

CHANGES TO PATENT AND TRADE MARK LAW IN THE CAYMAN ISLANDS

February 2012

The Cayman Islands legislature recently passed the Patents and Trade Marks Law, 2011 (the “Law”) which repeals and replaces the previous law and introduces some significant changes to patent and trade mark law in the Cayman Islands, as summarized below. The Law became effective on 7 December 2011.

Requirement for Registered Agent

Pursuant to the Law, except for general searches of the Cayman Islands Registry of Patents and Trade Marks (the “Registry”), only a registered agent who is ordinarily resident in the Cayman Islands and licensed by the Registrar of Patents and Trade Marks (the “Registrar”) may transact business with the Registry.

Owners of patents or trade marks recorded in the Cayman Islands who do not have a registered agent must now appoint one when they next deal with the Registry in relation to their patent or trade mark or when they next pay their annual fee, whichever is sooner. Harneys is a registered agent and is able to conduct business with the Registry. Upon being instructed by the owner of the patent or trade mark, the registered agent will deal with the Registry on such matters as registration, renewal, payment of annual fees and any other dealings as instructed by the owner.

Pursuant to the Law, if a registered agent with respect to a patent or trade mark resigns, the record of such patent or trade mark will be *cancelled* unless a new registered agent is appointed *within 60 days* of the Registrar being notified of the registered agent’s resignation.

Annual Fees and Penalties

After the year of initial recording of the patent or trade mark, annual fees are payable in January of each year. The failure to pay annual fees by the 31st of March will cause the recorded entry to be in abeyance from the 1st of April until the annual fee (currently CI\$200/US\$243.90 for patents and trade marks registered in one class) and a penalty fee (CI\$100/US\$121.95) have been paid.

In the event the applicable annual fee and penalty fee are not paid for more than 12 months, the record of a patent or trade mark may be liable for cancellation by the Registrar. In circumstances where the record of a patent or trade mark has been cancelled and the owner wishes to re-register the patent or trade mark in the

Cayman Islands, the owner, through its registered agent, must apply for recording again as though it was being registered for the first time.

Certificates of Good Standing

If requested by a registered agent, the Registrar may now issue a certificate of good standing evidencing that a patent or trade mark has been recorded and all applicable fees have been paid. The fee for the certificate of good standing is CI\$100/US\$121.95.

Renewal of expired patents or trade marks

The Law provides that a registered agent may apply for an expired patent or trade mark to be renewed on behalf of the owner of such patent or trade mark. However, a renewal application which is made *more than 2 months* after the recorded expiry date of the patent or trade mark will attract a penalty fee (CI\$100/US\$121.95) *in addition* to the renewal fee (CI\$200/US\$243.90) *and* any outstanding annual and penalty fees.

Abandoned patents or trade marks

Pursuant to the new Law, owners of a patent or trade mark must inform the Registry, via their registered agent, if a patent or trade mark has been abandoned. In such circumstances, the Registry will record the protected right as inactive. During the period of inactivity, the obligation to pay an annual fee is suspended. The registered agent can apply to reactivate the patent or trade mark on payment of a re-activation fee (CI\$150/US\$182.93) and any annual fees owed for the suspension period.

Changes in Particulars

If the particulars of the grant or registration of a right recorded in the Registry are modified or changed in the United Kingdom or the European Community and the Registry is not notified of such change *within 2 months*, the rights protected by the recorded entry in the Cayman Islands will be in abeyance against the person in default from the date the change was recorded in the United Kingdom or the European Community until the date the Registrar has been notified of the change and the applicable fee (CI\$150/US\$182.93) is paid.

FURTHER INFORMATION

If you have a trade mark or patent registered in the Cayman Islands or are interested in applying for registration of such a right, please do not hesitate to contact Wendy Lee (wendy.lee@harneys.com) or your usual Harneys attorney for further information about the new Law.

The foregoing discussion and analysis is for general information purposes only and is not intended to be relied upon for legal advice in any specific or individual situation.

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