



HSM IP Trade Mark Client Guide

ST. HELENA

Registration

A trade mark can be registered in St. Helena pursuant to *Section 3 of The Trade Marks (Registration) Ordinance, Chapter 127* which provides for applications to extend rights under an existing UK registration with effect from the date of registration in the UK.

The following information and documentation is required:

1. a certified representation of the mark
2. a Certificate of the Comptroller of the Intellectual Property Office of the UK (UK IPO) (under his title of Registrar of Trade Marks) giving full particulars of the registration
3. Appointment of Agent (Form No. 1) or a Power of Attorney
4. Application for Registration (Form No. 2)

It usually takes about two months for the Registrar of the St. Helena Supreme Court 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 St. Helena in all the classes covered by the UK registration, however, the classes in which the mark is to be registered in St. Helena must first be recorded in the UK registration.

Searches

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

Renewal

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

The registration can only be renewed in St. Helena once the UK 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 registration if necessary) or allow the mark to lapse. If the registration is to be renewed the documentation required is a Notice of Renewal (Form No. 6), a certified copy of the UK Certificate of Renewal issued by the UK IPO and the original St. Helena Certificate of Registration or a certified copy from the Registrar.

The application for renewal should be filed prior to the expiration date of the registration. A grace period of six months, however, is allowed from the expiration date for the filing of the application for renewal. If the registration is not renewed it shall be cancelled by the Registrar.

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 Renewal Certificate.

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 St. Helena (and in the UK if necessary). Before an assignment can be recorded in St. Helena 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 St. Helena.

To record the assignment of a trade mark registration the documentation required is an Application to Register Subsequent Proprietor (Form No. 4), a certified copy of the document showing the assignment and the original St. Helena Certificate of Registration or a certified copy from the Registrar.

It usually takes about four months for the Registrar to process an application to record an assignment. Once the recording is complete the Registrar shall endorse the Certificate of Registration.

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 St. Helena (and in the UK if necessary). Before a change can be recorded in St. Helena 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 St. Helena.

To record a change of name and/or address for a trade mark registration the documentation required is an Application to Register Subsequent Proprietor (Form No. 4), a certified copy of the document showing the change and the original St. Helena Certificate of Registration or a certified copy from the Registrar.

It usually takes about four months for the Registrar to process an application to record a Change of Particulars. Once the recording is complete the Registrar shall endorse the Certificate of Registration.

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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