



# HSM IP Patent Client Guide

## MONTSERRAT

### Registration

A patent can be registered in Montserrat pursuant to the *Patents Act 2002 (Cap 15.11) (Revised Edition)*, the *Registration of United Kingdom Patents Act, 2002 (Cap 15.22)* and the *Patents Regulations* which provide for both local patent applications and applications to extend rights under a UK or European Patent (EP (UK)) registration within three years from the date of issue in the UK.

For a local application the following information and documentation is required:

1. a request for the grant of the patent
2. a description of the invention
3. one or more claims and any drawings referred to in the description or any claim
4. an abstract
5. Authorisation of Agent (notarised)

For a UK or EP (UK) based application the following information and documentation is required:

1. a request for the grant of the patent
2. certified copy of the UK or EP (UK) patent issued by the Intellectual Property Office of the UK (UK IPO)
3. Authorisation of Agent (notarised)

It usually takes 18-24 months or less for the Registrar of Patents in Montserrat to process a local application for registration. A UK or EP (UK) based application usually takes about 12 months to be processed. Paris Convention priority cannot be claimed. Once the registration is complete the Registrar will issue a Certificate of Registration.

### Patent Cooperation Treaty

Montserrat is not a signatory to the Patent Cooperation Treaty (PCT). National phase filing of a PCT patent is not possible.

### Searches

Whilst there is no requirement to conduct a search in Montserrat prior to the filing of an application for registration a search is recommended to ascertain that there will be no discrepancies concerning the innovativeness of the patent. The result can usually be provided within one week.

### Annual Fees

Once a patent has been registered in Montserrat there is an annual fee payable to the Montserrat Government each year. The first fee is due on the fourth anniversary of the filing date and annually thereafter.

It is possible to pay all the annual fees due in advance up to the expiry date of the patent.

Failure to pay an annual fee will result in the rights protected by the registration being placed in abeyance. This will effectively prevent any enforcement action being taken.

### Expiry

A local patent registration is valid for 14 years and can only be renewed by an order of Cabinet.

A UK or EP (UK) based patent registration is valid for the same period that is shown on the UK or EP (UK) Certificate and can be renewed once the underlying UK or EP (UK) registration has been renewed.

If the UK or EP (UK) based registration is to be renewed the only documentation required is a certified copy of UK or EP (UK) Certificate of Registration showing the renewal issued by the UK IPO and an Authorisation of Agent (notarised).

It usually takes three months or less for the Registrar to process an application for renewal. Once the renewal is complete the Registrar will issue a Renewal Certificate.

### **Abandonment**

Please inform us as soon as possible if you wish to abandon your patent 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.

### **Restoration**

It is possible to make an application to the Registrar to restore an abandoned patent upon payment of any unpaid annual fees and penalties.

### **Assignment**

Please inform us as soon as possible if the patent has been assigned so that we can file an application to record the assignment in Montserrat (and the UK if necessary).

To record the assignment of a local patent registration the documentation required is the Deed of Assignment, a Declaration verifying the assignment (notarised), a Request to Enter Name on Register (Form L) and an Authorisation of Agent (notarised).

To record the assignment of a UK or EP (UK) based patent registration the documentation required is the Deed of Assignment, a Declaration verifying the assignment (notarised), a certified copy of the UK or EP (UK) extract showing the assignment issued by the UK IPO, a Request to Enter Name on Register (Form L) and an Authorisation of Agent (notarised).

It usually takes three months or less for the Registrar to process an application to record an assignment. Once the recording is complete the Registrar will issue a Certificate of Recordal of 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 Montserrat (and the UK if necessary).

To record a change of name and/or address for a local patent registration the documentation required is the official document evidencing the change (notarised) or an Affidavit verifying the change (notarised) and an Authorisation of Agent (notarised).

To record a change of name and/or address for a UK or EP (UK) based patent registration the documentation required is the official document evidencing the change (notarised) or an Affidavit verifying the change (notarised), a certified copy of the UK or EP (UK) extract showing the change issued by the UK IPO and an Authorisation of Agent (notarised).

It usually takes three months or less for the Registrar to process an application to record a Change of Particulars. Once the recording is complete the Registrar will issue a Certificate of Recordal of Change of Name and/or Address.

### **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, CITMA, MARQUES and IPCA.

### Contact Us

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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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