

CAYMAN ISLANDS



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**A BILL FOR A LAW TO AMEND THE PATENTS AND TRADE MARKS
LAW, LAW 30 OF 2011, TO REPEAL THE PROVISIONS RELATING TO
TRADE MARKS; AND FOR INCIDENTAL AND CONNECTED
PURPOSES**

THE PATENTS AND TRADE MARKS (AMENDMENT) BILL, 2016

MEMORANDUM OF OBJECTS AND REASONS

This Bill amends the Patents and Trade Marks Law, 2011, Law 30 of 2011, for the purpose of repealing the provisions relating to trade marks. The repeal is in light of the proposed legislation which will provide a new regime for the registration of trade marks in the Islands.

Clause 1 provides for the short title and commencement.

Clause 2 amends the long title of the principal Law.

Clause 3 amends section 1 of the principal Law to remove the words “trade marks” from the short title of the Law.

Clause 4 amends section 2 of the principal Law to remove terms and definitions related to trade marks.

Clause 5 repeals and replaces section 3 of the principal Law to remove the reference to trade marks from the name of the registry.

Clause 6 amends section 4 of the principal Law to remove the reference to trade marks.

Clause 7 amends section 5 of the principal Law to remove trade marks from the application of the provision and to substitute the word “supervision” for “management”.

Clause 8 amends section 6 of the principal Law to remove the references to trade marks.

Clause 9 repeals and replaces section 7 of the principal Law to remove the reference to trade mark.

Clause 10 amends section 8 of the principal Law to limit the application of the provision to patents.

Clause 11 amends section 9 of the principal Law to make the provision gender neutral.

Clause 12 repeals section 10 of the principal Law. The provision deals with the effect of recording a trade mark.

Clause 13 amends section 11 of the principal Law to remove the provision's application to trade marks.

Clause 14 amends section 12 of the principal Law to remove the application of the annual fee to trade marks.

Clause 15 amends section 13 of the principal Law to make the provision gender neutral.

Clause 16 repeals and substitutes section 14 of the principal Law to remove the references to trade marks.

Clause 17 repeals and replaces section 15 of the principal Law to remove trade marks from the application of the provision.

Clause 18 amends the principal Law to insert the new section 15A. The new section prohibits the assertion of patent infringement claims in bad faith and provides generally for the prohibition.

Clause 19 amends section 16 of the principal Law to remove the references to trade marks.

Clause 20 amends section 17 of the principal Law to remove the references to trade marks.

Clause 21 amends section 18 to remove trade marks from the application of the provision.

Clause 22 amends section 19 of the principal Law to make the provision gender neutral.

Clause 23 amends section 20 of the principal Law to empower the Cabinet to make regulations providing for, among other things, the prohibition of assertions of patent infringement which are made in bad faith and the bringing of actions in the Grand Court by aggrieved parties and for the recognition of persons as registered agents.

Clause 24 amends section 22 to modify the references to "Governor in Cabinet" to "Cabinet".

Clause 25 amends section 23(1) of the Law to remove the reference to trade marks.

Clause 26 amends the Schedule, among other things, to remove the fees for trade marks from the provision.

THE PATENTS AND TRADE MARKS (AMENDMENT) LAW, 2016

ARRANGEMENT OF CLAUSES

1. Short title and commencement
2. Repeal and substitution of the long title of the Patents and Trade Marks Law (Law 30 of 2011)
3. Amendment of section 1 - short title
4. Amendment of section 2 - interpretation
5. Amendment of section 3 - continuation of Registry
6. Repeal and substitution of section 4 - continuation of Registrar and staff
7. Amendment of section 5 - duties of Registrar
8. Amendment of section 6 - requirement for registered agent
9. Repeal and substitution of section 7 - recording of patents and trade marks
10. Amendment of section 8 - mode of recording rights
11. Amendment of section 9 - effect of recording a patent
12. Repeal of section 10 - effect of recording a trade mark
13. Amendment of section 11 - period of validity and certificate of good standing
14. Amendment of section 12 - annual fee
15. Amendment of section 13 - changes
16. Repeal and substitution of section 14 - renewal of patent or trade mark
17. Repeal and substitution of section 15 - abandonment of patent or trade mark
18. Insertion of section 15A - assertion of patent infringement in bad faith
19. Amendment of section 16 - cancellation of record
20. Amendment of section 17 - publication in Gazette
21. Amendment of section 18 - jurisdiction of Grand Court
22. Amendment of section 19 - searches
23. Repeal and substitution of section 20 - regulations
24. Amendment of section 22 - amendment of Schedule
25. Amendment of section 23 - savings, transitional and consequential provisions
26. Amendment of Schedule

CAYMAN ISLANDS

**A BILL FOR A LAW TO AMEND THE PATENTS AND TRADE MARKS
LAW, 2011, LAW 30 OF 2011, TO REPEAL THE PROVISIONS
RELATING TO TRADE MARKS; AND FOR INCIDENTAL AND
CONNECTED PURPOSES**

ENACTED by the Legislature of the Cayman Islands.

1. (1) This Law may be cited as the Patents and Trade Marks (Amendment) Law, 2016.

Short title and commencement

(2) This Law shall come into force on such date as may be appointed by order made by the Cabinet and different dates may be appointed for different provisions of this Law and in relation to different matters.

2. The Patents and Trade Marks Law, 2011, in this Law referred to as the principal Law, is amended by repealing the long title and substituting the following long title -

Repeal and substitution of the long title of the Patents and Trade Marks Law (Law 30 of 2011)

“A LAW TO REPEAL AND REPLACE THE PATENTS AND TRADE MARKS LAW (2010 REVISION) TO PROVIDE FOR THE MODERN REGULATION OF THE PRACTICE AT THE REGISTRY OF PATENTS; AND TO PROVIDE FOR INCIDENTAL AND CONNECTED PURPOSES”.

Amendment of section 1
- short title 3. The principal Law is amended in section 1 by deleting the words “and Trade Marks”.

Amendment of section 2
- interpretation 4. The principal Law is amended in section 2(1) -

- (a) by deleting the respective definitions of the words -
 - (i) “Community trade mark”;
 - (ii) “International trade mark”;
 - (iii) “Madrid Protocol”; and
 - (iv) “trade mark”;
- (b) in the definition of the word “extension”, by deleting the words “or trade mark”;
- (c) in the definition of the word “owner”, by deleting the words “or trade mark”;
- (d) in the definition of the word “recording”, by deleting the words “one or more of the registers” and substituting “the register”;
- (e) in the definition of the word “Registrar”, by deleting the words “and Trade Marks”;
- (f) in the definition of the word “Registry”, by deleting the word “combined” and the words “and Trade Marks”; and
- (g) in the definition of the word “right” by deleting the words -
 - (i) “or trade mark”; and
 - (ii) “and trade marks”.

Amendment of section 3
- continuation of
Registry 5. The principal Law is amended by repealing section 3 and substituting the following section -

“Continuation of
Registry 3. The Registry shall continue in being subject to
this Law.”.

Repeal and substitution
of section 4 -
continuation of Registrar
and staff 6. The principal Law is amended by repealing section 4 and substituting the following section -

“Continuation of
Registrar and staff 4. The Registry shall be supervised by the
Registrar who shall be a public officer and who shall
be assisted by such other public officers as may be
necessary for the proper functioning of the
Registry.”.

Amendment of section 5
- duties of Registrar 7. The principal Law is amended in section 5 as follows -

- (a) in paragraph (a) by deleting the word “management” and substituting the word “supervision”; and
- (b) in paragraph (b) by deleting the words “and trade mark”.

8. The principal Law is amended in section 6(5) by deleting the words “or trade mark” wherever they appear. Amendment of section 6 - requirement for registered agent
9. The principal Law is amended by repealing section 7 and substituting the following section - Repeal and substitution of section 7 - recording of patents and trade marks
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| <p>“Recording of patents
Schedule</p> | <p>7. The owner of a patent right may by the duly authorised registered agent, on payment of the fees specified in the Schedule, apply to the Registrar to have such right extended to the Islands, and the Registrar on being satisfied that such application is in order shall record the extension of such right accordingly.”.</p> |
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10. The principal Law is amended in section 8 by deleting the words “either a patent or trade mark” and substituting the words “a patent”. Amendment of section 8 - mode of recording rights
11. The principal Law is amended in section 9 by deleting the words “to him” and substituting the words “to the owner”. Amendment of section 9 - effect of recording a patent
12. The principal Law is amended by repealing section 10. Repeal of section 10 - effect of recording a trade mark
13. The principal Law is amended in section 11 as follows - Amendment of section 11 - period of validity and certificate of good standing
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| <p>(a) in subsection (1), by deleting the words “by sections 9 and 10” and substituting the words “by section 9”; and</p> <p>(b) in subsection (2), by deleting the words “or trade mark”.</p> | |
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14. The principal Law is amended in section 12(1) by deleting the words “or trade mark”. Amendment of section 12 - annual fee
15. The principal Law is amended in section 13(1) by deleting the words “his duly authorised registered agent” and substitute the words “the duly authorised registered agent”. Amendment of section 13 - changes
16. The principal Law is amended by repealing section 14 and substituting the following section - Repeal and substitution of section 14 - renewal of patent or trade mark
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| <p>“Renewal of patent
Schedule</p> | <p>14. (1) A patent currently recorded in the Islands may, on the application of the registered agent and payment of the fees specified in the Schedule, be renewed at any time if the rights have been renewed in the United Kingdom, all applicable annual fees and</p> |
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penalties have been paid and any change in the particulars since the initial recording of the extension have been recorded in the Islands.

(2) If an application for renewal is filed more than two months after the expiry date recorded in the Islands a penalty fee shall be payable as specified in the Schedule.”.

Repeal and substitution of section 15 - abandonment of patent or trade mark

17. The principal Law is amended by repealing section 15 and substituting the following section -

“Abandonment of patent

15. (1) The owner of a patent recorded in the Registry shall, by the duly authorised registered agent, notify the Registrar that a patent has been abandoned whereupon the rights protected by the recorded entry shall be held in abeyance and the Registrar shall record the patent as inactive.

(2) The obligation to pay an annual fee pursuant to section 12 shall be suspended while the patent is inactive.

(3) A registered agent may apply to re-activate a patent that has been abandoned under subsection (1) upon payment of the reactivation fee specified in the Schedule and the payment of the annual fees specified in the Schedule for the period the patent was suspended.”.

Schedule

Insertion of section 15A - assertion of patent infringement in bad faith

18. The principal Law is amended by inserting after section 15 the following section -

“Assertion of patent infringement in bad faith

15A. (1) A person shall not make an assertion of patent infringement in bad faith in respect of an extension recorded under section 9 of this Law.

(2) The Court shall not recognize or enforce a foreign judgment or give effect to an estoppel based on a foreign judgment insofar as the claim is based on an assertion of patent infringement made in bad faith.

(3) A person who is aggrieved by acts carried out contrary to subsection (1) may bring an action in

the Grand Court or may counterclaim in any action brought to purportedly to enforce rights conferred by a patent or an extension on the grounds that a person has made an assertion of patent infringement in bad faith.

(4) The Court may award to a plaintiff who is successful in an action or counterclaim under subsection (3) one or more of the following remedies -

- (a) equitable relief; and
- (b) damages, including aggravated and exemplary damages.”.

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| 19. The principal Law is amended in section 16 by - <ul style="list-style-type: none">(a) deleting the words “or trade mark” wherever they appear;(b) deleting the words “in accordance with section 9 or 10” and substituting the words “in accordance with section 9”. | Amendment of section 16 - cancellation of record |
| 20. The principal Law is amended in section 17 by deleting the words “or trade mark” wherever they appear. | Amendment of section 17 - publication in Gazette |
| 21. The principal Law is amended in section 18 by deleting the words “or trade mark conferred by sections 9 and 10” and substituting the words “conferred by section 9”. | Amendment of section 18 - jurisdiction of Grand Court |
| 22. The principal Law is amended in section 19 by deleting the words “for which he has so applied” and substituting the words “for which the application has been made”. | Amendment of section 19 - searches |
| 23. The principal Law is amended by repealing section 20 and substituting the following section - | Repeal and substitution of section 20 - regulations |

“Regulations

20. The Cabinet may make regulations prescribing all matters that are required or permitted under this Law to be prescribed, or are necessary or convenient to be prescribed for giving effect to the purposes of this Law and, in particular, regulations -

- (a) prescribing the forms and procedures for the conduct of business with the Registry;
- (b) respecting assertions of patent infringement which are made in bad faith including -
 - (i) prohibiting such assertions;
 - (ii) the bringing of actions in the Grand Court by persons aggrieved by such assertions; and
 - (iii) the award by the Grand Court of equitable relief and damages to persons aggrieved by such assertions; and
- (c) respecting applications for recognition as registered agents including -
 - (i) any qualification to being recognized as such; and
 - (ii) the payment of fees by applicants; or
 - (iii) the exemption from applying to be recognized as a registered agent where the applicant is a recognized registered agent for patents or design rights.”.

Amendment of section 22 - amendment of Schedule

24. The principal Law is amended in section 22 by deleting the words “Governor in Cabinet” and substituting the word “Cabinet”.

Amendment of section 23 - savings, transitional and consequential provisions

25. The principal Law is amended in section 23 as follows -

- (a) in subsection (1), by deleting the words “or trade mark”;
- (b) by repealing subsections (5) through (8).

Amendment of Schedule

26. The principal Law is amended in the Schedule -

- (a) by deleting Part 2; and
- (b) in Part 3, by -

- (i) deleting the words “and trade marks” wherever they appear;
and
- (ii) deleting the words “or trade mark” wherever they appear.

Passed by the Legislative Assembly the day of 2016.

Speaker.

Clerk of the Legislative Assembly.