

## Antigua and Barbuda Protection of Country names

### The legal basis of such protection (whether Trademark or Non-trademark law)

“**Antigua & Barbuda Trade Marks Act 2003**” favors the idea of “protection of country names”. Section 3 (2) (iv) of our Act explicitly states that **“A mark cannot be validly registered if it is identical with, or is an imitation of or contains as an element, an armorial bearing, flag and other emblem, a name or abbreviation or initials of the name of, or official sign or hallmark adopted by, any State, intergovernmental organizations or organization created by an international convention, unless authorized by the competent authority of that State or organization”**. This ground for refusal is strictly enforced in our office, usually to the dislike of the Applicant/Agent. Unless they can show authorization by the competent authority, these types of Trademark applications are always denied.

Further, a mark cannot be registered in accordance with Trademark Act Section 3(2)(III) **if it is likely to mislead the public or trade circles, in particular as regards the geographic origin of goods or services concerned or their nature or characteristics.**

“**The Geographical Indications Act**” further prevents the use of geographical names as a Trademark, to some extent. A Geographical Indication could include a name of a Country, a graphic representation of a country or a combination of both. Section 17 of this Act states “The Registrar shall, on his own motion or at the request of an interested party, refuse or invalidate the registration of a trademark which contains or consists of a geographical indication with respect to goods not originating in the territory indicated ...”. Therefore in the event Antigua’s name is contained in a Trademark with regards to goods not originating in the Country, then we have the legal ground to refuse it.

“**The Paris Convention for the Protection of Industrial Property**” to which Antigua and Barbuda is a member supports our local Trademark Act as it regards to “protection of country name”. Member States have an undertaking under section (1) (a) of Article 6<sup>ter</sup> “... to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.”

### The applicable procedures (pre-registration, post-registration, other)

When an application with a country’s name is received by our office, the applicant/agent is required to show authority of use from the competent authority as per 3(2) (iv) of our Act. As in accordance with section 16 (1) of the Trade marks regulations, 2006, if there are no response within the stipulated time (two months) then the application would have been deemed to have withdrawn. However, if it is shown that they are authorized by

the competent authority, and there is no other conflict then the Trademark will proceed to publication.

Section 19(1) of our Trade Marks Regulation states that any person may, within 3 months of the date on which the Application was published can oppose the Trademark. If there is no opposition within this time then the Registrar shall proceed to issue a registration certificate. The registration is valid for ten years and can be renewed for each succeeding period thereafter. The Holder can then assign the trademark or enter into a license contract.

**The scope of protection accorded to country names in the field of registration of trademarks (the sign applied for registration as a trademark is a country name, or the country name forms part of the sign)**

Our laws do not differentiate between a trademark that is a country's name or where the country's name forms part of the Trademark from other Trademarks, in terms of scope of protection. Therefore, as stated in the previous paragraph, that trademark would be valid for ten years and enjoy all the benefits as other trademarks with a possibility for renewal upon expiry.

**Protection is granted for the official name of the country only or also for variations of those names, such as common names, adjectives or abbreviations.**

Once proper authorization is received then protection is granted for the official name of the country as well as certain variations of those names. If the variation contains an adjective then the applicant is required to remove or disclaim the word as they are not allowed to monopolize descriptive words. We also have to take into account if the adjective is derogatory in nature, then we would request that it be removed under 3(2) (ii).

**Relevant case with a pending decision**

A vast majority of our local population is familiar with the American singing contest /talent show called "*American Idol*". It has become so popular and well-known worldwide that it has earned the reputation of one of the reality shows with the most viewers. In other words, it has become a lucrative brand. Just over two years ago we have received in our office a series of applications for the idol mark, but instead of using "American" the applicant utilizes the various countries of the Caribbean. So, for example they applied for "Antiguan Idol", "Haiti Idol", "Jamaica Idol" all under class 41 for "Entertainment" which is obviously the same as the well-known brand "American Idol".

As in accordance with 3(2) (iv) of our Act, the Holder was asked to show proof of Authorization for each trademark from the competent authority, which they could not. They filed submissions contesting our argument and hence my written decision is pending.

We are concerned with the generic nature and possible registration of the word Caribbean in trademark applications. We have seen applications for registrations using this which we find are geographically incorrect. Particularly, in light of assignments and licenses we are concerned about different jurisdiction laws concerning this.