



HSM IP Trade Mark Client Guide

GIBRALTAR

Registration

A trade mark can be registered in Gibraltar pursuant to *The Trade Marks Act 1948* which provides for applications to extend rights under an existing UK, European Union (EU) or International (WIPO) registration which designates the UK or EU.

The following information and documentation is required:

1. a certified representation of the mark
2. two copies of the mark (unless mark is word only)
3. a Certificate of the Comptroller of the UK Patent Office (under his title of Registrar of Trade Marks) giving full particulars of the registration
4. Application for Registration (Form 1)

It usually takes about two months for the Registrar at Companies House Gibraltar to process an application for registration. Paris Convention priority cannot be claimed. Once the registration is complete the Registrar will issue a Certificate of Registration.

Classes

The International Classification system is used. Multi-class applications are allowed. A mark does not have to be registered in Gibraltar in all the classes covered by the base registration, however, the classes in which the mark is to be registered in Gibraltar must be covered by the base registration.

Searches

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

Renewal

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

The registration can only be renewed in Gibraltar once the UK, EU or International 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, EU or International registration if necessary) or allow the mark to lapse. If the registration is to be renewed the only documentation required is a Notice of Renewal by the Registered Proprietor (Form 4) and a Certificate from the Registrar in the UK showing that the mark has been renewed.

The application for renewal must be submitted within three months of the date of renewal of the underlying UK, EU or International registration.

It usually takes about two months for the Registrar to process an application for renewal. Once the renewal is complete the Registrar will issue a Certificate of Renewal.

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

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 Registrar accordingly. This will avoid us sending out unnecessary Reminder Notices.

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 Gibraltar (and in the UK if necessary). Before an assignment can be recorded in Gibraltar it must first be recorded in the UK. If an assignment is underway in the UK we will monitor, free of charge, the pending application and when the assignment has been recorded proceed with the application in Gibraltar.

To record the assignment of a trade mark registration the only documentation required is an Application for the entry of the assignment, transfer or devolution of the proprietorship (Form 2) and a certified copy of the document showing the assignment.

It usually takes about two months for the Registrar to process an application to record an assignment. Once the recording is complete the Registrar will issue a Certificate showing the assignment.

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 Gibraltar (and in the UK if necessary). Before a change can be recorded in Gibraltar it must first be recorded in the UK. If a Change of Particulars is underway in the UK we will monitor, free of charge, the pending application and when the change has been recorded proceed with the application in Gibraltar.

To record a change of name and/or address for a trade mark registration the only documentation required is a Request under section 15 (Form 5) and two prints of the mark (unless mark is word only).

It usually takes about two months for the Registrar to process an application to record a Change of Particulars.

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.

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 offshore 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, CITMA, 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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