

Navigating the New IP Landscape: Key Changes in Bermuda

THE TRADE MARKS ACT 2023



KEY HIGHLIGHTS

Replaces the Trade
Mark Act 1974

Intent to standardise
the legislation in line
with common law
jurisdictions.

Mirrors the UK Trade
Marks Act 1994
(amended)

Regulation and
standardise with
international treaties

Modernizing the
trade mark landscape

12th Edition NICE
Classification
retroactively
implemented from 1
January 2023

**Date of
Enforcement: 1st
April 2025**

TRADE MARK REGISTRATION

A mark which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, *in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or the shape of goods or their packaging.*

OLD LAW (TRADE MARKS ACT 1974)	NEW LAW (TRADE MARKS ACT 2023)
<ul style="list-style-type: none">• Single Class Application	<ul style="list-style-type: none">• Multi Class Application [Section 41]
<ul style="list-style-type: none">• Limited to word marks, logos, designs	<ul style="list-style-type: none">• Extended to all signs capable of registration on the Register including sounds, shapes, colors, signs, trade dress. [Section 3]
<ul style="list-style-type: none">• Register divided into two parts – Part A and Part B	<ul style="list-style-type: none">• No division in the register and no Part A and Part B distinction. [Section 2, Schedule 4]
<ul style="list-style-type: none">• Associations mandatory with the previous trade marks registered filed by the same proprietor, along with a payment of official fees.	<ul style="list-style-type: none">• No requirement to associate with previously registered trade marks. [Schedule 4, Section 10(4)]
	<ul style="list-style-type: none">• Certification and Collective Trade Marks can be registered [Section 58 and Section 59]
	<ul style="list-style-type: none">• 6 trade marks can be registered as a series when there is no difference materially between the marks [Regulation 28]
	<ul style="list-style-type: none">• Existing trade marks can be merged with a common filing date into a single multi-class registration [Regulation 27]

TRADE MARK RENEWALS

**Initial
renewal
period**
extended from
7 years to 10
years

[Section 51]

Period:
Renewal to be
in *10-year
blocks* instead
of 7 to 14
years.

[Section 51]

**Filing
Window:** 6
months *prior
to expiry.*

[Regulation 36]

Grace Period:
6 months.
Failure to
remove will
lead to
abandonment

[Regulation 36]

Restoration:
3 months
post renewal

[Regulation 37]

NOTABLE CHANGES

Use Requirements	Disclaimer	Priority	Protection against infringement	Registrable Transactions	Inspection
<p>To state if the trade mark is “in-use”</p> <p><i>OR</i></p> <p>“Bona-fide” intention to use</p> <p><i>[Section 41]</i></p>	<p>Option to voluntarily disclaim elements on the trade mark application</p> <p>Assists in avoiding basic office actions</p> <p><i>[Regulation 31]</i></p>	<p>Can be claimed under Paris Convention</p> <p>Designates Bermuda as a contracting party to an international trade mark registration under WIPO.</p> <p><i>[Section 44]</i></p>	<p>Registrants and licensees can seek protection against infringing imports</p> <p>Work with Custom authorities to identify prohibited imports</p> <p><i>[Section 83]</i></p>	<p>Certain transactions are registrable including a security interest grant.</p> <p>Licenses and recordal of assignments need to be in writing and signed by both parties.</p> <p><i>[Section 34]</i></p>	<p>Documents filed with the registry can be inspected by public.</p> <p>Request to maintain confidentiality needs to be filed.</p> <p><i>[Regulation 50 and 58]</i></p>

ENFORCEMENT MEASURES



Increased penalties for
infringement of trade mark

Option to seek substantial
damages and injunctions
against bad faith activities

Enhanced role of Custom
Authorities

Protection extended to recognition of
Well-Known trade marks

[Section 97]



Thank you!

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