

A NOTE ON TRADEMARK REFORM published in the Bar Association Review
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"Successful reform is not an event. It is a sustainable process that will build on its own successes – a virtuous cycle of change.

Abdullah II of Jordan¹

Trademark Reform and Guyana Oil

Introduction

Intellectual Property Rights

Intellectual Property Rights (IPRs) are exclusive rights given to persons over the use of their creations. They include Trademarks, Patents and Designs, Trade Secrets, Copyright and Geographical Indications. This article highlights the need for Law Reform of IPRs laws and focuses primarily on Trademarks relating to services marks, priority rights and classification of marks. It also makes recommendations.

Definition of Trademark

A mark and trade mark have been defined in the Guyana Trade Marks Act to include "a device, brand, heading, label, ticket, name, signature, word, letter, numeral ..." used in relation to goods to indicate a connection in the course of a trade between the goods and the person or company registered as the proprietor of the goods. Modern legislation includes sound, scents and even three-dimensional shapes. The American historian Daniel J. Boorstin described a trademark or design image as "a studiously crafted personality profile of an individual, institution, corporation, product or service"².

International Intellectual Property Rights Obligations

Guyana became a member of the World Intellectual Property Organization (WIPO) in 1994 and the World Trade Organisation (WTO) in 1995. Guyana is also a signatory to the Protection of Industrial Property (Paris Convention) since 1994 and the Trade Related Aspects of International Property Rights (TRIPS). TRIPS is intended to give reciprocal protection of Intellectual Property Rights between countries.

Guyana also signed on to the Berne Convention for the Protection of Literary and Artistic Works in 1994 and the Universal Copyright Convention.

However, despite being a signatory to several international conventions, Guyana has failed to enact revised IPRs laws to reflect the technological advances made by those agreements.

Principal Intellectual Property Rights laws

The IPRs laws remain at pre-independence status. The Trade Marks Act Cap. 90:01 and Rules are dated 1956 with one amendment in 1972 based on the United Kingdom Trademarks Act of 1938.

The Merchandise Marks Act Cap. 90:04 is dated 1888 and was last amended in 1972. It relates to fraudulent marks on merchandise and carries offences and fines which bear no relevance to the present time.

The Patents and Designs Act Cap. 90:03 is also dated 1938 and was last amended in 1972. There are also Regulations.

The Copyright Act (Cap. 74) dated 1956 is also archaic and offers little or no protection to authors, musicians, artists, designers, film-makers and software developers.

There has been piecemeal legislative improvement in the form of a new Geographical Indications Act No. 15 of 2005 which states that it provides for the protection of geographical indications to fulfill Guyana's obligations under TRIPS and WTO. This Act which became law in 2008 was used by DDL in 2016 to become the proprietors of Demerara Rum, Demerara Sugar and Demerara Molasses.

Both the Geographical Indications and Copyright Acts have been omitted from the current 2012 'purple volumes' of the Laws of Guyana.

Services Marks

With regard to marks relating to services, the Guyana Trade Marks Act does not permit registration unless previously registered in the United Kingdom and a certificate issued by the United Kingdom Patent Office. This is an insult to our own Guyanese citizens who have never been able to register services marks, while UK services marks enjoy superiority. This legislative restriction of not allowing independent registration of services is a vestige of colonialism and one would have thought that more than 53 years after independence, the IPRs laws would not have remained stagnant. Other Caribbean jurisdictions including Trinidad, Barbados, Jamaica, Anguilla, Belize and St. Kitts-Nevis have been progressive and updated their laws to permit independent applications for service marks.

Priority Rights

International priority is another area that requires change as set out in the Paris Convention. A priority right applies when a proprietor who has registered a trademark out of Guyana and subsequently wishes to register the same mark in Guyana is permitted to do so effective from the date of filing the first application. This is permitted in several Caribbean jurisdictions including Barbados, Trinidad, Jamaica, Anguilla, Bahamas, Belize, Dominica, Grenada and St. Kitts & Nevis.

Guyana offers re-registration of United Kingdom trademarks, but does not extend this privilege to other countries. In this modern age, with Guyana being an independent nation, there can be no good reason why re-registration of trademarks ought not to be extended to the European Union, United States of America, Caribbean and other countries.

Classification of Marks

In relation to the registration of marks, the Guyana Trade Marks Act has its own Schedule of Classification of Goods. However, the Nice Agreement 1957 which established the Nice Classification system assigning goods to Classes 1 to 34 and services to Classes 35 to 45, is applied. The Nice Classification was developed in an era when the paper catalogue index reigned. This classification of goods still presents uniformity of goods challenges where the separation of goods otherwise considered to be in a group can lead to multiple applications. For example, Protex, Dial and Lifebuoy soaps strictly fall into Class 5 as they are labelled antibacterial soaps considered as medicated, while soaps such as Dove and Irish

Spring fall in Class 3 as they are considered antiperspirant and deodorant soaps. Beer, though it contains alcohol, is not included in Class 33 that lists alcoholic beverages since it is characterised as an alternative to a soft drink beverage. This anomaly is inconsistent with local culture.

Deeds and Commercial Registries Authority

Since the creation of the Commercial arm of the new Deeds and Commercial Registries Authority (DCRA) which administers Trademarks, Patents and Designs, there has been improvement. The backlog of Trademark applications for registration has been cleared and processing time for applications, renewals, assignments and related services has been substantially reduced. There is still some room for improvement to bring it in line with processing times in other jurisdictions.

Although the international IPRs agreements have not been incorporated into the Laws of Guyana, the DCRA uses the WIPO database and their Industrial Property Administration System (IPAS) software to support its operations. It is of interest that on the 2nd April 2019, WIPO announced that searches on their Global Brand Database for figurative marks will be carried out using new AI-based technology for classification. The WIPO database does not cover all international registered trademarks, however it is available to all users free of charge.

Recommendations

A Commission comprising of persons qualified in intellectual property rights law, legal knowledge, legislative drafting techniques and information technology skills ought to be established to recommend policies, balancing Guyana's culture and traditions with international obligations, to draft and implement new laws. With regard to trademarks, this ought to include services marks, expand priority rights, consider different ways in which the Nice Classification can be implemented and other matters, including colour marks. There are trademark offences and outdated fines in both the Trade Marks and Merchandise Marks Acts. New offenses and penalties must be considered and consolidated. The cut and paste slavish approach to legislative drafting ought not to be the standard.

With the development of computer programs and software, new ideas can be generated. In this modern digital age, the use of blockchain technology can be considered for the registration of property rights. The goal is to establish an

intellectual property rights algorithm so as to create the protections needed and to uplift Guyana from this pre-independence hangover.

The DCRA website ought to be updated and improved to include a database of all registered marks from which the public can carry out user friendly searches.

Finally, in order to complement the development of innovation and technological advancement, training is essential along with the development of maintenance capability.

Law Reform and Economic progress

Guyana is again in the international limelight with the discovery of gigantic quantities of oil with production slated to commence in 2020. This discovery has attracted businesses worldwide. The emergence of the oil industry makes it even more imperative not only for general law reform in many areas but for improvement of the Intellectual Property Rights laws. This will have the effect of demonstrating the commitment to a positive commercial environment by recognising the importance of IPRs in the form of law reform and change. The legislative gap is a disservice to our image. The protection of trademarks, designs and patent will encourage commerce and can only lead to promoting economic efficiency.

Conclusion

Notwithstanding previous draft legislation, it would be to Guyana's benefit to take legislative steps to permit services marks and expand priority rights to protect the foreign registered rights of investors in addition to those from the United Kingdom as other proprietors will undoubtedly want their registered logos and words associated with the special use of their brand to be protected. The creation of a more business friendly environment would certainly be welcomed by those doing business in Guyana.

It was Winston Churchill who said "to improve is to change"³. It is time to act now and make the changes.

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¹ Remarks made at Georgetown University, Washington, DC on the 21 March 2005.

² "*The Image: Or, What Happened to the American Dream*", Atheneum (1962) at p. 186.

³ *His complete speeches, 1897-1963*, edited by Robert Rhodes James, Chelsea House ed., vol.4 (1922-1928), p. 3706 (23 June 1925)