



Trade Marks Prosecution Fact Sheet

Popular UK Re-registration Countries

1	Anguilla	Page 2
2	Gibraltar	Page 3
3	Guyana	Page 4
4	Jersey	Page 6
5	Montserrat	Page 7
6	Solomon Islands	Page 9
7	St. Helena	Page 10

1 Anguilla

Type of filings	Both national applications and applications for the re-registration of UK trade mark registrations are accepted
Priority	Paris Convention Priority can be claimed, but Anguilla is not a party to the Paris Convention
Single or multi-class	Both single and multi-class applications are accepted
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected
Term of initial registration	<ul style="list-style-type: none"> • 10 years from the filing date for national registrations • UK re-registrations expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	<ul style="list-style-type: none"> • Due every 10 years with a 6-month grace period for national registrations • Due on the expiry of the underlying UK registration if UK-based and may be removed from the Register if not renewed within 12 months of expiry • Restoration is not available
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none"> • Original notarised Power of Attorney • Original notarised accompanying documents where relevant to the particular type of filing to be made, e.g. <ol style="list-style-type: none"> i) Assignment or licence agreements ii) Companies Registry certificates certifying changes of name / address / mergers iii) Affidavits certifying changes of name / address / mergers • UK-based applications/renewals/recordals: A certified hard copy of the underlying UK registration issued by UK IPO in addition to the above documents • Priority-based applications (new filings only): a certified hard copy priority document issued by the relevant IPO in English along with an original notarised priority declaration
Observations	Anguilla's trade mark filing and registration process is one of the smoothest in the Caribbean. The period from filing to registration can take as little as 4 months in straightforward cases. Office actions are seldom issued.

2 Gibraltar

Type of filings	<ul style="list-style-type: none">• Applications for the re-registration of UK trade mark registrations are accepted• Effective 1 January 2021, International Registrations designating the UK, and Comparable EU trade mark registrations and International Registrations designating the EU cloned onto the UK Register on 1 January 2021 are also protected automatically in Gibraltar; however, this does not preclude their re-registration in Gibraltar and there are benefits of re-registration when it comes to the exploitation and use of the trade mark in Gibraltar
Priority	Paris Convention Priority cannot be claimed even though Gibraltar is a party to the Paris Convention. This is because filings are currently limited to the re-registration of existing UK trade mark registrations.
Single or multi-class	Both single and multi-class applications are accepted, as dictated by the underlying UK trade mark registration
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected, as dictated by the underlying UK trade mark registration
Term of initial registration	To expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	Due on the expiry of the underlying UK registration and should be renewed within 3 months of the date of renewal in the UK for further 10-year periods
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none">• A certified hard copy of the underlying UK registration issued by UK IPO• Original notarised accompanying documents where relevant to the particular type of filing to be made, e.g. assignment or licence agreements / certificates of merger
Observations	Companies House Gibraltar provides a quick and efficient service. The period from filing to registration can take as little as 2 months.

3 Guyana

Type of filings	Both national applications and applications for the re-registration of UK trade mark registrations are accepted
Priority	Paris Convention Priority cannot be claimed. Guyana is a party to the Paris Convention, but there are no local implementing regulations.
Single or multi-class	<ul style="list-style-type: none"> • Single class applications only for national applications • Single and/or multi-class applications in respect of UK re-registrations as dictated by the underlying UK registration
Classification	<ul style="list-style-type: none"> • Nice (current Edition) for UK re-registrations • For national applications, the Fourth Schedule of the Trade Marks Rules applies to goods in classes 1 – 34
Protection of goods and services	<ul style="list-style-type: none"> • National registrations protect goods only • Services can be protected when re-registering a UK registration in Guyana if the UK registration covers the relevant services
Term of initial registration	<ul style="list-style-type: none"> • 7 years from the filing date for national registrations, which is also deemed to be the effective date of registration • UK re-registrations expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	<ul style="list-style-type: none"> • After the initial 7-year term, renewals are due every 14 years with a 1-month grace period for national registrations • Renewals are due on the expiry of the underlying UK registration if UK-based and may be removed from the Register if not renewed within the expiry/renewal deadline • Restoration is also possible after the expiry of the grace period in respect of national registrations
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none"> • Original signed Authorisation of Agent (one per application/registration and per type of work to be completed (e.g. new application, assignment recordal, renewal...)) • Original notarised accompanying documents where relevant to the particular type of filing to be made, e.g. <ol style="list-style-type: none"> i) Assignment or licence agreements ii) Companies Registry certificates certifying changes of name / address / merger iii) Affidavits certifying changes of name / address / mergers • UK-based applications/renewals/recordals: A certified hard copy of the underlying UK registration issued by UK IPO is also required in addition to the above

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Guyana (continued)

Observations

The Registrar automatically associates identical/similar marks owned by the same proprietor on examination – no office action is issued prior. Associated trade marks must be assigned together as a matter of law. However, as a matter of practice, the Registrar tends to take a lenient approach.

Office actions are frequently issued in respect of a likelihood of confusion with earlier applications/registrations and requests for disclaimers in respect of any descriptive words and/or words lacking distinctiveness.

Requests for clarity concerning any colour claims and codes are also common (a trade mark may be limited in whole or in part to one or more specified colours - if a trade mark is registered without limitation of colour, it is deemed to be registered for all colours).

4 Jersey

Type of filings	<ul style="list-style-type: none">• Applications for the re-registration of UK trade mark registrations are accepted• International registrations designating the UK, and EU trade mark registrations are also protected automatically in Jersey; however, this does not preclude their re-registration in Jersey and there may be benefits of re-registration in order to future-proof protection
Priority	Paris Convention Priority cannot be claimed even though Jersey is a party to the Paris Convention. This is because filings are currently limited to the re-registration of existing UK trade mark registrations.
Single or multi-class	Both single and multi-class applications are accepted, as dictated by the underlying UK trade mark registration
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected, as dictated by the underlying UK trade mark registration
Term of initial registration	To expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	Due on the expiry of the underlying UK registration and should be renewed within 12 months of the renewal due date in the UK at the latest, after which the Registrar may remove the trade mark from the Register after notifying the proprietor of same
Typical documentary requirements and formalities for key filings	A certified hard copy of the underlying UK registration issued by UK IPO is required
Observations	The Intellectual Property Registry provides a quick and efficient service. The period from filing to registration can take as little as 1 month.

5 Montserrat

Type of filings	Both national applications and applications for the re-registration of UK trade mark registrations are accepted
Priority	Paris Convention Priority cannot be claimed. Montserrat is not a party to the Paris Convention.
Single or multi-class	Both single and multi-class applications are accepted
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected
Term of initial registration	<ul style="list-style-type: none"> • 10 years from the filing date for national registrations, which is also deemed to be the effective date of registration • UK re-registrations expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	<ul style="list-style-type: none"> • Due every 10 years with a 6-month grace period for national registrations • UK-based registrations may be cancelled by the Registrar if not renewed within 3 months of the UK expiry/renewal deadline • Restoration is also possible in respect of national registrations if filed within 6 months of the expiry of the grace period/removal from the Register if, having regard to the circumstances of the failure to renew, it is just to renew • The Registrar also tends to allow an additional discretionary 6-month restoration period in respect of UK re-registrations as a matter of practice, although this is not provided for by law

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Montserrat (continued)

Typical documentary requirements and formalities for key filings

- **Original notarised** Authorisation of Agent per application/registration with details of mark / logo specified
- **Original notarised** accompanying documents where relevant to the particular type of filing to be made, e.g.
 - i) Assignment or licence agreements
 - ii) Official Registry forms to be signed by the applicant or relevant parties to the assignment / merger
 - iii) Companies Registry certificates certifying changes of name / address / mergers
 - iv) Affidavits or declarations certifying changes of name / address / mergers
- **UK-based applications/renewals/recordals:** A certified hard copy of the underlying UK registration issued by UK IPO is also required in addition to the above

Note: All documents must be signed by a director/officer/employee or general counsel of the proprietor and their capacity must be clearly stated on the Authorisation of Agent. If, on the other hand, an authorised signatory or attorney who is not an employee, director or officer of the proprietor signs, then a notarised true copy of the original Authorisation or Power granted from the proprietor to the authorised signatory or attorney must also be provided, as well as a notarised sworn declaration.

Observations

Montserrat's Registry is efficient at processing applications within 6 months or less, but the formality requirements and amount of paperwork can be onerous compared with some of the other Caribbean countries.



Solomon Islands

Type of filings	Applications for the re-registration of UK trade mark registrations are accepted
Priority	Paris Convention Priority cannot be claimed. The Solomon Islands is not a party to the Paris Convention.
Single or multi-class	Both single and multi-class applications are accepted, as dictated by the underlying UK trade mark registration
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected, as dictated by the underlying UK trade mark registration
Term of initial registration	To expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	Due on the expiry of the underlying UK registration and should be renewed as soon as the UK registration has been renewed for further 10-year periods
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none">• A certified hard copy of the underlying UK registration issued by UK IPO• Letter setting out the details of the application to be filed• It is also advisable to submit a simply signed original Power of Attorney
Observations	The Registrar General's Office operates a manual, paper-based system. The period from filing to registration can take around 6 months and much depends on the allocation of resources at the relevant time.

7 St Helena

Type of filings	Applications for the re-registration of UK trade mark registrations are accepted
Priority	Paris Convention Priority cannot be claimed. St. Helena is not a party to the Paris Convention.
Single or multi-class	Both single and multi-class applications are accepted, as dictated by the underlying UK trade mark registration
Classification	Nice Classification
Protection of goods and services	Both goods and services may be protected as dictated by the underlying UK trade mark registration
Term of initial registration	To expire on the same date as that of the underlying UK registration unless renewed for further 10-year periods
Renewals	Due on the expiry of the underlying UK registration and should be renewed as soon as the UK registration has been renewed and in any event within 6 months of the date of renewal in the UK for further 10-year periods
Typical documentary requirements and formalities for key filings	<ul style="list-style-type: none"> • A certified hard copy of the underlying UK registration issued by UK IPO • Simply signed original Appointment of Agent (Form 1) • Scanned accompanying documents are required where relevant to the particular type of filing to be made, e.g. <ul style="list-style-type: none"> i) Assignment or licence agreements ii) Companies Registry certificates certifying change of name / address / mergers • If filing a renewal or recordal of assignment, merger, change of name or address, etc. the original St. Helena trade mark registration certificate must also be provided for endorsement; if unavailable a certified copy must be ordered for this purpose
Observations	The Judicial section of the St. Helena Government operates a manual, paper-based system. The period from filing to registration can take around 6 months and much depends on the allocation of resources at the relevant time.