marks Act 2023, makes the following Regulations:

### **Citation**

- 1 These Regulations may be cited as the Trade Marks Regulations 2023.

## **PART 1 PRELIMINARY**

### **Interpretation**

- 2 (1) In these Regulations—
- “Act” means the Trade Marks Act 2023;
- “appropriate fee” means—
- (a) the fee prescribed in relation to a matter concerning trade marks under the Government Fees Act 1965; or
  - (b) in the case of an international trade mark (BM) or any other matter regarding an international registration with respect to which paragraph (a) does not apply, the fee published by the World Intellectual Property Organization;
- “Court” means the Supreme Court of Bermuda;
- “form” has the meaning given in regulation 3;
- “Nice Agreement” means the agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, as amended from time to time;
- “Nice Classification” means the system of classification established by the Nice Agreement, as amended from time to time;
- “notification date” means the date on which any required notice or copy of any document is sent by the Registrar in accordance with these Regulations;
- “opposer” means a person who files a notice of opposition in accordance with these Regulations to an application filed with the Registrar;
- “specification” means the statement of goods or services in respect of which a trade mark is registered or proposed to be registered;
- “statement of grounds” means a statement of the grounds on which an application or opposition to any application, as the case may be, is based;
- “statement of truth” means a statement which provides that the person making the statement believes the facts stated in a particular document are true;
- “witness statement” means a written statement signed by a person that contains—

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- (a) the evidence which that person would be allowed to give orally; and
- (b) a statement of truth.

(2) References to the filing of any application, notice or other document, unless the contrary intention appears, are to be construed in these Regulations as references to the application, notice or other document being delivered to the Registrar at the Registrar's office.

### **Forms of the Registrar**

3 (1) In all cases where a form is prescribed for use with a filing or other submission to the Registrar or any other person under the regulations, that prescribed form or a replica of that form which contains the same information arranged in the same order as the prescribed form shall be used.

(2) Where there is no form prescribed for a specific matter or required submission, the Registrar may use a form prescribed in the United Kingdom as provided in section 94(3) of the Act.

(3) If there is no form prescribed in Bermuda or the United Kingdom, the submission shall be in such form and shall include such information as the Registrar or the Court may direct, as the case may be.

(4) The forms prescribed under these regulations shall be published separately in the website of the Registrar: [www.gov.bm](http://www.gov.bm), and shall be available for inspection at the offices of the Registrar.

### **Requirement as to fees**

- 4 (1) The appropriate fee shall be paid in respect of any—
- (a) application, registration or other entry in the register of trade marks;
  - (b) form, notice or other request filed with the Registrar; or
  - (c) other matters as provided in the Act or these Regulations.

(2) The appropriate fee shall be paid in respect of any application, request for extension, registration or other matter related to an international trade mark (BM) or international registration.

## **Part 2**

### **Application for registration**

#### **Application for registration**

- 5 (1) An application for registration of a trade mark—
- (a) shall be filed on Form TM 3;
  - (b) shall be accompanied by the appropriate fee or fees;
  - (c) may relate to one or more classes of goods or services.

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(2) Where an application relates to more than one class of goods or services, regulation 8 shall apply.

### **Claim to priority**

6 (1) Where a right to priority is claimed by reason of an application for protection of a trade mark duly filed in a Convention country under section 44 of the Act or in another country under section 45 of the Act (an “overseas application”), the application for registration under regulation 5 shall specify the—

- (a) number accorded to the overseas application by the registering or other competent authority of the relevant country;
- (b) country in which the overseas application was filed; and
- (c) date of filing.

(2) The Registrar may, in any particular case, by notice require the applicant to file, within such period of not less than 1 month as the notice may specify, such documentary evidence as the Registrar may require certifying or verifying to the satisfaction of the Registrar—

- (a) the matters required in paragraphs (1)(a) to (c);
- (b) the representation of the mark; and
- (c) the goods or services covered by the overseas application.

### **Classification of goods and services**

7 (1) The prescribed system of classification for the purposes of the registration of trade marks is the Nice Classification.

(2) Goods and services shall be classified according to the version of the Nice Classification in effect on the date of application for registration.

### **Application to specify class and may relate to more than one class**

8 (1) An application shall specify the—

- (a) class of goods or services in the Nice Classification to which it relates; and
- (b) goods or services that relate to such class.

(2) The specification required under paragraph (1)(b) shall describe the goods or services with sufficient clarity and precision to—

- (a) on that sole basis, enable the Registrar and other competent authorities and relevant members of the public to determine the extent of the protection sought; and
- (b) allow the goods or services to be classified under the Nice Classification.

(3) For the purposes of paragraph (2), an application may specify the general indications included in the class headings of the Nice Classification or other general

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terms, provided that they satisfy the requirement that the goods or services be described with sufficient clarity and precision as referred to in paragraph (2).

(4) Where the specification contained in the application describes the goods or services using general terms, including the general indications included in the class headings of the Nice Classification, the application shall be treated as including only the goods or services clearly covered by the literal meaning of the term or indication.

(5) Where the application relates to more than one class in the Nice Classification—

- (a) the specification shall set out the classes in consecutive numerical order; and
- (b) the specification of the goods or services shall be grouped accordingly.

(6) If an application relates to all the goods or services included in a class, or a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or intends to make, if and when it is registered.

(7) If the specification contained in the application lists items by reference to a class in which they do not fall, the applicant may request that the application be amended to include the appropriate class for those items.

(8) The Registrar shall amend an application upon receipt of the request for an amendment pursuant to paragraph (7) and payment of the appropriate fee.

### **Determination of classification**

9 (1) The Registrar shall send a notice to the applicant where the requirements in regulation 8(1) and 8(2) or 8(5) have not been met.

(2) A notice sent under paragraph (1) shall specify a period, of not less than 1 month, within which the applicant must satisfy those requirements.

(3) If the applicant fails to comply with specification requirements set out in regulation 8(1) and 8(2) before expiry of the period specified under paragraph (2), the application shall be rejected by the Registrar.

(4) If the failure relates to only a portion of the goods or services, the application shall be rejected by the Registrar, but only as relates to those goods or services to which such failure applies.

(5) Where the applicant fails to comply with the specification requirements set out in regulation 8(5) before expiry of the period specified under paragraph (2), the application shall be treated as abandoned.

### **Prohibition on registration of mark consisting of arms**

10 Where it appears to the Registrar that a representation of any arms or insignia referred to in section 6(4) of the Act appears in a mark, the Registrar shall refuse to accept an application for registration of the mark unless he is satisfied that the consent of the person entitled to the arms has been obtained.

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### **Address for service**

11 (1) For the purposes of any proceedings under the Act or these Regulations, an address for service shall be filed by—

- (a) an applicant for the registration of a trade mark;
- (b) any person who opposes the registration of a trade mark in opposition proceedings;
- (c) any person who applies for a declaration of invalidity, revocation or rectification of a registration under the Act; and
- (d) the proprietor of the registered trade mark who opposes an application referred to in paragraph (c).

(2) The proprietor of a registered trade mark and any person who has a registered interest in a registered trade mark, may file an address for service with the Registrar.

(3) An address for service filed under this regulation shall be a physical address in Bermuda and may be substituted from time to time by filing notice of any change with the Registrar.

### **Failure to provide an address for service**

12 (1) Where—

- (a) a person has failed to file an address for service under regulation 11(1); and
- (b) the Registrar has sufficient information enabling him to contact that person,

the Registrar shall direct that person to file an address for service.

(2) Where a direction has been given under paragraph (1), the person directed shall, before the end of the period of two months beginning immediately after the date of the direction, file an address for service.

(3) Paragraph (4) applies where—

- (a) a direction was given under paragraph (1) and the period prescribed by paragraph (2) has expired; or
- (b) the Registrar had insufficient information to give a direction under paragraph (1), and the person has failed to provide an address for service.

(4) Where this paragraph applies in the case of—

- (a) an applicant for registration of a trade mark, the application shall be treated as withdrawn;
- (b) a person opposing the registration of a trade mark, that person's opposition shall be treated as withdrawn;



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- (c) a person applying for a declaration of invalidity, revocation or rectification, that person's application shall be treated as withdrawn; and
- (d) a proprietor opposing an application referred to in paragraph (c), the proprietor shall be deemed to have withdrawn from the proceedings.

(5) In this regulation an "address for service" means an address that complies with regulation 11(3).

### **Deficiencies in application**

13 (1) Where an application for registration of a trade mark does not satisfy the requirements of section 41(2), (3) or (4) of the Act or regulation 5(1), the Registrar may send notice to the applicant to remedy the deficiency or default of payment, as the case may be.

(2) A notice sent under paragraph (1)—

- (a) shall specify a period, of not less than seven days, within which the applicant must remedy the deficiency or default of payment; and
- (b) may require payment of the appropriate fee for excess processing in relation to any deficiency to be remedied by the applicant.

(3) Where, before the expiry of the period specified under paragraph (2), the applicant—

- (a) fails to remedy any deficiency notified to the applicant in respect of section 41(3) of the Act, the application shall be deemed never to have been made; or
- (b) fails to—
  - (i) make payment as required by section 41(2) of the Act or in accordance with paragraph (2)(b); or
  - (ii) remedy any deficiency notified to the applicant in respect of section 41(4) of the Act or regulation 5(1),

the application shall be treated as abandoned.

### **Notifying results of search**

14 (1) Where following a search of the register in accordance with section 46(2) of the Act it appears to the Registrar that the requirements for registration are not met due to the existence of any relative ground for refusal mentioned in section 7 of the Act, the Registrar shall notify this fact to the applicant.

(2) Regulation 63 shall not apply to any notification provided by the Registrar made in pursuance of this regulation.

### **Preliminary advice**

15 (1) Any person who proposes to apply or has made an application for the registration of a trade mark may make an application to the Registrar for preliminary

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advice as to whether it appears to the Registrar prima facie that the mark proposed for registration is capable of distinguishing goods or services of one undertaking from those of other undertakings as required by section 3(1)(b) of the Act.

- (2) An application under paragraph (1) shall—
  - (a) include a representation of the mark;
  - (b) where no application has been filed, indicate the goods or services to which the mark would relate if an application had been filed; and
  - (c) be accompanied by the appropriate fee.
- (3) The preliminary advice may relate to all or some only of the goods or services included in the application.
- (4) Preliminary advice issued by the Registrar under this regulation shall not be—
  - (a) a final decision by the Registrar; or
  - (b) subject to appeal.

### **Part 3**

#### **Publication, Oppositions, Observations and Registration**

##### **Publication of application for registration**

16 An application for registration that has been accepted by the Registrar shall be published in the Official Gazette.

##### **Opposition proceedings: filing of notice of opposition**

- 17 (1) A notice of opposition to an application for registration shall include a statement of grounds and shall be filed with the Registrar—
- (a) on Form TM 10;
  - (b) within a period of two months from the date of publication of the details of any application to which the notice of opposition relates.
- (2) Where the opposition is based on a registered trade mark, there shall be included in the statement of grounds—
- (a) a representation of that mark;
  - (b) details of the authority with which the mark is registered;
  - (c) the registration number of that mark;
  - (d) the goods and services in respect of which—
    - (i) that mark is registered; and
    - (ii) the opposition is based.

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(3) Where paragraph (2) applies and the registration procedure for the mark was completed before the start of the five year period ending on the date of application or the date of priority, if any, the statement of grounds shall include a statement of use detailing whether—

- (a) during the period referred to in section 10(3)(a) of the Act, the mark has been put to genuine use in relation to each of the goods and services in respect of which the opposition is based; or
- (b) there are proper reasons for non-use.

(4) Where the opposition is based on a trade mark in respect of which an application for registration has been made, the statement of grounds shall include—

- (a) a representation of that mark;
- (b) the details of the authority with which the application was made;
- (c) application number in relation to that mark; and
- (d) details regarding the goods and services to which the application relates.

(5) Where the opposition is based on an unregistered trade mark or other sign which the opposer claims is protected by any law (in particular, the law of passing off), the statement of grounds shall include—

- (a) a representation of that mark or sign; and
- (b) a description of the goods and services in respect of which such protection is claimed.

(6) The Registrar shall send a copy of any notice of opposition filed in respect of an application to the applicant.

### **Opposition proceedings: filing of counter-statement**

18 (1) Subject to paragraph (3), where a notice of opposition has been filed an applicant shall file a counter-statement on Form TM 10C within two months following the notification date with respect to the notice of opposition.

(2) Prior to the expiry of the period for filing a counter-statement under paragraph (1)—

- (a) the applicant and opposer (the “parties”) may agree to extend the deadline for filing the counter-statement;
- (b) following an agreement made in accordance with paragraph (a), either the applicant or opposer may file a request with the Registrar to extend the deadline for filing the counter-statement; and
- (c) a request for extension under paragraph (b) shall—
  - (i) state that the parties have agreed to the proposed extension; and
  - (ii) be accompanied by the appropriate fee.

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(3) Upon the Registrar's satisfaction that the parties have agreed to a request for extension filed under paragraph (2), the deadline for filing the counter-statement may be extended for up to eight months following the notification date.

(4) During the extended period provided for in paragraph (3)—

- (a) the applicant may file the counter-statement;
- (b) the opposer may file a notice to continue the opposition proceedings; or
- (c) the parties may agree to a further extension, following which either party may file a request for a further extension of time to file the counter-statement.

(5) Following receipt of a request for a further extension under paragraph (4)(c), the Registrar may extend the filing deadline for such time as he may reasonably determine.

(6) Where at any time following the Registrar's receipt of a request for extension under this regulation a notice to continue opposition proceedings is filed by either party, the date for filing the counter-statement shall be—

- (a) one month following the Registrar's receipt of the notice to continue; or
- (b) two months following the notification date to the applicant under regulation 17(6),

whichever is later.

(7) The Registrar shall send a copy of the counter-statement to the opposer.

(8) Where an applicant for registration fails to file a counter-statement within the time prescribed by this regulation, the application as regards those goods or services related to the opposition shall, unless the Registrar directs otherwise, be treated as abandoned.

### **Opposition proceedings: evidence rounds**

19 (1) Except as otherwise provided in the Act or these Regulations, evidence and submissions shall be filed within six months from the notification date by the Registrar to the parties to opposition proceedings where—

- (a) either party has filed a notice to continue under regulation 18; or
- (b) the opposition or part of it is based on grounds other than those set out in section 7(1) or (2) of the Act and the applicant has filed a counter-statement.

(2) An opposer of an application for registration shall file evidence supporting the opposition in cases where—

- (a) the opposition is based on an earlier trade mark of a kind falling within section 9(2) of the Act;

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- (b) the opposition or part of it is based on grounds other than those set out in section 7(1) or (2) of the Act; or
- (c) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant.

(3) Where paragraph (2) applies and the opposer fails to file evidence, the opposer shall be deemed to have withdrawn the opposition to the registration to the extent that it is based on—

- (a) the matters referred to in paragraph (2)(a) or (b); or
- (b) an earlier trade mark that has been registered and which is the subject of the statement of use referred to in paragraph (2)(c).

(4) The Registrar may at any time grant leave to either party to file evidence upon such terms as he thinks fit.

### **Procedure for intervention**

20 (1) In opposition proceedings based on the relative grounds for refusal set out in section 7(1), (2) or (3) of the Act, the following persons may file an application with the Registrar to intervene in the opposition proceedings—

- (a) licensees of an earlier trade mark; and
- (b) authorized users of certification marks and collective marks.

(2) Upon receipt of an application under paragraph (1), the Registrar may, after hearing the parties concerned if required, refuse or grant leave to intervene in the proceedings upon such terms and conditions (including any undertaking as to costs) as he thinks fit.

(3) Persons granted leave to intervene in an opposition proceeding under paragraph (2) shall, subject to any terms and conditions imposed by the Registrar in respect of the intervention, be treated as a party to the proceedings for purposes of regulations 19 and 62 to 68.

### **Observations on application to be sent to applicant**

21 The Registrar shall send to the applicant a copy of any document containing observations made under section 47(6) of the Act.

### **Publication of registration**

22 On the registration of the trade mark, the Registrar shall publish—

- (a) a reproduction of the registered trade mark; and
- (b) such other details as the Registrar thinks fit,

in the journal for industrial property which shall be published in the Official Gazette.

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### **Request to amend application**

23 A request for amendment of an application to correct an error or to change the name or address of the applicant or in respect of any amendment requested after publication of an application shall be made on Form TM 2.

### **Amendment of application after publication**

24 (1) Where—

- (a) a request is made under section 48 of the Act to amend an application that has been published in accordance with section 47 of the Act;
- (b) the amendment affects the representation of the trade mark or the goods or services covered by the application; and
- (c) the Registrar has accepted the amendment,

the amendment or a statement of the effect of the amendment shall also be published by the Registrar.

(2) Any person claiming to be affected by the amendment may within one month of the date on which the amendment or a statement of the effect of the amendment was published under paragraph (1) give notice to the Registrar of objection to the amendment on Form TM 10.

(3) A notice filed under paragraph (2) shall—

- (a) include a statement of the grounds of objection; and
- (b) indicate why the amendment would not fall within section 48(3) of the Act.

(4) The Registrar shall send a copy of the notice of objection filed to the applicant.

(5) The procedures in regulations 17, 18 and 19 shall apply to proceedings relating to the objection to the amendment of an application as they apply to proceedings relating to opposition to an application for registration, but with the following modifications—

- (a) any reference to—
  - (i) an application for registration shall be construed as a reference to a request for amendment of an application;
  - (ii) the person opposing the registration shall be construed as a reference to the person objecting to the amendment of an application;
  - (iii) the opposition shall be construed as a reference to the objection;
- (b) the relevant period, referred to in regulation 18(1), shall for these purposes be the period of two months beginning immediately after the notification date in accordance with paragraph (4); and
- (c) regulations 18(2) to (6) and 19(2) and (3) shall not apply.

**Part 4**

**Division, Merger and Series of Marks**

**Division of application**

25 (1) At any time prior to registration, an applicant may file with the Registrar a request to divide the specification included in his original application for registration into two or more separate applications (divisional applications).

(2) The request shall—

- (a) be submitted on Form TM 18, accompanied by the appropriate fee; and
- (b) indicate the specification of goods or services for each divisional application.

(3) Each divisional application shall be treated as a separate application for registration with the same filing date as the original application.

(4) Where the request to divide an application is sent after publication of the original application, any objections or opposition to the original application shall be taken to apply to each divisional application.

(5) Where, in relation to the original application, the Registrar has been provided with notice of particulars relating to any—

- (a) grant of a licence;
- (b) security interest; or
- (c) other right in or under the mark which is the subject of the application,

the notice and the particulars contained therein shall be deemed to apply in relation to each of the divisional applications.

**Division of registration**

26 (1) The proprietor of a trade mark may file with the Registrar a request to divide the specification of the registration into two or more separate registrations (divisional registrations).

(2) The request shall—

- (a) be submitted on Form TM 18, accompanied by the appropriate fee; and
- (b) indicate the specification of goods or services for each divisional registration.

(3) Each divisional registration shall be treated as a separate registration with the same registration date as the original.

(4) No request under paragraph (1) may be granted in respect of a registration which is the subject of any proceeding for revocation or invalidation where such request would introduce a division amongst the goods or services which are related to the proceeding.

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(5) Where the original registration is subject to a disclaimer or limitation, the divisional registrations shall also be subject to such disclaimer or limitation unless the Registrar directs otherwise.

(6) Where the registration includes particulars relating to—

- (a) the grant of a licence;
- (b) a security interest;
- (c) any right in or under the trade mark; or
- (d) any memorandum or statement of the effect of a memorandum,

the Registrar shall enter in the register the same particulars in relation to each of the divisional registrations.

### **Merger of separate registrations**

27 (1) The proprietor of two or more registrations of a trade mark resulting from applications filed on the same date may make an application to the Registrar to merge them into a single registration.

(2) The application under paragraph (1) shall be—

- (a) filed on Form TM 6; and
- (b) accompanied by the appropriate fee.

(3) The Registrar shall, if satisfied that the registrations are in respect of the same trade mark, merge them into a single registration.

(4) No application under paragraph (1) may be granted in respect of the registration of a trade mark which is the subject of—

- (a) proceedings for its revocation or invalidation; or
- (b) an international registration which has not become independent of the trade mark as provided for in accordance with Article 6 of the Madrid Protocol;

(5) Where the registration of a trade mark to be merged under paragraph (3) is subject to a disclaimer or limitation, the merged registration shall also be restricted accordingly.

(6) Where the registration of a trade mark to be merged under paragraph (3) includes particulars relating to

- (a) the grant of a licence;
- (b) a security interest;
- (c) any right in or under the trade mark; or
- (d) any memorandum or statement of the effect of a memorandum,



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the Registrar shall enter in the register the same particulars in relation to the merged registration.

(7) The date of registration of the merged registration shall, where the separate registrations bear different dates of registration, be the latest of those dates.

### **Registration of a series of trade marks**

28 (1) An application may be made under regulation 5 for the registration of a series of up to six trade marks in a single registration.

(2) An application under paragraph (1) to register a series of trade marks (as defined in section 50(2) of the Act) shall be—

- (a) filed on Form TM 3 ; and
- (b) accompanied by the appropriate fee.

(3) The Registrar shall accept an application under paragraph (1) on Form TM 3, if he is satisfied that the marks included in the application constitute a series.

(4) An applicant may at any time request the deletion of a mark included in an application that has been accepted by the Registrar pursuant to paragraph (3).

(5) Where a request under paragraph (4) is made—

- (a) the Registrar shall delete the affected mark from the application; and
- (b) the application for registration shall, in so far as it relates to the deleted mark, be treated as withdrawn.

(6) A proprietor of a registered series of trade marks may request deletion of a mark in that series.

(7) Following receipt of a request under paragraph (6), the Registrar shall delete the mark to which the request relates.

## **Part 5**

### **Collective and Certification Marks**

#### **Filing of regulations for collective and certification marks**

29 Where an application for registration of a collective or certification mark is filed, the applicant shall, within three months of the date of a notice from the Registrar, file a copy of the regulations governing the use of the mark.

#### **Amendment of regulations of collective and certification marks**

30 (1) The proprietor of a registered collective or certification mark may file an application to amend the regulations governing use of a registered collective or certification mark with the Registrar together with the appropriate fee.

(2) Where it appears to the Registrar that the amended regulations should be made available to the public, the Registrar shall publish the amendments in the Official

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Gazette together with a notice indicating where copies of the amended regulations may be inspected.

(3) Any person may, within two months of the date on which a notice under paragraph (2) was published—

- (a) make observations to the Registrar regarding the amendments relating to the matters referred to in paragraph 6(1) of Schedule 1 to the Act in relation to a collective mark, or paragraph 7(1) of Schedule 2 to the Act in relation to a certification mark; or
- (b) give notice to the Registrar of opposition to the amendment on Form TM 10 which shall include a statement of grounds indicating why the amended regulations do not comply with the requirements of paragraph 6(1) of Schedule 1 to the Act, or paragraph 7(1) of Schedule 2 to the Act.

(4) The Registrar shall send a copy of any observations or notice of opposition received to the proprietor.

(5) If a notice of opposition is filed within the required period, the procedure in the regulations 18 and 19 shall apply to the opposition proceedings relating to the amendment of regulations as they apply to opposition proceedings relating to an application for registration with the following modifications—

- (a) any reference to—
  - (i) the applicant shall be construed as a reference to the proprietor;
  - (ii) an application for registration shall be construed as a reference to an application for the amendment of the regulations;
  - (iii) the person opposing the registration shall be construed as a reference to the person opposing the amendment of the regulations;
- (b) the relevant period, referred to in regulation 18(1), shall for these purposes be the period of two months beginning immediately after the date upon which the Registrar sent a copy of the notice of opposition to the proprietor; and
- (c) regulations 18(2) to (6) and 19(2) and (3) shall not apply.

### **Registration subject to disclaimer or limitation**

31 Where an applicant for registration of a trade mark or a proprietor by notice in writing sent to the Registrar—

- (a) disclaims any right to the exclusive use of any specified element of the trade mark; or
- (b) agrees that the rights conferred by the registration shall be subject to a specified territorial or other limitation,

the Registrar shall make the appropriate entry in the register and publish such disclaimer or limitation.

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### **Alteration of registered trade marks**

32 (1) The proprietor of a registered trade mark may submit a request to the Registrar for such alteration of the mark as is permitted under section 53 of the Act by filing Form TM 2 .

(2) Following receipt of a request under paragraph (1), the Registrar may require evidence as to the circumstances in which the application is made.

(3) Where the Registrar proposes to allow the alteration, he shall publish the altered mark in the journal for industrial property published by the Registrar in accordance with section 93(1)(b) of the Act.

(4) Any person claiming to be affected by the proposed alteration may, within two months of the date of publication of the mark under paragraph (3), give notice on Form TM 10 to the Registrar of any objection to the alteration which shall include a statement of the grounds of objection.

(5) The Registrar shall send a copy of the notice of objection received under paragraph (4) to the proprietor.

(6) The procedure for opposition proceedings in regulations 18 and 19 shall apply to the proceedings for objection to the alteration as they apply to proceedings relating to opposition to an application for registration with the following modifications—

- (a) any reference to—
  - (i) the applicant shall be construed as a reference to the proprietor;
  - (ii) an application for registration shall be construed as a reference to a request for alteration;
  - (iii) the person opposing the registration shall be construed as a reference to the person objecting to the alteration;
  - (iv) the opposition shall be construed as a reference to the objection;
- (b) the notification date referred to in regulation 18(1) shall for these purposes be the date upon which the Registrar sent a copy of Form TM 10 to the proprietor;
- (c) regulations 18(2) to (6) and 19(2) and (3) shall not apply.

### **Surrender of registered trade mark**

33 (1) Subject to paragraph (2), a proprietor may surrender a registered trade mark by filing a written notice with the Registrar for surrender in respect of some or all of the goods or services for which the trade mark is registered.

(2) A notice under paragraph (1) shall—

- (a) be of no effect unless it includes the matters referred to in paragraphs (b) and (c);

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- (b) include the name and address of any person having a registered interest in the mark; and
  - (c) certify that any such person—
    - (i) has been given not less than three months' notice of the proprietor's intent to surrender the mark; or
    - (ii) is not affected or if affected, consents to the surrender.
- (3) The Registrar shall, upon the surrender taking effect, make the appropriate entry in the register and publish the date of surrender.

### **Part 6**

#### **Renewal and Restoration**

##### **Reminder of renewal of registration**

34 (1) Subject to paragraph (2), at least three months before the expiration of the last registration of a trade mark, the Registrar shall—

- (a) send to the registered proprietor notice of the approaching expiration of the registration; and
- (b) inform the proprietor at the same time that the registration may be renewed in the manner described in regulation 35.

(2) The Registrar is not subject to any liability by reason of any failure to notify the proprietor in accordance with paragraph (1) and no proceedings lie against any officer of the Registrar in respect of any such failure.

##### **Renewal of registration**

35 Renewal of registration shall be effected by filing a request for renewal on Form TM 9 at any time within the six-month period immediately preceding the date of expiration of the registration or following receipt of a notice from the Registrar pursuant to regulation 34(1).

##### **Delayed renewal and removal of registration**

36 (1) If the renewal fee has not been paid on or prior to the date of expiration of the last registration of a trade mark, the Registrar may publish that fact.

(2) The Registrar shall renew a registration without removing the mark from the register if a request for renewal is filed on Form TM 9 within six months from the date of expiration of the last registration.

(3) A request for renewal under paragraph (2) shall be accompanied by the appropriate fees for renewal and late renewal.

(4) Where no request for renewal is filed in accordance with paragraph (2), the Registrar shall, subject to regulation 37, remove the mark from the register.

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(5) The removal of the registration of a trade mark shall be published in the Official Gazette with effect from the day immediately following the expiry of the six month period referred to in paragraph (2).

### **Restoration of registration**

37 (1) Within the three month period following the date of removal of a mark from the register pursuant to regulation 36, the proprietor of the mark may file an application for restoration and renewal and late renewal of the registration.

(2) An application under paragraph (1) shall be accompanied by the appropriate fees for restoration, renewal and late renewal of the registration.

(3) Following receipt of an application filed in accordance with paragraphs (1) and (2), the Registrar may, if he is satisfied that the failure to renew was unintentional, restore the mark to the register and renew the registration.

(4) The restoration of the registration, including the date of restoration, shall be published in the Official Gazette.

(5) Where a mark is restored to the register, the proprietor of the mark may not bring an action for infringement against a third party who, acting in good faith, has provided goods or services under a sign which is identical with or similar to the mark in respect of the period beginning with the date of expiration of the registration and ending on the date its restoration is published in accordance with paragraph (4).

## **Part 7**

### **Revocation, Invalidation and Rectification**

#### **Application for revocation (on the grounds of non-use)**

38 (1) An application to the Registrar for revocation on the grounds set out in section 55(1)(a) or (b) of the Act shall be made on Form TM 17.

(2) The Registrar shall send a copy of the application to the proprietor of the registered trade mark.

(3) The proprietor shall file a counter-statement with the Registrar on Form TM 10C within two months of the notification date to the proprietor under paragraph (2).

(4) Where the proprietor fails to file evidence of use of the mark or evidence supporting the reasons for non-use of the mark within the period specified in paragraph (3), the Registrar may grant leave to the proprietor for a further period of up to two months within which the evidence shall be filed.

(5) The Registrar shall send to the applicant a copy of the counter-statement and any evidence of use or evidence supporting reasons for non-use filed by the proprietor.

(6) The registration of the mark shall be revoked if the proprietor fails to file the required Form TM 10C within the prescribed time period, unless the Registrar directs otherwise.

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(7) If the proprietor fails to file evidence within the period specified or within paragraph (3) or any further period specified by the Registrar under paragraph (4)—

- (a) the Registrar may treat the proprietor as not opposing the application for revocation; and
- (b) the registration of the mark shall be revoked,

unless the Registrar directs otherwise.

(8) The Registrar may, at any time, grant leave to either party to file evidence upon such terms as the Registrar thinks fit.

### **Application for revocation (on grounds other than non-use)**

39 (1) An application to the Registrar for revocation of a trade mark on the grounds set out in section 55(1)(c) or (d) of the Act shall—

- (a) be made on Form TM 17;
- (b) include a statement of grounds; and
- (c) be accompanied by a statement of truth.

(2) The Registrar shall send a copy of the application and the statement of grounds in respect of the application filed under paragraph (1) to the proprietor of the registered trade mark.

(3) The proprietor shall file a counter-statement with the Registrar on Form TM 10C within two months of the notification date to the proprietor of the matters specified in paragraph (2).

(4) The Registrar shall send to the applicant a copy of the counter-statement filed by the proprietor.

(5) If the proprietor fails to file the required counter-statement within the time prescribed in paragraph (3), the Registrar may treat the proprietor as not opposing the application and the registration of the mark shall be revoked, unless the Registrar directs otherwise.

### **Application for revocation (on grounds other than non-use): evidence rounds**

40 (1) Where the proprietor has filed a counter-statement under regulation 39, the Registrar shall specify the periods within which further evidence may be filed by the parties.

(2) If the applicant fails to file any further evidence in support of the application for revocation, he shall be deemed to have withdrawn the application unless the Registrar directs otherwise.

(3) The Registrar shall notify the proprietor of any direction given in respect of the application under paragraph (2).

(4) The Registrar may at any time grant leave to either party to file evidence upon such terms as the Registrar thinks fit.

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### **Application for invalidation: filing of application and counter-statement**

41 (1) An application to the Registrar for a declaration of invalidity under section 56 of the Act shall—

- (a) be filed on Form TM 20;
- (b) include a statement of grounds; and
- (c) be accompanied by a statement of truth.

(2) Where an application under paragraph (1) is based on a trade mark which has been registered, there shall be included in the statement required under paragraph (1)(b)—

- (a) a representation of that mark;
- (b) the details of the authority with which the mark is registered;
- (c) the registration number of that mark;
- (d) the goods and services in respect of which—
  - (i) the mark is registered; and
  - (ii) the application is based.

(3) Where paragraph (2) applies and neither section 56(5)(a) or (b) of the Act applies to the mark, there shall be included in the statement required under paragraph (1)(b) a statement of use detailing whether during the period referred to in section 56(6)(a) of the Act—

- (a) the mark has been put to genuine use in relation to each of the goods and services in respect of which the application is based; or
- (b) there are proper reasons for non-use.

(4) If the application under paragraph (1) is based on a mark for which an application for registration has been made, there shall be included in the statement required under paragraph (1)(b) those matters set out in paragraphs (2)(a) to (d), with references to registration being construed as references to the application for registration.

(5) If the application under paragraph (1) is based on an unregistered mark or other sign which the applicant claims to be protected by virtue of the law of passing off or any other law, then a representation of that mark or sign and the goods and services in respect of which such protection is claimed shall be included in the statement of grounds.

(6) The Registrar shall send a copy of the application for invalidation to the proprietor.

(7) The proprietor shall submit a counter-statement to the Registrar within two months following the notification date to the proprietor under paragraph 6.

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(8) If the proprietor fails to file a counter-statement within the time specified in paragraph (7), the registration of the trade mark shall be declared invalid, unless the Registrar directs otherwise.

### **Application for invalidation: evidence rounds**

- 42 (1) The Registrar shall send to the applicant for invalidation—
- (a) a copy of the counter-statement filed by the proprietor under regulation 41; and
  - (b) a notice inviting him to file evidence in support of the grounds on which the application for invalidation is made.
- (2) The notice under paragraph (1)(b) shall—
- (a) direct the applicant to send a copy of any evidence submitted to the proprietor and all other parties to the proceedings; and
  - (b) specify the time by which the applicant shall file any evidence supporting the application for invalidation with the Registrar.
- (3) Where—
- (a) the application for invalidation is based on an earlier trade mark of a kind falling within section 9(2) of the Act; or
  - (b) the application or part of it is based on grounds other than those set out in section 7(1) or (2) of the Act; or
  - (c) the truth of a matter set out in the statement of use required under regulation 41(3) is either denied or not admitted by the proprietor,
- the applicant shall file evidence supporting the application.
- (4) Where the applicant files no evidence under paragraph (3), the applicant shall be deemed to have withdrawn the application to the extent that it is based on—
- (a) the matters in paragraph (3)(a) or (b); or
  - (b) an earlier trade mark which has been registered and is the subject of the statement of use referred to in paragraph (3)(c).
- (5) The Registrar may at any time grant leave to the proprietor and any other party to file evidence upon such terms as he thinks fit.

### **Setting aside cancellation of application or revocation or invalidation of registration**

- 43 (1) This regulation applies where—
- (a) an application for registration is treated as abandoned under regulation 18(8);
  - (b) the registration of a mark is revoked under regulation 38(6) or regulation 39(4); or



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(c) the registration of a mark is declared invalid under regulation 41(8), and the applicant or the proprietor, as the case may be, claims that the decision of the Registrar to treat the application as abandoned or to revoke the registration of the mark or declare the mark invalid (the “original decision”) should be set aside on the grounds set out in paragraph (4).

(2) Where this regulation applies, the applicant or proprietor may apply to the Registrar to set aside his prior decision within three months following the date the application was refused or the register was amended to reflect the revocation or declaration of invalidity.

(3) The applicant or proprietor making an application under paragraph (2) shall—

- (a) include with the application the appropriate fee and any supporting evidence in relation to the matters set out in paragraph (4); and
- (b) send a copy of the application and supporting evidence to the other party to the proceeding which resulted in the Registrar’s original decision.

(4) Where the applicant or the proprietor demonstrates to the reasonable satisfaction of the Registrar that the failure to file a counter-statement within the prescribed time was due to a failure to receive a copy of the notice of opposition or application for revocation or declaration of invalidity, as the case may be, the original decision may be set aside on such terms and conditions as the Registrar thinks fit.

(5) In considering whether to set aside the original decision, the Registrar shall have regard to—

- (a) whether the person seeking to set aside the decision made an application to do so promptly upon becoming aware of the original decision; and
- (b) any prejudice which may be caused to the other party to the prior proceedings if the original decision were to be set aside.

### **Procedure on application for rectification**

44 (1) An application for rectification of an error or omission in the register under section 61 of the Act shall be filed with the Registrar and shall—

- (a) be accompanied by the appropriate fee; and
- (b) include a statement of grounds and any evidence to support such grounds.

(2) Where an application under paragraph (1) is made by any person other than the proprietor of the registered trade mark, the Registrar—

- (a) shall send a copy of the application, statement of grounds and evidence to the proprietor; and
- (b) may give directions with respect to the filing of additional evidence on such terms as the Registrar thinks fit.

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### **Procedure for intervention**

45 (1) Any person, other than the proprietor, claiming to have an interest in proceedings for revocation or invalidation of a registration or rectification of the register may file a request with the Registrar for leave to intervene in the subject proceedings.

(2) The request shall—

- (a) include a statement of the nature of the requestor's interest; and
- (b) be accompanied by the appropriate fee.

(3) The Registrar may, after hearing the parties if so requested, refuse the request or grant leave to the requestor to intervene on such terms and conditions as he thinks fit.

(4) Any person granted leave to intervene in a proceeding in accordance with this regulation shall, subject to any terms and conditions imposed by the Registrar, be treated as a party to the proceedings for purposes of regulations 38 to 42, 44 and 62 to 68.

## **Part 8**

### **Trade Marks Register**

#### **Form of register**

46 The register required to be maintained by the Registrar under section 60 of the Act may be kept in electronic or digital form or such other form as may be determined by the Registrar.

#### **Entry in register of particulars of registered trade marks**

47 There shall be entered in the register in respect of each trade mark the following particulars—

- (a) all information required under section 60(2) of the Act;
- (b) the date of registration as determined in accordance with section 49(5) of the Act;
- (c) the date of completion of the registration procedure;
- (d) the priority date (if any) to be accorded pursuant to a claim to a right to priority made under section 44 or section 45 of the Act;
- (e) the name and address of the proprietor;
- (f) the address for service filed under regulation 11;
- (g) any disclaimer or limitation of rights under section 19(1)(a) or (b) of the Act;
- (h) any memorandum or statement of the effect of any memorandum relating to a trade mark of which the Registrar has been notified;
- (i) the goods or services in respect of which the mark is registered;

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- (j) where the mark is a collective or certification mark, that fact;
- (k) where the mark is registered with the consent of the proprietor of an earlier trade mark or other earlier right pursuant to section 7(9) of the Act, that fact;
- (l) where the mark is registered pursuant to a transformation application in accordance with the Madrid Protocol—
  - (i) the number of the international registration, and
  - (ii) either of the following dates pursuant to the Protocol—
    - (aa) the date accorded to the international registration under Article 3(4), or
    - (bb) the date of recordal of the request for extension to Bermuda of the international registration under Article 3ter;
- (m) where the mark is a collective mark or a certification mark with respect to which amended regulations have been accepted by the Registrar, that fact; and
- (n) such other matters as the Registrar may determine.

### **Entry in register of particulars of registrable transactions**

48 Upon application made to the Registrar by such person as is mentioned in section 34(1)(a) or (b) of the Act there shall be entered in the register in respect of each trade mark the following particulars of registrable transactions—

- (a) the date of the entry;
- (b) in the case of an assignment of a registered trade mark or any right in it—
  - (i) the name and address of the assignee;
  - (ii) the date of the assignment; and
  - (iii) where the assignment is in respect of any right in the mark, a description of the right assigned;
- (c) in the case of the grant of a licence under a registered trade mark—
  - (i) the name and address of the licensee;
  - (ii) where the licence is an exclusive licence, that fact;
  - (iii) where the licence is limited, a description of the limitation; and
  - (iv) the duration of the licence if such duration is or is ascertainable as a definite period;
- (d) in the case of the grant of any security interest over a registered trade mark or any right in or under it—

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- (i) the name and address of the grantee;
- (ii) the nature of the interest (whether fixed or floating); and
- (iii) the extent of the security and the right in or under the mark secured;
- (e) in the case of an assent by personal representatives in relation to a registered trade mark or any right in or under it—
  - (i) the name and address of the person in whom the mark or any right in or under it vests by virtue of the assent; and
  - (ii) the date of the assent;
- (f) in the case of a court or other competent authority transferring a registered trade mark or any right in or under it—
  - (i) the name and address of the transferee;
  - (ii) the date of the order; and
  - (iii) where the transfer is in respect of a right in the mark, a description of the right transferred; and
- (g) in the case of any amendment of the registered particulars relating to—
  - (i) a licence under a registered trade mark; or
  - (ii) a security interest over a registered trade mark or any right in or under it,particulars to reflect such amendment.

### **Application to register or give notice of transaction**

49 (1) An application to register particulars of a transaction to which section 34 of the Act applies or to give notice to the Registrar of particulars of a transaction to which section 36(3) of the Act applies shall be made in relation to the following—

- (a) an assignment of a registered trade mark or any right in it;
- (b) a grant, amendment to, or termination of a licence under a registered trade mark;
- (c) a grant, amendment to or termination of any security interest; and
- (d) the making by personal representatives of an assent in relation to a registered trade mark or any right in or under it; or
- (e) an order of a court or other competent authority transferring a registered trade mark or any right in or under it.

(2) An application under paragraph (1) shall be accompanied by the appropriate fee and shall—

- (a) where the transaction is an assignment, be signed by or on behalf of the parties to the assignment;

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- (b) where the transaction falls within paragraphs (1)(b) or (c), be signed by or on behalf of the grantor of the licence or security interest; or
- (c) if not signed as provided in (a) or (b), be accompanied by such documentary evidence as appropriate to establish the transaction.

(3) Where an application to give notice to the Registrar has been made of particulars relating to an application for registration of a trade mark, the Registrar shall enter those particulars in the register upon registration of the trade mark.

### **Public inspection of register**

50 (1) The register shall be open for public inspection at the Registry General's office during the regular hours of business as provided in regulation 74.

(2) The Registrar shall on presentation of Form TM 1 accompanied by the appropriate fee, permit a person to inspect the register.

(3) Where the register or any portion of it is kept otherwise than in documentary form, the right of inspection is a right to inspect the material on the register.

### **Supply of certified copies, etc.**

51 The Registrar shall supply a certified or uncertified copy or extract of any entry in the register following receipt of a request on Form TM 1 accompanied by the appropriate fee.

### **Request for change of name or address in register**

52 (1) The Registrar shall enter a change in the applicant's name or address as recorded in the register following receipt of an application filed in accordance with this regulation.

(2) An application to enter a change of name or address recorded in the register may be filed by—

- (a) the proprietor of a registered trade mark;
- (b) a licensee registered under regulation 48; or
- (c) any person having an interest in or charge on a registered trade mark which has been registered under regulation 48.

(3) An application under paragraph (2) shall be—

- (a) filed on Form TM 8; and
- (b) accompanied by the appropriate fee.

### **Removal of matter from register**

53 (1) Where it appears to the Registrar that any matter in the register has ceased to have effect, before removing it from the register—

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- (a) the Registrar may publish in the Official Gazette the fact that it is intended to remove that matter; and
  - (b) where any person appears to the Registrar to be affected by the removal, the Registrar shall send notice of the intended removal to that person.
- (2) Any person may file a notice of opposition with the Registrar within two months of the date of publication under paragraph (1)(a).
- (3) Any person notified under paragraph (1)(b) may file an objection with the Registrar within two months of the notification date.
- (4) Regulation 63 shall apply in any case where the Registrar receives a notice of opposition or objection in accordance with paragraphs (2) or (3).
- (5) The Registrar shall not remove a matter if he is satisfied, after considering any objections or opposition to the removal, that the matter has not ceased to have effect.
- (6) If after considering any objections and representations made in furtherance of the objections, the Registrar is of the opinion that the entry or any part of it has ceased to have effect, he may remove all or part of the entry.
- (7) Where there has been no response to the notice sent by the Registrar under paragraph (1)(b), the Registrar may remove the matter.

### **Part 9**

#### **Change of Classification**

##### **Change of classification**

- 54 (1) Subject to paragraph (6), the Registrar may at any time amend an entry in the register which relates to the classification of a registered trade mark so that it accords with the version of the Nice Classification that has effect at that time.
- (2) Before making an amendment to the register under paragraph (1) the Registrar shall give the proprietor of the mark notice of the proposed change in classification.
- (3) The notice from the Registrar shall advise the proprietor that—
- (a) within two months of the notification date, he may make written objections to the proposed classification stating the grounds of those objections; and
  - (b) if no written objections are received within the period specified in paragraph (a)—
    - (i) the Registrar shall publish the proposed classification; and
    - (ii) the proprietor shall not be entitled to make objections to the proposed classification upon such publication.

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(4) If within the period specified in paragraph (3)(a) the proprietor makes no written objections or notifies the Registrar that he will not object, the Registrar shall publish the proposed classification.

(5) Where the proprietor makes written objections within the period specified in paragraph (3)(a), the Registrar shall after having considered the objections—

- (a) publish the proposed classification; or
- (b) where the Registrar has amended the proposed classification, publish the amended proposal.

(6) The Registrar may send a written notice to the proprietor of a registered trade mark requiring him to file a proposed classification for amendment of the register within two months of the date of the notice or such further time as may be specified by the Registrar.

(7) If the proprietor files the required proposed classification, the Registrar may—

- (a) accept and publish the proposed classification, and the proprietor shall not be entitled to make objections to the classification upon publication; or
- (b) notify the proprietor of his intent to amend or substitute the proposed classification and proceed as set out in paragraphs (2) to (5).

(8) If the proprietor fails to file the required proposed classification, the Registrar may cancel or refuse to renew the registration of the trade mark or proceed as set out in paragraphs (2) to (5).

### **Opposition to proposed classification change**

55 (1) Any person may, within two months of the date on which the proposed classification was published under regulation 54, give notice of opposition to the proposed classification to the Registrar.

(2) A notice of opposition filed under paragraph (1) shall—

- (a) include a statement of grounds; and
- (b) indicate why the proposed amendments would be contrary to section 62(3) of the Act.

(3) If no notice of opposition under paragraph (1) is filed within the time specified, or where any opposition has been determined by the Registrar, he shall—

- (a) make the amendments as proposed; and
- (b) enter in the register the date when the amendments were made.

**Part 10**

**Request for Information, Inspection of Documents and Confidentiality**

**Request for information**

56 A request for information relating to an application for registration that has been published or to a registered trade mark shall be filed with the Registrar and accompanied by the appropriate fee.

**Information available before publication**

57 (1) Before publication of an application for registration the Registrar may make available for inspection by the public—

- (a) the application and any amendments made to it; and
- (b) any particulars contained in a notice given to the Registrar under regulation 49.

(2) Nothing in section 64(3) of the Act relating to publication of information shall be construed as preventing the publication of decisions on cases relating to trade marks decided by the Registrar.

**Inspection of documents**

58 (1) Subject to paragraphs (2) and (3), the Registrar shall permit to be inspected documents filed or maintained at the Registry General in relation to a registered mark or an application for the registration of a trade mark that has been published.

(2) The Registrar shall not be obliged to permit the inspection of a document mentioned in paragraph (1) until the completion of any procedure, or the stage in the procedure which is relevant to the document in question, which the Registrar is required or permitted to carry out under the Act or these Regulations.

(3) The right of inspection under paragraph (1) shall not apply to—

- (a) any document prepared by or for the Registry General solely for its own use;
- (b) any document sent to the Registry General, whether at its request or otherwise, for inspection and subsequent return to the sender;
- (c) any request for information under regulation 56;
- (d) any document received by the Registry General which the Registrar considers should be treated as confidential; or
- (e) any document in respect of which the Registrar issues directions under regulation 59 that it be treated as confidential.

(4) The Registrar may publish a list of documents that may be inspected upon request in accordance with this regulation.



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(5) Nothing in paragraph (1) shall be construed as imposing on the Registrar any duty of making available for public inspection—

- (a) any document or part of a document which in the Registrar's opinion disparages any person in a way likely to cause damage to that person; or
- (b) any document or information filed at, or sent to or by the Registry General before commencement of the Act; or
- (c) any document or information filed at or sent to or by the Registry General after commencement of the Act relating to an application for registration of a trade mark under the Trade Marks Act 1974.

### **Confidential documents**

59 (1) The Registrar may direct that a document filed at the Registry General, other than a form required by the Registrar and published in accordance with regulation 3, be treated as confidential in whole or in part where the person filing it—

- (a) requests at the time of filing that the document or a specified part of it be treated as confidential; and
- (b) gives reasons for the request.

(2) A document subject to a request under paragraph (1) shall not be open to public inspection while the matter is being determined by the Registrar.

(3) Where a direction for confidentiality has been given and not withdrawn, no persons shall be entitled to inspect the document, or any part of it to which the direction relates, except by leave of the Registrar.

(4) The Registrar shall not withdraw any direction given under this regulation without prior consultation with the person at whose request the direction was given, unless the Registrar is satisfied that such prior consultation is not reasonably practicable.

(5) The Registrar may, as determined in his sole discretion, direct that any document issued by the Registry General be treated as confidential and upon such direction that document shall not be open to public inspection except by leave of the Registrar.

(6) Where a direction is given under this regulation for a document to be treated as confidential, a record of the fact shall be filed with the document.

## **Part 11**

### **Powers and Decision of Registrar and Requirements with respect to Agents**

#### **Proof of authorisation of agent may be required**

60 (1) Where an agent has been authorised in accordance with section 68 of the Act, the Registrar may require the personal signature or presence of the agent or the person authorising the agent to act as his agent.

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(2) Where a person appoints an agent for the first time or appoints one agent in substitution for another, whether before or after such person has become a party to any proceeding before the Registrar, the newly appointed agent shall file Form TM 13 with the Registrar accompanied by payment of the appropriate fee.

(3) Any act required or authorised by the Act in connection with the registration of a trade mark or any procedure relating to a trade mark may not be done by or to the newly appointed agent until on or after the date on which the newly appointed agent files Form TM 13 with the Registrar.

(4) The Registrar may by notice in writing require an agent to produce evidence of his authority.

(5) The Registrar may refuse to accept any application, filing or other submission from an agent where that agent has failed to comply with a request made by the Registrar in accordance with paragraph (4) until such time as the requested evidence has been provided.

### **Registrar may refuse to deal with certain agents**

61 (1) The Registrar may refuse to recognize as agent in respect of any business under the Act—

- (a) a person who has been convicted of an offence under section 86;
- (b) an individual whose name has been removed from and not restored to any register of agents maintained by the Registrar on the ground of misconduct; or
- (c) a person who is found by the Registrar to have been guilty of such conduct as would, in the case of an individual registered in a register of agents maintained by the Registrar, render that person liable to have their name erased from such register on the ground of misconduct;
- (d) a partnership or body corporate of which one of the partners or directors is a person whom the Registrar could refuse to recognise under paragraph (a), (b) or (c);
- (e) such other persons as may be prescribed.

### **General powers of Registrar in relation to proceedings**

62 (1) Except as otherwise provided in the Act or these Regulations, the Registrar may give such directions as to the management of any proceedings as he thinks fit, and in particular may—

- (a) require a document, information or evidence to be filed within such period as the Registrar may specify;
- (b) require a translation of any document;
- (c) require a party or a party's legal representative to attend a hearing;

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- (d) hold a hearing by telephone, video conference or using any other method of direct oral communication;
  - (e) allow a statement of case to be amended;
  - (f) stay the whole, or any part, of the proceedings either generally or until a specified date or event;
  - (g) consolidate proceedings;
  - (h) direct that part of any proceedings be dealt with as separate proceedings;
  - (i) exclude any evidence which the Registrar considers to be inadmissible.
- (2) The Registrar may control the evidence by giving directions as to the—
- (a) issues on which evidence is required; and
  - (b) way in which the evidence is to be placed before the Registrar.
- (3) When the Registrar gives directions under any provision of these Regulations, the Registrar may—
- (a) make them subject to conditions; and
  - (b) specify the consequences of failure to comply with the directions or a condition.
- (4) The Registrar may at any stage of any proceedings direct that the parties to the proceedings attend a case management conference or pre-hearing review.

### **Decision of Registrar to be taken after hearing**

63 (1) Without prejudice to any provisions of the Act or these Regulations requiring the Registrar to hear or give an opportunity to be heard to any party to proceedings under the Act or these Regulations, the Registrar shall, before taking any decision on any matter under the Act or these Regulations which is or may be adverse to any party to any proceedings, give that party an opportunity to be heard.

(2) The Registrar shall give a party mentioned in paragraph (1) at least 14 days' notice, beginning on the notification date, of the time when the party may be heard unless the party consents to shorter notice.

### **Evidence in proceedings before the Registrar**

64 (1) Subject to the Registrar's authority to issue directions under regulation 62(2), evidence may be given by—

- (a) witness statement;
- (b) affidavit;
- (c) statutory declaration; or
- (d) in any other form as would be admissible as evidence in proceedings before the Court.

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(2) Evidence at hearings may be given by witness statement unless the Registrar or any other applicable law requires otherwise.

(3) Any statement of truth shall be dated and signed—

(a) in the case of a witness statement, by the person making the statement; and

(b) in any other case, by the party or legal representative of such party, as appropriate.

(4) Evidence shall only be considered filed when it has been—

(a) received by the Registrar; and

(b) sent to all other parties to the proceedings.

### **Costs of proceedings**

65 (1) In any proceedings under the Act or these Regulations, the Registrar may by order—

(a) award to any party such costs as the Registrar may consider reasonable; and

(b) direct how and by what parties the costs so awarded are to be paid.

(2) Any order issued by the Registrar under paragraph (1) may, by leave of the Court or a judge thereof, be enforced in the same manner as a judgment or order of the Court to the same effect.

### **Security for costs**

66 (1) The Registrar may require any person who is a party in any proceedings under the Act or these Regulations to give security for costs—

(a) in relation to those proceedings;

(b) of any appeal from the Registrar's decision.

(2) If security for costs is required in accordance with paragraph (1) and the party so required fails to provide it, the Registrar or Court, in the case of an appeal, may treat the party in default as having withdrawn their application, opposition, objection or intervention, as the case may be.

### **Decisions of Registrar**

67 (1) The Registrar shall send to each party to a proceeding before him written notice of any decision made in the proceeding.

(2) The notice shall include a statement of the reasons for the decision;

(3) For purposes of any appeal from a decision of the Registrar notified in accordance with this regulation, the notification date shall be the date of the decision.

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(4) Where a decision is made by the Registrar in relation to a matter to which paragraph (1) does not apply, any person with an interest in or affected by the decision may file with the Registrar a request for a statement of reasons for the decision, accompanied by the appropriate fee.

### **Decisions subject to appeal**

68 Except as otherwise expressly provided in section 82 of the Act, an appeal lies from any decision of the Registrar made under these Regulations relating to a dispute between two or more parties in connection with a trade mark.

## **Part 12**

### **Correction of Irregularities, Calculation and Extension of Time**

#### **Correction of irregularities in procedure**

69 (1) Subject to regulation 71, the Registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceeding or other matter before the Registrar or the Registry General.

(2) Any rectification made under paragraph (1) shall be made—

- (a) after giving the parties such notice; and
- (b) subject to such conditions,

as the Registrar may direct.

#### **Delays in communication services**

70 (1) The Registrar shall extend any time limit in these Regulations where the Registrar is satisfied that the failure to do something under these Regulations was wholly or mainly attributed to a delay in, or failure of, a communication service.

(2) Any extension under paragraph (1) shall be made after giving the parties such notice and subject to such conditions as the Registrar may direct.

(3) In this regulation “communication service” means a service by which documents may be sent and delivered and includes post, facsimile, electronic mail and courier.

#### **Alteration of time limits**

71 (1) Subject to paragraphs (5) and (6), the Registrar may—

- (a) at the request of the person or party concerned or at the Registrar’s own initiative; and
- (b) where he is satisfied that the circumstances are such that it is just and appropriate to do so,

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extend a time or period prescribed by these Regulations or a time or period specified by the Registrar for doing any act, except for a time or period that is expressly provided for in the Act.

(2) Any extension of time granted under paragraph (1) shall be subject to such conditions as the Registrar thinks fit.

(3) A request for extension under this regulation—

(a) may be made before or after the time or period in question has expired; and

(b) shall be made on Form TM 14.

(4) Where an extension of time under paragraph (1) is requested in relation to proceedings before the Registrar, the party seeking the extension shall send a copy of the request to every other person who is a party to the proceedings.

(5) Any party to the proceedings may, within one month from the date of receipt of the copy referred to in paragraph (4), file observations on the request for extension.

(6) In considering whether to grant an extension of time in respect of a request mentioned in paragraph 4, the Registrar shall—

(a) take account of any observations filed under paragraph (5); and

(b) send a copy of his decision to the party seeking the extension and to every other person referred to in paragraph (4).

### **Part 13**

#### **Filing of Documents, Hours of Business, Trade Marks Journal and Translations**

##### **Filing of documents by electronic means**

72 (1) The Registrar may permit as an alternative to the sending by post or delivery of any application, notice or other document in legible form the filing of any such application, notice or other document by electronic means.

(2) An electronic filing in accordance with paragraph (1) shall be subject to such terms or conditions as the Registrar may specify either generally by published notice or in any particular case by written notice to the person desiring to submit the filing by electronic means.

##### **Electronic communications by Registrar**

73 (1) The Registrar may, at his election, deliver any notice or other written document required to be sent by the Registrar under the Act or these Regulations, by transmitting an electronic communication containing the notice or document to an address provided or made available to the Registrar by the recipient as an address for the receipt of electronic communications; and

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(2) Unless otherwise proven, delivery of an electronic communication in accordance with paragraph (1) is deemed to be effected immediately upon the transmission of the communication to the address so provided or made available by the recipient.

### **Days and hours of business**

74 (1) Subject to paragraph (2), the Registry General shall be open to the public and the register shall be open to inspection Monday through Friday between the hours of 8:30 a.m. and 5:00 p.m.

(2) The Registry General will be closed to the public and the register shall not be open to public inspection on—

- (a) public holidays; and
- (b) any other day as may be determined by the Registrar and published in the Official Gazette not later than seven days prior to such day.

### **Trade marks journal**

75 (1) The Registrar shall publish a periodical journal of industrial property that shall contain reproductions of registered trade marks and such other information as the Registrar thinks fit.

(2) The journal of industrial property shall be published in the Official Gazette.

### **Translations**

76 (1) Where any document or part thereof which is in a language other than English is filed or sent to the Registrar in pursuance of the Act or these Regulations, the Registrar may—

- (a) require that there be furnished a translation into English of the document or that part, verified to the satisfaction of the Registrar as corresponding to the original text; or
- (b) refuse to accept any translation which he considers to be inaccurate.

(2) Where paragraph (1)(b) applies, there shall be furnished another translation into English of the document or part thereof which shall be verified in accordance with paragraph (1)(a).

## **Part 14**

### **Transitional Provisions and Revocations**

#### **Revocation of prior regulations; Proceedings commenced under prior regulations**

77 (1) The Bermuda Trade Marks and Service Marks Regulations 1993 (the “1993 Regulations”) are hereby revoked.

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(2) Where immediately before these Regulations come into force, any time or period prescribed by the 1993 Regulations has effect in relation to any act or proceeding and has not expired, the time or period prescribed by the 1993 Regulations shall apply to that act or proceeding.

(3) Except as provided in paragraph (4), where a new step is to be taken on or after these Regulations come into force in relation to any proceedings commenced under the 1993 Regulations, these Regulations shall apply to such proceedings from that date.

(4) Subject to paragraph (5), where prior to the entry into force of these Regulations a notice of opposition and counter-statement have been filed in opposition proceedings or any proceedings for removal of a trade mark from the register, the Trade Mark Act 1974 and the 1993 regulations shall apply with regard to the filing of evidence in those proceedings;

(5) Where proceedings as described in paragraph (4) are consolidated with proceedings commencing on or after the date these Regulations come into force, these Regulations shall apply with regard to the filing of any evidence in the consolidated proceedings.

### **Commencement**

78 These Regulations come into operation on such day as the Minister appoints by notice published in the Gazette.

Made this 14th day of December 2023

Minister of the Cabinet Office

[Operative Date: 15 December 2023]