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## **INTERNATIONAL TRADEMARK ASSOCIATION COMMENTS ON IP BAHAMAS PUBLIC CONSULTATION FOR A MODERN IP FRAMEWORK**

**New York, March 15, 2024**

The International Trademark Association (INTA) would like to thank the Government of the Commonwealth of the Bahamas for the opportunity to provide comments on the public consultation to determine the direction of Intellectual Property regulation in The Bahamas, which seeks to modernize the framework for intellectual property and allow creators and entrepreneurs of your country to participate in global value chains.

The following comments were prepared by INTA's Legislation and Regulation Committee with the Geographical Indication, Harmonization, and Enforcement committees and INTA's staff.

We hope you will find these comments helpful in the context of the Bahamas progressive strategy to protect the Intellectual Property of Bahamas and welcome the opportunity to further engage in discussions on the topic.

The International Trademark Association (INTA) is a global association of brand owners and professionals dedicated to supporting trademarks and complementary intellectual property (IP) to foster consumer trust, economic growth, and innovation, and committed to building a better society through brands.

Members include more than 6,000 organizations, representing more than 33,500 individuals (trademark owners, professionals, and academics) from 181 countries, who benefit from the Association's global trademark resources, policy development, education and training, and international network. Of these 612 organizations and nearly 2,900 individuals are from Latin American and the Caribbean.

Founded in 1878, INTA, a not-for-profit organization, is headquartered in New York City, with offices in Beijing, Brussels, Santiago, Singapore, and Washington, D.C., and a representative in New Delhi, Aman and Nairobi. For more information, visit [www.inta.org](http://www.inta.org)

### **General Comments**

INTA has adopted Model Trademark Law<sup>1</sup> Guidelines<sup>1</sup>, Model Design Law Guidelines<sup>2</sup> and Guidelines for Examination of Trademarks<sup>3</sup> and Industrial Designs<sup>4</sup>, which contain INTA's basic positions on industrial property laws and practices and serve as a baseline standard by which INTA

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<sup>1</sup> [INTA-Model-Trademark-Law-Guidelines-v2019.pdf](#)

<sup>2</sup> [Model Design Law Guidelines \(inta.org\)](#)

<sup>3</sup> [Guidelines for Trademark Examination \(inta.org\)](#)

<sup>4</sup> [Guidelines for Examination of Industrial Designs \(inta.org\)](#)



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analyses and comments on national and regional trademark, design, geographical indication laws, regulations, and the practices of IP offices. Also, INTA positions are reflected in its board resolutions that reflect to common understanding of this global association to support balanced intellectual property systems at international and national levels.

In the following pages, INTA would like to comment on some of the criteria contained in the draft Bahamas` GI and TM Law Amendment Bills and Regulations 2023 published for comments. The comments are not exhaustive and further discussions about the recommendations may be convenient. INTA`s comments are based on INTA`s Board Decisions, Model Trademark Law Guidelines and Research Reports.

## Specific Comments

### GEOGRAPHICAL INDICATIONS (AMENDEMNT) BILL AND REGULATIONS, 2023

**Section 10(1)** of the 2015 Act provides that any interested party may object to the registration of a geographical indication that does not comply with Part II of the Act. Section 5 of Part II provides as follows:

*“5. Exclusion from protection.*

*The following shall not be registered as geographical indications.*

*(a) indications that do not correspond to the definition of "geographical indication" in section 1*

*(b) indications that offend public order or morality*

*(c) geographical indications that are not or cease to be protected in their country of origin, or that have fallen into disuse in that country.”.*

INTA would like to make the following points:

Section 22 of the Act headed “Exceptions regarding prior users”, states that where a trademark has been applied for in good faith either before the commencement of the act or before the registration of a geographical indication of origin in its country of origin nothing in the Act will prejudice the validity of that mark or the right to use it (Section 22.2).

INTA`s position is that conflicts between trademarks and geographical indications should be resolved on a “first in time, first in right” basis along with the principles of territoriality, exclusivity, priority, and good faith. On that basis we recommend that that the existence of an earlier validly registered trademark should form an additional ground for exclusion of protection under Section 5.

Notwithstanding this point, we also note that Section 22.4 of the 2015 Act enables the owner of a registered mark to apply for relief under Part II of the Act following the subsequent use of a Geographical Indication, but the Act is silent on the procedure to be followed to apply for relief, how any decision to grant relief will be determined, or what form the relief will take. It is possible that a remedy may be available under Section 6 “Prohibition against improper use of a geographical indication” but this is far from clear. This is detrimental to trademark owners, and we recommend that clearer wording be added.

We respectfully submit that there may be a typographical error in Section 22.5 which should say “Subsection (4) applies only where that mark has been published by the date of registration of the



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geographical indication in The Bahamas” rather than “by the date of registration of the mark in The Bahamas”, as it currently does.

Section 22.3 provides that nothing in the 2015 Act shall apply in respect of a geographical indication of any country with respect to goods or services for which the relevant indication is identical with the term customarily used in common language as the common name for such goods or services in The Bahamas.

INTA supports the position that common names which have become generic should not be impaired by registration of Geographical Indications. It therefore recommends that the fact that a name has become a common name in The Bahamas should be an additional ground for Exclusion from Protection in terms of Section 5. As things stand, there appears to be no mechanism for a party with an interest in using such a name to object to it becoming registered as a geographical indication. Not only is this detrimental to such parties but it also may lead to invalid geographical indications appearing on the register.

### **TRADE MARKS (AMENDEMENT) BILL AND REGULATIONS, 2023**

#### **Amendment of section 8 of the principal Act. Restriction of registration.**

Subsection (1) of section 8 of the principal Act is amended by the insertion immediately following paragraph (f) of the following new paragraph — “(g) any mark that consists of, or contains any element thereof, adopted and used by a public authority in The Bahamas as an official mark for goods or services.”

Despite the objects and reasons of the amendment, this paragraph may infringe third party registered trademarks; and it seems it must specify that under such circumstances the Official mark must be registered not “adopted and used”.

Both comments are according to section 9 of the INTA Model Trademark Law Guidelines. This amendment intends to expand the range of marks eligible for trademark protection under the BTMA, recognizing the significance of official marks used by public authorities.

Recommendation:

“(g) any mark, identical with or confusingly similar to an earlier registered trademark of a public authority in The Bahamas as an official mark for goods or services.”

#### **Infringement**

The Trademark Act 2015 stated that a person other than the proprietor of a trademark may be registered as a registered user and therefore act against any infringement. (section 39). With this amendment the licensee can also act against it.

This amendment complies with section 12 (Who May Sue) of the INTA Model Trademark Law Guidelines, and INTA welcomes this proposal.



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### **Amendment of section 44 of the principal Act.**

Subsection (2) of section 44 of the principal Act is deleted and substituted as follows “(2) Any such infringement of a trademark shall be actionable before the Court: (a) at the suit of the owner or an authorized user of the trademark; or (b) by a licensee, in accordance with the provisions of this Act.” With the amendment, a licensee can now bring an action for trademark infringement proceeding as well. However, there are no corresponding amendments to Section 44 which set out the circumstances in which a licensee can bring an action for infringement, e.g., in some countries, a licensee is required to first request the trademark owner to sue for infringement and where the trademark owner fails or refuses to do so within a prescribed time, then the licensee can take action.

The amendment also does not make a distinction between an exclusive licensee or non-exclusive license, or whether a licensee needs to be a registered user under Section 39 of the BTMA to enjoy this right given under section 44. This amendment appears to widen the scope of who can bring an action to include a mere licensee, which may not have any rights under the Act in respect of the mark in question.

There could also be an issue as to whether the licensee can entitle itself to all of the damages if the mark does not belong to the licensee, in particular where the owner is not informed of the action.

The amendment also does not address whether a licensee is entitled to relief under s 44(5), s 46 and s46A, which makes reference to “any person whose trademark rights are infringed” (arguably excludes a licensee)”, “proprietor of a registered trade mark” and “owner of trade mark,” respectively.

### **Insertion of new section 46A into the principal act**

The principal Act is amended by the insertion immediately after section 46 of the following new section:

*“46A. Power of Court to order certain information.*

*(1) Where the owner of trade mark has commenced legal proceedings against a defendant for infringement of a trade mark and has alleged that the defendant has engaged in acts of infringement on a commercial scale, the Court may, on the application of the owner of the trade mark order the defendant, a financial services provider or any other person within the jurisdiction of the Court, to disclose to the owner of the trade mark or the Court, the banking or other commercial information of that defendant.*

*(2) Where in any legal proceedings commenced by the owner of trade mark the Court has adjudged that one or more defendants have, in relation to specific goods, engaged in acts of infringement of that trademark, the Court may order any of or all of the defendants to those proceedings to provide to the owner of the trade mark or the Court, information on the origin and distribution networks of the goods in issue.”*

Despite the objects and reasons of this amendment, data protection rules must be reviewed in the first amendment.



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The second amendment underlined complies with section 14.7 of INTA Model Trademark Law Guidelines.

The amendment in section s46A(1) empowers the court to order the disclosure of banking or commercial information in cases of trademark infringement, particularly when the infringement is alleged to have occurred on a commercial scale. The order extends to third parties other than the defendant. One of the benefits of such disclosure is that it makes it easier for a trademark owner to trace the ill-gotten gains made by the defendant.

If the court finds that the defendant has engaged in trademark infringement in relation to specific goods, it may order the defendant to provide information on the origin and distribution networks of the infringing goods. This would provide the trademark owner with more information on the source of infringement and the distribution network of the infringing goods.

Overall, the amendments herein appear to strengthen the enforcement mechanisms available to trademark owners. Thus, the second amendment underlined complies with section 14.7 of INTA Model Trademark Law Guidelines.

## **Classification**

The Bahamas' intention to implement the Nice Classification in its national trademark system signals a promising step towards aligning with international intellectual property standards. This move is likely to streamline the process of cross-border protection of IP rights, reducing potential legal complexities for international businesses.

Cross-border harmonization of IP law through various international treaties facilitates cross-border collaboration and technology transfer, is an essential element of promoting global innovation and economic growth. Moreover, a harmonized IP system encourages foreign investment and trade, as businesses can operate with confidence knowing their IP rights will be respected and protected in a consistent manner globally. The previous divergence introduced complexities for foreign entities seeking to protect their intellectual property rights within the Bahamas. With this reform, which simplifies the process for international businesses, the Bahamas are fostering a more accessible and globally coherent IP environment.

The current requirement in the Bahamas for separate applications to be filed for each class of goods and services, as per Section 23 of the Trade Marks Regulations, 2023 could be perceived as burdensome for businesses with diverse product or service offerings. A multi-class trademark system offers several advantages over a single-class system. Firstly, a multi-class system provides cost-effectiveness for businesses. In a multi-class system, businesses can file a single application covering multiple classes of goods or services, which often leads to a reduction in filing fees, attorney charges, and administrative costs.

Secondly, it brings efficiency and simplicity. The multi-class system streamlines the registration process, saving time and resources for both the businesses and the trademark office. Businesses can avoid the redundancy of submitting multiple applications, and the trademark office can manage fewer applications, which may also lead to faster processing times. Thirdly, a multi-class system offers broader protection for brands. Businesses often expand their product or service offerings over



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time. With a multi-class system, businesses can ensure their brand is protected across all categories of their operation, providing a comprehensive shield against potential infringements. Lastly, the multi-class system aligns with international standards. Many jurisdictions, including those within the European Union and under the Madrid System, employ a multi-class system. Adopting a similar approach would align the Bahamas with these global practices, fostering a more internationally harmonized and accessible IP landscape. In sum, a multi-class system is a more cost-effective, efficient, comprehensive, and internationally aligned approach to trademark registration compared to a single-class system.

Adopting a multi-class system would promote efficiency and be more user-friendly, possibly encouraging more businesses to protect their intellectual property rights within the Bahamas.

Some additional benefits of implementing the Nice Classification System include:

**Global Standardization:** The Nice Classification System is widely recognized and utilized across the globe. By aligning with this system, The Bahamas would harmonize its IP practices with international norms, facilitating smoother interactions with other countries and businesses.

**Clarity and Efficiency:** The Nice Classification System categorizes goods and services into distinct classes, making it easier to identify and protect specific IP assets. Adopting this system would streamline the registration process, reduce ambiguity, and enhance legal clarity for both creators and users of IP.

**Enhanced Trademark Protection:** Trademarks play a crucial role in branding and business identity. The Nice Classification System provides a comprehensive framework for classifying goods and services associated with trademarks. By adopting it, The Bahamas would strengthen its trademark protection regime, benefiting local businesses and encouraging foreign investment.

**Facilitating International Trade:** As The Bahamas seeks to expand its global trade relations, adherence to the Nice Classification System becomes essential. Consistent classification ensures that IP rights are respected across borders, promoting fair competition, and fostering economic growth.

**Ease of Search and Examination:** The Nice Classification System simplifies trademark searches and examinations. It enables efficient retrieval of relevant information, reducing administrative burdens for IP offices and applicants alike.

**Recommendations: Education and Training:** Invest in training IP professionals, legal practitioners, and examiners on the principles and application of the Nice Classification System. Building expertise within the IP Office is crucial for successful implementation.

**Public Awareness Campaigns:** Educate local businesses, creators, and innovators about the benefits of the Nice Classification System. Encourage them to utilize this system when seeking IP protection.

**Collaboration with WIPO:** Establish a collaborative relationship with WIPO to access resources, guidance, and best practices related to the Nice Classification System.



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## TRADE MARKS REGULATIONS 2023

### Part II Formal Requirements

In general, INTA finds that the Regulations section is in accordance with INTA Model Trademark Law Guidelines. The bill refers to goods and services, apparently meaning that trademarks for services will be included. Also, electronic filings have been included, as well as sending documents via electronic means. The address can be a physical one or an email.

By including protection to services the Bahamian tourism and its cultural industry could be granted protection through trademarks, which is one of the goals stated in your public consultation: *“Bahamian creatives have long been major contributors to sustaining the tourism industry in The Bahamas, providing the authentic cultural feel demanded by visitors. Sadly, local creatives have historically been limited in their ability to fully participate and extract value from the local tourism industry.”*

The applicant or the opponent must have an address within the Bahamas and can appoint agents to represent them. Agents who are an undischarged bankrupt or are not a qualified “counsel and attorney” may not be recognized by the Registrar.

**Amendment of Section 2** of the principal Act is amended by the insertion in the appropriate alphabetical order of the following definition of “Official mark” as a mark adopted and used by a public authority of The Bahamas for use with goods or services;” and by the deletion and substitution of the following definition “Registrar” means the Registrar of the Intellectual Property Office any reference to the Registrar shall be construed as including a reference to any officer discharging the functions of the Registrar;”.

For Definition of “Official mark” The proposed insertion of the definition of “Official mark” is to facilitate the interpretation of the proposed section 8 (g) of BTMA which stipulates the non-registrability of Official marks. Nonetheless, the definition of “Official mark” entails the use by a “public authority” in the definition, which is undefined in anywhere of the BTMA, Constitution of Bahamas and Bahamas Interpretation and General Clauses Act. This may cause some uncertainty as to what constitutes a “public authority”. Can a quasi-government agency be deemed as public authority entitled to enjoying the protection under section 8 (g) of BTMA for its mark?

The definition of “Registrar” Is being amended from “Registrar of the Registrar General’s Department with responsibility for the Intellectual Property Office” to “Registrar of the Intellectual Property Office”.

The proposed amendment appears consistent with the fact that the “Registrar” responsible for intellectual property falls under the scope of Registrar General’s Department, which is a central government department of the Office of the Attorney General & Ministry of Legal Affairs of Bahamas responsible for the following areas:

- Registration of Deeds and Documents
- Certification and Registration of Births, Marriages and Deaths
- Companies



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- Deeds Search
- Registration of Commission Merchants
- Intellectual Property Office (Patents, Trademarks & Copyright, Design Copyright (underline added)
- Data Management of Births, Deaths and Marriages
- Maritime Marriages

With the proposed amendment to “Registrar of the Intellectual Property Office”, it corresponds with section 3 of BTMA which uses “Registrar of the Intellectual Property Office” in the provision. This makes the definition of “Registrar” in BTMA consistent as the current BTMA defines “Registrar” as “Registrar of the Registrar General’s Department with responsibility for the Intellectual Property Office” but section 3 of BTMA uses “Registrar of the Intellectual Property Office”.

#### **Part IV Application Procedure**

*“18-- Applications to be signed”* — This provision is in alignment with INTA recommendations; however, it must be more explicit regarding the documents and requirements necessary to demonstrate that signatories, representing companies, firms, and/or legal entities, are authorized accordingly.

*“19 - Convention applications”* - This topic provides a forecast regarding priority requests under Article 4 of the Paris Convention. The requests submitted are within the normal range; however, it would be interesting to consider item 6. FORMALITIES EXAMINATION of the INTA Guideline, which state that "In some cases, examination may be required of Paris Convention or other priority claims; however, applications made according to the Madrid Agreement or Madrid Protocol that claim priority should receive priority 'without requiring compliance with the formalities prescribed' in Article 4D of the Paris Convention." It is advisable, therefore, for the law to have some provision in this regard, anticipating and avoiding future legal and regulatory changes.

*“20 - Acknowledgment of application”* - This topic simply states that the Registrar should provide the applicant with an acknowledgment of receipt once the filing is made. However, it would be advisable for the text to provide more details on how this receipt will be issued, adhering to item 3.2. Filing of the INTA Guidelines, emphasizing that it should be done within a reasonable timeframe.

*“21 - Representation of the mark to be affixed”* – This provision is in alignment with INTA recommendations. The format required by the new Trademark law in the Bahamas may be deemed bureaucratic due to the completion of Form 2. However, this action will provide the Registrar and the applicant with the opportunity to adhere to the INTA recommendation on the Representation of the Mark (item 6.1), which states that "It is recommended that Trademark Offices require that a mark be represented in a format that is clear, precise, and easily understandable, using generally accepted technologies."

*“22 - Additional specimens”* - The questionable part of the topic is as follows: "and noted with all such particulars as may from time to time be required by the Registrar. These additional representations of a mark must be considered suitable to the Registrar and be sent in an electronic format permitted by the Office." By stating that the Registrar may request new specimens from time to time, depending on their understanding, without providing any specific timeframe for such action or response deadline





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for the applicant, the item becomes vague and concerning. It should be analyzed considering item 3.3 Response Time of the INTA Guideline, which states that the "applicant should be provided with a time period of a minimum of ninety (90) days within which to respond to any objections issued by the Trademark Office. One reasonable extension of this term is recommended."

*"23- Same mark in different classes"* – This provision is in alignment with INTA recommendations.

*"24 - Additional representations"* - This topic is questionable. By stating that the Registrar may request new specimens at any time, depending on their understanding, without justification or providing any specific timeframe for such action or response deadline for the applicant, the item becomes vague and concerning. It should be analyzed considering item 3.3 Response Time of the INTA Guideline, which states that the "applicant should be provided with a time period of a minimum of ninety (90) days within which to respond to any objections issued by the Trademark Office. One reasonable extension of this term is recommended."

*"25 - Specimens"* – This provision is in alignment with INTA recommendations. However, it should be clearer the way the specimen or copy of the trademark should be presented. 3.2 Filing – INTA Guideline: "Trademark Offices should allow for the receipt of applications and prosecution documents by hand, by post, by e-filing, and by other means of electronic transmission, and/or other means using generally acceptable technologies."

*"26 - Series of trade marks"* – This provision is in alignment with INTA recommendations.

*"27 - Transliteration or translation"* – This provision is in alignment with INTA recommendations. However, it would be advisable that more details and information about the translation/transliteration requirements or formalities be provided, as "to the satisfaction of the Registrar" is too vague. As stated in item 5.1 Determined by Trademark Office of the INTA Guideline, the practices of Offices are governed by the substantive law of the jurisdiction in which they operate. However, they "should publish its jurisdiction's statutory laws and regulations, guidelines, practice notes, and requirements, and make them freely available to the public", thereby ensuring a fairer process.

The analysis reveals a mix of alignment with INTA recommendations and areas for improvement within the examined trademark registration topics. While certain aspects, such as "Representation of the mark" and "Transliteration or translation," align well with guidelines, others, like "Additional specimens" and "Additional representations," raise concerns due to vagueness and lack of specific timeframes. Clarity and specificity in documentation, adherence to established response time guidelines, and the imperative for Trademark Offices to publish comprehensive regulations emerge as key focal points for refining and fortifying the trademark registration process, ensuring fairness, and fostering confidence.

## **Part V Procedure on Receipt of Application**

Section 28, titled *"Search of registered marks"* is in alignment with INTA recommendations regarding prior trademark searches ("8.1 Search - Compiling a Group of Similar Marks" from INTA's Guidelines for Trademark Examination").



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In general, it would be advisable to standardize the criteria for describing deadlines, as some references use "1 month" while others indicate "thirty days." INTA's Guidelines for Trademark Examination establishes deadlines in terms of days.

It is advisable to clarify the nature of deadlines by specifying whether they are business or calendar days, consecutive, mandatory, and non-extendable. For instance, they could be defined as "90 consecutive, mandatory, and non-extendable days, commencing from the day following publication in the Industrial Property Bulletin; or from the day following notification.

Additionally, we suggest adopting INTA's recommendation of granting longer deadlines than 30 days to respond to objections. Either 60 days or 90 days would be preferred. ("3.3 Response Time: Trademark Offices should examine the application and issue a notification of objections to registration, if any, within a reasonable period at the appropriate stage in the procedure according to the particular law of each country. The applicant should be provided with a minimum of ninety (90) days within which to respond to any objections issued by the Trademark Office. One reasonable extension of this term is recommended by the Guidelines for Trademark Examination).

Section 34 establishes: "Disclaimer. The Registrar may call on an applicant to add a disclaimer as the Registrar may think fit, in order that the public generally may understand what the applicant's rights, if the mark is registered, will be." It should be considered that the INTA Guidelines for Trademark Examination state in section 7.2.2.2 Voluntary and Mandatory Disclaimers: "...If disclaimers are mandatory under the applicable law, the authority should have clear rules on what is required (e.g., what happens in cases of compound words, etc.) and those rules should be applied consistently." Therefore, we recommend adding clear rules to ensure consistency and clarity in the application of disclaimers as required by Section 34 and the INTA Guidelines for Trademark Examination.

In Section 42, titled "non-completion," it is stipulated that if the registration of a trademark is not finalized within twelve months from the application date due to an omission by the applicant, the application will be considered abandoned if, after thirty days from the notification of such a situation, the registration remains incomplete. Therefore, it would be advisable to consider the possibility of requesting an extension within the thirty-day period provided, supported by valid reasons (in line with items 3.3 Response Time; 12.1 Opposition proceedings; 12.5 Answer; 12.11.1 Timing of Submission of the Guidelines for Trademark Examination).

## **Part VI Opposition Proceedings**

About the opposition proceedings provided by the Bahamas TM Regulations 2023, we would like to recommend that a provision be included granting a default judgment in the event that the applicant for the opposed mark has not, within a specified period, filed an official response to the opposition. Such proposal is set forth on item 5 (Opposition procedure) of INTA Model Trademark Law Guidelines.

Furthermore, INTA's Guidelines for Trademark Examination provides, in item 12.1 (Opposition Proceedings), that "The parties shall also be permitted to place the opposition proceedings into a "cooling off," suspension, or similar period to facilitate settlement negotiations". In this regard, since



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Bahamas TM Regulations 2023 do not foresee such a cooling off period, INTA recommends that a provision be included to permit this.

It is also noted that Bahamas TM Regulations 2023 do not provide a procedure for suspension of an opposition with consent of the parties or upon good cause. This type of proceeding is recommended by INTA in its Guidelines for Trademark Examination – item 12.10. Consequently, INTA's proposal is to include a provision regarding this specific issue.

### **Part VII Renewal**

Regarding comments on the Bahamas Trademark Regulations 2023, INTA suggests including the term against which the trademarks are to be renewed, as this is not currently included. In accordance with item 3.7 of the INTA Model Trademark Law Guidelines, it is suggested that the renewal period be ten years.

Section 59 of the Bahamas Trademark Regulations 2023 indicates that a notice will be sent to the registered owner's address before the trademark's final expiration.

INTA would respectfully inquire about the procedure for notifying trademark owners, when the owner is a foreign organization, whose address is not in the Bahamas. INTA suggests that the Bahamian government could clarify this notification process and could establish a different procedure for trademark owners from abroad or could clarify that this notice will be sent to the attorney of record listed on the trademark registration application.

### **Part XIII Defensive Registration**

INTA would like to recommend further review for this section, as well as to the proposed procedures associated to this subject as some contradictions may arise for example with registration requests, the possibility of formal defects arising, opposition procedures, and trial openings, among others.

For instance, in 16.2 a reference is made to "legal representatives" of deceased individuals, but "successors" may be more appropriate to refer to those individuals or companies who have an agreement allowing them to commercially exploit the name or likeness of a person (and register it as a trademark).

No reference to causes of nullity when the trademark is composed exclusively by terms lacking distinctiveness, fantasy, generic expressions, or those that have become of common usage is included in this section. We suggest considering explicitly adding them to prevent trademark applications with these defects and potential grants of such registrations.

As for the procedures, we suggest reviewing the regulation regarding the evidence in the opposition proceedings; specifically, Article 52.1, where it is stated that "If an opponent files no evidence, the opponent shall be deemed to have abandoned the opposition." It may be convenient to clarify that the initiation of a trial period is available whenever a party requests it (trademark applicant and opponent) or when the Trademark Office examiner deems it necessary to proceed because there are elements to accredit.



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Regarding 'Defensive Trademarks', we recommend revising the regulation for these types of trademarks, considering that article 22 of the regulation requires the submission of a declaration of use or intention to use for applications.

In the event a 'Defensive Trademark' is registered it would be convenient to require that the applicant holds a prior, granted, and valid trademark registration (of the defensive trademark that is applying for), for certain products or services that they currently use.

### **Part XVI Certification Marks**

As to the regulation proposed for Certification Marks, we find the bill in accordance with the general principles provided by the INTA Model Trademark Law Guidelines.

INTA's only recommendation refers to Section 121, with regards to the Advertisement of certification marks in the Official Gazette of every application or amendment to an application when accepted; it is recommendable to include in the TM Regulations Bill the specific time and manner the publication will take place.

### **DESIGNS - Trade Marks (Amendment) Bill and Regulations, 2023**

INTA's Model Design Law Guidelines articulate INTA's current position in favour of non-protection of a design if the overall appearance of the design is solely dictated by its function.

The most relevant excerpts from these documents are set out below.

INTA Model Design Law Guidelines. Section 5. Designs Incorporating Functional Features Proposal.

Design registrations protect the overall ornamental appearance of a design, not an aggregation of separable features. The fact that a design includes one or more elements or features that serve a functional purpose should not be a bar to protection of the design unless the overall appearance of the design is solely dictated by its function.

Rationale. Many countries allow protection for designs having features whose appearance is essentially (and even solely) dictated by the technical function, while others deny protection for features of appearance of a product which are solely dictated by its technical function. Features of a design should rarely be excluded from protection for being solely dictated by technical function. And it should be rare for whole design to be invalidated because the overall appearance of that design is dictated by function. Any exclusion for features of a design solely dictated by technical function should be narrowly construed and the threshold of "solely dictated by technical function" is not met in the case of mere functionality of a design or some of its features.

Design protection should be afforded unless the appearance of the design as a whole is solely dictated by its technical function, even if individual features of the design or the design as a whole serves a function. A design applicant should be afforded the opportunity to respond to any objection



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made on the ground that the appearance of the design itself, or that the appearance of elements of the design, is dictated by their technical function.

INTA applauds the initiative of the IP Office of Bahamas to amend of section 48 of the principal Act, however to maintain a focus on the design as a whole, rather than its individual parts, INTA recommends modifying the proposed new subsection as follows:

“(2) Protection conferred by a patent shall not apply to anything in a design which serves solely to obtain a technical or functional result.”

The IP Bahamas proposal is based upon Clause 6 of the Bill pointing out that “protection conferred by a patent shall not apply to anything in a design which serves solely to obtain a technical or functional result, to the extent that it leaves no freedom as regards arbitrary features of appearance”. However, the better practice is that Design protection should be afforded unless the appearance of the design as a whole is solely dictated by its technical function, even if individual features of the design or the design as a whole serves a function.

INTA is aligned with this amendment, which is supported by our INTA Model Design Law Guidelines (section 5). Therefore, only if the overall appearance of a design is solely dictated by its function will the design not be protected.

## INTERNATIONAL TREATIES

### International registries

INTA shares the vision expressed by the Government of The Bahamas that *“by participating in international treaties and agreements (..) allow Bahamians to capitalize on their unique talents in the international marketplace”*.

The Madrid Protocol<sup>5</sup> and the Hague Agreement<sup>6</sup> are powerful tools for the protection and enforcement of IP. These treaties provide efficient and cost-effective procedures for protecting trademarks and designs in multiple countries and intergovernmental organizations.

Therefore, INTA welcomes and strongly supports the stated intention to adhere to the Madrid Protocol and encourages the inclusion of the Hague Agreement in this package.

Some other benefits for brand owners and creators are:

- **Simplified Process:** Brand and design owners can file a single application in one language, with one set of fees, to protect their IP in multiple countries. This simplifies the registration process and reduces the administrative burdens compared to filing separate applications in each country.
- Both the Madrid and the Hague systems provide a centralized platform for managing international registrations. Changes to the registration, such as assignments, or changes in

<sup>5</sup> [INTA Letterhead general template usletter.](#)

<sup>6</sup> [INTA Letterhead general template usletter.](#)



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ownership, can be made centrally through the World Intellectual Property Organization (WIPO), rather than dealing with multiple national offices.

- Time Efficiency: The Madrid and Hague systems generally offer faster processing times than filing separate applications in each country.

The Madrid Protocol also allows for streamlined maintenance of international registrations as renewals and other administrative tasks can be handled centrally through WIPO's secretary, reducing administrative burden on brand owners.

Finally both, the Madrid and Hague systems promote harmonization of trademark and design registration procedures and standards among member countries, which can lead to greater consistency and predictability for brand owners and creators operating internationally.

### **Other treaties**

INTA also supports the Bahamas' adherence to the Singapore<sup>7</sup> Treaty on the Law of Trademarks and would like to highlight some of its benefits from a brand owner's perspective:

The trademark License Recordal Provisions: Provisions relating to trademark license recordal, based on the 2000 WIPO Joint Recommendation on Trademark Licenses set forth the maximum requirements for requests to record, amend or cancel the recordal of a license. Importantly, non-recording of a license shall not affect the validity of the registration of the mark. The recordation of a license may not be required as a condition for a licensee's use of a mark to be considered as use by the owner in proceedings relating to the acquisition, maintenance and enforcement of marks. Similarly, registration of a license may not be required as a condition for a licensee to intervene in infringement proceedings brought by the owner or to recover damages for infringement in such proceedings, although any state or intergovernmental organization may, by reservation, declare that it requires registration of a license as a condition in this respect.

The Singapore Treaty provides for remedies for failure to comply with time limits, considering three possible types of remedies. These are: (i) extension of time; (ii) continued processing; and (iii) reinstatement of rights if the Trademark Office finds that the failure to comply with the time limit occurred despite due diligence or was unintentional. Applicants, proprietors and interested persons may be required to file requests for extension of time limits and continued processing within a period of not less than two months from the date of expiry of the relevant time limit. Requests for re-establishment of rights must be filed within a "reasonable time", which may not be less than six months from the date of expiry of the relevant time limit.

The Singapore Treaty allows contracting parties to choose the means of communication and to determine whether they accept paper, electronic or other forms of communication. There are also provisions governing the procedures for electronic communications, including paper communications transmitted electronically.

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The TLT 1994 covers only visible signs, but non-visible signs such as sounds and smells, as well as non-traditional marks such as three-dimensional marks and holograms, are increasingly being protected in jurisdictions around the world. In line with this trend, the Singapore Treaty can be applied generally to all signs registrable under the national law of a Contracting Party.

It should be noted, however, that the Supplementary Resolution adopted with this Treaty states that Contracting Parties are not obliged to register the "new types of marks" mentioned in the Regulations to the Treaty or to implement electronic filing or other automated systems. The resolution also supports the provision of technical assistance to developing countries.

### **Concluding remarks**

Intellectual property rights are crucial for innovation and knowledge-based economic and social development. They allow creators to be compensated for their work and encourage investment in uncertain, risky, and long-term scientific fields. They are also a valuable tool for preserving and sharing knowledge in all fields of science and culture.

The study entitled "Economic Impact in 10 Latin American and Caribbean Countries" published by INTA in October 2019<sup>8</sup> found that trademark-intensive sectors contribute 18 percent to employment—equivalent to 35 million jobs—and pay their employees up to 57 percent more in wages. It also found that about one-third of a country's international trade derives from trademark-intensive sectors. Thus, robust intellectual property laws that help businesses thrive are critical drivers of economic growth and social welfare. Trademarks are an effective mechanism for identifying the origin and quality of goods and services, providing useful information to consumers and society at large. On the other hand, as intangible assets, trademarks have become accessible business tools, particularly for small and medium-sized enterprises (SMEs) from developing countries.

The essential function of a trademark is to identify the origin of the marked goods and/or service to consumers by enabling them to distinguish the goods and/or services of a brand owner from those of competitors, thereby enabling consumers to make informed choices. Trademarks also serve to protect consumers against confusion as to what products they are purchasing, as well as against fraud and counterfeiting affecting health and safety, including adulterated, defective, or otherwise unsafe goods.

Accordingly, trademarks must necessarily appear in advertising to enable consumers to identify the source of the advertised goods and/or services, and while such use of trademarks is essential to any advertising campaign, advertising should not be confused with the use of trademarks on goods and services. Legislation must ensure that the mere use of a trademark on goods and/or services is not, by or in itself, treated as advertising and should not confuse the attributes of a trademark with its functions.

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<sup>8</sup> [Trademarks in Latin America—Economic Impact in 10 Latin America and Caribbean Countries - International Trademark Association \(inta.org\)](#)



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INTA would be pleased to answer any questions that the Government of the Bahamas may have and is available to discuss our recommendations in more detail. Please contact INTA's Chief of the Latin America and Caribbean Representative Office, Carolina Belmar (cbelmar@inta.org).

Thank you in advance for considering the views of INTA.

Yours sincerely,

A handwritten signature in blue ink, which appears to read "Etienne Sanz de Acedo". The signature is fluid and cursive, with a prominent initial "E".

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**Etienne Sanz de Acedo**  
**Chief Executive Officer**  
**International Trademark Association**