



HSM IP Trade Mark Client Guide

CAYMAN ISLANDS

Registered Agent

Under section 6 of *The Patents and Trade Marks Law 2011* only a registered agent may transact business with the Cayman Islands Patents & Trade Marks Registry. A registered agent must be legally and ordinarily resident in the Cayman Islands.

The owner of a trade mark must appoint a registered agent upon the next dealing with the Registry or upon payment of the next annual fee.

Registration

A trade mark can be registered in the Cayman Islands pursuant to *The Patents and Trade Marks Law 2011* which only provides for applications to extend rights under an existing UK or European Union (EU) registration with effect from the date of the underlying registration. An application for registration cannot be based on a pending UK or EU trade mark application.

The only information required is the UK or EU registration number. No further documentation is required.

It usually takes two months or less for the Registry to process an application for registration. Paris Convention priority cannot be claimed. Once the registration is complete the Registry will issue a Certificate of Recording.

Classes

The International Classification system is used. Multi-class applications are allowed. A mark does not have to be registered in the Cayman Islands in all the classes covered by the UK or EU registration, however, the classes in which the mark is to be registered in the Cayman Islands must first be recorded in the UK or EU registration.

Searches

It is generally not necessary to conduct a search in the Cayman Islands to ascertain that there will be no difficulty with the application for registration because of the requirement that there be a pre-existing UK or EU registration. If, however, a search is required, the result can usually be provided within three working days.

Annual Fees

Once a trade mark has been registered in the Cayman Islands there is an annual fee payable to the Cayman Islands Government in January each year.

Failure to pay an annual fee will result in the rights protected by the registration being placed in abeyance. This will effectively prevent any enforcement action being taken. A penalty has also been introduced for the late payment of annual fees where payment has not been received by the Registry before 1 April each year.

The Registry may cancel the record of a trade mark for failure to pay annual fees and penalties for 12 months.

Renewal

A trade mark registration is valid for the same period as specified on the underlying UK or EU registration on which it is based.

The registration can only be renewed in the Cayman Islands once the UK or EU registration has been renewed.

Two months before the renewal date we will send you an Expiry Notice asking whether you wish us to renew the registration (and the UK or EU registration if necessary) or allow the mark to lapse.

The application for renewal should be filed prior to the expiration date of the registration. A grace period of two months, however, is allowed from the expiration date for the filing of the application for renewal. After that time a late fee is payable.

It usually takes two months or less for the Registry to process an application for renewal. Once the renewal is complete the Registry will issue a Renewal Certificate.

If you do not wish to renew the mark please inform us so that we can advise the Registry accordingly.

Cancellation

A trade mark record may be cancelled by the Registry for failure to pay annual fees and penalties for 12 months or failure by the proprietor to appoint a new registered agent where the previous registered agent has resigned. In these instances it is possible to make an application to the Registry to re-register a cancelled trade mark.

If, however, the underlying UK or EU registration is cancelled the Cayman Islands registration will also be cancelled.

Abandonment

Please inform us as soon as possible if you wish to abandon your trade mark or allow it to lapse so that we can update our records and advise the Registry accordingly. This will avoid us sending out unnecessary Reminder Notices regarding annual fees etc.

Restoration

It is possible to make an application to the Registry to restore an abandoned trade mark upon payment of a restoration fee and any unpaid annual fees and penalties.

Certificates of Good Standing

The Registry may issue a Certificate of Good Standing to evidence that a trade mark has been recorded in the Cayman Islands and that all applicable fees have been paid.

Assignment

Please inform us as soon as possible if the trade mark has been assigned so that we can file an application to record the assignment in the Cayman Islands (and the UK or EU if necessary).

Any change in the underlying UK or EU registration must be recorded in the Cayman Islands within two months of the change being recorded in the UK or EU. If the change is not recorded within this time then the rights protected by the registration will be placed in abeyance. This will effectively prevent any enforcement action being taken.

It usually takes two months or less for the Registry to process an application to record an assignment. Once the recording is complete the Registry will issue a Certificate of Recording.

Change of Particulars

Please inform us as soon as possible if there is any change to the registration so that we can file an application to record the change in the Cayman Islands (and the UK or EU if necessary).

Any change in the underlying UK or EU registration must be recorded in the Cayman Islands within two months of the change being recorded in the UK or EU. If the change is not recorded within this time then the rights protected by the registration will be placed in abeyance. This will effectively prevent any enforcement action being taken.

It usually takes two months or less for the Registry to process an application to record a Change of Particulars. Once the recording is complete the Registry will issue a Certificate of Recording.

Security Interests

The Registry does not provide for the formal recording of security interests.

A security interest may be recorded against the underlying UK or EU registration, however, and a certified copy of the UK or EU register, showing the security interest, may be lodged at the Registry so that anyone inspecting the public record is put on notice.

Licences

There is no provision under Cayman Islands law for the recording of licences.

The only way a licence can be protected is by:

1. registering the mark in the Cayman Islands and recording the licence in the UK or EU.
2. ensuring that the licence either requires the proprietor of the mark to take legal action if necessary to protect the rights of the licensee or gives the licensee the right to sue in the Cayman Islands in the name of the proprietor to protect their interests.
3. lodging a copy of the UK or EU registered entries, including details of the licence, at the Registry. This is not the same as recording the licence, but does put anyone inspecting the public record on notice.

Our Firm

HSM IP Ltd. provides worldwide intellectual property services. Based in the Cayman Islands and independently owned and operated, our experienced team of attorneys and paralegals deliver first class service to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues internationally.

The success and growth of our firm is due to our keen understanding of our clients' needs for a comprehensive "one-stop shop" which encompasses a wide range of services from the initial consultation process to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly and substantially paperless workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements, including multi-currency invoicing and e-billing. We offer a competitive schedule of fixed fees, inclusive of both disbursements and official fees, which means we can provide clients with an accurate estimate of their project costs before embarking on a global filing programme for their portfolio.

As a leader in the field, HSM IP understands the value of long-term business relationships. We have a wealth of knowledge and specialise in the Caribbean, Central and Latin America and other off shore jurisdictions. Our staff regularly contribute to leading IP publications and we also publish a range of country-specific IP Client Guides which are available on our website.

Supported by HSM Chambers, an offshore law firm with experienced attorneys admitted in multiple jurisdictions, we have substantial experience in taking action to address the infringement of trade marks and patents and in the conduct of passing-off actions. We are also able to offer investigative services to identify the source of, and distributors of, infringing goods, working closely with police and customs officials as necessary.

Memberships: INTA, ASIPI, ITMA, MARQUES and IPCA.

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HSM IP Ltd. is a Law Firm recognised under the Legal Practitioners (Incorporated Practice) Regulations, 2006 (as amended).

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