

## Trade Marks Act 2023

### Practice Note no. 1

#### *Presentation of Specifications*

When submitting new trademark applications, we ask that the class number/s contained in the Application to register a Trade mark (Form 3) be followed by the specifications of the good and services for which the trademark is being applied for.

Additionally, where the application is a multiple class application, we ask that the respective class numbers and accompanying specifications be listed in chronological order. There is no longer the requirement to add the qualification “all included in class X” at the end of the specifications.

For example:

Class Number	List of goods and services
Class 9	Computer hardware; computer software; computer peripherals; electronic and online manuals; mouse pads.
Class 16	Books; manuals; notebooks; notepads; pens; greeting cards; stickers; decals; sticky notes.
Class 36	Charitable fund raising; providing grants to charitable organizations; financial services; financial transaction processing services; payment and billing services.

Aubrey Pennyman  
Registrar General

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### **Practice Note no. 2**

#### *Address for Service*

The practice remains that applications for the registration of a trademarks in Bermuda must have an address for service in Bermuda.

This address will be used by the Intellectual Property Office in all correspondence related to the application.

This practice is in line with Regulation 11 of the Trade Marks Regulations 2023 and is accepted practice at the UKIPO and in most developed jurisdictions.

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Registrar General

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### Practice Note no. 3

#### *Entering a Trademark on the Register*

Noting that the ambiguity of the 1974 Act, resulted in the unfortunate circumstance of trademarks being entered onto the register several years after the marks had been advertised and the opposition period had long been exhausted, the Registry General has chosen to implement clearer statutory requirements as relates to “Registry Entries”.

It is hoped that the adherence to these requirements will ensure that the turnaround time from the submission of a trademark application and the registration of the trademark will be dramatically decreased, making trademark registration in Bermuda more attractive to potential trademark proprietors.

The Registry’s practice in accordance with Section 49 of the Trade Marks Act 2023 will be as follows:

- 1) Where no opposition has been filed against the registration of a mark or where opposition proceedings have been withdrawn or decided in favor of the Applicant, the Registry will issue a notice to Agents/Applicants, indicating that they can proceed with the registration of the mark/entering the mark on the register. This notice will be issued via email and will be effective immediately, pursuant to Regulation 73 of the Trade Marks Regulations 2023.
- 2) Agents/Applicants are therefore encouraged to ensure that the Registry has current and functional email addresses for its usage. Further, Agents/Applicants should immediately report to the Registry any changes in email addresses to avoid delays in the delivery of notices.
- 3) Agents/Applicants will have three months from receipt of the electronic notice to request that the mark be entered onto the register.
- 4) Agents/Applicants are to submit the prescribed form (TM 4) and prescribe fees to enter the mark on the register.

- 5) Agents/Applicants may seek an extension, where necessary. However, the extension cannot exceed a period of three months and the request for an extension must have been made in time (See Section 49 (3) (b)) of the Trade Marks Act 2023. Once the extension period of three months has been exhausted, there will be no further extensions granted.
- 6) In order to accommodate the statutory requirement to provide notice to Agents/Applicants, under Section 49 (3) (a) of the Trade Marks Act 2023, the Registry will no longer issue “Advert Notice” letters to agents/applicants.
- 7) Agents/Applicants are strongly encouraged to frequently check the monthly journals of trademarks issued online by the Registry and govern themselves accordingly.

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Registrar General

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### **Practice Note no. 4**

#### *Advertisement Fees*

The Registrar shall charge an administrative fee of \$40 to advertise matters requiring publication pursuant to the following provisions of the 2023 Act:

- *Publication of the alteration of a registered trademark, pursuant to Section 53 (4) of the Trade Marks Act 2023.*
- *Publication of Amended Regulations for Collective marks, pursuant to Schedule 1, Section 10 (2) of the Trade Marks Act 2023.*
- *Publication of Amended Regulations for Certificate marks, pursuant to Schedule 2, Section 11 (c) of the Trade Marks Act 2023.*
- *Publication of Amended Trademark applications after publication, pursuant to Regulation 24 of the Trade Marks Regulations 2023.*

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Registrar General

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### **Practice Note no. 5**

#### *Retail services under class 35*

In accordance with the UKIPO Manual of Trademark Practice, the Registrar will continue to apply the following guidelines in relation to class 35 applications:

#### **Acceptable**

- The bringing together, for the benefit of others, of a variety of [indicate goods or types of goods], enabling customers to conveniently view and purchase those goods;
- The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase [indicate goods or types of goods];
- Retail services connected with [indicate goods or types of goods];
- Retail services connected with the sale of [indicate goods or types of goods]; Retail store services in the field of [indicate goods or types of goods];
- Department store retail services connected with [indicate goods or types of goods]
- Shop retail services connected with [indicate goods or types of goods];
- Mail order retail services connected with [indicate goods or types of goods]; Electronic shopping retail services connected with [indicate goods or types of goods]; Retail clothing shop services;
- Wholesale services connected with the sale of [indicate goods or types of goods]
- The bringing together for the benefit of others, of a variety of retail outlets, entertainment, restaurant and [other clearly defined related services], enabling customers to conveniently view and purchase goods and make use of and purchase such services in a shopping centre or mall.
- The bringing together for the benefit of others, via the internet, of a variety of retailers and [other clearly defined related services] through a virtual shopping mall, enabling customers to conveniently view and purchase

goods and make use of and purchase such services by means of telecommunications.

### **Not Acceptable**

- Sale of electrical and electronic goods for industrial use [ the sale of goods is not a service];
- Trade in building products [ trading in goods is not a service]
- Retailing [ retailing goods is not a service per se];
- Retailing of cards [retailing of goods is not a service]
- Retail services for the sale of foods [ sale of foods is not a service]
- Retail of licenses specializing in the sale of alcoholic beverages [ sales are not a service]
- Shops [not a service per se]
- Factory shops [not a service per se]
- Merchandising [not a service per se]
- Distributorship [not a service per se]
- Sales services [not a service per se]
- Direct selling [not a service per se]
- Mail order[not a service per se]
- Television shopping [not a service per se]
- Electronic shopping [not a service per se]
- Computer shopping [not a service per se]
- E-commerce [not a service per se]
- Retail services [unqualified]
- Retail store services [unqualified]
- Department store services [unqualified]
- Mail order catalogue services [unqualified]
- The bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a department store [ “department store” does not identify the type of goods];
- Retail services connected with the sale of electrical and electronic goods [ the terms “electrical” and or “electronic” are too vague without further indication to define the types of goods];
- Retail services connected with stationery products and the like goods [ “and the like goods” fails to identify the goods and types of goods];

- The same practice will apply for wholesale services and it will be necessary to specify the goods of types of goods, for example:
- Wholesale services connected with the sale of [ indicate goods or types of goods]

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Registrar General



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**Practice Note no. 6**

*Certificates of Renewals*

Section 52 of the Trade Marks Act 2023 and Regulations 35 of the Trade Marks Regulations 2023 provide that when a registration is renewed the Registrar shall make an entry in the Register of Trademarks and publish the renewal notification in the Trademark Journal.

Form TM 9, accompanied by the appropriate fees, should be submitted to request the renewal of a mark. The fee to renew a mark can be found at items 57- 59 of the Government Fees (Trade Marks) Regulations 2025.

If the registered proprietor requests a Certificate of Renewal, then the Registrar shall issue same. The fees to issue the certificates can be found at items 60 and 61 of the Government Fees (Trade Marks) Regulations 2025.

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### **Practice Note no. 7**

#### *Fees for Authorisation of Agent*

Where new applications held by the same proprietor are submitted at the same time, one Authorisation of Agent may be submitted for the marks and the fee of \$68 will be charged for the first mark and \$38 for each additional mark being submitted at that time.

The same principle applies for requests for renewals and other transactions in the life of a trademark, which are being submitted by a newly appointed agent (an agent coming on record for the first time).

The tiered fee structure will only be applied to new applications and other requests submitted as a bundle, that is submitted at the same time, in person or via the same email.

Aubrey Pennyman  
Registrar General